

**BL O/0158/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3639136**

**BY**

**BORA CREATIONS S.L.**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**TRUE SKIN**

**AND**

**OPPOSITION NO. 427253 THERETO**

**BY**

**TRUE SKINCARE LIMITED**

## **Background and pleadings**

1. On 10 May 2021, Bora Creations S.L. (the “Applicant”) applied to register the word only trade mark **TRUE SKIN**. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 2 July 2021. Registration of the mark is sought in respect of the following goods:

Class 3      *Decorative cosmetics; high lighter; Bronzing powders; Face powder; Rouges; Make-up preparations; Concealers; Make-up bases; Make up foundations; Skin foundation; Cosmetic primers.*

2. On 1 October 2021, True Skincare Limited (the “Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is aimed against all of the goods in the contested application. For the purposes of the opposition, the Opponent relied upon all of the goods for which the following earlier United Kingdom Trade Mark (UKTM) is registered:

UKTM No. 3616430



**T R U E**

Filing date: 25 March 2021

Registration date: 20 August 2021

Class 3      *Cosmetics; soaps; perfumery; cosmetic kits; bubble bath; bath salts; body, face and skincare lotions, gels, oils, milks and creams; night creams and oils; lip balms; lip salves; skincare preparations; non-medicated foot cream; cosmetic hand cream; eye cream; creams for firming the skin; cosmetic preparations for skin firming; anti-aging moisturizer, toner, cleanser, creams and skincare preparations; organic*

*cosmetics; non-medicated cosmetics; body and facial washes and scrubs; facial toner; face and body masks; face serums; body serums; skin cleansers; gels; moisturisers; collagen preparations; facial peel preparations; herbal extracts for cosmetic purposes; cosmetic wipes, tissues and towelettes; cleaning pads impregnated with cosmetics; sun block; SPF sun block preparations, oils and lotions; sun protection lipstick; after sun lotion; nail oils; nail strengthening treatments; cleaner for cosmetic brushes; baby care products; baby lotions, shampoo, soaps, bubble bath; baby powder; baby oils; baby wipes; hair dye; beard dye; beard oils, balm, lotions and tints; hair pomade; pre-shaving preparations; shaving preparations; shaving balm, lotion, foam, soap, creams, gels and oils; aftershave balm; preparations for use after shaving; none being adhesives for affixing false nails.*

3. Since the filing date of the earlier mark predates that of the contested application, the Opponent's mark is considered to be an "earlier mark" in accordance with Section 6 of the Act. However, as the mark has not been registered for a period of five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

4. On 20 December 2021 the Applicant filed a counterstatement, in which it denied that the application offended under Section 5(2)(b), and argued that there is no likelihood of confusion between the marks.

5. The Applicant filed submissions, which were received on 25 July 2022. The Applicant submitted that there are significant visual differences between the marks, including an "eye-catching figurative element, which occupies around half of the overall area of the sign, appears in the prominent top and central position, and naturally draws the average consumer's attention". The Applicant referred to the contested mark containing eight letters arranged into two words, whilst the earlier mark contains only half the number of letters. The Applicant submitted that the highly stylised two middle letters in the earlier mark are distorted by the addition and removal of lines, which the Applicant argued makes it "difficult to clearly discern the particular

letters they represent, or to attribute any single or coherent meaning to them in combination”. The Applicant contended that due to the lack of clear and coherent identity of the two middle letters, the average consumer would be more likely to place reliance on the figurative element and stylisation when recalling the mark. For the reasons summarised above, the Applicant argued that the degree of visual similarity between the marks is low to negligible.

6. The Applicant argued that the degree of aural similarity is also low to negligible. According to the Applicant, this is because the contested mark consists of eight letters resulting in two syllables, whilst the earlier mark consists only of four letters. The Applicant again referred to the distortion of the two middle letters in the earlier mark, and argued the average consumer would struggle to identify and pronounce them.

7. The Applicant also argued that the distortion of the two middle letters impacts on the conceptual comparison of the marks, as the distortion will result in a lack of coherent meaning of the word in the earlier mark. The Applicant argued that even if the letters in the earlier mark were perceived to spell the word ‘TRUE’, this word has little inherent distinctive character and would be understood as a laudatory term used to indicate that the goods are “good, genuine or reliable”. The Applicant referred to two decisions of the Board of Appeal at the European Union Intellectual Property Office (EUIPO) to support this position, with said decisions finding that if the word ‘TRUE’ were to be used without additions it would merely be perceived as a laudatory advertising term (see R 2880/2014-1 and R 552/2017-5). The Applicant contended that in those instances where the average consumer perceives the term ‘TRUE’ in the earlier mark then the degree of similarity with the contested mark ‘TRUE SKIN’ would in any case be low because the term ‘TRUE’ in the contested mark is subsidiary, acting only to qualify the dominant component ‘SKIN’.

8. According to the Applicant, the goods at issue would be purchased predominantly by visual means and would have an average consumer who will display a medium degree of attention.

9. On 6 September 2022 the Opponent filed submissions in reply, within which it referred to a decision of the Opposition Division in the EUIPO (B 3115451), whereby the Opponent successfully opposed the Applicant’s application EUTM 18170353

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(TRUE SKIN) using its earlier mark EUTM 17951844 ( T R U E ). The Applicant's EU application was for an identical specification of goods. The Opponent also referred to the Board of Appeal decision at the EUIPO (R 1712/2021-5), which dismissed the Applicant's appeal against the above-mentioned Opposition Division's decision. In addition, the Opponent referred to the preliminary indication issued in accordance with Rule 19 of the Trade Marks Rules 2008 and Tribunal Practice Notice 3/2007, which found a likelihood of either direct or indirect confusion between the marks at issue.

10. The Opponent argued that the "relevant consumer will naturally attach greater significance to word elements, even when a mark incorporates visual elements". With this in mind, the Opponent submitted that with 'TRUE' being the only word element in the earlier mark it would carry greater weight and prominence. The Opponent refuted the Applicant's claims that the middle two letters of the word element in the earlier mark are indiscernible, and argued that the only possible word they could produce is either 'TREE', 'TIE', 'TRYE' or 'TRUE'. The Opponent argued that because the third letter is clearly neither an E, I or Y, the only word that the element could be perceived as being is 'TRUE'. The Opponent referred again to the Board of Appeal decision (R 1712/2021-5), which concluded that the middle two letters in the earlier mark would be perceived as 'R' and 'U'. The Opponent argued that because each of the marks contain the word 'TRUE' they are visually highly similar, especially when considering the second word in the contested mark (SKIN) is descriptive and will not be attributed any real significance by the consumer.

11. The Opponent also argued that because each of the marks contain the word 'TRUE' they share an identical phonetic element, and are therefore aurally similar to a high degree, especially when considering the second word in the contested mark (SKIN) is descriptive and may not even be pronounced by the consumer.

12. The Opponent argued that because the element 'SKIN' in the contested mark is descriptive, the marks are therefore conceptually highly similar as they share the concept of the "clearly recognised and understood" English word 'TRUE'.

13. The Opponent contended that the average consumer of the goods at issue is the public at large, without specialist knowledge, who will purchase the goods frequently. The Opponent argued that the goods at issue are identical.

14. No Hearing was requested. Only the Applicant filed submissions in lieu of a hearing, on 30 November 2022.

15. In its submissions, the Applicant stated that neither the preliminary indication issued by the UKIPO nor the Board of Appeal decision (R 1712/2021-5) issued by the EUIPO are binding. Further, the Applicant referred to the fact that it had appealed the decision of the Board of Appeal to the General Court of the European Union (EGC). This appeal is yet to be decided. The Applicant “wishes to point out” that the Opponent missed the deadline to indicate its intention to file evidence in reply by one day. I consider it pertinent to point out that the period set for filing evidence is administrative, rather than a statutory period set in accordance with the Trade Mark Rules 2008. As a result, and in accordance with Rule 62 of the Trade Mark Rules 2008, the Tribunal is prepared to accept the evidence as having been validly filed.

16. The Applicant referred to and reiterated its previous position regarding the visual, aural and conceptual comparison of the marks, and stipulated further that it rejected the Opponent’s assertion that the earlier mark presents the word ‘TRUE’, as the middle two letters are disfigured and not easily or readily recognisable. The Applicant disagreed with the Opponent’s contention that the distinctive character of the earlier mark extends to the word ‘TRUE’, which the Opponent had claimed was the main element of the earlier mark, as ‘TRUE’ is a common and laudatory word for ‘real’, ‘genuine’ or ‘authentic’. The Applicant argued that it is actually the “overall impression generated by the other elements...namely the figurative element and stylised font, that imbues the Opponent’s mark with the distinctive character it is claimed to possess.” Finally, the Applicant argued it is the “unusual, surprising, and inventive juxtaposition” of the combination of terms ‘TRUE’ and ‘SKIN’ that generates the contested mark’s distinctive character.

17. Both parties are represented. The Applicant is represented by Squire Patton Boggs (UK) LLP, and the Opponent is represented by Bird & Bird LLP.

## **Decision**

18. 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.

### **Section 5(2)(b)**

19. 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”.

20. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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**

21. The respective goods are.

Earlier mark	Application
<p>Class 3: <i>Cosmetics; soaps; perfumery; cosmetic kits; bubble bath; bath salts; body, face and skincare lotions, gels, oils, milks and creams; night creams and oils; lip balms; lip salves; skincare preparations; non-medicated foot cream; cosmetic hand cream; eye cream; creams for firming the skin; cosmetic preparations for skin firming; anti-aging moisturizer, toner, cleanser, creams and skincare preparations; organic cosmetics; non-medicated cosmetics; body and facial washes and scrubs; facial toner; face and body masks; face serums; body serums; skin cleansers; gels; moisturisers; collagen preparations; facial peel preparations; herbal extracts for cosmetic purposes; cosmetic wipes, tissues and towelettes; cleaning pads impregnated with cosmetics; sun block; SPF sun block preparations, oils and lotions; sun protection lipstick; after sun lotion; nail oils; nail strengthening treatments; cleaner for cosmetic brushes; baby care products; baby lotions, shampoo, soaps, bubble bath; baby powder; baby oils; baby wipes; hair dye; beard dye; beard oils, balm, lotions and tints; hair pomade; pre-shaving preparations; shaving preparations; shaving balm, lotion, foam, soap, creams, gels and oils; aftershave</i></p>	<p>Class 3: <i>Decorative cosmetics; high lighter; Bronzing powders; Face powder; Rouges; Make-up preparations; Concealers; Make-up bases; Make up foundations; Skin foundation; Cosmetic primers.</i></p>

<i>balm; preparations for use after shaving; none being adhesives for affixing false nails.</i>	
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22. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

23. 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.

24. It has also been established by the General Court (“GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 fur 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”.

25. The earlier mark is registered for *Cosmetics*. This is a general category that encompasses a broad scope of products and preparations for the purposes of beautification. Cosmetics are also used to treat, restore or improve a person’s appearance. The contested goods in Class 3 are all products and preparations used for such purposes, and are therefore considered to be identical under the *Meric* principle.

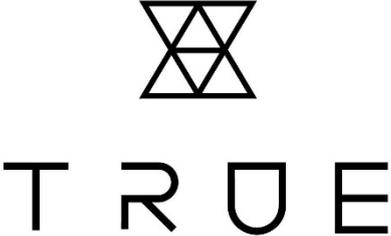
### **Comparison of the marks**

26. 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.”

27. 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.

28. The respective trade marks are shown below:

Earlier mark	Application
	<p style="text-align: center;"><b>TRUE SKIN</b></p>

29. The earlier mark is a figurative trade mark. It contains a device/graphical element consisting of two overlapping and inverted triangles, whereby the tip of one triangle is touching the central base of the other, and vice versa. This creates the image of a series of six smaller interconnected triangles, with three along the top hemisphere (with the outer triangles inverted), and three along the bottom hemisphere (with the inner triangle inverted). Below the device is a verbal element that in my opinion clearly contains the letters 'TR\_E'. The letters 'T' and 'E' are un-stylised and are in a standard font, whereas the letter 'R' is stylised to the degree that the top stem is missing. The element that appears between the letter 'R' and 'E' would, in my view, most likely be perceived to be a stylised letter 'U', despite its alien crossbar. Although in isolation the identification of the letter would be more arguable, it is my opinion that the human cognitive process and recognition patterns would perceive it as a letter 'U' due to its position within the four-letter term, which in this instance would most likely be perceived to be the word 'TRUE'. Although the verbal element is wider than the figurative element, I consider each element to be equally eye-catching and dominant, with neither element being clearly more distinctive than the other. In my opinion, the

distinctiveness of the contested mark lies in the overall impression created by the combination of both verbal and figurative elements.

30. The contested mark consists of the combination of words 'TRUE' and 'SKIN'. Each word is a recognised English language word, with 'TRUE' being understood as an adjective meaning accurate, reliable, sincere, genuine, not false, and 'SKIN' being understood as a noun meaning a layer of tissue that covers the body, or an outer layer. The word 'SKIN' is also a verb, meaning the action of removing skin, i.e., to skin an animal. Due to the fact that the combination of words 'TRUE SKIN' follows the rules of English grammar, insofar as the adjective describes the noun, I consider the word 'SKIN' to more likely be understood as referring to a layer (noun) as opposed to an action (verb). Also, in light of the combination's obvious accordance with the rules of English grammar, I believe that the two words will be perceived to hang together as a combination creating the meaning of a layer that is not false. This is an unusual concept. Neither of the two words can be considered to be more distinctive than the other and, because they are of equal size, I do not consider either word to be more dominant. The overall impression of the contested mark therefore derives from the combination of words 'TRUE SKIN', which is also where any distinctiveness lies.

### **Visual similarity**

31. Visually, the marks are similar insofar as their respective first, second and fourth letters coincide (i.e., 'T', 'R' and 'E'). For the consumer that would perceive the third letter of the earlier mark to be the letter 'U', the degree of visual similarity between the marks will increase due its coincidence with the third letter of the contested mark. This is the extent of the visual similarity. The presentation of the respective second letters is notably different, whilst the presentation of the respective third letters is even more different (in those instances where the third letter in the earlier mark will be perceived as stylised letter 'U'). The contested mark contains a second word consisting of four letters (SKIN), which has no counterpart in the earlier mark. Likewise, the earlier mark has a figurative element that has no counterpart in the contested mark. In view of the above, the marks are considered to be visually similar to no more than a low degree.

## **Aural similarity**

32. For the consumer who perceives the third letter of the earlier mark to be the letter 'U' (which in my opinion will be the majority of consumers), the marks are aurally similar to the extent that they share the identically pronounced word 'TRUE'. For the minority of consumers for whom the third letter is not the letter 'U', the marks will nonetheless coincide in the identical first sound created by the combination of letters 'TR'. The marks differ aurally due to the inclusion of the word 'SKIN' in the contested mark, which has no counterpart in the earlier mark. Whilst the Opponent has argued that the term 'SKIN' is descriptive in relation to the goods at issue, and therefore may not even be pronounced, it should be kept in mind that the descriptiveness of a word does not of itself render an element negligible or aurally invisible.<sup>1</sup> The figurative element is a device/graphical element that does not convey any immediate concept that would likely lead to it being pronounced. It therefore has no aural impact. In view of the above, for the consumer who perceives the word element in the earlier mark to be 'TRUE', the marks are considered to be aurally similar to a medium degree. For the consumer who does not perceive the word 'TRUE' in the earlier mark (due to the disguised third letter), the marks are considered to be aurally similar to an extremely low degree by virtue of only sharing the beginning 'TR'.

## **Conceptual similarity**

33. The figurative element contained within the earlier mark is a device with no inherent meaning, and therefore does not convey a conceptual message. The verbal element in the earlier mark will, in my opinion, be perceived as the word 'TRUE' by the majority of consumers. The word in the earlier mark has the concept of being genuine/not false. The contested mark also contains the word 'TRUE', and therefore also contains the concept of being genuine/not false. However, by way of being an adjective in a combination that hangs together, the word 'TRUE' in the contested mark is qualified as relating to 'SKIN', creating the concept of a layer that is not false. This overall concept is not identically replicated in the earlier mark. In fact, the concept of 'SKIN' is not present in the earlier mark at all, either as part of a combination or in

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<sup>1</sup> BL O-115-22 *Purity Hemp Company*

isolation. In view of the above, the marks are considered to be conceptually similar to no more than a low degree.

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

34. 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.<sup>2</sup> 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.”

35. The majority of goods at issue relate to the cosmetic and beautification world, although some are more closely aligned to the hygiene and care/protection fields. All of the goods at issue are considered to be everyday products, insofar as they are bought and used daily/frequently. Although there will likely be instances whereby certain goods (e.g., cosmetics) are promoted as being more high-end or “premium” / “luxurious” than others, which in turn will be reflected in their pricings, there will likely be an equal number of instances where those same goods are indicated as being more “basic”, lower-budget alternatives. In general, the goods at issue fall within a generally affordable price range of inexpensive items. The relevant public will be the average consumer, whose level of attention will range from low for the inexpensive items to medium/high for the more “premium” / “luxurious” items. In such instances it is important to recognise that even the more high-end goods are not specialist items, in which case the level of attention will overall be no more than medium.

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<sup>2</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

36. Based on the nature of the goods at issue they will most likely be purchased in a store, or online, or via a magazine. With this in mind I consider the purchase process to be primarily visual. However, I do not discount the possibility that the goods may also be bought over the telephone from a telemarketer, or following consultation with a shop assistant, for example, in which case both interactions will rely heavily on an oral exchange. Therefore, there may also be an aural element to the purchasing process.

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

37. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has the Opponent filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

38. 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).”

39. In *Kurt Geiger v A-List Corporate Limited* BL O-075-13, Mr Iain Purvis K.C., acting 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.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

40. It is noted that the Applicant has argued that the word ‘TRUE’ has little inherent distinctive character, and would likely be understood as a laudatory term that is used to indicate the goods at issue are real, genuine or authentic. Whilst I agree that in general the word ‘TRUE’ has such connotations, the meaning must be assessed in relation to the goods at issue and not in the abstract. As such, I consider the relationship between the word ‘TRUE’ and the cosmetic/hygiene products etc., to be more vague or allusive rather than directly descriptive. In addition, it must be acknowledged that the word ‘TRUE’ in the earlier mark is stylised, with a distinctive version of the letters ‘R’ and ‘U’. Further, the earlier mark contains a distinctive

device/graphical element. Overall, the earlier mark is considered to be inherently distinctive to between a medium and high degree.

### **Likelihood of confusion**

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

42. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely

primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

44. In *Quelle AG v OHIM*, Case T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

45. Having conducted a full analysis and thorough comparison of both the marks and their respective goods at issue, I have determined that it is the visual considerations which are of a greater importance in the assessment of a likelihood of confusion, due to the purchasing process being visually dominated. In this regard, I refer to the fact that I have found the marks to be visually similar to no more than a low degree. It should not be forgotten that I also considered the aural aspect to be prevalent in certain purchasing situations, in which case I refer to the fact that I have found the marks to be aurally similar to either a medium or extremely low degree, depending on whether or not the word 'TRUE' is perceived. As to the relevant public, I have found it to be the average consumer, who is considered to be reasonably well informed and reasonably observant and circumspect,<sup>3</sup> and whose level of attention will overall be no more than medium for the goods at issue.

46. I find it is useful to first address the perception of the term 'SKIN' in the contested mark, which the Opponent has argued is descriptive to the extent that it will not be attributed any real significance by the consumer, and may not even be pronounced. I do not entirely agree. I am aware of the finding in *Lloyd Schuhfabrik Meyer*, whereby the CJEU found that the assessment of the distinctive character of a mark should take into account whether or not that mark contains a descriptive element. I would tend to agree that in isolation the term 'SKIN' is directly descriptive (or at least non-distinctive) of a characteristic of the goods at issue, insofar as it is the part of the body to which one would apply the products. However, as I have made clear, the contested mark consists of the combination of two words 'TRUE SKIN', which in my opinion hang together to create the unusual and ultimately distinctive concept of a layer that is not false. It is my opinion that the contested mark will most likely be perceived by the average consumer as the combination 'TRUE SKIN', rather than the word 'TRUE' plus an arbitrary and secondary descriptive element. In addition, even if the word 'SKIN' were to be perceived merely as a secondary descriptive element, the word is nevertheless neither negligible nor aurally invisible, and therefore it creates at least a visual and aural distinction between the marks.

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<sup>3</sup> See paragraph 60 of *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*.

47. In my opinion, the verbal element in the earlier mark will be perceived by the average consumer as being the word 'TRUE'. Whilst the middle two letters are of a different font than the other two letters in the mark, I nevertheless consider them to be sufficiently clear in the context of the term as a whole to contribute to the creation of a stylised version of the word 'TRUE'. The word 'TRUE' is clearly present in the contested mark as part of the two-word combination that hangs together, 'TRUE SKIN'. The marks at issue therefore coincide in the only verbal element of the earlier mark, and the beginning of the contested mark, which is where the consumer normally attaches more importance.<sup>4</sup> However, this does not mean that the marks are subsequently automatically confusable. It is established in case law that a stylised form of a word should not be considered to be identical to its non-stylised equivalent. In *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16, the GC held that the mark shown below was not identical to the word mark CREMESPRESSO.

**CR**eMESPRESSO

The court stated that:

“According to the case law, word marks are marks consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element (see, to that effect, judgment of 7 October 2010, *Accenture Global Services v OHIM - Silver Creek Properties (acsensa)* (T-244/09) not published, EU:T:2010:430 , at [28] and the case-law cited). Therefore, the applicant’s claim that the protection of the earlier mark held by it would also apply with respect to the variations of stylisation CReMESSO and **CReM** ESSO must be rejected.”

48. Therefore, a word mark registered in standard characters may be considered to cover the use of the same word(s) presented in any normal font. This is so irrespective of the use of upper and lower case letters, or any customary combination of the two. However, normal and fair use of word-only marks, in this case CREMESSO, should not be taken to include stylisation that goes beyond normal and fair use of the word mark, such as in the CReMESPRESSO example shown above. In my opinion, the

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<sup>4</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81 -83.

same applies the other way around, i.e., registration of a stylised word does not extend to use of the word in “any normal font”. As such, whilst I wholly believe the word ‘TRUE’ will be perceived by the majority of consumers to exist in the earlier mark, it is nevertheless my position that it cannot be considered to be identical to the standard representation of the word in the contested mark due to its elaborate stylisation of the letters ‘R’ and ‘U’.

49. It seems to me self-evident that the inclusion of the figurative element in the earlier mark and the inclusion of the word ‘SKIN’ in the contested mark prevent the marks from being mistaken for one another. This is due both to the fact that the figurative element has no counterpart, and my opinion that the word ‘SKIN’ cannot be isolated, dismissed or ignored. I therefore find there to be no likelihood of direct confusion.

50. Having found there to be no likelihood of direct confusion, any confusion would now be dependent on a finding of indirect confusion. It should be borne in mind 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.<sup>5</sup> In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., (as he then was) 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.”

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<sup>5</sup> In *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCH Civ 2017, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor QC’s (as he then was, sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.

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).”

51. The marks at issue coincide only in their respective use of the word ‘TRUE’. The Applicant argued that in isolation the word ‘TRUE’ is of little inherent distinctive character, as it would be understood as a laudatory term used to promote the goods as being real, genuine or reliable. I previously indicated that I consider the concept of the word ‘TRUE’ to more likely be vague or allusive (rather than directly descriptive) in relation to the goods at issue. After all, what is a not-false cosmetic? That having been said, as a word in and of itself, the word ‘TRUE’ is not so inherently distinctive that one would expect no-one other than the brand owner to be using it in trade (see category (a) of *L.A. Sugar*). In general, I agree with the Applicant that the inclusion of the word ‘TRUE’ in a mark would most likely be perceived by the consumer as laudatory, intending to suggest a positive attribute of the goods or services at issue. Therefore, the coincidence of this term alone in the marks at issue would not lead to a likelihood of indirect confusion, especially when the word forms part of a combination that hangs together in the contested mark.

52. The remaining two categories of *L.A. Sugar* (which by no means constitute an exhaustive list) could be interpreted to reach a conclusion that leans towards a finding of a likelihood of indirect confusion. For example, the word ‘SKIN’ is arguably the addition of a non-distinctive element to the earlier mark (see category (b) of *L.A. Sugar*), and as such may seem logical or consistent with a brand extension (see category (c) of *L.A. Sugar*). However, in neither scenario is the word ‘SKIN’ being added to an exact replica of the earlier mark. It must be kept in mind that the inherent distinctiveness of the earlier mark lies in its overall impression as a whole, which includes both the figurative element and stylised word, which are equally dominant. Therefore, in my opinion, the finding of indirect confusion could only be the result of incorrectly ignoring the composition and subsequent overall impression of the earlier mark as a whole.

53. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

54. Whilst I have acknowledged that the marks coincide in the word ‘TRUE’ (in the majority of cases where the consumer perceives the term to exist in the earlier mark), I have made it quite clear that I consider the contested mark to be a composite mark, with a conceptual meaning dictated by the combination of its terms that hang together. It is clear from the above judgment that it is signs as a whole that must be compared. Therefore, in relation to the marks at issue, the comparison must be made between an earlier mark with the concept of a stylised version of something undefined that is not false plus a distinctive figurative device, and a later mark with the concept of not-false layers. In my opinion, the comparison of such overall impressions would not lead to indirect confusion. I believe that the concept of the contested mark is so dependent on the combination of terms that hang together that there will not be any situation where the consumer perceives the term ‘TRUE’ to have an independent and distinctive role within it. In addition, the perception of the contested mark as a whole is different from the meaning of its separate components.

55. I note that the Opponent argued the “relevant consumer will naturally attach greater significance to word elements, even when a mark incorporates visual

elements”. This is supported by the finding of the GC in *Migros-Genossenschafts-Bund v EUIPO* (T-68/17) (CReMESPRESSO), whereby it stated:

52 “In that regard, it should first of all be noted that, according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements (see, to that effect, judgment of 6 December 2013, *Premiere Polish v OHIM — Donau Kanol (ECOFORCE)*, T-361/12, not published, EU:T:2013:630, paragraph 32 and the case-law cited).”

56. However, this is not a hard and fast rule. Indeed, in *L&D SA v OHIM* [2008] E.T.M.R. 62, the CJEU stated that:

“55 Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant.”

57. Further, in *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253 the GC compared two figurative marks, both of which contained the words “Museum of Illusions”. In holding that the words were weakly distinctive, and that they were no more dominant than the figurative elements, it pointed out that:

“57 According to the case-law, the public will not generally consider a descriptive or weakly distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see judgment of 5 April 2006, *Madaus v OHIM – Optima Healthcare (ECHINAID)*, T-202/04, EU:T:2006:106, paragraph 54 and the case-law cited;

judgment of 28 October 2009, *CureVac v OHIM – Qiagen (RNAiFect)*, T-80/08, EU:T:2009:416, paragraph 49).

58 It does not therefore automatically follow that, where a sign consists of both figurative and word elements, it is the word element which must always be considered to be dominant. In certain cases, in a composite sign, the figurative element may therefore rank at least equally with the word element (see, to that effect, judgment of 24 October 2018, *Grupo Orenes v EUIPO – Akamon Entertainment Millenium (Bingo VIVA! Slots)*, T-63/17, not published, EU:T:2018:716, paragraph 43 and the case-law cited”).

58. Whilst I did not go as far as the Applicant in finding the word ‘TRUE’ to be directly descriptive, I nevertheless found it to be vague and allusive, and part of the general language used in promotion. As such, it is arguably weakly distinctive, and would therefore not be considered to be the dominant element of the composite mark. Rather, as I identified previously, it would likely be perceived to be of equal dominance and on an equal footing with the figurative element. The effect of the above is that simply coinciding in one element would not lead to a finding of indirect confusion, especially when the word of the earlier mark is “weakly distinctive”, and/or is part of a composite mark in which the other element is equally dominant (and does not appear in the contested mark).

59. One of the factors in the global assessment of comparing trade marks includes the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. Having found the goods at issue to be identical, this could offset a lower degree of similarity between the marks at issue. However, it is my opinion that the overall impression of each mark is unique, and sufficiently different from one another to overcome the fact that the goods are identical.

60. In conducting the comparison of the marks, I have also kept in mind *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which Mr James Mellor Q.C. (as he then was), acting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind

another mark, as this would be mere association rather than indirect confusion. To my mind, whilst the marks share the word 'TRUE' its respective impact on each mark is different, standing alone in meaning in the earlier mark whilst forming part of a phrase that hangs together in the contested mark. The coincidence of this word is not enough, in and of itself, to overcome the visual, aural and conceptual differences between the marks, nor does it overcome the fact that the earlier mark contains a distinctive figurative device that is as equally dominant as the word element, and which has no counterpart in the earlier mark.

61. Having found there to be no direct confusion, there would have needed to be a "proper basis" for finding a likelihood of indirect confusion.<sup>6</sup> In my opinion, I consider it unlikely that a consumer would carry out the mental process whereby they either consciously or subconsciously assume the contested mark to be a logical extension of the earlier mark, based purely on the coincidence of the word 'TRUE', which is not highly distinctive, and which has a different role in each mark. I therefore find there to be no likelihood of indirect confusion.

## **Conclusion**

62. The opposition fails under Section 5(2)(b). Subject to an appeal, the contested application will proceed to registration.

## **Costs**

63. As the opposition has failed, the Applicant has been successful and is entitled to a contribution to its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Applicant the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering a notice of opposition and

filing a counterstatement	£200
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<sup>6</sup> *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCH Civ 2017, paragraph 13,

Preparing submissions and considering the other side's submissions	£300
Preparing submissions in lieu of a Hearing	£300
Total	£800

64. I therefore order True Skincare Limited to pay Bora Creations S.L. the sum of £800. 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 14<sup>th</sup> day of February 2023**

**Dafydd Collins**

**For the Registrar**