

**O/0001/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3645757  
BY PRIME COSMETICS LTD**

**TO REGISTER:**

**SKINSURE**

**AS A TRADE MARK IN CLASSES 3, 21 & 44**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 427718 BY  
UNILEVER GLOBAL IP LIMITED**

## BACKGROUND AND PLEADINGS

1. Prime Cosmetics Ltd (“the applicant”) applied to register **SKINSURE** as a trade mark in the United Kingdom on 23 May 2021. The application was accepted and published on 23 July 2021 in respect of the following goods and services:

### Class 3

*Skin clarifiers; Skin toner; Skin creams; Skin conditioners; Skin moisturizers; Skin masks; Skin emollients; Skin moisturisers; Skin lotions; Skin balms [cosmetic]; Clay skin masks; Skin masks [cosmetics]; Skin make-up; Skin care mousse; Skin cleansing cream; Skin care cosmetics; Skin creams [cosmetic]; Skin moisturizer masks; Skin cleansers [cosmetics]; Skin care preparations; Oils for the skin; Non-medicated skin balms; Skin care oils [cosmetics]; Non medicated skin toners; Non-medicated skin creams; Lotions for the skin; Moisturising skin creams [cosmetic]; Skin care lotions [cosmetic]; Skin creams [non-medicated]; Cosmetics and cosmetic preparations; Eyebrow cosmetics; Cosmetic pencils; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetics preparations; Cosmetic masks; Decorative cosmetics; Lip cosmetics; Cosmetic soaps; Nail cosmetics; Eye cosmetics; Cosmetic kits; Natural cosmetics; Cosmetic bath salts; Non-medicated cosmetics; Cosmetic massage creams; Facial washes [cosmetic]; Body scrubs [cosmetic]; Facial gels [cosmetics]; Hair oils; Hair creams; Hair cosmetics; Hair gels; Hair balm; Eye makeup; Eye makeup remover; Gel eye masks; Cosmetics for eye-lashes; Cosmetics for eye-brows; Liners [cosmetics] for the eyes; Cosmetic preparations for eye lashes; Skin, eye and nail care preparations.*

### Class 21

*Cosmetics applicators; Cosmetic utensils; Cosmetic sponges; Cosmetic spatulas; Cosmetic brushes; Holders for cosmetics; Dispensers for cosmetics; Applicators for cosmetics; Eye make-up applicators; Applicators for applying eye make-up.*

Class 44

*Skin care salons; Laser skin tightening services; Laser skin rejuvenation services; Skin care salon services; Dental services; Dental consultations; Cosmetic treatment; Cosmetic electrolysis; Cosmetic dentistry; Injectable filler treatments for cosmetic purposes; Cosmetics consultancy services.*

2. On 22 October 2021, the application was opposed by Unilever Global IP Limited (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods and services in the application.

3. Under section 5(2)(b), the opponent is relying on UK Trade Mark (“UKTM”) no. 1332322, **SURE**, which has an application date of 15 January 1988 and a registration date of 8 November 1991. The opponent relies on all the goods for which the mark stands registered, namely:

Class 3

*Deodorants and anti-perspirants; all included in Class 3.....Anti-perspirants.*

Class 5

*Deodorants.*

4. The opponent claims that the marks are visually and aurally similar. On the subject of the goods and services, it asserts:

“The respective goods are all in the nature of personal care products or goods for applying personal care products and are identical or highly similar. They are complementary and converge in terms of purpose, trade channels, nature and target consumers. In addition, the services covered by the mark in suit all relate to the personal care field, including skin care, invasive and non-invasive cosmetic treatments and cosmetic dentistry. They are complementary to the goods covered by the earlier mark and consumers will readily make an association as to origin given the clear visual and

phonetic similarities between the marks, in particular given the descriptive nature of the word SKIN.”

5. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. Under section 5(3), the opponent is relying on the same mark. It claims that this mark has a significant reputation and that the public would make a link between the marks. It attests that use of the applied-for mark would ride on the coattails of the earlier mark and benefit from its power of attraction, reputation and prestige, and/or that the ability of the earlier mark to identify the goods for which it is registered would be weakened as a result of the use of the later mark. It also claims that use of the contested mark would tarnish the reputation of the earlier mark as the Class 44 services would compromise the earlier mark’s brand values.

7. Under section 5(4)(a), the opponent claims to have used the sign **SURE** throughout the UK since at least 1970 for the following goods: *Deodorants and anti-perspirants*. It claims that the sign benefits from “*overwhelming reputation and goodwill*” and that use of the contested mark by the applicant would constitute a misrepresentation resulting in significant damage to the opponent’s goodwill.

8. The applicant filed a defence and counterstatement denying the claims made. It argues that:

“Since everyone deserves the right to accurately identify the type of goods or services it sells, to allow a single company to claim trademark rights to a generic term would impoverish the language and unfairly hamper competition. By no means is the mark ‘SKINSURE’ an extension of the mark ‘SURE’, and it is extremely unlikely that consumers would confuse or readily make an association between the two marks and believe there to be an economic connection between both.”

9. Neither party requested a hearing and only the opponent filed written submissions in lieu. These are dated 10 October 2022. I have taken this decision following a careful consideration of all the papers.

10. In these proceedings, the opponent is represented by Lane IP (having initially been represented by Murgitroyd & Company) and the applicant by Leonard Solicitors LLP.

## **EVIDENCE**

11. Only the opponent filed evidence. This comes from Stephen Beale, Trade Mark Counsel for the Unilever group of companies, including Unilever Global IP Limited. It is dated 29 April 2022. Mr Beale's evidence covers the use made of the earlier mark and promotional activities.

12. When filing this evidence, the opponent also filed a request for an extension of time to file additional evidence relating to trends in the skin care and anti-perspirant and deodorant sector. It said that this evidence had only recently come to hand. The request was granted. The additional evidence was filed under cover of another witness statement from Mr Beale dated 13 May 2022.

## **PRELIMINARY ISSUES**

13. The applicant claims that the contested mark was previously registered by another company between 2005 and 2015 and submits that *"it is unlikely that if this mark did not pose any threat or confusion to the 'SURE' mark during this time, that it would cause threat or confusion at present and in the future"*. There is no evidence before me as to the extent to which this mark might have been used between 2005 and 2015 and whether there was actually any opportunity for confusion to arise. Furthermore, the decision to oppose an applied-for mark, or to seek invalidation of one that has already been registered, is a commercial decision and influenced by a number of different factors. Therefore, the fact that this mark was on the register between 2005 and 2015 is not relevant to my consideration of this opposition.

14. The existence of other marks containing the word “SURE” is also a point that does not assist the opponent. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case T-400/06, the General Court (“GC”) stated that:<sup>1</sup>

“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, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”<sup>2</sup>

15. I shall consider this point no further.

## **DECISION**

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

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

“A trade mark shall not be registered if because –

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<sup>1</sup> 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 Trade Marks Act relied on 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, although the UK has left the EU.

<sup>2</sup> Paragraph 73.

...

(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.”

17. The registration upon which the opponent relies qualifies as an earlier trade mark under section 6(1)(a) of the Act. The earlier mark was registered more than five years before the date on which the application for the contested mark was made, but, as the applicant did not require the opponent to prove use under section 6A of the Act, the opponent may rely on all the goods for which the mark is registered.

18. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their

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 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; and



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***

19. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

“... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”<sup>3</sup>

20. The earlier goods are *Deodorants* and *Anti-perspirants* in Class 3 and *Deodorants* in Class 5. The difference between the two is that the Class 5 goods are medicated, while those in Class 3 are non-medicated. I have come to this view on the basis of the class headings in the Nice Classification.<sup>4</sup> Such an approach was approved by the High Court in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)* [2018] EWHC 3608 (Ch), paragraph 94. The goods will be used by members of the general public to prevent unwanted body odour and sweating and to maintain the freshness and hygiene of the person. They will come in the form of liquids in spray cans and roll-ons or as solid sticks that the user will, in all these cases, apply to the skin. They are sold in general retailers, such as supermarkets

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<sup>3</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

<sup>4</sup> The system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, last amended on 28 September 1979.

and convenience stores, as well as shops selling cosmetics, toiletries and pharmaceutical products.

21. I shall now compare them to the contested goods. In doing so, I will group these goods where they “*are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons*”: see *SEPARODE Trade Mark*, BL O-399-10, paragraph 5.

22. I also bear in mind the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”<sup>5</sup>

### *Class 3*

23. The opponent submits that all the Class 3 goods are either identical or highly similar to its goods, as they are all “personal care” products that are sold through the same trade channels, often close to each other, and frequently have the same manufacturer.

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<sup>5</sup> Paragraph 12.

24. The first group of goods that I shall consider consists of *Skin balms [cosmetic]; Skin masks [cosmetics]; Skin care cosmetics; Skin creams [cosmetic]; Skin cleansers [cosmetics]; Skin care oils [cosmetics]; Moisturising skin creams [cosmetic]; Skin care lotions [cosmetic]; Cosmetics and cosmetic preparations; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic preparations; Cosmetic masks; Cosmetic kits; Natural cosmetics; Non-medicated cosmetics; Cosmetic massage creams; Facial washes [cosmetic]; Body scrubs [cosmetic]; Facial gels [cosmetics]*. Cosmetics are products that are used to improve a person's appearance. This purpose differs from that of the opponent's goods which I identified in paragraph 20 above. However, I consider that the applicant's goods may also be used to care for the skin and improve its condition, and this is a feature of some of the applicant's goods. There could be some overlap in physical nature and method of use, in that they will all be applied to the skin via a variety of means (such as by a spray or sponge). I accept that they will be targeted towards the same users and share trade channels, but I do not consider that they are complementary or in competition. Overall, I find that there is a low to medium degree of similarity between the goods.

25. I now turn to *Skin clarifiers; Skin toner; Skin creams; Skin conditioners; Skin moisturizers; Skin masks; Skin emollients; Skin moisturisers; Skin lotions; Clay skin masks; Skin care mousse; Skin cleansing cream; Skin moisturizer masks; Skin care preparations; Oils for the skin; Non-medicated skin balms; Non medicated skin toners; Non-medicated skin creams; Lotions for the skin; Skin creams [non-medicated]; Eye makeup remover; Gel eye masks; Skin, eye ... care preparations*. In my view, the contested goods will all be used to clean the skin or maintain and improve its condition. Consequently, there is a degree of overlap between the purposes of both parties' goods, which will be targeted at the same users. There is a degree of similarity in their method of use, as they will all be applied to the skin. I agree with the opponent that they will be sold through the same trade channels. I do not consider that they are in competition, as the applicant's goods are not readily substitutable for the opponent's *Deodorants* and *Anti-perspirants*. Neither do I consider them to be complementary in a trade mark sense. Overall, I find that there is a medium degree of similarity between the goods.

26. The next group consists of *Skin make-up; Eyebrow cosmetics; Cosmetic pencils; Decorative cosmetics; Lip cosmetics; Eye cosmetics; Eye makeup; Cosmetics for eye-lashes; Cosmetics for eye-brows; Liners [cosmetics] for the eyes; Cosmetic preparations for eye lashes*. The primary purpose of these goods is to improve the user's appearance, so this differs from that of the opponent's goods. However, I do not consider that the core meanings of these terms would include goods with hygiene- or skincare-related purposes, where there might have been some overlap with the opponent's goods. There will be shared trade channels and users, but the goods are neither complementary nor in competition with each other. I find that there is a very low degree of similarity between them.

27. The applicant's *Cosmetic soaps* will have the dual purpose of cleansing the body and improving its appearance. They may also have deodorising properties. The applicant's goods will come in the form of a solid block or a liquid and be used with water to form a lather which is then applied to the body, rather than being applied directly as with the opponent's goods. There will be shared trade channels and users, and it is possible that there may be some competition between the goods. I find that there is a medium degree of similarity between them.

28. The applicant's *Cosmetic bath salts* will also, in my view, have the dual purpose of cleansing the body and improving its appearance. They will be used with water, and have the form of crystals that will be dissolved in a bath. There will be some overlap in purpose but the method of use and physical nature are different. Trade channels and users are likely to be shared. I find a low degree of similarity between the goods.

29. Finally for this Class, I come to *Nail cosmetics; Hair oils; Hair creams; Hair cosmetics; Hair gels; Hair balm; ... nail care preparations*. As the terms suggest, these goods are all applied to the hair or nails to improve the condition and/or appearance. I consider that the purpose is different from that of the opponent's goods, except at a fairly general level. I agree that they will be sold to the same users through largely the same trade channels as the opponent's goods, although they are likely to be in less close proximity than the skincare products, as they are intended for a different part of the body. The goods are not in competition or complementary. I find that there is a very low degree of similarity between them.

## Class 21

30. I shall consider all the Class 21 goods together. These are as follows: *Cosmetics applicators; Cosmetic utensils; Cosmetic sponges; Cosmetic spatulas; Cosmetic brushes; Holders for cosmetics; Dispensers for cosmetics; Applicators for cosmetics; Eye make-up applicators; Applicators for applying eye make-up*. It will be seen that these are all tools that are used for applying Class 3 cosmetics. The opponent submits that they are all “*complementary to personal care could constitute a range of goods to which the opponent’s mark may readily be applied by way of brand extension*”.<sup>6</sup> This argument may have more force if I were comparing, say, *Eye make-up applicators* with *Eye make-up*. However, I am to compare the Class 21 goods with *Deodorants* and *Anti-perspirants*. The purposes of these goods are different, as are the physical natures. I do not find that there is any complementarity. None of the Class 21 goods are essential for the use of the opponent’s goods in such a way that the average consumer would think they came from the same entity. The goods may have the same users and share trade channels, but this is not enough for me to find similarity. In my view, the goods are dissimilar.

## Class 44

31. The opponent submits that:

“... the services in Class 44 of the mark in suit are all highly complementary and/or similar to the ‘deodorants and antiperspirants’ covered by the opponent’s mark, noting that as stated above and in the evidence of Mr Stephen Beale, the opponent’s goods are often marketed to the skin sensitive consumer who will readily access the services at issue. This is also true of the opponent’s ‘deodorants’ in class 5 which, inherent to that classification, are for use by consumers seeking out a ‘medicated’ variant. It should also be noted that clinics which dispense skin treatments will often sell personal care products, including deodorants and antiperspirants.”<sup>7</sup>

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<sup>6</sup> Opponent’s written submissions, page 7, unnumbered paragraph.

<sup>7</sup> Opponent’s written submissions, page 7, unnumbered paragraph.

32. The applicant's *Skin care salons* and *Skin care salon services*; are all services that are intended to improve the user's appearance and the condition of their skin. They would include the application of selected products to the user's skin by a beautician. The applicant's *Cosmetic treatment* is a broader term that would include those services. Their nature is evidently different from that of the opponent's goods. I accept that the opponent's evidence shows that some deodorants and antiperspirants are formulated to be more gentle and are targeted at consumers with sensitive skin. The primary purpose, though, of the opponent's goods is, as I have already found, to deal with body odour and maintain hygiene. The overlap in purpose therefore is small. I have no evidence to support the opponent's assertion that there are shared trade channels and I do not consider that this is a point that I can take on judicial notice. I do not find any complementarity or competition, but can accept that the services and goods have the same users. I find that the services are dissimilar.

33. I now come to *Laser skin tightening services*; *Laser skin rejuvenation services*; *Cosmetic electrolysis*; *Injectable filler treatments for cosmetic purposes*. I understand that electrolysis involves the application of an electrical current to hair follicles to remove unwanted body hair. The purpose of all these services is to improve the appearance of the user. I therefore find that there is no overlap in purpose between these services and the opponent's goods. They are different in nature and I have no evidence that trade channels are shared. I do not consider that they are in competition or are complementary. I find them to be dissimilar.

34. The only similarity that I can see between the opponent's goods and the applicant's *Dental services*; *Dental consultations*; *Cosmetic dentistry* is that they have the same users. I find them to be dissimilar.

35. The final service to be compared is *Cosmetics consultancy services*. I understand this to mean the provision of advice and consultancy on products and services that will improve the appearance of the user. As with the services I have considered in the two paragraphs above, I find the only similarity to be in user. Consequently, they are dissimilar.

## *Conclusion*

36. Section 5(2)(b) of the Act requires the goods and services to be at least similar. Therefore, this ground proceeds for all the goods in Class 3. The ground fails with respect to the goods in Class 21 and the services in Class 44.

### ***Average consumer and the purchasing process***

37. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”<sup>8</sup>

38. The opponent submits that the average consumer is a member of the general public. I agree. It also contends that the goods and services are everyday goods and services and that the consumer will pay no more than a medium degree of attention. I agree with respect to the Class 3 goods, but I consider that a slightly higher than medium level of attention will be paid during the choice of *Skin care salons*, *Skin care salon services* and *Cosmetic treatments*. These services are not everyday purchases and can be bought as a treat. The consumer will want to ensure that the services offered and the ambience of the salon meets their preferences.

39. When buying the goods, the consumer will select them from shelves or from a website. They may also have been exposed to advertising in print media, on television or online. The visual element of the mark will be more significant although the aural

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<sup>8</sup> Paragraph 60.

element cannot be ignored, given the potential for word-of-mouth recommendations, assistance from sales staff or the ordering of goods by telephone.

40. I consider that the visual element will also be important when purchasing the services. The consumer is likely to have seen advertising but they may also see the mark in use on signage on a salon's premises. Consumers may also seek recommendations from others, and so the sound of the marks will play a part in the purchasing process.

### ***Comparison of marks***

41. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”<sup>9</sup>

42. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components 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 marks are shown below:

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<sup>9</sup> Paragraph 34.



Earlier mark	Contested mark
SURE	SKINSURE

44. Both marks are word marks. Registration of a word mark protects that word or words irrespective of colour, form or typeface: see *LA Superquimica v European Union Intellectual Property Office*, Case T-24/17, paragraph 39. The earlier mark is a single word and the overall impression of that mark rests in the word itself. The contested mark consists of the words “SKIN” and “SURE” joined together. The overall impression of that mark consists of the juxtaposition of those two words, which I consider will be identified by the average consumer and hang together as a unit. I note the opponent’s submission that “SKIN” is “*wholly descriptive and non-distinctive in the context of the goods and services at issue*”. I also take account of the comments of Mr Philip Harris, sitting as the Appointed Person, in *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd*, BL O-115-22. He said:

“31. Whilst it is a reasonable conclusion as regards the barely visible ‘strap’ or ‘puff’ phrase ‘IMPROVING LIFE AS NATURE INTENDED’ in the Applicant’s mark, it is self-evident that neither Gel in Purity Gel nor HEMP COMPANY in the Contested Mark can be regarded as ‘negligible’. Descriptiveness does not of itself render an element negligible or aurally invisible. Furthermore, the terms, Purity Gel and PURITY HEMP COMPANY each have a unitary character that extends beyond the individual elements.

32. Thus, insofar as the Hearing Officer concluded that these elements could be simply ignored in the aural comparison because they were descriptive, giving rise to a finding of potential identity based on the common element PURITY, I find he went too far and engaged in an unprincipled dissection of the parties’ trade marks.”

45. It is clear, then, that I cannot ignore “SKIN” in the contested mark when making the comparison.

46. Visually, the earlier mark consists of four letters which are repeated in exactly the same order at the end of the eight-letter contested mark. I find that the marks have a medium degree of visual similarity.

47. The earlier mark has a single syllable, while the contested mark has two, the second of which would be pronounced identically to the earlier mark. I find that the level of aural similarity between the marks is medium.

48. Now I come to the conceptual comparison. The word “SURE” in the earlier mark would bring to mind the idea of safety, reliability or certainty. The contested mark would convey the message that the products were safe or reliable to use on the skin. I find that there is a medium level of conceptual similarity between the marks.

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

49. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and

statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

50. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The word “SURE” alludes to a characteristic of the goods for which the mark is registered. The consumer will look for an antiperspirant or deodorant that is reliable. I find that the earlier mark has a low level of inherent distinctiveness.

51. The opponent claims that the distinctive character of the earlier mark has been enhanced through the use made of it.

### *Evidence*

52. Mr Beale states that the mark has been continuously used in relation to deodorants and anti-perspirants by the opponent or its predecessors in title since 1966.<sup>10</sup> Exhibit SB1 shows images of products dating from 1965 (i.e. pre-launch) to 1999. All bear the SURE mark. Approximate UK sales figures are shown in the table below:<sup>11</sup>

<b>Year</b>	<b>Sales values in the UK</b>
2017	£125m
2018	£134m
2019	£120m
2020	£119m
2021	£112m

53. According to Mr Beale, the mark enjoys a 20% share of the market for deodorants and anti-perspirants. However, he does not explain what period of time this figure covers.

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<sup>10</sup> First witness statement, paragraph 4.

<sup>11</sup> Paragraph 5.

54. Deodorants and anti-perspirants bearing the earlier mark are sold in supermarkets, pharmacies, convenience stores and garages. Mr Beale gives ASDA, Sainsburys, Tesco, Morrisons and Boots as examples of national retailers that stock the products. They are also for sale on online platforms such as Amazon. Exhibit SB7 contains examples of advertisements showing promotions at some of these retailers, including the one below from Boots in 2011:<sup>12</sup>



55. Approximate expenditure on promoting the mark is shown in the table below:<sup>13</sup>

Year	Promotional spend in the UK
2015	£6m
2016	£6.5m
2017	£7m
2018	£6.5m
2019	£7m
2020	£7m
2021	£7m

<sup>12</sup> Page 56.

<sup>13</sup> Paragraph 7.

56. Exhibit SB2 contains sample advertisements from 1965 to 2021, although in most cases it is not indicated where they appeared. All show the earlier mark used on the earlier goods. Exhibit SB3 shows digital posters used at London railway stations and other public places. Mr Beale states that these were used before 1 January 2021. The mark is not visible on the station posters. Exhibit SB4 took the form of a memory stick containing 22 television adverts broadcast in the UK from the 1970s. The dates are not clear for all of these but they span the period up to at least 2011. The branding throughout these television adverts has been consistent, the mark frequently being used with a tick and the slogan *“it won’t let you down”*. They show the products being used in stressful situations, such as interrogation, or hot locations.

57. Mr Beale states that a dedicated UK website for SURE-branded products has been in operation since 2014 at [suredeodorants.co.uk](http://suredeodorants.co.uk). The mark is shown at the top of the printouts from 2015 and 2018, all retrieved by the Wayback Machine.<sup>14</sup> Visitor numbers are reported to have exceeded 200,000 in 2021, although it is not clear if all of these were from the UK or how many visits were made up to the relevant date of 23 May 2021.<sup>15</sup> The opponent also operates a number of social media accounts, including on Facebook, YouTube and Twitter. Exhibit SB9 contains screenshots from social media campaigns before the relevant date.

58. The opponent has also partnered with Williams Racing and Mr Beale says that the advert below was published in *“leading UK consumer lifestyle magazines before May 2021”*.<sup>16</sup> However, he does not say what these were.

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<sup>14</sup> Exhibit SB8.

<sup>15</sup> Paragraph 13.

<sup>16</sup> Paragraph 17; Exhibit 10.



59. The evidence shows a long period of use and promotion of the mark, with what appear to be impressive sales. These are relatively low cost items, so £125 million of sales would equate to a very large volume of deodorants and antiperspirants. The majority of the goods shown in the evidence would fall under Class 3, but there is some indication that antibacterial deodorants were produced.<sup>17</sup> Mr Beale states that these were the subject of a promotional campaign in 2017 involving a number of Premiership footballers.<sup>18</sup> I am satisfied that the scale and duration of the use are such as to have enhanced the distinctive character of the mark for *Deodorants and anti-perspirants* in Class 3 to an above average degree.

### ***Conclusions on likelihood of confusion***

60. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I keep in

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<sup>17</sup> See, for example, Exhibit SB2, page 28.

<sup>18</sup> Paragraph 15.

mind 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 they have in their mind.

61. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained the ways in which confusion could occur:

“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.’

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)."

62. Earlier in my decision, I found that:

- The applicant's Class 3 goods are similar to between a very low and medium degree to the opponent's Class 3 goods;
- The remaining goods and services are dissimilar;
- The average consumer is a member of the general public who will be paying a medium degree of attention when buying the goods and a higher degree of attention when choosing the services;
- The purchase process will largely be influenced by visual aspects of the mark, but I cannot ignore the aural element;
- The marks are visually, aurally and conceptually similar to a medium degree; and
- The earlier mark has a low degree of inherent distinctive character, but that this has been enhanced to an above average level through the use that has been made of it for *Deodorants* and *Anti-perspirants* in Class 3.

63. The opponent submits that, given the imperfect recollection of the average consumer, there is the scope for mistakes. This would point towards a finding of direct confusion. However, in my view, there are sufficient differences between the marks for this to be unlikely. The contested mark is twice as long and begins differently. I do not believe that the "SKIN" element will be ignored, despite its descriptiveness, particularly as it appears at the beginning of the mark. The average consumer tends to pay more attention to the beginning of marks: see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraphs 81 and 82. In my view, there is no likelihood of direct confusion.



64. I turn now to indirect confusion which Mr Purvis explained as the result of the average consumer recognising that the marks are different, but assuming that they belong to the same entity or ones that are economically connected. He gave three examples of scenarios in which that may arise. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”<sup>19</sup>

65. The opponent submits that the contested mark will be seen as a related brand or a skin-sensitive brand extension. It refers me to the evidence of Mr Beale which, it submits, show that “*there is a clear trend towards satisfying the demands of skin sensitive consumers in the relevant market*”.<sup>20</sup> This evidence consists of a selection of products from the opponent’s skin sensitive range, together with an advert for the women’s skin care range.<sup>21</sup> These are undated, but Mr Beale states that his company has been present in this sector since at least 2003, which was when the “Sure for Men Sensitive” deodorant and antiperspirant was launched.<sup>22</sup> Exhibit SB11 to his second witness statement contains extracts from the websites of competitors, namely Dove and Nivea, and from the retailer Boots illustrating a range of skin sensitive anti-perspirant and deodorant products.

66. Confusion should not be found merely because the two marks share a common element: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.4. I acknowledge that the distinctive character of the earlier mark has been enhanced to an above average degree through the use that has been made of it over a considerable period of time. Nevertheless, the earlier mark is not in my view so strikingly distinctive that the average consumer would assume that only the opponent would be using it in a mark, as the word “SURE” is, as I have found, allusive. Given the long use of the earlier mark, I take the view that it is likely that it will be brought to the mind of the

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<sup>19</sup> Paragraph 12.

<sup>20</sup> Written submissions, page 5, unnumbered paragraph.

<sup>21</sup> Exhibit SB6.

<sup>22</sup> First witness statement of Mr Beale, paragraph 10.

average consumer when seen on goods that share the same trade channels, but this is mere association and not confusion. I do not consider that either of Mr Purvis's other suggestions apply here and I can see no other reason why the average consumer would assume a connection. I find there is no likelihood of indirect confusion.

67. The opposition fails under section 5(2)(b).

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

68. Section 5(3) of the Act is as follows:

“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 (or, in the case of a European Union trade mark or international trade mark (EU) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

69. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the application. I have already found in the opponent's favour here. Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the

factors which must be assessed in deciding whether the public will make a link between the marks.

70. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07) and *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened

as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77.

g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

## **Reputation**

71. In *General Motors Corp*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on

the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

72. The date on which reputation needs to be shown is the date of application for the contested mark, i.e. 23 May 2021. The relevant public is the general public.

73. The factors that are relevant to reputation are the same as those I considered in the context of the enhanced distinctive character of the earlier mark. The evidence adduced by the opponent was sufficient for me to find enhanced distinctive character and they are sufficient for me to find a strong reputation for *Deodorants and anti-perspirants*. I will, however, say a little about what the evidence shows as to the nature of that reputation. The television advertisements in Exhibit SB4 show the opponent's deodorant and antiperspirant products used in the context of stressful situations or in hot locations, with the consistent message that Sure "*won't let you down*". The

message is one of reliable, high-performing goods that can stand up to the toughest of conditions.

### ***Link***

74. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

#### *The degree of similarity between the conflicting marks*

Under section 5(2)(b), I found that the marks were visually, aurally and conceptually similar to a medium degree.

#### *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

I found the Class 3 goods similar to a very low to medium degree to the opponent's goods and the remaining contested goods and services to be dissimilar. The opponent submits that all the goods and services are part of the "personal care" sector and I accept that, at a general level, this is the case.

#### *The strength of the earlier mark's reputation*

I found the earlier mark to have a strong reputation.

#### *The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

The earlier mark has a low level of inherent distinctive character, but this has been enhanced through the use made of it, so that the distinctiveness of the mark is above average.

#### *Whether there is a likelihood of confusion*

I found that there was no likelihood of confusion for the goods I found to be similar under section 5(2)(b). The opponent submits that similarity between the goods and/or services is not essential for a finding of confusion under section 5(3). In

*Claridge's Hotel Ltd v Claridge Candles Limited & Anor*, [2019] EWHC 2003 (IPEC), Mr Douglas Campbell QC, sitting as a Judge of the Intellectual Property Enterprise Court ("IPEC") found a likelihood of confusion even though the goods and services were not similar. However, this finding was based on a number of factors, including the very high degree of similarity between the signs ("CLARIDGE'S" and "CLARIDGE"), the strong reputation of the earlier mark and its high degree of distinctive character.<sup>23</sup> While I have found that "SURE" has a strong reputation, it is not, in my view, as highly distinctive as "CLARIDGE'S", given the inherently allusive nature of the mark, and neither are the marks as similar as in the cited case. Taking all these factors as a whole, it is my view that there would not be confusion where the goods and services are dissimilar.

75. Although I found no likelihood of confusion under section 5(2)(b), I did come to the view that, particularly given its enhanced distinctive character, the earlier mark would be brought to the mind of the average consumer (who is identical to the relevant public under this section, both being the general public). In the light of the strong reputation of the earlier mark, I find there would be a link for those goods that were similar, namely the Class 3 goods.

76. The opponent's submissions that there would be a link in relation to all the contested goods and services is based on the premises that the earlier mark has an "*overwhelming*" reputation, that the level of similarity between the marks is high and that there is a connection between the goods and services. No further reasoning is given. It will be recalled that I found that the marks were visually, aurally and conceptually similar to a medium degree. Given that the goods are used with skincare products and will be sold through the same trade channels as the opponent's goods, I consider that the strength of the opponent's reputation would lead to a link being made in the mind of the consumer.

77. Turning now to the services, I do not see how there is a connection between *Dental services*, *Dental consultations* and *Cosmetic dentistry* and *Deodorants and anti-perspirants* except at the very general level that they are all concerned with "personal

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<sup>23</sup> Paragraphs 48-49.

care”. In my view, though, the average consumer would not make a link between what I have found to be a mark with a strong reputation for those goods and the opponent’s services. Even though *Skin care salons; Laser skin tightening services, Laser skin rejuvenation services, Skin care salon services; Cosmetic treatment; Cosmetic electrolysis, Injectable filler treatments for cosmetic purposes* and *Cosmetics consultancy services* all have a connection to skincare, I consider that the allusive nature of the later mark would reduce the likelihood of a link being made with dissimilar services which are delivered through what I have no evidence to dispute are different sales channels. If there is a link, it will be so fleeting as not to give rise to damage to the earlier mark.

78. The section 5(3) claim fails with respect to the services in Class 44.

### ***Damage***

79. The opponent claims that damage would occur in at least one of four ways. The first is that the strength of the link is such that there is a likelihood of confusion even where the goods are dissimilar. I have dealt with this point above.

### ***Unfair advantage***

80. Unfair advantage means that consumers are more likely to buy the goods and services of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. Essentially, the later mark will get a marketing or commercial “leg up” because the link with the earlier reputed mark means that the owner of the later mark does not have to put in as much effort into making the later mark known because it already feels familiar or sends a message to consumers as to what they can expect: see *L’Oréal*, paragraphs 41 and 50. Such a finding can be made if that is the objective effect of the later mark, even if there is no proof that the applicant intended to take unfair advantage of the earlier mark’s reputation: see *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch), paragraph 80.

81. The opponent submits that the applicant will gain an unfair advantage through the transfer of the image of the earlier mark to the contested one. I have found that the



image of the opponent's mark that is communicated to the relevant public is one of products that are reliable and have the capacity to withstand, or protect in, the toughest conditions. These are attractive qualities for the Class 3 goods and so I find that unfair advantage is made out for these goods. I do not see that they would be particularly relevant or attractive qualities for the Class 21 goods and so I find no unfair advantage for these.

*Detriment to reputation ("tarnishment")*

82. The opponent submits that use of the contested mark for the Class 44 services will tarnish the reputation of the earlier mark. For these services, I found that no link would be made in the mind of the consumer, but even if I am wrong in this the opponent's argument is based on consumer concerns about *"the safety, value and indeed the outcomes attaching to cosmetic treatments of the type listed in class 44"*. I have been given no evidence of such concerns and it is not a point of which I can take judicial notice. Tarnishment is not made out.

*Detriment to distinctive character ("dilution")*

83. The opponent submits that the presence of another highly similar mark in the market for goods covered by the contested application would weaken the ability of the earlier mark to distinguish the opponent's goods from those of others. It continues:

*"This is likely to result in an eventual change in the economic behaviour of the opponents' customers and potential customers. SURE will stand out less from the crowd and consumers will therefore be less likely to select SURE branded Personal care products."*

84. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P, the CJEU stated that:

*"34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average*

consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81, and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38. The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or

similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No. 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

85. I accept that direct evidence of a change in consumers' economic behaviour is unlikely to be available, and that, in such an instance, a change in behaviour can be inferred from the inherent probabilities of the situation: see *32Red Plc v WHG (International) Limited & Ors* [2011] EWHC 665 (Ch), paragraph 133. I do not see how it is likely that the use of the contested mark for the Class 21 goods would make it less likely that the opponent's customers would buy its *Deodorants and anti-perspirants*. Detriment to distinctive character has not been made out.

86. The applicant has not shown that it has due cause to use the contested mark and so the section 5(3) ground succeeds in relation to the Class 3 goods.

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

87. Section 5(4)(a) of the Act states that:

“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 or 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 4(A) is met

...”

88. Subsection 4(A) is as follows:

“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.”

89. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must

demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."<sup>24</sup>

### **Relevant Date**

90. In *Advanced Perimeter Systems v Keycorp Limited (MULTISYS)*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

"Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made."<sup>25</sup>

91. As the applicant has not shown that it has used the contested mark before the date of application (23 May 2021), that is the relevant date for the purposes of this ground.

### **Goodwill**

92. The opponent must show that it had goodwill in a business at the relevant date and that the sign relied upon, **SURE**, is associated with, or distinctive of, that business.

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<sup>24</sup> Page 406.

<sup>25</sup> Quoted in paragraph 43 of BL O-410-11.

93. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

94. Given my findings on reputation under section 5(3), I am satisfied that at the relevant date the opponent had goodwill in *Deodorants and anti-perspirants* and that the sign **SURE** was distinctive of that goodwill.

### ***Misrepresentation***

95. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].

The same proposition is stated in Halsbury's Laws of England 4<sup>th</sup> Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

96. Although 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 is unlikely, in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. Consequently, this ground of opposition does not take the opponent any further.

## **OUTCOME**

97. The opposition has been partially successful. Registration will be refused for the following goods:

### Class 3

*Skin clarifiers; Skin toner; Skin creams; Skin conditioners; Skin moisturizers; Skin masks; Skin emollients; Skin moisturisers; Skin lotions; Skin balms [cosmetic]; Clay skin masks; Skin masks [cosmetics]; Skin make-up; Skin care mousse; Skin cleansing cream; Skin care cosmetics; Skin creams [cosmetic]; Skin moisturizer masks; Skin cleansers [cosmetics]; Skin care preparations; Oils for the skin; Non-medicated skin balms; Skin care oils [cosmetics]; Non medicated skin toners; Non-medicated skin creams; Lotions for the skin; Moisturising skin creams [cosmetic]; Skin care lotions [cosmetic]; Skin creams [non-medicated]; Cosmetics and cosmetic preparations; Eyebrow cosmetics; Cosmetic pencils; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetics preparations; Cosmetic masks; Decorative cosmetics; Lip cosmetics; Cosmetic soaps; Nail cosmetics; Eye cosmetics; Cosmetic kits; Natural cosmetics; Cosmetic bath salts; Non-medicated cosmetics; Cosmetic massage creams; Facial washes [cosmetic]; Body scrubs [cosmetic]; Facial gels [cosmetics]; Hair oils; Hair creams; Hair cosmetics; Hair gels; Hair balm; Eye makeup; Eye makeup remover; Gel eye*

*masks; Cosmetics for eye-lashes; Cosmetics for eye-brows; Liners [cosmetics] for the eyes; Cosmetic preparations for eye lashes; Skin, eye and nail care preparations.*

96. The mark will proceed to registration for the following goods and services:

*Class 21*

*Cosmetics applicators; Cosmetic utensils; Cosmetic sponges; Cosmetic spatulas; Cosmetic brushes; Holders for cosmetics; Dispensers for cosmetics; Applicators for cosmetics; Eye make-up applicators; Applicators for applying eye make-up.*

*Class 44*

*Skin care salons; Laser skin tightening services; Laser skin rejuvenation services; Skin care salon services; Dental services; Dental consultations; Cosmetic treatment; Cosmetic electrolysis; Cosmetic dentistry; Injectable filler treatments for cosmetic purposes; Cosmetics consultancy services.*

## **COSTS**

97. Both parties have had some success in these proceedings, with the larger part going to the opponent, who is therefore entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. My calculation of the award is shown below and has been reduced to reflect the balance of success enjoyed by both sides:

*Preparing a statement and considering the other side's statement: £200*

*Preparing evidence: £500*

*Preparing submissions in lieu of a hearing: £200*

*Official fees: £200*

***TOTAL: £1100***

98. I therefore order Prime Cosmetics Ltd to pay Unilever Global IP Limited the sum of £1100 which should be paid within twenty-one days of the expiry of the appeal period



or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 3<sup>rd</sup> day of January 2023**

**Clare Boucher,  
For the Registrar,  
Comptroller-General+**