BL O/0378/24

ON APPEAL FROM

THE UK INTELLECTUAL PROPERTY OFFICE

Thursday, 23rd April 2024

Before:

MR. GEOFFREY HOBBS KC
(Sitting as the Appointed Person)
(VIA MS TEAMS)

In the Matter of the Trade Marks Act 1994 (as amended)

- and -

IN THE MATTER OF the UK designation of International Registration No. 1581221 in the name of LLC Crystal Management Company

(Respondent)

- and –

IN THE MATTER OF Opposition thereto under No. 427905 in the name of Environ Skin Care (Proprietary) Limited

(Appellant)

IN THE MATTER OF an Appeal against Decision O-0855-23 under s.76 of the Trade Marks Act 1994

(Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd.,
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Mr Thomas St Quintin (instructed by Potter Clarkson LLP) appeared for the Appellant.

The Respondent did not appear and was not represented.

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APPROVED DECISION

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THE APPOINTED PERSON:

1. On 1st December 2021, Environ Skin Care (Proprietary) Limited filed an amended form TM7 Notice and Grounds Opposition under No. 427905 to the UK designation of International Registration No. 1581221, which now stands in the name of Whitespace Brands Limited.

2. The Opponent objected to the request for protection of the word mark **RAD** in the United Kingdom for the goods listed in Class 3 of the International Registration. It is necessary and sufficient for present purposes to note that the request for protection in Class 3 was opposed under sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 on the basis of the prior rights claimed by the Opponent by virtue of registration and use of the word mark **RAD** for "suncream and sunscreen" products.

3. The Opposition was determined without recourse to a hearing on the basis of the papers on file. It was in large measure rejected by Mr. Matthew Williams acting for the Registrar of Trade Marks for the reasons he gave in a carefully considered Decision issued under reference BL O/0855/23 on 11th September 2023. The Opponent was ordered to pay £300. to the Applicant as a contribution to its costs of the Registry proceedings.

4. The outcome of the Opposition is set out in paragraph [80] of the Hearing Officer's Decision, where the Class 3 goods of the opposed application were listed with strikethrough lines superimposed for the purpose of identifying the particular listings in respect of which the Opposition succeeded as shown in the Appendix to this Decision.

5. The Opponent now appeals to this Tribunal under section 76 of the 1994 Act contending that the Hearing Officer should have gone further than he did and upheld its objections to registration under sections 5(2)(a) and 5(3) in relation to the goods for which he allowed the opposed application to proceed.

6. Three Grounds of Appeal are relied on as summarised in the Opponent's skeleton argument in the following terms:

> "6.1. Ground 1 challenges the approach to the comparison of goods, and as a consequence challenges the conclusion reached in respect of some goods. This impacts the level of similarity of those goods.
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> 6.2. Ground 2 says the Hearing Officer made an error in the application of his conclusion that RAD 'may' be perceived 'as a reference or allusion to the goods' purpose in shielding from rays radiating from the sun'. The Hearing Officer did not consider whether a significant proportion of people with the characteristics of the average consumer would not have that perception. That impacts the level of distinctiveness of the Earlier Mark, and therefore on the analysis of likelihood of confusion.
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> 6.3. Had either or both of those mistakes not been made, ESC submits that the outcome of the s.5(2)(a) case would have resulted in the opposition succeeding entirely, or at least to a greater extent.
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> 6.4. Ground 3 relates to the finding that ESC had not established a reputation. That involved an error of law. The Hearing Officer should have found that a reputation had been proved. Had he done so, and then gone on to consider the remaining matters relevant to s.5(3), he would have found that the opposition succeeded entirely, or at least to a greater extent."

7. These grounds were further developed in the Opponent's written and oral submissions before me.

8. In support of Ground 1 it is submitted that the Hearing Officer failed to consider each of the Class 3 goods in issue separately for the purpose of determining

whether they were open to objection for conflict with the Opponent's prior rights.

9. The Opponent accepts that if and to the extent that a list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision. However, it refers more specifically in that connection to the proposition that in order to be sufficiently comparable to be addressed collectively, it is necessary for the goods in question to be interlinked in a sufficiently direct and specific way to the point where they form a sufficiently homogenous category or group: see Case C-437/15P *EUIPO v Deluxe Entertainment Services Group Inc* at [28] to [34] reaffirming previous case law to that effect, including Case C-239/05 *BVBA v Benelux-Merkenbureau* at [30] to [38].

10. The Hearing Officer is said to have proceeded incompatibly with that requirement in the present case. I do not accept that submission. I can see from his Decision that the Hearing Officer proceeded by stages, at each stage sifting the itemisations in the Class 3 list of goods for the purpose of assessing them for conflict relative to the Opponent's prior rights in the word mark **RAD** for suncream and sunscreen goods.

11. He began by setting out the Class 3 list in full in paragraph [25], where he referred to them as the 'Contested Goods'. In paragraphs [26] to [34] he singled out the itemisations with respect to which he determined that the Opponent's 'double identity' objection under section 5(1) should be upheld. In paragraphs [44] to [47] he sifted through the remainder of the itemisations in the list of

Contested Goods and segregated them into those which he found to be similar to suncream and sunscreen only to a low degree and those which he identified as similar to suncream and sunscreen to a medium or higher degree. In paragraphs [56] to [61] he upheld the objection to registration under section 5(2)(a) in relation to the latter itemisations of goods.

12. He did not go through the list of Contested Goods again for the purposes of the objection to registration under section 5(3) because he found in paragraphs [66] to [70] that the evidence filed by the Opponent was not sufficient to satisfy the threshold requirements for an objection under that section of the Act.

13. On a fair reading of his Decision as a whole, the outcome of the Opponent's objections to registration under sections 5(1) and 5(2)(a) as set out and shown in paragraph [80] can be seen to be the end result of a process of sifting and segregation in which all of the Contested Goods were examined with enough regard for the nature and characteristics they each possessed to render the 'collective assessment' complaint raised in Ground 1 of the appeal inapplicable.

14. I am not persuaded otherwise by the Opponent's criticisms of the Hearing Officer's conclusions relative to particular itemisations in the list of 'low degree of similarity' goods. Those were itemised assessments involving multifactorial evaluations made by an experienced Hearing Officer in the course of carrying out the task he was required to undertake. They do not separately or together lend themselves to reversal on the basis underpinning Ground 1 of the appeal.

15. Ground 2 relates to paragraph [55] of the Hearing Officer's Decision where he stated:

> "The Opponent submits that 'the word RAD can mean extremely exciting or good.' I accept that that may be so, in which case the mark would be somewhat laudatory, which may tend to lower its distinctive character. However, in the context of the goods under the Opponent's fair specification - suncream and sunscreen – it seems likely that the average consumer may also perceive the RAD Mark as a reference or allusion to the goods' purpose in shielding from rays radiating from the sun. In my view, that three-letter word is not especially distinctive on an inherent basis. The distinctive character of a trade mark may be enhanced through its use, but having regard to the factors from case law identified in my previous paragraph, the extent of use shown in the evidence is not in my view enough to have enhanced the distinctiveness of the mark among the UK public. In reaching that conclusion, I note the great size of the UK market for suncream and sunscreens, the lack evidence of active promotion by the Opponent or iiaa and the relatively modest annual sales. I find the distinctive character of the Opponent's RAD Mark in respect of suncream and sunscreens to be lower than medium."

16. He confirmed in paragraph [60] that he had "found the inherent distinctive character of the Opponent's **RAD** mark in respect of suncream and sunscreens to be lower than medium based on the laudatory and/or allusive possibilities of the word and its use alongside the ENVIRON house mark and extending only to those limited goods…".

17. I am not able to say that the 'lower than medium' conclusion which the Hearing Officer came to on distinctive character was not open to him on the evidence and materials before him. I am also not persuaded that it would have made any significant or substantial difference to the outcome of the Opposition if he had attributed a higher degree of distinctive character to the earlier mark in the context of his other reasoning.

18. Ground 3 relates to paragraph [70] of the Hearing Officer's Decision, where he stated:

> "Since I find that the Opponent's evidence has not established the claimed reputation, which is a required component of section

> 5(3), it follows that the claim must fail. In the circumstances it is not necessary for me to consider whether the necessary mental link would arise, nor the claimed bases of damage."

19. His conclusion to that effect was based on a full and measured assessment of the Opponent's evidence as set out in paragraphs [11] to [23] together with the further determinations he made in that regard in paragraphs [66] to [68] as follows:

> "66. I note the Opponent's submission that it (presumably Environ) 'is a globally recognised professional skin care brand'. If that is so, it is not made out in the evidence. The evidence contains a couple of references to a presence in South Africa, but that is not relevant for the purposes of this decision, which is concerned with the territory of the EU. As I have noted previously, the evidence focuses almost exclusively on the UK, though case law permits that evidence relating only to the UK may be capable of satisfying the requirement for a reputation in a substantial part of the EU.
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> 67. Although the evidence of Mr Dunn's witness statement contains figures relating to sales in the UK over the five-year period up to the relevant date, the Opponent does not break those figures down between the two Earlier Registrations, so it cannot be said with any certainty what proportion of those figures may relate to the Opponent's RAD SHIELD Mark (which the Opponent does not claim as a basis for the present ground).
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> 68. Even taking the stated figures in full - where the 'value in sales' within the UK totalled nearly £725,000 over 5 years, from the sale of over 82,000 units - these are not figures that indicate that the Opponent's RAD Mark was known to a significant part of the relevant public in the territory, even if limited to the UK. The claimed goods are bought by the general public. The UK population is somewhere in excess of 65 million people; even discounting heavily from that population total to take into account that many of those constituting the UK general public will lack either the capacity or interest to buy the relevant goods, and even proceeding on the (unlikely) basis that each of those 82,000 sales was to a different individual, that is, in my view, still an insufficiently significant proportion of the relevant public to establish a reputation. I also particularly note the negligible evidence of promotion of the goods (via social media) and total lack of evidence of expenditure on advertising."

20. I do not accept that his reference to "an insufficiently significant proportion of the relevant public" in paragraph [68] betrays an error of analysis which could be said to detract from the fact that his examination and assessment of the evidence fully accorded with the approach required by Case C-301/07 *PAGO International GmbH v Tirolmilch* at paragraphs [21] to [26]:

> "21. The concept of 'reputation' assumes a certain degree of knowledge amongst the relevant public.
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> 22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).
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> 23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).
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> 24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).
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> 25. In examining this condition, 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 (*General Motors*, by way of analogy, paragraph 27).
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> 26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers."

21. In my view the Hearing Officer was entitled to find that the evidence and materials before him did not establish that the threshold requirement for protection under section 5(3) was satisfied in relation to the word mark **RAD** for suncream and sunscreen on which the Opponent relied.

22. For completeness, I note that there is no appeal from the Hearing Officer's rejection of the Opponent's objection under section 5(4)(a) on the basis that it added nothing to the objection under section 5(2)(a).

23. For the reasons I have given, the appeal is dismissed.

[APPEAL DISMISSED. APPELLANT ORDERED TO PAY £300. TO THE RESPONDENT IN RESPECT OF ITS COSTS OF THE APPEAL WITHIN 21 DAYS OF 25 APRIL 2024. THAT SUM TO BE PAID IN ADDITION TO THE SUM OF £300. AWARDED TO THE RESPONDENT BY THE HEARING OFFICER IN RESPECT OF ITS COSTS OF THE PROCEEDINGS IN THE REGISTRY.]

APPENDIX

Abrasives; breath freshening sprays; ~~balms, other than for medical purposes; lip glosses; petroleum jelly for cosmetic purposes~~; cotton wool for cosmetic purposes; adhesives for cosmetic purposes; scented water; lavender water; toilet water; depilatory wax; moustache wax; creams for leather; massage gels, other than for medical purposes; dental bleaching gels; ~~make-up~~; deodorants; depilatories; perfumes; perfumery; decorative transfers for cosmetic purposes; eyebrow pencils; cosmetic pencils; adhesives for affixing false eyelashes; adhesives for affixing false hair; hair conditioners; ~~cosmetic creams~~; skin whitening creams; hair sprays; nail polish; hair lotions; ~~lotions for cosmetic purposes~~; aftershave lotions; cosmetic masks; perfume oils; ~~cosmetic oils; oils for toilet purposes~~; essential oils; oils for cleaning purposes; cleansing milk for toilet purposes; soaps, except soaps for babies; ~~cosmetic kits~~; nail art stickers; artificial nails; pumice stone; lipstick cases; hydrogen peroxide for cosmetic purposes; breath freshening strips; teeth whitening strips;

abrasive cloth; glass cloth (abrasive cloth); lipstick; pomades for cosmetic purposes; shaving preparations; cosmetic preparations for baths; bath preparations, not for medical purposes; hair straightening preparations; hair waving preparations; color-removing preparations; denture polishes; mouthwashes, not for medical purposes; nail polish removers; make-up removers; nail care preparations; denture cleaning preparations; ~~aloe vera preparations for cosmetic purposes; sunscreen preparations~~; breath freshening preparations for personal hygiene; make-up powder; nail varnish removers; artificial eyelashes; bath salts, not for medical purposes; eyebrow cosmetics; ~~make-up products; sun-tanning preparations (cosmetics~~); hair dyes; neutralizers for permanent waving; cosmetic preparations for eyelashes; ~~cosmetic preparations for skin care; cosmetics; cosmetics for children; mascara; toiletry preparations; phytocosmetic preparations~~; talcum powder, for toilet use; cotton swabs for cosmetic purposes; henna [cosmetic dye]; dry shampoos; shampoos; herbal extracts for cosmetic purposes; extracts of flowers (perfumes); ethereal essences; all of the above-mentioned goods, except for babies.