

**O-305-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3262541**

**BY NKED FACE LTD**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**Nked Face**

**IN CLASS 3**

**AND**

**OPPOSITION THERETO UNDER NO. 411674**

**BY VITA LIBERATA LIMITED**

## BACKGROUND AND PLEADINGS

1. On 10 October 2017, Nked Face Ltd (“the applicant”) filed trade mark application number UK00003262541 for the mark **Nked Face**. The application was accepted and published for opposition purposes on 17 November 2017, in respect of the following goods:

Class 3 Beauty products, namely, cosmetics, skin care preparations, creams, serums, soaps, body lotions, facial oils and creams, toilet waters, essential and herbal oils, cosmetics, make-up preparations, make-up, non-medicated toilet preparations, toiletries, skin care preparations, preparations for use in the bath or shower, bath and shower oils, gels, creams and foams, face and body masks, face and body scrubs, facial washes, skin cleaners and hydrators, skin toners, skin moisturizers, skin care preparations, body lotion, blemish creams and blemish gels, facial peels, exfoliants, makeup removers, cotton wool for personal use, lip balm, petroleum jelly, pre-moisturised baby wipes, tissues impregnated with cosmetic lotions, sponges impregnated with soaps or toiletries, sun protection products, sunscreen, sun-block, after-sun lotion, kits consisting of one or more of the foregoing products.

2. Vita Liberata Limited (“the opponent”) opposes the application (for all of the goods for which it is seeking protection) under section 5(2)(b) and (for some of the goods of the application, listed below) under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

Goods of the application opposed under section 5(4)(a): Skin care preparations, creams, serums, soaps, body lotions, facial oils and cream, cosmetics, make-up preparations, make-up, non-medicated toilet preparations, toiletries, skin care preparations, skin cleaners and hydrators, skin toners, skin moisturizers, skin care preparations, body lotion, blemish creams and blemish gels, exfoliants, sun protection products, sunscreen, sun-block, after-sun lotion, kits consisting of one or more of the foregoing products.

3. Under section 5(2)(b) the opponent relies upon one United Kingdom trade mark (“UKTM”) and two European Union trade marks (“EUTM”), the details of which are as follows.

4. UKTM no. 2384994 is for a series of marks consisting of **NKDSKN** and **nkdskn**. It has a filing date of 19 February 2005 and a registration date of 12 August 2005. The mark is registered in classes 3, 5, 25, 32 and 44; for the purposes of these proceedings, the opponent relies upon cosmetics and hand lotions. The mark qualifies as an earlier mark in accordance with section 6 of the Act. Given its registration date, it is subject to the proof of use provisions contained in section 6A of the Act. To this extent, the opponent made a statement of use corresponding to the goods on which it relies (cosmetics and hand lotions).

5. EUTM no. 4598116, **NKDSKN**, has a filing date of 19 August 2005 and a registration date of 2 July 2009. It is registered in classes 3, 5, 9, 14, 18, 25, 32 and 44; for the purposes of these proceedings, the opponent relies upon cosmetics and hand lotions. The mark qualifies as an earlier mark in accordance with section 6 of the Act. Given its registration date, it is subject to the proof of use provisions contained in section 6A of the Act. To this extent, the opponent made a statement of use corresponding to the goods on which it relies (cosmetics and hand lotions).

6. EUTM no. 13727631 has a filing date of 10 February 2015 and a registration date of 12 August 2017. It is registered in classes 3 and 21. For the purposes of these proceedings, the opponent stated in its statement of grounds that it wished to rely on all goods of this EUTM registration.

7. The representation of EUTM no. 13727631 is as follows (hereafter referred to as “NKD SELF TAN SKN”):

NKD  
S E L F T A N  
SKN

8. The mark qualifies as an earlier mark in accordance with section 6 of the Act. Given its registration date, it is not subject to the proof of use provisions contained in section 6A of the Act. As a result, the opponent is entitled to rely upon all of the goods for which it is registered.

9. The opponent's case under section 5(2)(b) is that the applied for mark is visually, aurally and conceptually similar to its earlier marks and is seeking registration for identical or similar goods, resulting in a likelihood of confusion.

10. Under section 5(4)(a), the opponent relies on the use of two signs, the first of which, **NKDSKN**, has been used (according to the opponent), throughout the UK (including Northern Ireland) since 2005. The second sign has been used (according to the opponent), throughout the UK (including Northern Ireland) since 2015. The representation of this sign is as follows:

NKD  
S E L F T A N  
SKN

11. The opponent claims that the two signs relied upon under section 5(4)(a) have been used for skincare products, sun protection preparations and tanning preparations. The opponent's case under section 5(4)(a) is that it has accrued substantial goodwill in the two signs relied upon through extensive use in the UK and overseas. The opponent claims that the products sold under these signs have been the recipients of numerous awards and have featured in numerous articles in prestigious publications, as well as receiving celebrity endorsements. The opponent states that use of the applied for mark in respect of beauty products would misrepresent that there is a connection between the opponent and the applicant, and that such a misrepresentation could result in damage to the opponent's reputation and to sales of its products.

12. The applicant filed a counterstatement in which it denies the 5(2)(b) ground on the basis that not all the class 3 goods covered by the application are identical or similar to the goods covered by the opponent's earlier marks, and that the differences between the marks at issue will be sufficient to avoid any likelihood of confusion. The applicant further denies that the opponent has acquired the requisite goodwill in the signs relied upon under its 5(4)(a) ground. In addition, the applicant requested the opponent provide proof of use of its UKTM no. 2384994 and EUTM no. 4598116 for the goods upon which it relies (cosmetics and hand lotions).

13. Both parties filed evidence and accompanying letters containing written submissions. Neither party requested a hearing, nor did they file written submissions in lieu of a hearing. The opponent is represented by Ansons. The applicant is represented by Wildbore & Gibbons.

## **EVIDENCE**

### **The opponent's evidence**

14. The opponent's evidence consists of a witness statement and four exhibits from Jogesh Choda, the opponent's Chief Operating Officer.

## Witness statement

15. Mr Choda's witness statement is dated 16 July 2018, which simply describes what is contained within each exhibit and includes some submissions relating to the similarity of its earlier marks and the mark applied for by the applicant.

16. Mr Choda also states that the marks relied upon by the opponent have been put to use in the United Kingdom and that consumers recognise these marks as referring to products originating from the opponent.

## Exhibits

17. Exhibit JC1 contains three undated pages, showing a total of six images of what Mr Choda describes as samples of the packaging used by the opponent. The products shown within this exhibit are: body bling instant body bronzer; dig deep cleansing mask; tinted tan liquid; and tinted tan mousse.

18. Exhibit JC2 is described by Mr Choda as containing web extracts from social media, namely, Twitter and Facebook. It is not clear where the first 17 pages are taken from, however, I assume these are the Facebook extracts since the remainder of the exhibit clearly displays the Twitter web address.

19. The 17 pages of Facebook extracts (four of which are duplicates) contain 37 Facebook 'posts' between 19 January 2013 and 27 December 2017, which refer to the opponent and/or its goods as nkdskn or NKDSKN (some of which are preceded by '#'). Some of these posts contain images of the following products: body bronzer; tanning mousse; gradual tan moisturiser; matte wash off instant tan; tinted tan mousse; tanning mitt; tinted tan liquid; and pre-shower tan. Only two of the posts (24 July 2016 and 26 July 2017) indicate where the goods referred to can be purchased.

20. The remaining pages of exhibit JC2 contain extracts from Twitter, which show eight posts between 20 January 2014 and 25 September 2017. The products shown in these posts are described as: the luxe tanning range; tanning kits; tinted tan liquid; tan

products; gradual glow; pre-shower tan; and tanning mitts. All extracts are taken from a Twitter account in the name 'nkdskn', which can be seen in the background.

21. Exhibit JC3 contains 27 pages of web extracts from www.nkdskn.co.uk between May 2013 and October 2017. The website has clearly evolved during that time and the available products to purchase are: matte wash off instant tan; tinted tan liquid; tinted tan mousse; tanning sets; pre-shower tan; tanning mitts; and gradual tan moisturiser. Each product has a corresponding price and the option to 'add to cart'.

22. Exhibit JC4 contains five invoices sent to five different locations from Vita Liberata Limited, County Antrim. The details of each invoice are contained within the table below.

<b>Invoice date</b>	<b>Recipient</b>	<b>Products</b>	<b>Net total</b>
27/02/2014	McKeevers Chemist, Armagh	144 x NKDSKN tanning products	£961.20
09/04/2014	Douglas Perfumeries s.r.o, Prague	26 x NKDSKN tanning products	€107.50
31/07/2015	BoscoV's Department Stores, Reading, US	96 x NKD SKN tanning products	\$868.14
08/01/2016	Superdrug Stores plc, Surrey, GB	1708 x NKDSKN tanning products	£4292.70
20/01/2017	Amazon US	204 x NKD SKN tanning products	\$1099.66

23. This concludes my summary of the opponent's evidence, insofar as I consider it relevant. It is not necessary to separately summarise the written submissions, however, I take them into account and will refer to them, where necessary, throughout this decision.

## **The applicant's evidence**

24. The applicant's evidence consists of a witness statement and four exhibits from Christopher Andrew Baume, an attorney of the representatives acting for the applicant.

25. Mr Baume's witness statement simply confirms his position and describes each of the exhibits, as follows.

26. Exhibit CAB1 is a printout from Google showing the results of a search for 'NAKED + dictionary definition'. The definitions include, inter alia:

- “1. (of a person or part of the body) without clothes.  
(of an object) without the usual covering or protection.”

27. Exhibit CAB2 contains extracts from two online articles which use the word naked in reference to cosmetics. The first of the articles is on The Guardian's website and is dated 15 May 2016, the title of which is “The eco guide to naked cosmetics”. The second article, taken from Lush.com, is dated 2017 and titled “The naked truth: Packaging-free cosmetics”. Both articles describe 'naked cosmetics' as being cosmetics containing no synthetic preservatives and packaged within minimal packaging.

28. Exhibit CAB3 contains extracts from two websites (nakedcos.com and urbandecay.co.uk) showing examples of cosmetic products displaying the word NAKED. In total there are 28 products which visibly show the word NAKED on their packaging.

29. Exhibit CAB4 contains printouts from the Intellectual Property Office website displaying 23 trade mark registrations in Class 3 which contain the word NAKED (as the plain word or stylised).



## DECISION

### Proof of use

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

“6A Raising of relevant grounds in opposition proceedings in case of non-use

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

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

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

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

(6) Where an earlier trade mark satisfies the use condition 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.”

31. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

32. The relevant period in the current case, in which the opponent must prove use of its mark (no claim for proper reasons for non-use having been made), in accordance with section 6A of the Act, is 18 November 2012 to 17 November 2017.

33. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *Walton International Ltd & Anot v Verweij Fashion BV*<sup>1</sup>, Arnold J. summarised the case law on genuine use of trade marks:

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<sup>1</sup> [2018] EWCH 1608 (Ch) (28 June 2018)

“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 Bunderversvereinigung 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 Behher 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].”

34. I will now consider whether the evidence filed is sufficient to constitute genuine use of the mark.

35. The undated images of goods’ packaging at Exhibit JC1 do not prove use of the mark for goods that are currently being marketed, since it is not apparent where the images are taken from (be it a website or a brochure, for example), or whether the public has seen them.

36. I agree with the applicant that the majority of social media posts at Exhibit JC2 appear to have been made, for example, by bloggers who have been sent the goods in order to test and review them for advertising purposes. Whilst this might not be sufficient evidence of use by itself, the correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other<sup>2</sup>. The social media posts are supported by the extracts of the opponent’s website (Exhibit JC3) and the invoices which, collectively, clearly show that goods under the earlier marks were clearly available to the public during the relevant period. The invoices at Exhibit JC4 are also evidence that sales were made across the UK and the EU, which is required since the opponent relies upon UK and EU trade marks. Although the figures on the invoices are far from huge, they do indicate a small but growing business.

37. Putting all the evidence together provides me with a picture which is sufficient to establish that the opponent has genuinely used its mark in the relevant period.

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<sup>2</sup> See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* [2014] WL 517611

## Fair specification

38. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*<sup>3</sup>, 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

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<sup>3</sup> [2016] EWHC 3103 (Ch)

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.”

39. No evidence has been filed, except the undated image of a cleansing mask (which I have already found to be insufficient to show use), of any goods other than what I, and the average consumer, would describe as tanning preparations. Cosmetics and hand lotions (as relied upon by the opponent) are not terms that the average consumer would describe such goods as: although the goods are forms of cosmetics, it is much too wide a category to permit; and hand lotions have simply not been shown anywhere in the evidence. Under its UKTM 2384994 and EUTM 4598116, the opponent may rely on what I consider to be a fair specification of “tanning preparations” only for the purposes of this opposition. This represents a fair sub-category of product. However, since it was not subject to proof of use, the opponent may also rely upon its EUTM 13727631 (NKD SELF TAN SKN) and its class 3 goods (listed in paragraph 6, above).

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

40. Under section 5(2)(b), I will focus on the opponent’s EUTM 13727631 (NKD SELF TAN SKN), since it has a wider specification than the specification I came to for the NKDSKN and nkdskn marks.

41. Section 5(2)(b) of the Act states that:

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

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

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

## **Relevant law**

42. 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.

### *The principles*

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

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

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

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



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

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

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

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

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

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

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

### **Comparison of goods**

43. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>4</sup>, that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

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<sup>4</sup> Case T-133/05

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

44. When making the comparison of goods, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*<sup>5</sup> is also relevant. The CJEU stated as paragraph 23 of its judgment:

“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.”

45. Guidance on this issue has also come from Jacob J in the *Treat*<sup>6</sup> case, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (a) The respective users of the respective goods or services;
- (b) The physical nature of the goods or acts of service;
- (c) The respective trade channels through which the goods or services reach the market;
- (d) 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;
- (e) 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

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<sup>5</sup> Case C-39/97

<sup>6</sup> [1996] R.P.C 281

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

46. The goods to be compared are as follows:

Earlier mark (NKD SELF TAN SKN)	Applied for mark
<p>Soaps, skin soap, shower gel, bubble bath; perfumery, essential oils for aromatherapy, essential oils for massage, essential oils for treatment of acne; cosmetics, preparations in powder, granule, solid, cream, lotion or liquid form for the eyes, face, lips and nails; foundation and body shimmer; skincare products, namely moisturizers, toners, cleansers, polishes, sun protection preparations, tanning preparations, preparations for pedicures and manicures; hand lotions.</p>	<p>Beauty products, namely, cosmetics, skin care preparations, creams, serums, soaps, body lotions, facial oils and creams, toilet waters, essential and herbal oils, cosmetics, make-up preparations, make-up, non-medicated toilet preparations, toiletries, skin care preparations, preparations for use in the bath or shower, bath and shower oils, gels, creams and foams, face and body masks, face and body scrubs, facial washes, skin cleaners and hydrators, skin toners, skin moisturizers, skin care preparations, body lotion, blemish creams and blemish gels, facial peels, exfoliants, makeup removers, cotton wool for personal use, lip balm, petroleum jelly, pre-moisturised baby wipes, tissues impregnated with cosmetic lotions, sponges impregnated with soaps or toiletries, sun protection products, sunscreen, sun-block, after-sun lotion, kits consisting of one or more of the foregoing products.</p>

47. In reaching the conclusions which follow, I have taken into account (but do not intend to record here) all the written submissions made in relation to this aspect of this case.

48. Since 'beauty products' defines what the goods in the applicant's specification are, only the goods after the word 'namely' require consideration.

49. The applicant's 'cosmetics, toilet waters, essential and herbal oils, and sun protection products, sunscreen, sun-block' are identical (either due to the identical wording or in accordance with *Meric*) to the opponent's 'cosmetics, perfumery, essential oils for aromatherapy, essential oils for massage, essential oils for treatment of acne, and sun protection preparations' respectively.

50. Cosmetics are defined<sup>7</sup> as substances applied to the face or body to improve its appearance. This accords with my understanding of the term. *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*<sup>8</sup> is relevant here. Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations” ... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

51. Neuberger J. went on to hold that skin lightening cream and/or dry skin lotion fell within the term cosmetics and were thus identical.

52. Bearing in mind the above guidance, I come to the view that the applicant's 'skin care preparations, creams, serums, body lotions, facial oils and creams, make-up preparations, make-up, non-medicated toilet preparations, toiletries, face and body masks, skin toners, skin moisturizers, body lotion, blemish creams and blemish gels, facial peels, exfoliants, lip balm, petroleum jelly, and after-sun lotion' fall within the

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<sup>7</sup> See Cambridge English dictionary

<sup>8</sup> [2000] F.S.R. 267 (HC)

scope of the opponent's 'cosmetics'. These goods are identical in accordance with the principle outlined in *Meric*.

53. 'Soaps, preparations for use in the bath or shower, bath and shower oils, gels, cream and foams, face and body scrubs, facial washes, skin cleaners and hydrators, and makeup removers' are unlikely to fall within 'cosmetics' given that they are generally just for cleaning purposes rather than improving appearance. However, given their reasonably close trade channels together with the facts that (i) they all form part of the personal grooming regime and (ii) the goods at issue could well include ingredients designed to improve the appearance of the face/body (i.e. moisturising), there is still a high degree of similarity between these goods.

54. 'Cotton wool for personal use, pre-moisturised baby wipes, tissues impregnated with cosmetic lotions, and sponges impregnated with soaps or toiletries' are also unlikely to fall within 'cosmetics' given the difference in nature (goods used to apply cosmetic substances or containing cosmetics substances as opposed to the substances themselves). That being said, the purpose is similar to cosmetics in that the goods are all used on the face or body to clean it or improve its appearance. Moreover, the goods complement each other and will be available in close proximity to one another in physical stores or under the same/similar category online. Although they do not compete with each other, overall, I consider 'cotton wool for personal use, pre-moisturised baby wipes, tissues impregnated with cosmetic lotions, and sponges impregnated with soaps or toiletries' and 'cosmetics' to have a reasonably high degree of similarity.

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

55. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*<sup>9</sup>.

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<sup>9</sup> Case C-342/97

56. 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.”

57. The average consumer of the parties’ goods is a member of the general public. Although the price of the goods can vary (for example, some make-up products can be quite expensive, others less so), they are not, generally speaking, particularly expensive and they are purchased fairly frequently. I bear in mind that the average consumer is likely to consider, for example, the ingredients, the suitability for their skin and the cost of the goods in question and I find that, taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be average. The purchase is likely to be predominantly visual: the goods will be self-selected from physical stores or websites. However, I do not discount that there may be an aural element with conversations taking place with sales staff in a retail setting.


### **Comparison of marks**

58. It is clear from *Sabel BV v Puma AG* 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 their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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 relevant 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.”

59. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

60. The marks to be compared are as follows:

Earlier mark	Applied for mark
 The earlier mark consists of the word "NKD" in large, bold, black, sans-serif capital letters. Below "NKD" are the words "SELF" and "TAN" in smaller, black, sans-serif capital letters, separated by a space. Below "SELF TAN" is the word "SKN" in large, bold, black, sans-serif capital letters.	Nked Face

61. The parties have made various submissions on the similarities of the marks and I have considered them all in reaching my decision. I will refer to some of the arguments raised below (although I do not propose to reproduce the submissions in full).

#### Overall impression

62. The applicant’s mark consists solely of the words Nked Face. Consumers who would purchase the goods at issue would likely recognise the relevance of the word

face in relation to beauty products. Whilst this may mean that the prefix Nked plays a slightly greater role in the overall impression of the mark, the word face still contributes to the overall look and feel of the mark when it is considered as a whole, the former word qualifying the other.

63. The overall impression of the opponent's mark resides in the presentation of four words or textual components, namely NKD SELF TAN SKN. Given the larger size of the words NKD and SKN, and the overall manner of presentation, I consider that NKD SKN will be seen as one element, which is intersected by another, SELF TAN. Given the size of the elements (and the distinctiveness of SELF TAN) I find the words NKD SKN to bear by far the greatest weight in the overall impression of the mark, although the words SELF TAN still contribute to the overall impression.

#### Visual comparison

64. The similarities in the marks are the letters N, K and D in the first component of each mark. The differences are that the applicant's mark contains the second word 'Face' as opposed to 'SKN', the difference in presentation, and the opponent's mark contains a further two words, SELF TAN. Overall, I find a medium degree of visual similarity between the marks.

#### Aural comparison

65. Both parties submit that the first element of their respective marks will be pronounced 'naked'. I accept this. The applicant's mark will therefore be pronounced naked face. Since the words SELF TAN in the opponent's mark are descriptive for some of the goods for which the mark is registered, and that its weight in the overall impression is low, I think it likely that the average consumer would not articulate these words and instead refer to the mark by the words NKD SKN (pronounced naked skin). I find a medium degree of aural similarity between the marks. In the alternative, if the average consumer does articulate all components of the opponent's mark ('naked skin self tan'), I would find a lower degree of aural similarity between the marks.



## Conceptual

66. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*<sup>10</sup>. The assessment must be made from the point of view of the average consumer.

67. As I have found (and the parties submit) the words *nked* and *nkd* in the marks will be seen as misspellings of the common dictionary word *naked*. In both marks, the two words (*naked skin* and *naked face*) combine to create a clear concept of a naked or bare part of the body. Overall, I find the marks to be conceptually similar to a high degree.

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

68. Firstly, I deal with the applicant's evidence which has been filed to show that the word *naked* is commonly used in relation to cosmetics. Firstly, I bear in mind the guidance of the GC in *Zero Industry Srl v OHIM*<sup>11</sup>:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865,

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<sup>10</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

<sup>11</sup> Case T-400/06

paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

69. Accordingly, it would not have been appropriate for me to consider other marks currently on the register per se. However, as I set out below, the applicant does provide evidence of the word being used in trade.

70. The applicant’s remaining evidence does satisfy me that the word naked is commonly used on or in relation to cosmetics. Such use is not of those other traders using it as a brand name, but more in a descriptive manner<sup>12</sup>. As such, the word NAKED, per se, is not particularly distinctive for such goods. I bear in mind that the earlier mark is dominated by the words NKD SKN (which will be understood as naked skin). The addition of the word skin, which is descriptive of the area of the body on which the goods are used, does not alter the distinctive character. However, the omission of the vowels to create NKD SKN changes the look of the mark and therefore adds to its distinctive character. Overall, the opponent’s earlier mark has an average degree of inherent distinctive character.

71. A mark may have an enhanced distinctive character because of the use that has been made of it. With this in mind, I need to assess whether the use made by the opponent of its mark has improved its inherent distinctiveness level. I have not been provided with enough information on the opponent’s annual turnover or the market share of its goods. As such, I am not satisfied that the evidence filed is sufficient to show an enhanced level of distinctiveness, which remains at average.

### **Likelihood of confusion**

72. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter

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<sup>12</sup> See the comments of Floyd J. in *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch

of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

73. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertaking being the same or related).

74. The marks have been found to be visually similar to a medium degree, aurally similar to a medium degree (or a lower degree if the average consumer articulates all components of the opponent's mark) and conceptually highly similar. The goods at issue have been found to be identical or highly similar.

75. Considering the visual differences between the marks, and notwithstanding the concept of imperfect recollection, I do not find direct confusion to be likely. The average consumer will not mistake one of these marks for the other.

76. In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*<sup>13</sup>:

“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 recognised 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>13</sup> BL 0/375/10

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).”

77. These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach<sup>14</sup>.

78. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common element of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

79. Both marks begin with what the average consumer will see as naked and are followed by an area of the body and (in the earlier mark) words describing some of the goods it is registered for. I consider that the use of the word naked (as NKD or Nked) in both the earlier mark and the later mark on identical goods at issue, particularly

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<sup>14</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

when in both marks that word is followed by a word which references a part of the body, will create an expectation on the part of the consumer that the goods come from the same or economically linked undertakings. Both marks have removed vowels from the word meaning that visually, it is no longer the ordinary dictionary word naked (although it evokes it), and the word in both marks, as stated earlier, has the added word referencing a part of the body. I am of the view that the average consumer is likely to remember that the word NAKED in each mark had a letter or letters missing but not necessarily which one/s. The difference created by the change of body part would be seen as a natural brand variation, and the inclusion/removal of SELF TAN a non-distinctive alteration. There is, therefore, a likelihood of indirect confusion in relation to the identical goods I am firstly considering. In relation to the other goods, I consider that the level of similarity between the goods, and the type of relationship that exists between them, coupled with the assessment I have already made, would similarly result in indirect confusion. The average consumer would assume that the goods are an expansion of range using an appropriately varied (but confusable) brand.

80. The opponent's case under section 5(2)(b) has been successful.

81. Since the opposition has succeeded on this ground, there is no need to consider the other earlier marks relied upon by the opponent.

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

82. I have considered the opponent's case under section 5(4)(a) of the Act and all relevant caselaw. In the case before me, the marks relied upon under 5(4)(a) are the same as those under 5(2)(b). In addition, one earlier mark under section 5(2)(b) has a wider specification than the goods on which the opponent may rely as having goodwill for section 5(4)(a). Whilst it is not always the case that the outcome of the 5(4)(a) ground is the same as that of the 5(2)(b) ground, the 5(4)(a) ground in this case does not put the opponent in a better position, in fact, the opponent is in a weaker position under this ground. I do not consider it necessary to go any further into the 5(4)(a) ground.

## Conclusion

83. The opponent's case under section 5(2)(b) has been successful. Subject to appeal, the applicant's mark is refused registration.

## Costs

84. As the opponent has been successful, it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2016. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fee:	£200
Preparing a statement and considering the other side's statement:	£200
Preparing evidence (and accompanying submissions) and considering the other side's evidence and submissions:	£700
<b>Total:</b>	<b>£1100</b>

85. I order Nked Face Ltd to pay Vita Liberata Limited the sum of **£1100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 31 May 2019**

**Emily Venables**  
**For the Registrar,**  
**The Comptroller-General**