

**BL O/347/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3285984**

**BY**

**KIWI SKIN LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 44:**

 **SKINOLOGY**

**AND**

**OPPOSITION THERETO (NO. 413374)**

**BY**

**LA COLLINE INTERNATIONAL**

## **Background and pleadings**

1. Kiwi Skin Limited (the applicant) applied to register the trade mark:



in the UK on 21 February 2017. It was accepted and published in the Trade Marks Journal on 11 May 2018, for the following services:

**Class 44:** Botulinum toxin treatments; dermal filler treatments; providing dermatological treatments; microdermabrasion treatments; skin peel treatments; radio frequency skin tightening treatments; fractional laser skin treatments; mole and skin tag removal treatments; LED light skin treatments; body fat freezing treatments; cellulite and body shaping treatments; laser treatment for hair removal; sweating reduction treatments; lines and wrinkles skin treatments; acne treatments; unwanted hair removal treatments; unwanted fat or cellulite removal treatments; age spots and pigmentation removal treatments; facial thread veins and redness removal treatments; leg thread veins removal treatments.

2. La Colline International (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is raised against all of the services of the application.
3. The opposition is based on earlier European Union Trade Mark (EUTM) 4740791, filed on 24 November 2005 and registered on 15 December 2006, in classes 03 and 05, for the mark:

SKIN · OLOGY

4. For the purposes of this opposition, the opponent relies only on the class 03 element of its registration, namely:

**Class 03:** Soaps, perfumes, cosmetics, make-up removing preparations, beauty masks, lipsticks.

5. Following submissions from the applicant, the opponent, in correspondence dated 25 March 2019, restricted the scope of the goods on which it relies for the purposes of this opposition to:

**Class 03:** Cosmetics; beauty masks.

6. Given the date of registration, the opponent's mark qualifies as an earlier mark in accordance with Section 6 of the Act and is subject to the proof of use provisions contained in Section 6A.

7. In its statement of grounds, the opponent claims that:

- As the letter 'A' in the later mark is in a logo format, the dominant, memorable and aural part of that mark is the word element 'SKINOLOGY'.
- The marks at issue are aurally, visually and conceptually highly similar as they share the same distinctive element 'SKINOLOGY'.
- Applying the principle of imperfect recollection, the average consumer would confuse the two marks directly or would see the later mark as an extension or sub-brand of the opponent's earlier mark.
- The opponent's earlier goods in class 03 are similar to all of the applied for services in class 44 of the later mark.
- The nature and purpose of the goods and services at issue are to change and enhance the features of the consumer's face and body. As such they are identical.

- The goods and services at issue can be sold through the same channels, e.g. at beauty salons and health spas.
- Given the similarities between the marks and the goods and services, there is a likelihood of confusion which includes a likelihood of association.

8. In its counterstatement the applicant states that:

- The opponent's claim that the applied for mark is the letter 'A' in a logo combined with the word 'SKINOLOGY' is incorrect. The mark is the word 'ASKINOLOGY'.
- Placing the letter 'A' in the applied for mark in a hexagon, does not sufficiently divorce that letter from the rest of the word elements in the mark, such that the dominant part can be said to be the word 'SKINOLOGY'. The letter 'A' is the same size and font and has the same spacing as the rest of the letters in the later mark.
- The only realistic interpretation of the applied for mark is the word 'ASKINOLOGY', nobody would read it as 'A SKINOLOGY' as this makes no grammatical sense.
- The marks are not similar enough to give rise to any likelihood of confusion. The initial letter 'A' results in the distinctive prefix 'ASKIN' which has very different visual, phonetic and conceptual meanings to the prefix 'SKIN' of the earlier mark.
- The applied for services are not similar to the earlier goods. The goods and services at issue do not share nature or purpose. It is untenable for the opponent to claim that the goods and services are all intended 'to change and enhance features of the consumer's face and body', for example, soap and Botox treatments are very different products and could not be considered similar. The services at issue have a medical or quasi-medical nature and are

technical in nature. The user of such services will have to travel, complete medical forms, undergo specialist treatment and a recovery process.

- The goods and services are not complementary, they are not used in conjunction with each other, they are not purchased together and there would be no expectation that the provider of the applicant's services would also manufacture the opponent's goods.
- The goods and services will not be sold through the same channels of trade. The applicant's services will be provided in a clinical setting and not in a health spa or beauty salon.
- There is no likelihood of confusion between the marks at issue.
- The applicant put the opponent to proof of use.

9. The opponent filed proof of use evidence and submissions in writing. The applicant filed written submissions, in which it commented on the opponent's statement of grounds and evidence. I will not summarise the written submissions of either party here, but will refer to them when necessary, throughout my decision.

10. As no hearing was requested, this decision is taken following a careful perusal of the papers.

11. Throughout the proceedings the applicant has been represented by Baron Warren Redfern and the opponent has been represented by Dolleymores.

### **Evidence**

12. The opponent submitted evidence of use in the form of a witness statement of Mr Jerome Desouches, the President of the opponent company La Colline International, along with several exhibits numbered JD1 - JD9. Only exhibits JD1, JD2 and JD4 provide information directly relating to the use of the opponent's earlier mark.

13. In his witness statement, Mr Desouches establishes his position in the opponent company and goes on to summarise the contents of the exhibits accompanying the witness statement.

- **JD1:** this exhibit contains a number of photographs showing the packaging used for the opponent's 'SKIN · OLOGY' products as well as the cover page and 'SKIN · OLOGY' pages from the opponent's Skincare Programme brochure, showing 'SKIN · OLOGY' products.
- **JD2:** is comprised of a large number of invoices which date between 2012 and 2017 and show sales of the opponent's 'SKIN · OLOGY' goods to customers in France. These goods are packaged as per the goods shown in exhibit JD1.
- **JD3:** comprises a Wikipedia extract showing that as of 01 January 2018, France has a population of approximately 67 million people which is 13% of the EU population. France is the second largest constituent population in the EU.
- **JD4:** comprises webpages from the internet archive website (Wayback Machine). These webpages show the opponent's website 'www.lacolline-skincare.com' on 08<sup>th</sup> May 2016 and 18 January 2017, offering the opponent's goods under the 'SKIN · OLOGY' brand name.

#### **Evidence supporting the opposition**

14. The opponent also provided information intended to support its claims in respect of the nature of its goods and the applicant's services. This information forms exhibits JD5 – JD9. I summarise these exhibits below for the sake of completeness and will deal with this information later in my decision if and where I feel it may be appropriate to do so. These exhibits do not have any bearing on the issue of genuine use of the earlier mark and form no part of my assessment of such.

- **JD5:** the opponent claims that its goods in class 03 are cosmeceutical products which contain a bioactive ingredient. Exhibit JD5 comprises webpages from

Wikipedia defining the term 'cosmeceutical'. I note that the Collins English Dictionary defines 'Cosmeceutical' as a cosmetic that has, or is claimed to have, pharmaceutical properties.<sup>1</sup>

- **JD6:** this exhibit comprises pages taken from the applicant's website showing the applicant advertising the services of its Facial Bar alongside treatments such as Botox, Intense Pulsed Light treatments, Dermal Filler treatments etc. The page detailing the applicant's Facial Bar shows that it provides non-invasive treatments using cosmeceuticals alongside these treatments. This information is provided by the opponent as the applicant has claimed that the goods and services at issue are not complementary to, in competition with, or sold through the same trade channels. The opponent suggests that the information in JD6 shows that the goods and services can be seen to be complementary or in competition.
- **JD7:** this exhibit contains pages taken from a small selection of UK based aesthetics clinics that provide a similar range of services to those of the applicant. It shows that other UK based providers of such services also sell goods that may be taken away by a consumer in order to perform certain treatments at home.
- **JD8:** The applicant has stated that the services it provides are technical treatments which cannot be self-administered and can only be performed by a professional in a clinical setting. This exhibit comprises webpages showing products available to purchase from Amazon.co.uk which enable the consumer to self-administer some of the services which the application covers, in their own homes. The goods on offer include dermal filler treatments and lines and wrinkle skin treatments.
- **JD9:** this exhibit comprises a webpage from the website of NHS Direct Wales regarding the regulation of non-surgical procedures. It states "...these

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

procedures aren't regulated in the same way as cosmetic surgery, and practitioners of many treatments don't require medical qualifications." The only procedures listed on the NHS Direct Wales webpage that correspond with the services in the application, and which require a medical qualification to administer, are Botox treatments. The opponent states therefore that the applicant's claim that the later services cannot be administered by an unqualified person outside of a specialised clinic are false.

## **Decision**

### **Proof of use**

15. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

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),  
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)  
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed  
before the start of the period of five years ending with the date of  
publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

(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.”

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.”

16. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed, or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet

for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

17. According to section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. Consequently, the relevant period begins on 12 May 2013 and ends on 11 May 2018.

18. The evidence in exhibit JD1 is comprised of four photographs of the opponent's products, all displaying the earlier mark; a cover sheet referring to a 'skincare programme' and a page of marketing text providing information about the opponent's goods. The page of informational text is in English. The first photograph shows a box labelled with the earlier mark and also the terms 'Cellular Facial Anti-Aging Programme' and 'Programme Cellulaire Anti-Age Visage'. Based on the comments of Mr Desouches in paragraph 4 of his witness statement, this is a product sold by his company as a programme (a kit) which contains three items, a cellular modelling bio-peel; a cellular face energizing collagen mask and a cellular intense radiance serum. The other three photographs show the individual items that make up the programme. None of the pages in exhibit JD1 are dated.
19. The evidence in JD2 comprises a large number of invoices of the opponent, all showing sales of an item listed either as a 'Cellular Facial Anti-Aging Programme' or a 'Programme Cellulaire Anti-Age Visage'. Some of these invoices predate the relevant period, however the majority of the invoices fall within the relevant period.
20. I accept that the product listed on all of the invoices in JD2 tallies with the item shown in the first photograph of exhibit JD1, namely the programme containing a cellular modelling bio-peel; a cellular face energizing collagen mask and a cellular intense radiance serum. The fact that the photographs in JD1 are undated is mitigated by the dates clearly shown on the invoices in JD2.
21. The invoices in JD2 that fall within the relevant period amount to approximately €20,000 euros in sales of the item referred to above, namely the programme listed as 'Cellular Facial Anti-Aging Programme' or a 'Programme Cellulaire Anti-Age Visage'. The invoices show sales only in France, as the applicant has pointed out. Sales of the opponent's goods have however been made across several towns and cities in France, covering a fairly wide geographical spread including Paris, Grenoble and Marseilles.
22. Exhibit JD4 shows that the opponent has, through its website 'www.lacolline-skincare.com', generated exposure to its products widely. This exhibit also shows use

in the English language, which suggests that the opponent has actively targeted a customer base outside of the territory of France.

23. In '*Sant Ambroeus*'<sup>2</sup>, Ms Anna Carboni, sitting as the Appointed Person (AP) stated:

57. That brings me to the *Sonia Rykiel* case, from which the hearing officer relied on the passages set out at paragraph 34 above. That case also concerned the use of a trade mark in relation to clothing. The CFI began its findings in the usual way, citing article 43(2) and (3) of the old Regulation and the proof of use provisions under rule 22(2) IR, and considering the authorities on the meaning of genuine use. Having referred to the fact that scale and frequency of use of the mark were among the factors to be taken into account, the CFI added the following:

“40. As regards the scale of the use made of the earlier trade mark, account must be taken of, inter alia, first, the commercial volume of all the acts of use and, second, the duration of the period over which the acts of use were carried out and the frequency of those acts (judgment of 14 December 2006 in Case T-392/04 *Gagliardi v OHIM – Norma Lebensmittelfilialbetrieb (MANŪ MANU MANU)*, not published in the ECR, paragraph 82).

41. To examine whether an earlier trade mark has been put to genuine use in a particular case, an overall assessment must be carried out, taking account of all the relevant factors in the case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing

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<sup>2</sup> BL O/371/09

capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court of Justice has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark (order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21; *LA MER*, cited in paragraph 32 above, paragraph 57; see, by way of analogy, *Ansul*, cited in paragraph 21 above, paragraph 39).

42. ...

43. The Court of Justice also added, in paragraph 72 of its judgment in Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, that it was not possible to determine *a priori* and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down. Thus, in that judgment, the Court held that, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use.”

24. The opponent has shown sales of its goods during the relevant period. Whilst the sales figures are not particularly substantial, they do show regular and consistent use of the mark on at least a part of the relevant goods.

25. The evidence provided by the opponent cannot be said to be token or ‘sham’, in the sense that the opponent has shown only use intended purely for the purpose of maintaining the trade mark. It is also the case that a small amount of use can be deemed to amount to genuine use in certain circumstances and that no *de minimis* rule should apply. The assessment of evidence of genuine use cannot be based solely

on the volume of sales of goods or services, a multi-factorial assessment must be carried out.

26. The applicant, in written submissions, has referred to case law in respect of the question of genuine use of an EUTM. The applicant claims that it has been established that use of an EUTM in just one Member State is not sufficient to sustain an EUTM against revocation under Article 58 EUTMR and hence also insufficient to sustain an EUTM as the basis for a UK trade mark opposition under Section 6a of the Act. In *The Sofa Workshop Ltd v Sofaworks Ltd*, [2015] EWHC 1773 (IPEC), Hacon J considered the CJEU's decision in *Leno Merken BV v Hagelkruis Beheer BV* (C-149/11) where it was found that *'it may be necessary to have used the mark in more than two Member States, depending on the size of the market for the relevant goods or services in the States concerned when compared to the market in the Community as a whole'*
27. The opponent, in response to the applicant's comments, stated that the decision in *Leno*, left it to the relevant court hearing the proceedings to decide the matter of genuine use, based on evidence and the multi-factorial assessment required, including the characteristics of the market concerned, the nature of the goods or services protected by the mark and the territorial extent and scale of use as well as its frequency and regularity.
28. The opponent also referred to the General Court (GC) and the decision in *Now Wireless Ltd v OHIM* (T-278/13) which referred to Arnold J in *London Taxi* and ruled that use in a single Member State can suffice to sustain an EUTM when considered as an element of the correct multi-factorial assessment for genuine use.
29. The opponent also noted that in *Fruit of the Loom Inc* (T-431/15, paras 59/60) the GC found that it was *"sufficient that the goods were on the market and available, there is no requirement that they actually be sold"* and that in *La Mer Technology Inc v Laboratoires Goemar SA*, it was found that quantity of sales was not decisive to show genuine use, but how the mark has been used and whether this use constituted real, commercial exploitation of the mark.



30. The opponent also disputed that it had only used the mark in France and referred to the website pages comprising exhibit JD4. The website pages are in English whilst the prices displayed are in Euros. The opponent claims that its website is used widely throughout the EU and it has not restricted the advertising of its products to a single EU territory. It is worth noting in this regard that the website domain name suffix is '.com' and not '.fr', however it is also noteworthy that no evidence of sales activity outside of France has been provided. Advertising via the opponent's website suggests that exposure to the opponent's mark and products has not been limited to France, however it is also worth noting that France comprises 13% of the population of the EU, which suggests that sales of the opponent's products only in France is of significance and must be given due weight.
31. Applying the principles set out above in paragraph 16, I find that the earlier mark has been shown to be in genuine use by the proprietor. That use cannot be said to be merely token use, the opponent has provided evidence that shows use of the mark between 2012 and 2017. The use shown in evidence is clearly trade mark use intended to distinguish the goods of the opponent from other goods which have a different origin. I find the use shown in evidence to be use of the mark intended to create or preserve a place in the relevant market. There has been real commercial exploitation of the mark, in order to create and maintain a market share. The scale and frequency of use of the mark has been established. Whilst there have not been very high levels of sales, sale of goods under the mark has been established and is reasonable. There has been regular and consistent use of the mark throughout the relevant period. The mark has however, only been shown in use on a part of the goods on which the opponent relies.
32. I conclude therefore, that the evidence submitted by the opponent is sufficiently clear and detailed and is sufficiently solid to prove genuine use of the mark relied upon. Accordingly, I find that there has been genuine use of the opponent's earlier mark during the relevant period.

## **Fair Specification**

33. I now need to determine a fair specification to reflect the use made. 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.”

34. 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.

“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."

35. For the purposes of this opposition the opponent has relied upon 'cosmetics' and 'beauty masks'. The term 'cosmetics' is a very broad term that encompasses a wide range of products such as lipstick, eye liner, facial creams and powders etc. The term 'beauty masks' is somewhat vague but clearly encompasses a mask for the face that is intended to beautify by e.g. moisturising the skin.

36. Following analysis of the opponent's evidence, I do not accept that the opponent has shown genuine use on a sufficiently broad range of goods such that I can accept the term 'cosmetics'. The evidence has shown, primarily through the combination of information within exhibits JD1 and JD2, that the opponent has used its earlier mark on an anti-aging programme specifically intended for use on the face. This programme is provided in a 'kit' form. The opponent states in paragraph 4 of the witness statement

of Mr Desouches, that the programme is comprised of a cellular modelling bio-peel; a cellular face energizing collagen mask and a cellular intense radiance serum.

37. Based on the information shown in evidence, I conclude that a fair specification for the earlier mark is:

**Class 03:** Facial peels; facial masks and facial serums.

**Section 5(2)(b) of the Act**

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

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

(a) ....

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

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

39. The following principles are gleaned 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.

## **The principles**

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

40. In the judgment of the Court of Justice of the European Union 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”.

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

42. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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”.

43. The parties’ respective specifications are:

<b>Earlier mark</b>	<b>Application</b>
<b>Class 03:</b> Facial peels; facial masks and facial serums.	<b>Class 44:</b> Botulinum toxin treatments; dermal filler treatments; providing dermatological treatments; microdermabrasion treatments; skin peel treatments; radio frequency skin tightening treatments; fractional laser

	<p>skin treatments; mole and skin tag removal treatments; LED light skin treatments; body fat freezing treatments; cellulite and body shaping treatments; laser treatment for hair removal; sweating reduction treatments; lines and wrinkles skin treatments; acne treatments; unwanted hair removal treatments; unwanted fat or cellulite removal treatments; age spots and pigmentation removal treatments; facial thread veins and redness removal treatments; leg thread veins removal treatments.</p>
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44. The applicant's services are all intended to provide beautification of the body through e.g. the removal of wrinkles, acne scars, hair and thread veins. The opponent's goods are intended to beautify the face of the users. These goods and services therefore coincide in respect of intended purpose. They can also coincide in respect of end consumers and trade channels, as the earlier goods can be provided alongside the contested services and to a certain extent, vice versa.

45. I must also consider complementarity. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria 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 General Court stated that "complementary" means:

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



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

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

Whilst on the other hand;

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

47. In exhibit JD7, it can be seen that other undertakings providing similar services to the applicant, also provide goods similar to the opponents, which the consumer may purchase and take away for use at home. Whilst the applicant has stated that they do not provide goods in this way, it is evident that such a practice is far from unusual in the relevant market.

48. I therefore find the applicant's services similar to a medium degree to the opponent's goods.

#### **Average consumer and the purchasing act**

49. 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*.

50. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

51. The goods and services at issue are day to day items such as face masks and peels, and more specialised services such as laser skin treatments. Irrespective of the nature of these goods and services, or the selection process involved, I find that the average consumer of both the goods and the services will be a member of the general public.

52. Decisions taken on the selection of these kinds of goods and services are generally important to most consumers. In respect of the services at issue, they are often also decisions not taken frequently, for example, the selection of a laser skin treatment service. The average consumer of such services would generally pay a high level of attention when selecting a service provider. The goods at issue are more likely to be day to day purchases, to which the average consumer would still pay a reasonable level of attention, however not the very highest level of attention.

53. The goods and services at issue are both likely to be selected by visual means, from websites, television advertisements, brochures, newspapers, magazines, etc. Word of mouth recommendation may also play some part in the selection process, so aural consideration is also important.


## Comparison of marks

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

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

55. It would be wrong, therefore, to dissect the trade 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.

56. The marks to be compared are:

Earlier mark	Contested mark
SKIN · OLOGY	

57. The earlier mark consists of the words ‘SKIN’ and ‘OLOGY’, separated by a dot. The word ‘SKIN’ has an obvious meaning, and the suffix ‘OLOGY’ will be understood to

refer to a 'science or other branch of knowledge'.<sup>3</sup> Neither element can be said to be more dominant or distinctive within the mark and both elements make an equal contribution to the whole. The overall impression of the earlier mark lies in its totality.

58. The later mark is comprised of a letter 'A' placed in a hexagon, followed by the word 'SKINOLOGY'. Whilst the logo element of a letter 'A' in a hexagon forms the first part of the mark, the verbal element 'SKINOLOGY' forms the majority of the whole and can be said to be the more dominant element due to its length and the visual impact of the bold and non-bold combination of typeface. Whilst the initial element of the mark cannot be overlooked, due to its dominance the word 'SKINOLOGY' can be said to play a greater role in the mark.

### **Visual similarity**

59. The marks are visually similar inasmuch as they both contain the word 'SKIN' and the suffix 'OLOGY', sharing those nine letters in identical order. They differ in the separation of those elements in the earlier mark and in the dot placed between them which has no counterpart in the later mark, and in the letter 'A' presented in a hexagon in the later mark which has no counterpart in the earlier mark. The word 'SKIN' in the later mark, whilst conjoined with the suffix 'OLOGY' is presented in a darker typeface which serves to distinguish the two verbal elements. The presentation of the letter 'A' within a hexagon border, serves to set that element apart from the word element 'SKINOLOGY'.

60. Weighing up the similarities and differences, I find the marks to be visually similar to a high degree.

### **Aural similarity**

61. The opponent's earlier mark will be enunciated as /SKIN/OL/OGEE/. The applicant's contested mark will be articulated as /AY/SKIN/OLO/OGEE/ by those consumers who enunciate the letter 'A'. It is however possible that due to its presentation, the letter 'A'

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<sup>3</sup> [https://www.collinsdictionary.com/dictionary/english/ology\\_1](https://www.collinsdictionary.com/dictionary/english/ology_1)

in the later mark may not be articulated at all. For the consumer who articulates all of the elements in the later mark, the marks can be said to be aurally similar to a high degree. For the consumer who will not articulate the letter 'A' in the later mark, the marks are aurally identical.

### **Conceptual similarity**

62. The letter 'A' in the later mark may be perceived as a code number because of the way in which it is presented in the mark. It may alternatively be perceived as the indefinite article, referring to something or someone. Whichever way that it may be perceived, it plays no clear or obvious conceptual role in the mark. The words 'SKIN' and 'OLOGY' both have meanings that are likely to be understood by the average consumer and, whilst creating an invented term when combined, will ultimately convey the notion of science or knowledge applied in some way to the skin.
63. The earlier mark will be perceived as the word 'SKINOLOGY' in spite of the separation of the two elements and the dot placed between those terms. The average consumer will perceive the same concept in the earlier mark as in the later, namely science or knowledge applied in some way to the skin.
64. As both marks convey the same message, they are considered to be conceptually identical.
65. In conclusion, the marks have been found to be visually highly similar, aurally highly similar or identical, and conceptually identical.

### **Distinctive character of the earlier trade mark**

66. 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).”

67. The opponent has not claimed that its earlier mark has an enhanced distinctive character through use. I therefore have only the inherent position to consider.

68. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

69. The opponent’s mark is comprised of the elements ‘SKIN’ and ‘OLOGY’ separated by a small dot. The common elements between the marks at issue are the verbal elements ‘SKIN’ and ‘OLOGY’. Although the earlier mark forms an invented term, I believe that the average consumer will understand the meaning of the whole, as set out above in paragraphs 62 and 63. I therefore find the earlier mark to be inherently distinctive to an average degree.

### **Likelihood of Confusion**

70. I now draw together my earlier findings into a global assessment of the likelihood of confusion, keeping in mind the legal principles established previously (see paragraph 39 above).

71. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks side by side but must instead rely upon the imperfect picture of them he has retained in his mind.

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods/services down to the responsible undertakings being the same or related.

73. I have already found that:

- the goods and services are similar to a medium degree;
- the marks are conceptually identical, visually highly similar and phonetically highly similar or identical;
- the average consumer will be a member of the general public;
- the consumer can be expected to be paying a high level of attention when selecting the services at issue, and a reasonable level of attention during selection of the goods at issue;
- during the selection process, the visual and aural considerations will both be important;
- the earlier mark has an average level of inherent distinctiveness;
- The word 'SKINOLOGY' is the dominant element in the marks to hand.

74. Having weighed up all of the factors, I conclude that there is no likelihood of direct confusion between the marks. The average consumer is likely to be paying greater than average attention during the purchasing act and will not mistake one mark for the other. The initial element in the applicant's mark will not go unnoticed.

75. I must therefore go on to consider the potential for indirect confusion between the marks.

76. 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.

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).”

77. The word ‘SKINOLOGY’ has been found to be the dominant element within each mark. The logo element of a letter ‘A’ in a hexagonal border in the later mark will not go unnoticed, but, having a conceptually neutral impact, will be considered by the average consumer to be an element incorporated to indicate a sub-brand or brand extension of the earlier mark. Consequently, a consumer who is aware of the earlier ‘SKIN · OLOGY’ brand will, when faced with the applicant’s mark, assume that that mark is simply a brand extension of the opponent’s range of goods.

78. Whilst I accept that indirect confusion should not be reached merely because the marks share a common element, and that what is required by the average consumer is an instinctive reaction that leads them to the conclusion that the goods and services come from the same (or related) trade origin, I find that that instinctive reaction is present in this case.

## **Conclusion**

79. The opposition is successful, there is a likelihood of confusion between the marks. The application is therefore, subject to appeal, refused.

## **Costs**

80. The opponent has been successful and is entitled to a contribution towards its costs, which are sought on the usual scale (contained in Tribunal Practice Notice 2/2016). I award La Colline International the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for opposition	£100
Preparing the statement of case and considering the counterstatement	£300
Preparing written submissions and evidence and considering the applicant's written submissions	£500
Total	£900

81. I therefore order Kiwi Skin Limited to pay La Colline International the sum of £900. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 19<sup>th</sup> day of June 2019**

**Andrew Feldon  
For the Registrar  
The Comptroller-General**