


O/0399/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 918207722

IN THE NAME OF MARILISA FRANCHINI

FOR THE TRADE MARK:

BEAUTY**C**LOGY

IN CLASSES 3, 21 AND 35

AND

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 504263 BY BAYLISS & HARDING PLC

## BACKGROUND AND PLEADINGS

1. Marilisa Franchini (“the proprietor”) is the owner of the trade mark shown on the cover page of this decision (“the Contested Mark”). The Contested Mark was applied for on 9 March 2020 and was registered on 24 June 2020 for the following goods and services:<sup>1</sup>

Class 3      Cosmetics.

Class 21     Cosmetic utensils.

Class 35     Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Mail order retail services for cosmetics; Retail services connected with the sale of subscription boxes containing cosmetics; Business management of wholesale and retail outlets; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

2. On 20 October 2021, Baylis & Harding Plc (“the applicant”) applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

3. Under section 5(2)(b), the applicant relies upon UKTM no. 2604582 for the trade mark **beauticolology**. The earlier mark was filed on 15 December 2011 and registered on 30 March 2012. The applicant relies upon all goods for which the mark is registered, namely:<sup>2</sup>

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<sup>1</sup> The Contested Mark is a comparable mark deriving from an EUTM. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trade marks for all rights holders with existing EUTMs. As a result, the Contested Mark was automatically converted to a comparable UK trade mark. Comparable UK trade marks are now recorded on the UK trade marks register, have the same legal effect as if they had been applied for and registered under UK law, and the original filing dates remain the same.

<sup>2</sup> Although the applicant relies upon all goods for which the earlier mark is registered, it has made a statement of use in relation to only some of the goods, as set out at paragraph 4 below.

Class 3      Soaps; toilet articles; perfumery, perfumes; essential oils; cosmetics; make-up preparations; non-medicated toilet preparations; skin care preparations; shampoos and hair care preparations; anti-perspirants; deodorants for personal use; dentifrices; talcum powder; bath and shower oils and gels; bath salts; bubble bath; bath milk; hand wash; incense.

The applicant claims that there is a likelihood of confusion, because the trade marks are similar and the goods are identical or similar.

4. Under section 5(3), the applicant relies upon the same trade mark and claims a reputation for some of the goods for which the mark is registered, namely:

Class 3      Soaps; toilet articles; perfumery; perfumes; essential oils; cosmetics; non-medicated toilet preparations; skin care preparations; shampoos and hair care preparations; deodorants for personal use; bath and shower oils and gels; bath salts; bubble bath; bath milk; hand wash; incense.

The applicant claims that use of the proprietor's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier mark.

5. Under section 5(4)(a), the applicant relies upon the sign **BEAUTICOLOGY** which it claims to have used throughout the UK since at least 2011 in relation to:

“Cleaning preparations; soaps; toilet articles; perfumery; perfumes; essential oils; cosmetics; non-medicated toilet preparations; skin care preparations; shampoos and hair care preparations; deodorants for personal use; bath and shower oils and gels; bath salts; bubble bath; bath milk; hand wash; incense; personal hygiene and beauty care products; body care preparations; preparations for the care of the scalp; creams, milks, lotions, gels and powders for the skin, the face, the body and the hands; personal hygiene and beauty

care products; body care preparations; preparations for the care of the scalp; creams, milks, lotions, gels and powders for the skin, the face, the body and the hands; hand gels; hand oils; room fragrances; diffusers for use with fragrances; reed diffusers; diffusers for use with room fragrances; retail services for the aforesaid goods.”

The applicant claims that use of the proprietor’s mark would be contrary to the law of passing-off.

6. The proprietor filed a counterstatement denying the claims made and putting the applicant to proof of use.

7. The proprietor is represented by Trowers & Hamlins LLP and the applicant is represented by Marks & Clerk LLP.

8. The applicant filed evidence in chief. The proprietor filed written submissions during the evidence rounds and the applicant filed evidence in reply. Neither party requested a hearing, and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

9. The applicant filed evidence in chief consisting of the first witness statement of Emma Sandland dated 27 May 2022. Ms Sandland is the Strategy and Compliance Manager for the applicant, a position she has held since 30 March 2020. Ms Sandland’s evidence is accompanied by 20 exhibits (exhibits 1-19, and confidential exhibit 4A).

10. The proprietor filed written submissions dated 24 October 2022.

11. The applicant filed evidence in reply consisting of the second witness statement of Emma Sandland dated 21 December 2022. Ms Sandland’s second statement was accompanied by 5 exhibits (exhibits ES1 to ES5).

12. The applicant filed written submission in lieu dated 2 February 2023.

13. I have taken the evidence and submissions into consideration in reaching this decision and will refer to them below, where necessary.

### **RELEVANCE OF EU LAW**

14. 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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

### **PRELIMINARY ISSUE**

15. The proprietor has made submissions in relation to an EU dispute between the parties. In that case, the proprietor was the opponent and the cancellation applicant was the applicant for registration. The parties' respective marks were the same. The proprietor relies upon this because, in the EUIPO proceedings, the cancellation applicant was making the opposite argument to those made before this Tribunal (i.e. that the marks were not similar). However, I note that the proprietor in this case (the opponent in the EUIPO case) must also have been making the opposite argument (i.e. that the marks were similar). I have noted this, but I do not consider that it assists the proprietor's case.

### **DECISION**

16. Sections 5(2)(b), 5(3) and 5(4)(a) have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.



(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

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

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

“5(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.”

18. The trade mark upon which the applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the application for a declaration of invalidity, it is subject to proof of use, as requested by the proprietor.

### **Proof of use**

19. I will begin by assessing whether there has been genuine use of the earlier mark. As explained in the above legislation, there are two relevant periods for proof of use. The first is the period of 5 years ending with the date of the application for invalidity i.e. 21 October 2016 to 20 October 2021, and the second is the period of 5 years ending with the filing date of the Contested Mark i.e. 10 March 2015 to 9 March 2020.

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “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” is, therefore, not genuine use.

22. I note the following from the applicant’s evidence:

- a) The applicant began using the mark in 2012.
- b) Product brochures have been provided (which Ms Sandland says were distributed to wholesale and retail customers) dated between 2016 and 2019.<sup>3</sup> I have included some examples of the products shown below:



<sup>3</sup> Exhibit 3 and Exhibit ES1



The products shown include goods such as shower crème, body butter, bubble bath, body lotion, soap, foot lotion, socks, body wash, shower gel, hand lotion, cosmetic bags, cuticle sticks, emery boards, bath soak crystals, mugs, hot water bottle covers, slippers, foot soak crystals, hand wash, shower scrubs, fragrance mist, gift sets, candles, diffusers, weekend bags, wash bags, bath fizzers, lip balm, bath salts and a note book.

- c) Ms Sandland notes that until December 2015, the applicant's mark was used with a colon at the end i.e. beauticolgy:. However, since then, the mark has appeared without the colon.
- d) Ms Sandland states that in the years 2013 to 2020, the applicant made sales of BEAUTICOLOGY products exceeding £19million, with over £1million being sold in each individual year (although average annual sales exceeded £2million).<sup>4</sup>
- e) Since 2013, goods sold under the BEAUTICOLOGY mark have been sold throughout the UK to a network of more than 200 retailers including Boots, Asda, Amazon, Tesco and Sainsburys. I note that these are all national retailers.<sup>5</sup>

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<sup>4</sup> Confidential Exhibit 4A

<sup>5</sup> Exhibit 5

- f) A sample of invoices have been provided which show sales of goods under the BEAUTICOLOGY brand to customers located around the UK (including Warwickshire, Scotland, Derbyshire and Southampton).<sup>6</sup> Those dated within the relevant period relate to goods including bags, shower scrubs, bath and shower crème, gift sets, hand wash, hand cream, body butter and bath fizzers.
- g) Various bestselling BEAUTICOLOGY products have been identified for the years 2015 to 2020 by Ms Sandland, which include body lotion, foot soak crystals, body lotion, hand cream, hand wash and bath fizzers.<sup>7</sup>
- h) The applicant has worked with celebrities/influencers to promote the brand. For example, in July 2018 Kelly Brook posted to over 900,000 followers about the applicant's BEAUTICOLOGY bath foam and shower crème.<sup>8</sup> Also, in November 2019, the applicant held a promotional event for BEAUTICOLOGY in London as part of a collaboration with 8 influencers, with a social media audience reach of over 9million consumers.<sup>9</sup>

23. Firstly, I note that the applicant previously used the mark BEAUTICOLOGY with a colon, but since January 2016 uses the word only. The proprietor submits that use of the mark BEAUTICOLOGY cannot be relied upon to show use of the earlier mark. However, in my view, use of BEAUTICOLOGY (without the colon) is use upon which the applicant can rely.<sup>10</sup> This is because the distinctive and dominant element of the earlier mark is the word BEAUTICOLOGY. The addition or removal of the colon does not alter that distinctive character. In addition, use of the words BAYLISS & HARDING BEAUTICOLOGY is also use upon which the applicant can rely. This is because BEAUTICOLOGY continues to indicate origin. For the sake of completeness, I do not consider that use in upper/lower/title case has any bearing, as all would be covered by notional and fair use of the earlier mark.

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<sup>6</sup> Exhibit 7

<sup>7</sup> Exhibit 8

<sup>8</sup> Exhibit 12

<sup>9</sup> Exhibit 13

<sup>10</sup> See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 and *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

24. I note that there are some issues with the applicant's evidence. For example, as the proprietor submits, there is no breakdown of the sales figures by goods. I also note that there is no breakdown by jurisdiction. However, as there is no evidence of the applicant trading outside of the UK, I am prepared to accept that the sales referred to were (at least mostly) to UK-based customers. I must take the evidence as a whole into account and the picture of the applicant's activities that it creates. Given the sales figures, the national retailers through which the applicant sells its goods and the invoices provided, it is clear to me that the applicant has been attempting to maintain and/or create a share in the market for the goods protected by the earlier mark. Although a variety of goods are displayed in the brochures, I am prepared to find genuine use only in relation to those goods referenced in the invoices or which have been confirmed as bestsellers (which enables me to identify the extent of the sales made).

25. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs K.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.”

26. 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."

27. There has clearly been use in relation to goods which would fall within the categories of "bath and shower gels", "non-medicated toilet preparations" and "skin



care preparations". In my view, the breadth of goods sold within these categories is sufficient to justify the applicant retaining the broader terms. There has also been use in relation to "handwash". Consequently, I consider a fair specification to be:

Class 3      Non-medicated toilet preparations; skin care preparations; bath and shower gels; handwash.

### **Section 5(2)(b) – case law**

28. 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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly 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**

29. The competing goods and services are as follows:

| Applicant's goods   | Proprietor's goods and services   |
|---|---|
| <p data-bbox="204 306 319 338"><u>Class 3</u></p> <p data-bbox="204 360 783 504">Non-medicated toilet preparations; skin care preparations; bath and shower gels; handwash.</p> | <p data-bbox="810 306 922 338"><u>Class 3</u></p> <p data-bbox="810 360 970 392">Cosmetics.</p> <p data-bbox="810 472 938 504"><u>Class 21</u></p> <p data-bbox="810 526 1070 557">Cosmetic utensils.</p> <p data-bbox="810 638 938 669"><u>Class 35</u></p> <p data-bbox="810 692 1390 1279">Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Mail order retail services for cosmetics; Retail services connected with the sale of subscription boxes containing cosmetics; Business management of wholesale and retail outlets; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.</p> |

30. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

31. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

### Class 3

33. The proprietor's "cosmetics" may be considered identical on the principle outlined in *Meric* to "skin care preparations" in the applicant's specification. However, even if they are not identical, they will clearly overlap in trade channels, as both are likely to be sold through beauty retailers. The method of use is likely to overlap as both will be applied to the skin/body. The purpose will overlap as both are intended to improve the appearance of the user. The nature may overlap as there could be shared ingredients. Clearly, the user will overlap. Consequently, I consider the goods to be highly similar.

### Class 21

34. The proprietor's "cosmetic utensils" is likely to overlap in trade channels with the applicant's goods as they could all be sold through beauty retailers, or businesses with a beauty section. The users will also clearly overlap. In my view, there may be complementarity with some of the goods in the opponent's broader categories, as they may be important or indispensable for each other and the average consumer would conclude that they originate from the same undertakings.<sup>11</sup> I accept that the nature, purpose and method of use of the goods will differ. I consider them to be similar to a medium degree. Even if I am wrong in my finding that they are complementary, they will still be similar to between a low and medium degree.

### Class 35

35. The proprietor's "Online retail services relating to cosmetics", "Online retail store services relating to cosmetic and beauty products", "Mail order retail services for cosmetics" and "Retail services connected with the sale of subscription boxes containing cosmetics" are likely to be sold through the same trade channels as the applicant's goods, as they could all be sold by beauty retailers. They will also overlap in users. I accept that the nature, method of use and purpose of the goods and services

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<sup>11</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

will differ. However, they will be complementary. Consequently, I consider them to be similar to a medium degree.

36. The proprietor's "business management of wholesale and retail outlets" is a business-to-business service. This will be provided by businesses (such as consultancies) which specialise in supporting wholesale and retail businesses. Consequently, the nature, purpose, method of use, trade channels and user will be completely different to the applicant's goods. I can see no point of overlap and I consider the goods and services to be dissimilar.

37. The proprietor's "Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies" may be sold through the same trade channels to the same users as the applicant's goods. For example, pharmacies very often sell retail services relating to medicines and toiletries/cosmetics. However, the nature, method of use and purpose clearly differ. There is no competition or complementarity. Consequently, I consider the goods and services to be similar to between a low and medium degree.

### **The average consumer and the nature of the purchasing act**

38. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 (as he then was) 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.”

39. The average consumer for the parties’ goods and services is likely to be a member of the general public. The goods and services are unlikely to be particularly expensive and are likely to be reasonably frequent purchases. However, various factors will still be taken into account such as fragrance, ingredients and suitability for skin type (for the goods) and ease of use and speed of service (for the services). Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

40. The goods and services are likely to be selected following the perusal of signage on websites, at bricks-and-mortar premises, on packaging or on advertisements. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that aural components may play a part as word-of-mouth recommendations may be made or advice may be sought from retail assistants.


### **Comparison of trade marks**

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the 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.”

42. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

43. The respective trade marks are shown below:

| Applicant's mark | Proprietor's mark   |
|------------------|---|
| beauticolology:  | <b>BEAUTYCOLOGY</b><br> |

44. The applicant's mark consists of the word BEAUTICOLOGY, presented in lower case, followed by a colon. The overall impression lies in the combination of these elements, with the word playing the greater role. The proprietor's mark consists of the word BEAUTYCOLOGY, with the first O replaced by a hexagon device, which is itself part of a larger device. The proprietor notes that its mark is presented in "the highly stylised distinct font, Montserrat". However, the applicant's mark could be used in any standard font and so I do not consider that this has any impact on the visual comparison. The overall impression is dominated by the word itself, with the device playing the lesser role.

45. Visually, the marks overlap in that they both contain the words BEAUTICOLOGY/BEAUTYCOLOGY. Clearly, the differing letters I/Y will act as a point of visual difference. Further, the colon in the applicant's mark (if it is noticed) and the device in the proprietor's mark act as points of visual difference. I consider the marks to be visually highly similar.

46. With regard to the aural comparison, the proprietor submits that:

"11. The Registered Mark and the Applicant's Mark are also aurally distinct as the use of the "Y" in the Registered Mark lengthens the pronunciation of the



mark so that it is pronounced “BEAUTY”, then “COLOGY” as if it were two words with a clear pronunciation of “BEAUTY” and then “COLOGY”. The Applicant’s mark is pronounced more rapidly as one word with a short “I”, “beauticolology” with even emphasis throughout the word.”

I do not consider that any difference will be created by the differing letters I/Y in how the words are articulated. Both letters, when used in the middle of the word in this way, are likely to result in the same pronunciation. Neither the colon in the applicant’s mark, nor the device in the proprietor’s mark will be articulated (other than the part of the device which makes up the letter O). Consequently, I consider the marks to be aurally identical.

47. Conceptually, both marks follow the same or similar pattern as dictionary words such as BIOLOGY, MUSICOLOGY and LEXICOLOGY, which are all names for the study of different subjects (living things, music and vocabulary respectively). Consequently, the average consumer is likely to view both marks as referring to the study of beauty. I do not consider that the colon or device impact this meaning. As a result, I consider the marks to be conceptually identical.

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

48. 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-2779, 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).”

49. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

50. I will begin by assessing the inherent distinctive character of the earlier mark. The applicant submits that the earlier mark is highly distinctive by virtue of it being an invented word. Clearly, the earlier mark is an invented word. However, as noted above, the word BEAUTICOLOGY is likely to be viewed as referring to the study of beauty. It is allusive for the goods and services. Consequently, and bearing in mind that it is the distinctiveness of the common element which is key, I consider that word to have between a low and medium degree of inherent distinctive character for the goods in relation to which I have found that the applicant has used the mark. I do not consider that the addition of the colon increases the distinctiveness of the mark.

51. Turning now to consider whether the distinctive character of the mark has been enhanced through use, I bear in mind the applicant’s evidence as summarised above. I also note the following from the applicant’s evidence:

- a) There was coverage in *The Daily Mail* of Love Island stars attending the event referred to in paragraph 22(h) above in November 2019.<sup>12</sup>
  
- b) The applicant's mark has been referenced in publications such as *Mail Online* (2013), *Daily Record* (2015), *Beauty Magazine* (2018) and *The Sun* (2019).<sup>13</sup>

52. I have limited information in relation to advertising and promotional activities and no information regarding overall expenditure. However, bearing in mind the consistent sales made under the mark, over a lengthy period of time and the geographical spread of the use through national retailers, I am satisfied that distinctiveness of the earlier mark has been enhanced through use to at least a medium degree.

### **Likelihood of confusion**

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

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<sup>12</sup> Exhibit 15

<sup>13</sup> Exhibit 16

54. I have found as follows:

- a) Apart from the goods and services I found to be dissimilar, the goods and services vary from being identical to similar to between a low and medium degree.
- b) The average consumer is a member of the general public who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The marks are visually highly similar and aurally and conceptually identical.
- e) The earlier mark is inherently distinctive to between a low and medium degree which has been enhanced through use to at least a medium degree.

55. Bearing in mind that the marks are visually highly similar and aurally and conceptually identical, I consider it likely that they will be mistakenly recalled or misremembered as each other. The differing letter Y/I in the middle of the marks is likely to be overlooked, as will the colon at the end of the applicant's mark and the device within the proprietor's mark. Consequently, I consider there to be a likelihood of direct confusion, even when used on goods and services which are only similar to between a low and medium degree.

56. Even if the consumer did notice the colon and/or the device, I still consider that the common element BEAUTYCOLOGY/BEAUTICOLOGY would lead the consumer to conclude that the marks originate from the same or economically linked undertakings. The device is likely to be seen as an alternative mark, perhaps one used on packaging as opposed to in written form. I consider there to be a likelihood of indirect confusion in relation to all of the goods and services that I have found to be similar at any level.

57. In respect of those goods and services that I have found to be dissimilar, there can be no likelihood of confusion.<sup>14</sup>

58. In reaching this decision, I have borne in mind the proprietor's submission that the applicant has not filed any evidence of actual confusion. The absence of evidence of actual confusion is rarely significant.<sup>15</sup> Certainly, I consider that to be the case here. In any event, whilst I note that the proprietor's mark has been registered since 2020, I have no evidence before me that it has actually been used in the UK. Consequently, I see no reason for the absence of evidence of actual confusion to count against the applicant.

59. The application for invalidation based upon section 5(2)(b) succeeds in relation to the following goods and services:

Class 3      Cosmetics.

Class 21     Cosmetic utensils.

Class 35     Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Mail order retail services for cosmetics; Retail services connected with the sale of subscription boxes containing cosmetics; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

### **Final remarks**

60. For the avoidance of doubt, my finding would have been the same even if the earlier mark did not benefit from enhanced distinctiveness. This is because, in my view, given the level of similarity between the marks, confusion would arise

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<sup>14</sup> Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

<sup>15</sup> See *Roger Maier and Another v ASOS* [2015] EWCA Civ 220 and *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

notwithstanding the relatively low level of inherent distinctive character of the earlier mark.

**Section 5(4)(a)**

61. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

62. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

63. I can deal with this ground relatively swiftly. I am satisfied that the applicant has a moderate degree of goodwill in relation to non-medicated toilet preparations, skin care preparations, bath and shower gels and handwash. I am also satisfied that the applicant’s sign is distinctive of that goodwill. Whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it

has been acknowledged that they are unlikely to produce different outcomes in practice.<sup>16</sup> Certainly, I believe that to be the case here. For the same reasons set out above, I consider that there would be deception of a substantial number of members of the public where the proprietor's mark was used on goods and services within the same or similar fields of activity (i.e. those that I have identified as being similar, as set out above) as those for which the applicant has goodwill. Damage is easily foreseeable. In relation to those goods and services I have found to be dissimilar, the distance is sufficient to offset the similarities of the marks and the extent of the applicant's goodwill and no misrepresentation or damage will occur.

64. The opposition based upon section 5(4)(a) succeeds in relation to the same goods and services as set out at paragraph 59 above.

### **Section 5(3)**

65. Section 5(3) of the Act states:

“5(3) A trade mark which -

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

66. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

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<sup>16</sup> *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

67. Again, I can deal with this ground relatively swiftly. Given the applicant's evidence summarised above, I am satisfied that it has a moderate reputation for non-medicated toilet preparations, skin care preparations, bath and shower gels and handwash. However, this ground does not put the applicant in any stronger position than it would have been under the section 5(2)(b) and 5(4)(a) grounds. Bearing in mind the factors identified in *Intel*<sup>17</sup>, I am satisfied that a link would be made in relation to those goods and services that I have found to be similar. Given the similarity of the goods and services, it is clear to see that damage could arise, either through the relevant public believing that the goods/services originate from the same undertaking or through the proprietor benefiting from the familiarity arising from the applicant's significant sales. However, the remaining services in the proprietor's specification (those that I have found dissimilar and for which there is no confusion under section 5(2)(b)) are too far removed from the goods for which the applicant has a reputation for a link to be made or for damage to occur. This distance will offset the similarities of the marks and the applicant's reputation.

68. The opposition based upon section 5(3) succeeds in relation to the same goods and services as set out in paragraph 59 above.

## **CONCLUSION**

69. The application for invalidity succeeds in relation to the following goods and services:

Class 3      Cosmetics.

Class 21     Cosmetic utensils.

Class 35     Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Mail order retail services for cosmetics; Retail services connected with the sale of subscription boxes

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<sup>17</sup> *Case C-408/01*



containing cosmetics; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

70. In respect of those goods, the Contested Mark is hereby declared invalid (subject to appeal) and, under section 47(6) of the Act, the registration is deemed never to have been made.

71. The application for invalidity fails in relation to the following services for which the Contested Mark can remain registered (subject to appeal):

Class 35 Business management of wholesale and retail outlets.

## **COSTS**

72. The applicant has enjoyed the greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, and bearing in mind the only partial success, I award the applicant the sum of **£1,900**, calculated as follows:

|  |               |
|--|---------------|
| Preparing a Notice of Invalidation and considering the proprietor's counterstatement | £350          |
| Preparing and filing evidence  | £1,000        |
| Written submissions in lieu  | £350          |
| Official fee   | £200          |
| <b>Total</b>   | <b>£1,900</b> |

73. I therefore order Marilisa Franchini to pay Baylis & Harding Plc the sum of £1,900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 27<sup>th</sup> day of April 2023**

**S WILSON**

**For the Registrar**