O/0728/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3906958

BY ALEXANDRA ELIZABETH ROSARIA RDUCH

TO REGISTER:

MYSKIN

AS A TRADE MARK IN CLASSES 1, 4, 35, 39 & 42

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 443588 BY

MZ SKIN LIMITED

BACKGROUND AND PLEADINGS

1. On 2 May 2023 ("the relevant date"), Alexandra Elizabeth Rosaria Rduch ("the applicant") applied to register **MYSKIN** as a trade mark in the United Kingdom in respect of the goods and services shown below. The application had also included goods in Class 3 and retail services in Class 35, but these were successfully opposed.[1]

> *Class 1*
> *Emollients for use in the manufacture of cosmetics; Vitamins for use in the manufacture of cosmetics; Antioxidants for use in the manufacture of cosmetics; Emulsifiers for use in the manufacture of cosmetics; Antimicrobial preservatives for cosmetics; Chemical preparations for use in the manufacture of cosmetics; Chemical substances for use in the manufacture of scented cosmetics; Proteins for use in the manufacture of cosmetics.*
>
> *Class 4*
> *Lanolin for use in the manufacture of cosmetics; Beeswax for use in the manufacture of cosmetics; Mineral oil for use in the manufacture of cosmetics and skin care products.*
>
> *Class 35*
> *Marketing research in the fields of cosmetics, perfumery and beauty products.*
>
> *Class 39*
> *Storage of cosmetics; Transportation of cosmetics.*
>
> *Class 42*
> *Testing of cosmetics; Cosmetics research; Research of cosmetics; Inspection of cosmetics.*

2. On 13 October 2023, the application was opposed by MZ Skin Limited ("the opponent"). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and concerns all the goods and services in the application. The opponent relies on UKTM No. 3359060, **MZ SKIN**, which has a filing date of

[1] See BL O/0597/24.

6 December 2018 and a registration date of 22 March 2019. It is registered for the following goods, all of which are being relied upon:

> *Class 3*
> *Skin care preparations; skin care products; skin creams; skin lotions; skin cleansers; skin moisturisers; skin conditioners; creams and lotions for the skin; soaps; perfumery, aftershave, perfumes, toilet water, cologne, toilet articles; essential oils; deodorants and anti-perspirants; preparations for the care of the scalp and hair; hair lotions; preparations for nails; shampoos and conditioners; hair colourants; hair styling products; toothpaste; dentifrices; mouthwash not for medical purposes; preparations for the care of mouth and teeth; non-medicated toilet preparations; bath products; bath and shower preparations; bubblebath; showergels and creams; oils for the skin; shaving preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cottonwool, cottonsticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes, beauty masks, facial packs, medicated soaps; skin masks; face masks; facial masks.*
>
> *Class 8*
> *Facial rollers; hand-held operated apparatus for the care of the skin.*
>
> *Class 10*
> *Skin masks for medical purposes; face masks for medical purposes; therapeutic face masks.*

3. This mark qualifies as an earlier mark under the provisions of section 6(1) of the Act, as it has a filing date earlier than the relevant date. As the mark was registered less than five years before the relevant date, the opponent may rely on all the goods for which the earlier mark stands registered for the purposes of the section 5(2)(b) claim, without having to prove that it has used them.

4. Under section 5(2)(b), the opponent claims that the marks are highly similar, differing only in their second letters, and that the goods and services covered by the marks are either identical or highly similar. It also claims that the earlier mark enjoys

an enhanced degree of distinctive character. It asserts that, as a result of these factors, there exists a likelihood of confusion on the part of the relevant public in the UK.

5. Under section 5(3), the opponent claims that the earlier mark has a substantial reputation in the UK for *Cosmetics* and *Skin care products*. It considers that a mental link between the marks would easily be made by the relevant public and that use of the contested mark, being without due cause, would result in damage in one or more of the following ways:

> a) Use of the contested mark would take unfair advantage of the earlier mark by free-riding on its distinctive character and reputation. The applicant would gain attention for its goods and services because of the opponent's marketing efforts and the opponent's reputation would be transposed to the contested mark;
>
> b) It would cause detriment to the reputation of the earlier mark if the goods and services were of inferior quality; and/or
>
> c) It would cause detriment to the distinctive character of the earlier mark by weakening the ability of the earlier mark to identify the goods of the opponent.

6. The applicant filed a defence and counterstatement. She denies that there is a likelihood of confusion under section 5(2)(b), denying in particular that the marks are similar and she disagrees that the products are identical or similar. Under section 5(3), she denies that there would be any detriment to the reputation or character of the earlier mark.

7. In preparing to write this decision, I noted that the applicant's defence and counterstatement had been admitted despite the fact that various claims of the opponent had not been admitted or denied. When this happens, it is the usual practice of the Registry to write to the party concerned to inform them that any claim that is not denied may be deemed to be admitted. The need for both parties' pleadings to be fully particularised was emphasised by Professor Phillip Johnson, sitting as the Appointed Person, in *SkyClub Trade Mark*, BL O/044/21, paragraphs 23-28. At paragraph 26, he quoted Lord Hoffmann's statement in *Barclays Bank Plc v Boulter* [1999] 1 WLR 1919 at [1923]:

> "The purpose of the pleadings is to define the issues and give the other party fair notice of the case which he has to meet."

8. Tribunal Practice Notice ("TPN") 4/2000 contains the following guidance on the content of counterstatements:

> "19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.
>
> 20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided."

9. I wrote to the applicant on 2 July 2025, drawing her attention to a submission made by the opponent that, as its claim under section 5(3) had not been addressed fully, it must be assumed that the claim was admitted. I gave the applicant 14 days to make any comments on the submission. No comments were received.

10. In these proceedings, the opponent is represented by Taylor Wessing LLP, while the applicant is representing herself.

RELEVANCE OF EU LAW

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE AND SUBMISSIONS

12. Only the opponent filed evidence. This is in the form of a witness statement from Maya Muchemwa, a Trade Mark Attorney at Taylor Wessing, the opponent's legal representative. Her evidence goes to the reputation of the earlier mark. It is dated 2 April 2024 and is accompanied by 7 exhibits. The opponent also filed written submissions with the same date.

13. Neither side requested a hearing and only the opponent filed written submissions in lieu of one on 16 August 2024. This decision has been taken following a careful consideration of the papers before me.

PRELIMINARY ISSUES

14. The applicant stresses in her counterstatement that the parties' goods are targeted at different parts of the skincare market. However, I am required to make my assessment of the opposition on the basis of how the applied-for mark could fairly be used: see *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66. Furthermore, the Class 3 goods that appear to be the subject of this argument have been refused registration in the other opposition to the application. Consequently, the submission that the opponent targets the market for anti-ageing products, while the applicant does not, is not relevant to the decision I have to make.

DECISION

Section 5(2)(b)

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

> "A trade mark shall not be registered if because–
>
> …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

16. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These 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]. As the General Court ("GC") said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

> "82. … 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."

18. The goods and services to be compared are shown in the table below:

Contested goods and services	Earlier goods
Class 1 *Emollients for use in the manufacture of cosmetics; Vitamins for use in the manufacture of cosmetics; Antioxidants for use in the manufacture of cosmetics; Emulsifiers for use in the manufacture of cosmetics; Antimicrobial preservatives for cosmetics; Chemical preparations for use in the manufacture of cosmetics; Chemical substances for use in the manufacture of scented cosmetics; Proteins for use in the manufacture of cosmetics.* *Class 4* *Lanolin for use in the manufacture of cosmetics; Beeswax for use in the manufacture of cosmetics; Mineral oil for use in the manufacture of cosmetics and skin care products.* *Class 35* *Marketing research in the fields of cosmetics, perfumery and beauty products.* *Class 39* *Storage of cosmetics; Transportation of cosmetics.*	*Class 3* *Skin care preparations; skin care products; skin creams; skin lotions; skin cleansers; skin moisturisers; skin conditioners; creams and lotions for the skin; soaps; perfumery, aftershave, perfumes, toilet water, cologne, toilet articles; essential oils; deodorants and anti-perspirants; preparations for the care of the scalp and hair; hair lotions; preparations for nails; shampoos and conditioners; hair colourants; hair styling products; toothpaste; dentifrices; mouthwash not for medical purposes; preparations for the care of mouth and teeth; non-medicated toilet preparations; bath products; bath and shower preparations; bubblebath; showergels and creams; oils for the skin; shaving preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cottonsticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes, beauty masks, facial packs, medicated soaps; skin masks; face masks; facial masks.*

Contested goods and services	Earlier goods
<u>Class 42</u> *Testing of cosmetics; Cosmetics research; Research of cosmetics; Inspection of cosmetics.*	<u>Class 8</u> *Facial rollers; hand-held operated apparatus for the care of the skin.* <u>Class 10</u> *Skin masks for medical purposes; face masks for medical purposes; therapeutic face masks.*

19. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

> "5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the 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."

20. I shall adopt this approach in the following analysis.

<u>Classes 1 and 4</u>

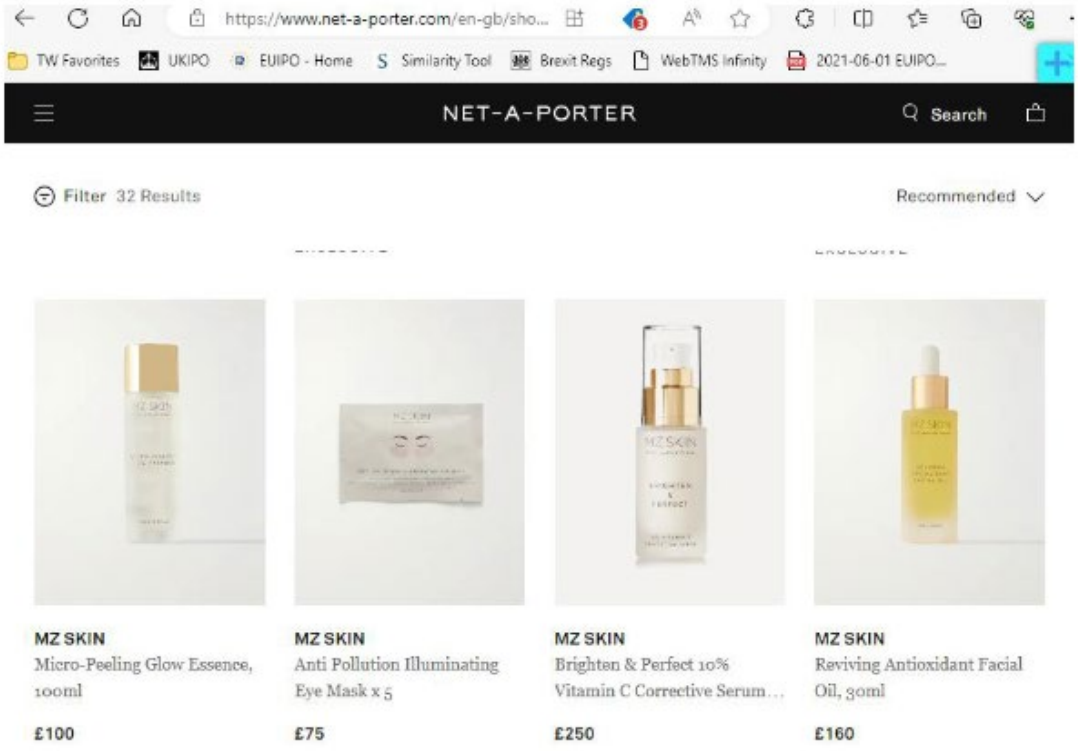
21. The opponent submits that the contested goods in these classes are all ingredients that are used in the manufacture of cosmetics and that the finished products are often marketed by reference to their ingredients and effects. It argues that there is a low degree of similarity between the parties' goods.

22. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC said that:

> "61. … The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

23. The applicant's goods are, as the opponent admits, used to manufacture cosmetics. They will be bought by businesses and individuals making the products. The users and purpose are therefore different from those of the earlier goods. The method of use is different, and I consider that the physical nature of the goods will not be similar, as the opponent's goods are finished products sold to the general public, while the applicant's are ingredients. It does not seem to me to be likely that the parties' goods would share trade channels.

24. The evidence contains examples of the opponent's products, the descriptions of which contain ingredients such as vitamins and antioxidants:[2]



25. In *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch), Mr Iain Purvis KC, sitting as a deputy High Court judge, said:

> "23. … the overall purpose of considering similarity should not be forgotten. That purpose is to identify similarities which might be relevant to the question of likelihood of confusion."

[2] Exhibit G, page 30.

26. It can be seen that the opponent's facial oil in the image above is described as *Reviving Antioxidant Facial Oil*, but given the differences in the intended user of the cosmetic product and the antioxidant ingredients, the purpose and the physical nature, I do not consider that it is plausible that a situation could arise in which confusion might be likely. I find that the goods are dissimilar.

Class 35

27. The services in this Class that remain following the earlier opposition are as follows: *Marketing research in the fields of cosmetics, perfumery and beauty products.* The opponent's submissions focus on the retail services, for which registration was refused. It refers me to the decision of another hearing officer in *UP Global Sourcing UK Limited v Print and Sign World Limited (eezeekleen/eezeecleen)*, BL O/595/21, that the goods and services are similar to a medium degree. However, this decision did not concern *Marketing research* or similar services, but retail services.

28. The contested services are provided to companies in the cosmetics, perfumery and beauty sectors or the advertising and marketing companies that they commission to promote their products. The users are therefore different from the users of the earlier goods. The purpose, nature and method of use of the goods and services are also different. They will not be distributed through shared trade channels and are not in competition. The goods may be necessary for the delivery of the services, but I do not consider that the average consumer would believe that the same undertaking is producing cosmetics and beauty products and also supplying marketing research services to its competitors. The goods and services are dissimilar.

Class 39

29. The opponent submits that the applicant's *Storage of cosmetics* and *Transportation of cosmetics* are complementary to its goods and adds that:

> "47. … Various online and brick and mortar large cosmetics manufacturers and retailers today offer a 'joined up' service from start to finish and the average consumer will be aware of this business behaviour."

30. In *Sanco, SA v OHIM*, Case T-249/11, the GC considered the similarity between one party's *Transport, storage and distribution of chickens* with the other party's *Meat, poultry and game* and *Live animals*. The GC said:

> "48. … in order to assess the complementarity of those goods and services, it is necessary to determine not only the specialisation of the undertakings, but also whether the consumers of those goods and services may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking due to the connection between those goods and services. Consequently, the existence of undertakings specialising in the production of goods of the earlier mark and in the provision of the services of transport, storage and distribution of chickens is not sufficient to establish a lack of complementarity between those goods and services."

31. Earlier in the judgment, the GC said:

> "25. The relevant public for the assessment of the likelihood of confusion is composed of users likely to use both the goods and services covered by the earlier mark and those covered by the mark applied for (see judgment of 24 May 2011 in Case T-408/09 *ancotel v OHIM – Acotel (ancotel)*, not published in the ECR, paragraph 38 and the case-law cited)."

32. The opponent submits that the average consumer is a member of the general public or an undertaking engaged in the production, marketing, sale or distribution of those goods.[3] I do not consider it likely that a member of the general public would be purchasing *Storage of cosmetics* or *Transportation of cosmetics*. In my view, the average consumer of these services would be a cosmetics manufacturer, distributor, retailer or wholesaler. The position therefore appears to me to be analogous to that described in *Sanco*. An undertaking such as a distributor, retailer or wholesaler would need to buy the opponent's goods and the applicant's services. I consider that it is likely that they would think that the responsibility for the production of the goods and provision of the services lies with the same undertaking. Consequently, I find that the goods and services are complementary. Complementarity is an autonomous criterion,

[3] Final written submissions, paragraph 23.

capable of being the sole basis for the existence of similarity between goods and services: see *Kurt Hesse v OHIM*, Case C-50/15 P, paragraph 23. I find that the services are similar to the opponent's *Cosmetics* to a low degree.

33. I am conscious that I have made a different finding here from the one made in the other opposition against this application. However, I note that I have had the benefit of submissions from the opponent, while the hearing officer in the other opposition had no submissions from either party.

Class 42

34. The opponent submits that:

> "48. … The average consumer may perceive the Applicant's goods, cosmetics, as being tested and manufactured in house as part of its joined up business offering to promote the efficacy of its business. Again, the goods and services are complementary. …"

35. Those services are *Testing of cosmetics; Cosmetics research; Research of cosmetics; Inspection of cosmetics*. I understand these to be scientific services, with the aim of developing new cosmetic products and ensuring that they are safe to use. The purpose, nature and method of use of the goods and services are different, and I do not consider that they would be distributed through the same trade channels. They are not in competition. I must now deal with the submission that the goods and services are complementary and again I will follow the approach set out in *Sanco*. The average consumer of these services is a cosmetics manufacturer, while the average consumer of the opponent's goods is, as I have already noted, a member of the general public or part of the cosmetics distribution chain. I cannot see any circumstance in which the average consumer of the goods would purchase the services, or vice versa. Therefore, I do not consider that the average consumer would believe the goods and services to be the responsibility of the same undertaking. I find the goods and services to be dissimilar.

Final remarks on the comparison of goods and services

36. In *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, Lady Justice Arden stated that:

> "49. … I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

37. I found that the goods in Classes 1 and 4 and the services in Classes 35 and 42 were dissimilar to the opponent's goods. The opposition under section 5(2)(b) fails with respect to these goods and services.

Average consumer and the purchasing process

38. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik*, paragraph 26.

39. I have already identified that the average consumer of the services that remain in play and the opponent's goods is a professional in the cosmetics distribution chain. A likelihood of confusion will only arise where there is a common purchaser; this is why I have discounted the member of the general public who would purchase the opponent's Class 3 goods. They will purchase the goods and services on a frequent basis, although the services may also be delivered on a contractual basis. I consider that the average consumer will pay a slightly higher than medium degree of attention during the purchasing process, as its commercial success will to some extent depend upon the quality of the goods and services. The purchasing process is likely to be primarily visual, as the choice will be made after viewing promotional literature or

websites. However, I do not discount the possibility of the mark being heard through word-of-mouth recommendations or spoken on the telephone.

Comparison of marks

40. 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:

> "34. … 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."

41. Artificial dissection of the marks would therefore be wrong, although it is necessary for me 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.

42. The respective marks are shown below:

Contested mark	**Earlier mark**
MYSKIN	**MZ SKIN**

43. The contested mark consists of the words "MY" and "SKIN" joined together. In my view, the average consumer will recognise the two words, which are common words in the English language. The overall impression of the mark lies in the juxtaposition of those two words.

44. The earlier mark consists of the letters "M" and "Z" followed by the word "SKIN". The letters do not produce a word and I consider that it is likely that the average

consumer will believe that this is an abbreviation. In the context of the goods for which the earlier mark is registered, “SKIN” is allusive. Consequently, I find that the more distinctive element of the mark is “MZ”.

Visual comparison

45. The opponent submits that the marks are visually similar to a high degree. It argues that the only difference between the marks lies in the second letter and that the average consumer will pay little attention to them, given the remaining similarities in the letters and the construction of the two marks. I am not persuaded that the average consumer will pay little attention to the differences, as I found that the more distinctive element of the earlier mark was “MZ”. In addition, the average consumer tends to pay more attention to the beginning of marks than to the end: see *El Corte Inglés, SA v OHIM*, Joined Cases T-183/02 and T-184.02, paragraphs 81 and 82. In my view, the marks are visually similar to a medium to high degree.

Aural comparison

46. I have already said that I consider the average consumer would identify the two words that make up the contested mark. These would be pronounced in the usual way, resulting in two syllables. The earlier mark would be pronounced as the letters “M” and “Z”, followed by the word “SKIN”, resulting in three syllables. The opponent submits that both marks begin with the sound “EM”. While that letter is indeed present in both of the first syllables, there are audible differences between them, with the contested mark beginning “MAI”. I find that the marks are aurally similar to a medium degree.

Conceptual comparison

47. The opponent submits that the marks are conceptually similar since they both contain the word “SKIN”. I agree. This is the only conceptual content of the earlier mark, as the letters “M” and “Z” would convey no message. The contested mark would bring the idea of their own skin to the mind of the average consumer, while the earlier mark evokes “SKIN” in the abstract. Consequently, I find that the marks are similar to a medium degree.

Distinctive character of the earlier mark

48. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

49. Registered trade marks possess varying degrees of inherent distinctive character 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 distinctiveness of the mark can be enhanced by the use that has been made of it.

50. Earlier in this decision, I found that the word "SKIN" is allusive and that the more distinctive element of the mark are the letters "MZ". It is not uncommon for marks to consist of two-letter abbreviations and so I find that the earlier mark has a medium degree of inherent distinctive character.

51. The opponent submits that the inherent distinctive character of the earlier mark has been enhanced through the use made of it. To that end, and to prove reputation, it has filed a witness statement and accompanying exhibits from a trade mark attorney at the opponent's legal representative. The evidence consists of material publicly available on the internet. I have been given no figures for the levels of sales or the amount of money spent on promoting the mark. I note the following:

a) The brand was launched in September 2016 and first sold in Harrods as a luxury medical skincare range;[4]

b) Goods have also been sold on the opponent's website, which has been maintained since 2017. The first solid evidence I can see that the goods could be purchased on the website is a screenshot from 12 February 2019, on which a shopping basket symbol can be seen. However, it is also clear from the website address that this site was aimed at customers in the US and prices on later screenshots are in US dollars;[5]

c) The opponent's goods are also sold by retailers such as Harvey Nichols, Cult Beauty, Dermoi, Selfridges and Net-a-Porter. However, none of the screenshots in the evidence is dated;[6]

d) The mark is visible on the pots and other containers in which the skincare is sold;

e) The opponent maintained social media accounts on Instagram, Facebook, Twitter/X and LinkedIn. The number of followers at the relevant date of 2 May 2023 are not shown, neither are their locations;[7]

f) Goods sold under the mark have been featured in articles on the *Daily Mail*'s website (23 September 2022), theteenmagazine.com (6 December 2021), theindustry.beauty (6 October 2022), *The Independent* website (undated, but the heading is "The best sheet masks for 2022 are:"), *The Guardian* website (28 March 2021), *Hello Magazine* website (undated), *Stylist* magazine ("7 months ago", i.e. around October 2023, after the relevant date), *Marie Claire* (undated);[8]

g) Ms Muchemwa says that the brand has attracted the attention of celebrities. The ones shown in the evidence are Keira Knightley, Gwyneth Paltrow and Selma Blair. Of these, only the YouTube video featuring Ms Knightley has an approximate date. This was posted *"one year ago"* by *Harper's Bazaar UK*. It is

[4] Exhibit A.
[5] Exhibit B.
[6] Exhibit G.
[7] Exhibit C.
[8] Exhibit D.

possible that this may have been posted before the relevant date. The screenshot shows that she is holding the MZ Skin Tone & Lift Germanium Contouring Facial Roller;[9]

h) The opponent's products have won the following awards: Best Skincare device awarded by *Woman & Home* in 2019 (MZ Skin Light Therapy Mask); Best Eye Treatment and Best Face Mask, awarded by *The Wardrobe ICONS* in 2020 (MZ Skin Hydra-Bright Golden Eye Treatment Mask and Radiance & Renewal Clarity Refining Mask, respectively); Best Undereye Mask Patches by *The Stylist* in 2020; Best for Acne-Prone Skin awarded by *The Wardrobe ICONS* in 2021 (MZ Skin Radiance & Renewal Clarity Refining Mask); Best Ampoule awarded by *Prestige Best of Beauty* in 2022 (MZ Skin Glow Boost Ampoules); and Bronze Award in the Best Eye Cream or Serum category in the GET THE GLOSS Awards in 2022 (Soothe & Smooth Hyaluronic Brightening Eye Complex). Ms Muchemwa also mentions a Best Brightening Face Mask awarded by *Beauty Bible* in 2020, but I cannot see documentary evidence of this.[10]

52. The lack of any sales figures and dated information on sales outlets other than Harrods makes it difficult to assess how intensive the use of the mark has been. I note there has been some media coverage. While I am prepared to accept that the reach of the websites of the *Daily Mail* and *Guardian* is significant, I cannot say the same about some of the other websites, such as theindustry.beauty or the teenmagazine.com. The second of these appears to be a non-UK publication, given the format of the date shown in the exhibit. Other articles are undated. Turning to the awards, I have no information on how likely these are to have come to the attention of the average consumer in the UK.

53. The opponent did, however, claim in its pleadings that the earlier mark enjoyed an enhanced level of distinctive character. The applicant has not denied this claim and made no request to amend the pleadings, even after receiving the opponent's written submissions in lieu of a hearing or my letter of 2 July 2025, to which I refer in paragraph 9 above. Indeed, the applicant has played no part in the proceedings after filing the defence. Consequently, I take the claim to an enhanced degree of distinctive character

[9] Exhibit E.
[10] Exhibit F.

to have been admitted by the applicant. That said, I do not consider, on the basis of the evidence filed, that this enhancement is any more than slight, taking the distinctiveness of the mark to a little above medium.

Conclusions on likelihood of confusion

54. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods and services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to 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 and services or vice versa.

55. Earlier in my decision, I found that:

a) The applicant's Class 39 services are similar to the opponent's *Cosmetics* to a low degree;

b) The remaining goods and services were dissimilar to the opponent's goods;

c) The average consumer would be a professional in the cosmetics distribution chain. They would pay a slightly higher than medium degree of attention in what would be a largely visual purchasing process;

d) The parties' marks are visually similar to a medium to high degree, aurally similar to a medium degree and conceptually highly similar;

e) The earlier mark has a medium degree of inherent distinctive character, which has been enhanced through use to a little above medium.

56. The opponent submits that there is a likelihood of direct or indirect confusion. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but assumes that the later mark also identifies goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/20, paragraph 16.

57. I shall consider the likelihood of direct confusion first. The opponent submits that the average consumer may misread or mishear **MYSKIN** as **MZ SKIN**, because of the identical first letters and last four letters/syllable. However, it also argues that there is a higher degree of similarity between the goods and services than I found, that the earlier mark has an enhanced degree of distinctive character and that the average consumer would be paying a medium degree of attention, which is lower than my finding of a slightly higher degree of attention. The consumer that is likely to come across both the opponent's goods and the applicant's services is in the trade. Given this slightly higher degree of attention, and bearing in mind the interdependency principle, I consider that the differences between the marks and the goods and services are such that the marks are unlikely to be directly confused. I would have come to the same conclusion had I found that the level of attention paid was only medium.

58. In *L.A. Sugar*, Mr Iain Purvis QC, sitting as the Appointed Person, gave a number of examples of scenarios in which indirect confusion might occur:

> "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)."

59. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. 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.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

60. The opponent submits that the contested mark, **MYSKIN**, may be mistakenly understood as a brand extension of **MZ SKIN**. As the word "SKIN" has, because of its allusiveness, only a low degree of distinctive character, it does not seem to me likely that the average consumer would believe that a change to the more distinctive part of the mark (**MZ**) is a logical brand extension. The opponent has not put forward any other reasons why there might be indirect confusion. I find that there is no likelihood of indirect confusion.

61. The section 5(2)(b) ground fails.

Section 5(3)

62. 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 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."

63. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the opponent 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.

64. 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), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) 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, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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.

j) 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.*

65. I have already found under section 5(2)(b) that the marks are similar.

Reputation

66. The opponent submits that the applicant has not fully addressed the claim under this ground in its defence, and that therefore this must be taken as an admission.

67. The applicant's counterstatement begins with a comment on the value of the UK skincare industry. She then denies that the goods to be marketed by the two parties are similar or comparable, and that there would be a likelihood of confusion. As I have already noted, the Class 3 goods in the application have been successfully opposed in separate proceedings. The applicant does not address any of the other goods or the services in the application. The rest of the counterstatement concerns the allegations of similarity between the marks and denies that use of the contested mark *"would be detrimental in any way to the reputation or character of MZ SKIN"*.

68. I have already noted that I wrote to the applicant inviting her to comment on the opponent's submission that she had not addressed the ground. As no reply was received, I deem that the applicant has admitted that the opponent has a reputation.

On the basis of my analysis of the evidence that has been filed, I find that this reputation is not more than modest.[11]

Link

69. The applicant has not directly denied that there will be a link. It denies a likelihood of confusion, but the existence of such a likelihood is not necessary for a link to be created in the mind of the public: see *Intra-Presse SAS v OHIM*, Joined Cases C-581/13 P and C-582/13 P, paragraph 72. It is also not essential under section 5(3) that the goods and services are identical or similar. For the reasons set out above, I deem the existence of a link to have been admitted.

Damage

70. The applicant has denied that there will be detriment to the reputation of the earlier mark and to its character (which I interpret to mean "distinctive character"). The opponent has also pleaded that the applicant would gain an unfair advantage by free-riding on the earlier mark's reputation and distinctive character. Again, there is no explicit denial of this last claim.

71. The CJEU explained in *L'Oréal* that:

> "41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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."

72. The applicant denies that the opponent would suffer any financial loss, but as the above passage makes clear, when assessing unfair advantage the focus must be on

[11] See paragraphs 47 and 48.

the effect on the applicant, not the opponent. I consider that, as unfair advantage has not been denied, it is admitted.

73. The section 5(3) claim is successful.

OUTCOME

74. The opposition is successful and Application No. 3906958 is refused registration.

COSTS

75. The opponent has been successful and is entitled to a contribution towards its costs in line with the scale set out in TPN 1/2023. The award has been calculated as follows:

£300 for preparing a statement and considering the other side's statement
£600 for preparing evidence
£400 for preparing written submissions in lieu of a hearing
£200 for official fees
£1500 in total

76. I therefore order Alexandra Elizabeth Rosaria Rduch to pay MZ Skin Limited the sum of £1500. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of August 2025

Clare Boucher,
For the Registrar,
Comptroller-General