O/0987/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003925521

BY GEMMA ALEXANDER AND JERMAINE BRYAN

TO REGISTER THE TRADE MARK:

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 442840

BY ABI SHOKEYE

BACKGROUND AND PLEADINGS

1. On 21 June 2023, Gemma Alexander and Jermaine Bryan ("the applicants") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 7 July 2023. The applicants seek registration for the following goods under the above application:

Class 3 Scented body lotions and creams; Cosmetic creams and lotions; Moisturising creams, lotions and gels; Skin lotions; Lotions for the skin; Non-medicated lotions; Moisturizing body lotions; Scented body lotions; Massage oils and lotions; Non-medicated skin lotions; Facial lotions; Cleansing lotions; Body lotions; Hand lotions; Moisturizers; Scented body creams; Moisturizing creams.

2. The application was opposed in full by Abi Shokeye ("the opponent") on 4 September 2023 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act ("the Act").

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark:

UK registration no. UK00003374087
Filing date 9 February 2019; Registration date 3 May 2019.
Relying upon all of the goods and services for which the earlier mark is registered, namely:

Class 3 Cosmetics.

Class 21 Applicators for cosmetics.

Class 25 Clothing.

Class 35 Advertising services relating to cosmetics.

Class 44 Advice relating to cosmetics.

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion "given the shared industry of skincare and cosmetics and the similarity in the marks" including its phonetic and visual similarities.

5. Under section 5(3), the opponent claims that due to the parties identical and closely related goods, and the similarity between the trade marks, the public will believe that the marks are used by the same company or they will assume that there is an economic connection between the users of the marks. The opponent also claims that its mark has been established in the market since June 2019, and has "garnered significant recognition and reputation". On this basis, the opponent submits that the similarity of the marks being used on identical goods, in combination with the opponent's reputation, "raises legitimate concerns of unfair advantage, detrimental distinctive character and a high likelihood of consumer confusion". The opponent claims that the applicants' mark could potentially capitalise on its "established customer base, benefiting from the goodwill and trust built by "Rich Skxn" amongst its consumers. The opponent states that there is a potential detriment to the reputation and distinctive character of the earlier mark, and that "this blurring can affect the economic behaviour of consumers who many no longer view "Rich Skxn" as a uniquely distinctive brand, or a brand of good quality, potentially impacting their purchasing decisions and brand loyalty".

6. Under section 5(4)(a), the opponent relies on the **RICH SKXN** sign contained in paragraph 3 to this decision, which it claims to have used since 31 November 2018 on its Instagram page and its website, as well as in a summer festival hosted in London on 31 August 2019. The opponent claims to have used this mark on cosmetics (skincare and body preparations), skincare consulting, and beauty tools (beauty bags,

vanity mirrors and face dermaplanners[1]).[2] The opponent claims that use of the applicants' mark would be contrary to the law of passing off.

7. The applicants filed a counterstatement denying all of the claims.

8. The opponent and applicants are unrepresented. Both parties filed evidence in chief and the opponent filed written submissions during the evidence rounds. Neither party requested a hearing, however, both parties filed written submissions in lieu. I make this decision having taken full account of all the papers.

RELEVANCE OF EU LAW

9. 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

10. The opponent's evidence consists of the witness statement of Abi Shokeye dated 8 April 2024. The opponent is the director of "Rich Skxn ltd", a position which she has held since 2019. The opponent's statement is accompanied by 10 exhibits, and has been filed to establish its reputation and goodwill in the mark.

11. The applicants' evidence consists of the witness statement of Gemma Alexander dated 2 August 2024. The applicant is one of the founders of "Rich Skin", and her statement is accompanied by 1 exhibit, which contains screenshots of the opponent's exhibits, replying to the evidence.

[1] I consider this is likely to be a misspelling of "dermaplaner".
[2] The opponent also listed operation of its website, social media promotion and engagement, press and business exhibitions, albeit this is how the opponent has used its mark, and not the goods and services for which the earlier right has been used for, which is what question 3 of the Form TM7 asks.

12. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

PRELIMINARY ISSUE

13. Before I proceed with my decision, it is noted that in the applicants' submissions in lieu, they refer to the opponent acting in "bad faith". However, the applicants are not relying upon a counterclaim based on section 3(6) of the Act, and therefore any reference to bad faith within the submissions will not be taken into consideration.

DECISION

Section 5(2)(b)

14. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

15. The opponent's trade mark qualifies as an earlier mark pursuant to section 6 of the Act. The opponent's earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely upon all of its goods and services without demonstrating that it has used its mark.

Section 5(2)(b) case law

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

17. The competing goods and services are as follows:

Opponent's goods and services	**Applicants' goods**
Class 3 Cosmetics. Class 21 Applicators for cosmetics.	Class 3 Scented body lotions and creams; Cosmetic creams and lotions; Moisturising creams, lotions and gels; Skin lotions; Lotions for the skin; Non-medicated lotions; Moisturizing body

Class 25 Clothing. Class 35 Advertising services relating to cosmetics. Class 44 Advice relating to cosmetics.	lotions; Scented body lotions; Massage oils and lotions; Non-medicated skin lotions; Facial lotions; Cleansing lotions; Body lotions; Hand lotions; Moisturizers; Scented body creams; Moisturizing creams.

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

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

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

21. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the GC stated that "complementary" means:

> "… 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 the responsibility for those goods lies with the same undertaking."

Scented body lotions and creams; Cosmetic creams and lotions; Moisturising creams, lotions and gels; Skin lotions; Lotions for the skin; Non-medicated lotions; Moisturizing body lotions; Scented body lotions; Non-medicated skin lotions; Facial lotions; Cleansing lotions; Body lotions; Hand lotions; Moisturizers; Scented body creams; Moisturizing creams.

23. I find that "cosmetics" in the opponent's class 3 specification is a broad term which covers types of preparations which are applied to the user's skin (face and body), hair and nails, to beautify them, or to improve their appearance. I therefore consider that the applicants' above goods are all skincare cosmetics, i.e. they are applied to the user's skin in order to approve its appearance by moisturising it, which improves its texture making it smoother and softer. On this basis, I find that all of the applicants' above goods fall within the opponent's broader category of "cosmetics", making them identical on the principle outlined in *Meric.*

Massage oils and lotions.

24. The applicants' above goods are used during a massage to reduce friction, and are typically scented to relax the user. I also note that these goods can have hydrating properties, and therefore moisturises the skin. On this basis, to some extent, these goods overlap in nature and purpose with the opponent's "cosmetic" goods which encompass skincare cosmetics. The goods may also overlap to some extent in method of use, as they are all applied to the user's skin, albeit the applicants' goods are specifically used during a massage. I find that there may be an overlap in trade channels, being sold by cosmetic companies, or that the goods may be sold in close proximity in cosmetic stores or beauty retail outlets. However, the goods are unlikely to be in competition, and I do not find them to be complementary. Therefore, taking the above into account, I find that the goods are similar to above a medium degree.

The average consumer and the nature of the purchasing act

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In

Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

26. The average consumer for the goods will be members of the general public, however, I do not discount that it could also include a professional user such as a beautician or masseuse. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The goods will be purchased relatively frequently and the average consumer will take various factors into consideration such as the cost, quality, aesthetic, scent and the suitability for their specific needs. Therefore, the level of attention paid during the purchasing process will be medium.

27. The goods are likely to be obtained by self-selection from the shelves of a beauty retail outlet, cosmetic stores or their online equivalents. I also note that cosmetics can be on display with tester products, for the user to test and use in store. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.

Comparison of the trade marks

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

impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

30. The respective trade marks are shown below:

Opponent's mark	Applicants' mark
	

31. The opponent's mark consists of the words "RICH SKXN" written in a standard capitalised typeface, presented in a copper to gold gradient, presented against a dark brown rectangular background. As I will come to discuss in the conceptual comparison, I find that the spelling of the "SKXN" element (which will be recognised

by a significant proportion of consumers as a misspelling of the word “SKIN”) is where the distinctiveness of the opponent’s mark lies.

32. The applicants’ mark consists of the words “Rich Skin” written in a stylised title case, copper to gold gradient typeface. As I will come to assess in the conceptual comparison, the words “Rich Skin” is descriptive of the use and purpose of the applicants’ cosmetic goods. This element is therefore non-distinctive and consequently the distinctiveness of the mark must come from its stylisation.[3]

33. Visually, the marks overlap in the word RICH/Rich at the beginning of the marks, a position to which the average consumer usually pays more attention.[4] The second word of the marks also overlap in the letters S, K and N, in the same order and placement. They are also both presented in a copper to gold gradient colour. These act as visual points of similarity. However, the third letter of the second word in the opponent’s mark is “X” and the third letter of the second word in the opponent’s mark is “i”. I note that these letters are not visually similar. Moreover, the wording of the marks are presented in different typefaces (standard capitalised typeface vs stylised title case). The opponent’s mark also consists of the dark brown rectangular background. These all act as visual points of difference. Therefore, taking the above into account, I find that the marks are visually similar to a medium degree.

34. Aurally, the word RICH/Rich at the beginning of both marks will be given its ordinary dictionary pronunciation, and the word “Skin” at the end of the applicants’ mark will be given its ordinary dictionary pronunciation. In the applicants’ submissions in lieu, they state that the deliberate use of “X” in “SKXN” in the opponent’s mark changes the pronunciation of the word. However, the opponent claims in video reviews, many people explicitly pronounce “Rich Skxn” as Rich Skin”[5], including the first video exhibited at **5.1**. The video contained in **exhibit 5.1** is from the Rich Skxn Instagram account, and matches a screenshot from a post on the opponent’s Instagram account which is dated 22 July 2020 contained in **exhibit 4.3**. The video is a customer review of the “black girl sunscreen”. I do not have any narrative evidence

[3] As per *Formula One Licensing BV v OHIM* Case C-196/11P
[4] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[5] Opponent’s submissions in lieu

to confirm where the customer is located, and if they are located in the UK (albeit the customer makes it clear in the video itself that they brought it from a "UK black-owned online store").

35. I also note that there is second video review contained in **exhibit 5.1a**. This is undated and there is no accompanying narrative evidence in Ms Shokeye's witness statement explaining where this video was taken from, (for example, if it is a video made by the opponent or a review from another customer) and what UK consumers would have been exposed to it. Nevertheless, I note that the second video pertains to a "RICH SKXN" sunscreen, which, as I will discuss later, appears to be a product that was only available after the relevant date of these proceedings.

36. While I do not consider that alone, one customer review video (the geographical location of which is unknown) from the relevant period would be persuasive in establishing that the opponent's mark would be pronounced as "RICH SKIN" by a significant proportion of UK consumers, I acknowledge that the word "SKXN" cannot be broken down into verbal elements/syllables. I find that as a word, it is unpronounceable. It is also clear that the "SKXN" element closely resembles the word "skin" (sharing the letters S, K and N), and I bear in mind that the applicants' class 3 goods are cosmetics which are applied to the skin. I therefore consider that a proportion of average consumers may pronounce the "SKXN" element as "SKIN" in the opponent's mark. However, I do not consider that such a proportion would be significant. Instead, I consider that a significant proportion of consumers will pronounce "SKXN" how it is presented before them, by individually pronouncing the letters as ESS-KAY-EXX-EN. On the basis that a significant proportion of consumers will pronounce the opponent's mark as RICH ESS-KAY-EXX-EN, I find that the parties marks are aurally similar to a medium degree.

37. Conceptually, I consider that the ordinary dictionary words "Rich Skin" in the applicants' mark qualify each other, and therefore, together, will be understood as "skin that is rich" in something useful. As this mark is being used on skincare cosmetics such as lotions and moisturisers, I find that the mark evokes that the skin is rich in moisture and hydration as a result of using the applicants' cosmetic skincare goods, which I note is descriptive of its use and purpose (and thus non-distinctive). I consider

that the stylisation of the applicants' mark (that being the copper to gold gradient stylised typeface) does not contribute to its conceptual message, and in regard to the brown background and stylisation in the opponent's mark, I also find that this does not contribute to its conceptual message either.

38. As highlighted above, the opponent claims that in video reviews, many people explicitly pronounce "Rich Skxn" as Rich Skin". Therefore, whilst the opponent has not made any specific submissions as to the concept conveyed by its mark, I consider that it is logical to assume that the opponent also would believe that "SKXN" would be seen by the consumer as conveying "SKIN". As noted above, I have found that a significant proportion of average consumers will pronounce the "SKXN" element by individually pronouncing its letters. However, I still consider that these consumers would nonetheless recognise that the word "SKXN" is highly similar to the word "SKIN" as the only difference between these words is their third letters (X vs I) and will acknowledge that the opponent's mark is being used on cosmetic goods which are used and applied on the skin. On this basis, I consider that a significant proportion of consumers will see the "SKXN" element in the opponent's mark as being an intentional misspelling of "SKIN". Consequently, I consider that the opponent's mark as a whole will also evoke the meaning of the skin being rich in moisture and hydration as a result of using the opponent's goods cosmetic skincare goods. This concept is therefore descriptive of the use and purpose of the opponent's goods (and thus non-distinctive). Therefore, on the basis that the same descriptive concept will be conveyed both of the parties' marks, I find that they are conceptually identical.

Distinctive character of the earlier trade marks

39. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberge*r [1999] ECR 1-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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)."

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

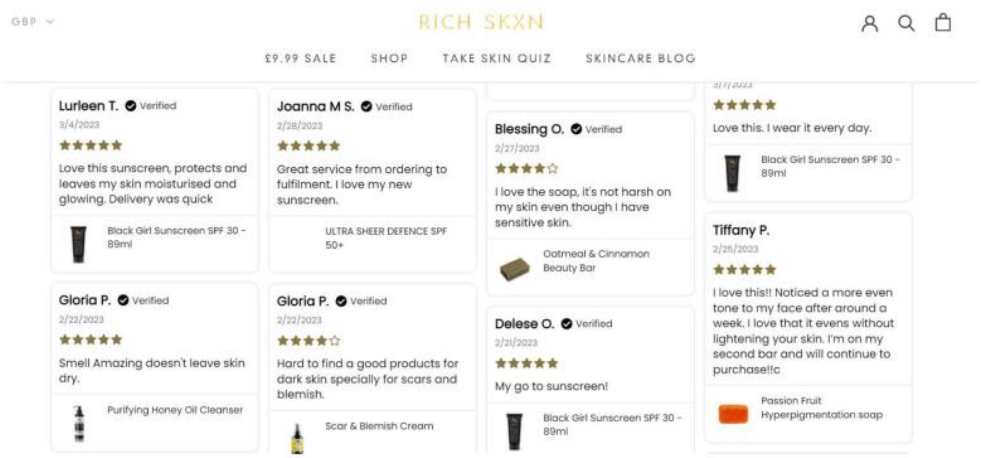
41. I will begin by assessing the inherent distinctive character of the opponent's mark. As highlighted above, the opponent's mark is comprised of the words "RICH SKXN" written in a copper to gold gradient capitalised standard typeface, presented against a dark brown rectangular background. I find that the stylisation and typeface used contributes to the distinctiveness of the mark, but not significantly.

42. As noted above, I have found that a significant proportion of average consumers will see "SKXN" as an intentional misspelling of "SKIN". Therefore, as a whole, the opponent's mark conveys the concept of "rich skin", which indicates to the user that the skin is rich in moisture and hydration as a result of using the opponent's skincare goods. I note that as per *Formula One*, the earlier mark must be considered to have at least some distinctive character and I bear in mind that in the opponent's submissions in lieu, Ms Shokeye states that "RICH SKXN" is not a generic term but a

distinctive brand that incorporates a unique spelling". I consider that the unique spelling referred to by Ms Shokeye is the "SKXN" element. I also find that the unique spelling of "SKXN" is where the distinctiveness of the opponent's mark lies, especially as the concept conveyed by the opponents mark is descriptive of the use and purpose of the goods. Therefore, taking all of the above into account I find that the opponent's mark is inherently distinctive, but only to between a low and medium degree.

43. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

44. Ms Shokeye confirms that her company Rich Skxn ltd "began in 2019 by selling products from multiple suppliers under the trademark Rich Skxn" which provides "a cosmetic service which curates the best skincare products to sell on the Rich Skxn online platform". I find that this is supported by the following screenshot provided in **exhibit 5.3**:



45. This screenshot clearly shows that the goods being sold on the RICH SKXN website (richskxn.co.uk)[6] which appear to be class 3 cosmetic skincare goods (soaps, cleansers, suncream, blemish creams and beauty bars), do not use the RICH SKXN mark on their packaging. However, I also note that at **exhibit 5.1a** and **8.1**, I have been provided with a photo of a "RICH SKXN" clear mineral sunscreen and a screenshot of this sunscreen being sold on its website. However, both the

[6] Exhibits 9.1 and 9.2

photographic and screenshot evidence is undated. **Exhibits 8.4** to **8.6** also contains screenshots from the RICH SKXN website showing RICH SKXN dermaplaning face razors, RICH SKXN coconut and mango body butter and RICH SKXN skincare and makeup bags for sale, but again, all of these screenshots are undated. These items are also shown within a photograph contained in **exhibit 8.7**, which again, is undated. I bear in mind that whilst I have been provided with photographs of packaging (boxing, tissue paper and thank you cards) using the wording "RICH SKXN" in **exhibits 8.2** and **8.3**, these photographs are, again, undated.

46. I bear in mind that Ms Shokeye has provided the following "turnover in the relevant period":

2019/2020 £65,522
2020/2021 £208,846
2021/2022 £172,803
2022/2023 £54,913

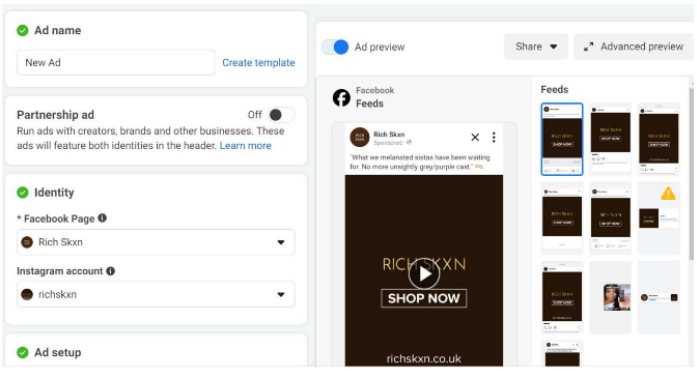
47. These figures have been taken from the "Rich Skxn" Shopify account, screenshots of which are contained in **exhibits 1.2** to **1.5**. From these exhibits I am also able to determine the following amount of orders made in those years:

2019/2020 2,054
2020/2021 6,205
2021/2022 4,743
2022/2023 1,499

48. To support the above sales figures, I have been provided with the "sessions by location" on the opponent's website between 1 April 2020 and 8 April 2024 contained in **exhibit 1.8**. In her written submissions in lieu, Ms Shokeye states that this exhibit provides "valid evidence of user engagement" and it supports her "brand's active online presence and sales". However, I note that some of the sessions fall after the relevant period. I also bear in mind that in Ms Alexander's witness statement, and the applicants' submissions in lieu, the applicants state that the above figures and exhibits are "not indicative of sales made by selling their trademarked class 3 products". I agree

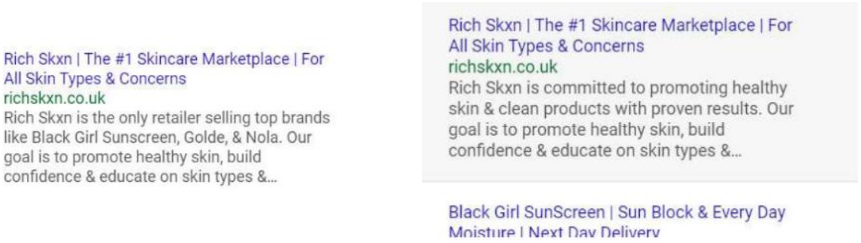
that there is nothing within these exhibits to confirm what proportion of the sales pertain to class 3 cosmetic goods using the opponent's mark, nor is there a breakdown of the turnover via the different types of cosmetics sold before the relevant date. However, the opponent has provided me with 3 sample invoices, all of which use the opponent's RICH SKXN mark on the top of the invoice page. In **exhibit 3.1**, the invoice from "Rich Skxn Ltd" clearly shows the sale of a Rich Skxn beauty bag, recovering oil, vitamin C serum and a goji berry balm. However, the invoice is dated 27 March 2024, and therefore falls after the relevant date. Another invoice from "Rich Skxn Ltd" contained within **exhibit 3.3** shows the sale of 17 "Black Girl SPF 30" goods for £250 on 11 May 2022. In her witness statement, Ms Shokeye confirms that this invoice was to "Coldr Ltd for skincare products for gifting at an event". The last invoice provided by Ms Shokeye is contained in **exhibit 3.2**, however, under the description it lists "Fireside Chat", in which Ms Shokeye confirms that this invoice was for a "Pinterest fireside panel chat about beauty".

49. I have been provided with screenshots from the "richskn" Instagram, X and TikTok pages including their following,[7] however, these are all undated and therefore I am unable to determine the amount of followers the pages had before the relevant date. While I have been provided with evidence of customer engagement via an Instagram post which dated 22 October 2021 which has 766,821 impressions,[8] this evidence does not show how many UK customers it engaged/reached. While I have also been provided with a screenshot from Rich Skxn's Facebook page showing ad previews for richskxn.co.uk in **exhibit 4.1**, this screenshot is undated and the ads themselves do not show any class 3 goods using the RICH SKXN mark, as follows:



[7] **Exhibit 6.1**
[8] **Exhibit 6.2**

50. Ms Shokeye states that the above ads have “reached hundreds of thousands of people on Instagram and Facebook”, but I have not been provided with any further evidence supporting this. At **exhibit 4.3** Ms Shokeye also provides the following screenshot which she states is evidence of google search ads from 2021 to 2023:



51. The “black girl sunscreen” as referred to in the above google ad and aforementioned invoice is shown in an Instagram post which is dated 22 July 2020 on the “richskxn” account as follows:

52. The above evidence is supported by an Instagram Story from Beverly Knight posting her use of the “black girl sunscreen”, tagging @richskxn on 17 August 2021[9] and an undated Instagram post from Adeola Patronne (a BBC podcast presenter) also using the “black girl sunscreen”.[10] Firstly, I note that this evidence confirms that the

[9] **Exhibit 7.3**
[10] **Exhibit 7.4**

"black girl sunscreen" goods do not use the RICH SKXN mark on the product itself. Secondly, whilst it shows use and engagement on Instagram, I bear in mind that I have not been provided with any supporting evidence to show how many UK consumers were exposed to these posts and stories before the relevant date.

53. Alongside her witness statement, Ms Shokeye has provided me with screenshots of marketing spend from Rich Skxn's Starling business banking app, dated between 9 December 2020 to 16 December 2022. This shows payments for Google marketing and ads, Facebook marketing, "Unlockd" marketing, Instantprint marketing and "Squirrel and Bears" marketing. It shows that the amount paid for these services was between £4.12 and £900. This is supported with further marketing spend evidenced in **exhibit 2.2** which shows the opponent purchasing Google ads from October to December 2022 on its Barclays business banking app.[11] However, I have not been provided with any supporting evidence to show what the marketing and advertisements looked like. If the aforementioned Facebook ad evidence reflects the marketing used on these platforms, then again, it does not show any cosmetic goods being promoted under the RICH SKXN mark before the relevant date.

54. In her witness statement, Ms Shokeye has stated that the above marketing spend has helped RICH SKXN gain "thousands of paying customers and over 14,725 sale order to date" evidenced in **exhibit 1.7**. I note that the latest order number on the RICH SKXN Shopify website is "#15725, which is likely to reflect that the there have been 15,725 orders. However, the customer and their location have been censored, and the goods purchased are unlisted, and therefore the screenshot only shows the latest 8 "unfulfilled" orders that were made "yesterday", "Saturday" and "Sunday". I bear in mind that all the orders are listed as coming from the "online store", but the latest transaction occurred in a "shop", to which the opponent has not provided any evidence or submissions on.

55. Ms Shokeye confirms that Rich Skxn "has a large community of 16,834 people who have brought or subscribed to the brand", as evidenced in **exhibit 1.6**. I note that

[11] I was also provided with an invoice for "klaviyo" dated 7 March in **exhibit 2.3**, however, this is clearly dated after the relevant date.

this exhibit contains an undated screenshot from the Rich Skxn Shopify account which states that they have 16,834 customers who are subscribed to their email subscription (with their location clearly pertaining to the UK, including London, Southall, Beckenham, Staines-upon-Thames, Lisburn and Barnet). However, as this is undated, I am unable to determine whether all of these customers were subscribed before the relevant date, nor am I able to determine how many of these subscribers brought from them, or brought their class 3 goods using the RICH SKXN mark, before the relevant date.

56. Ms Shokeye has provided evidence of the publicity that her company and mark has received. This includes an award won by Rich Skxn on the "Pinterest Black gold accelerator" in January 2022,[12] where they were subsequently paid to speak at the Fireside chat for Pinterest as demonstrated by the invoice at **exhibit 3.2**. Ms Shokeye states that they promoted Rich Skxn at this event to a big audience, however, no evidence of how many consumers attended the talk has been provided. I also note that Ms Shokeye states that the company initially exhibited and sold their goods at the beauty event "KOL Socials". This is supported by an undated post from the "richskxn" Instagram account in **exhibit 4.2**, which Ms Shokeye confirms is a post from 2 September 2019 showing a KOL social beauty event which took place in August 2019. I bear in mind that there is no supporting evidence provided by the opponent to show how many consumers attended this event and therefore was exposed to the mark. I also note that whilst the post itself shows a banner which clearly uses the opponent's mark, there is nothing within the post which shows the opponent's cosmetic goods.

57. Lastly, I note that I have been provided with evidence in regard to Ms Shokeye herself being celebrated as a female entrepreneur in **exhibits 7.5** to **7.8**, however, these exhibits all contain undated screenshots from Instagram, LinkedIn and Facebook.

58. I bear in mind that Ms Alexander has provided criticisms of the opponent's above evidence, including the following:

[12] **Exhibit 7.2**

a) The goods contained in **exhibit 8.1**, that being the RICH SKXN suncream, did not exist on their website until June 2024. This is supported by posts taken from richskxn's Instagram page contained on page 6 of in Ms Alexanders exhibit.
b) As of October 2024, the RICH SKXN mark was only found on 2 products on the website, neither of which were cosmetic class 3 goods. In **exhibit 005**, Wayback Machine screenshots taken from the opponent's website dated October 2023 only shows the dermaplaning face razor and skincare/makeup bag for sale using the RICH SKXN mark.
c) **Exhibit 005c** contains Wayback Machine screenshots taken from the opponent's website dated 25 October 2020, 27 November 2020, 19 January 2021, 21 September 2021 and 27 January 2022, all of which do not show any goods for sale using the RICH SKXN mark.
d) **Exhibit 005b** contains Wayback Machine screenshots taken from the opponent's website dated July 2024, the RICH SKXN mineral sunscreen and the RICH SKXN coconut and mango body butter are listed for sale. However, this is clearly after the relevant date.
e) The opponent has a blog page which does not include or list any of its own products. To support this, **exhibit 001** shows an undated screenshot of this page which highlights that Rich Skxn curates and promotes products "selected from various innovative indie brands" which are "best suited for black and brown skincare needs".
f) As of October 2023, RICH SKXN had 2 products bearing their mark that being a makeup bag and facial razor, both of which are not cosmetic goods.

59. Ms Alexander also mentions another entity trading as "Rich Skin" in the US, however, as they are not a party to the proceedings, the submissions on this entity does not assist the applicants.

60. I find that the opponent's above evidence contains multiple deficiencies. Whilst it is clear that cosmetic skincare goods have been sold via the richskxn.co.uk website, the goods themselves do not display the RICH SKXN mark, as the opponent curates products from other brands to sell on its website. Whilst there is minimal evidence provided by the opponent which pertains to cosmetic goods including sunscreen and body butter that uses the RICH SKXN mark, the evidence is either undated or

establishes that these products were available for sale in 2024, which falls after the relevant date. The applicants' evidence also establishes that the dermaplaning tool and the makeup/skincare bag were available for sale from October 2023 which also falls after the relevant date. Nevertheless, these goods do not fall within any of the opponent's class 3, 21, 25, 35 and 44 goods and services.

61. When considering the relevant cosmetic goods and their market, the turnover and unit figures provided from the Rich Skxn Shopify account are relatively low. I also note that without a breakdown of these figures, I cannot conclude with any certainty what goods were sold, if they were cosmetic goods (and if there was a range of cosmetic goods sold), and if any were sold displaying the RICH SKXN mark. There is also no invoice evidence to confirm the sale of goods which use the RICH SKXN mark before the relevant date. The invoice evidence only shows the sale of "Black Girl SPF 30", which is shown throughout the evidence as not using the RICH SKXN mark.

62. Whilst I have also been provided with evidence of marketing costs, I have not been provided with any example advertising used to promote the opponent's class 3 goods and the advert evidence, being the Facebook ad, does not show any class 3 goods using the RICH SKXN mark. The majority of the social media evidence provided is undated and therefore I am unable to determine how many UK followers the pages had. For the social media posts which are dated, I am unable to determine how many UK customers were exposed to these posts. In regard to the KOL social beauty event which took place in August 2019, there is no evidence showing cosmetic goods being advertised under the RICH SKXN mark, nor does the opponent confirm how many UK consumers attended this event.

63. Therefore, taking all of the above into account, I find that the evidence is unable to establish that the opponent has sold class 3 cosmetic goods under the RICH SKXN mark before the relevant date. Whilst the evidence shows that the RICH SKXN website sells cosmetics, and therefore provided class 35 retail services for cosmetics, the opponent does not have protection for this term. On this basis, I do not consider the evidence sufficient to establish enhanced distinctiveness of the opponent's mark for any of its goods and services at the relevant date.

Likelihood of confusion

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

65. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar a medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually identical.
- I have found the opponent's earlier mark to be inherently distinctive to between a low and medium degree, with the unique spelling of "SKXN" being where the distinctiveness of the opponent's mark lies.
- I have identified the average consumer as the general public, and professionals such as beauticians or masseuses, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical and similar to above a medium degree.

66. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

67. I also take into account the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

68. Therefore, taking all of the above case law into account, I consider that it is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

69. I also bear in mind that in *Nicoventures Holdings v The London Vape Company* [2017] EWHC 3393 (Ch), the High Court found that there was no likelihood of confusion between the following marks:

70. Birss J held that the common elements between the marks, being VAPE and Co, were "low in distinctiveness either alone or in combination", and as the common elements were found to be descriptive and non-distinctive, it was necessary "to focus on the impact of this aspect on the likelihood of confusion". The Court found that:

> "36. Bearing all this in mind but in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection **the differences in the two marks will take on a greater significance for the average consumer than they might otherwise.** Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different. From the point of view of visual similarity, the likelihood of confusion is low. Considering conceptual similarity, the concept the two marks share is entirely down to their non-distinctive elements. It is the common concept which is non-distinctive. That does not lead to a likelihood of confusion. In some ways the respondent's best case could be thought to come from considering the aural similarity. From that point of view of course the visual stylised elements will not be present, and hearing "Vape dot co" or "THE Vape dot co" is not so far away from hearing "Vape and co" but the fact is again that they are not the same and what they share is entirely non-distinctive when one bears in mind this is all in the context of electronic cigarettes." **(my emphasis)**

71. The opponent's mark, as a whole, is composed of the words "RICH SKXN". I have found above that a significant proportion of average consumers will see the "SKXN" element as being an intentional misspelling of the word "SKIN", and therefore as a whole, the opponent's mark evokes the meaning of skin that is rich in moisture and hydration, as a result of using cosmetic skincare goods. I note that this concept is also conveyed by the applicants' "Rich Skin" mark. I bear in mind that the parties' goods are cosmetics that are applied and used to enhance the appearance of the skin, for example improving its hydration. I therefore find that the identical concepts conveyed by the parties' marks is low in distinctiveness as it simply describes the use and purpose of the goods. As the common element is low in distinctiveness, *the differences between the two marks will take on a greater significance for the average consumer than they might have otherwise*. Therefore the stylisation of the parties' marks, that

being the capitalised typeface and brown background in the opponent's mark and the stylised typeface in the applicants' mark, may not be very remarkable, however, they are clearly visual points of difference. I have also found that the distinctiveness of the applicants' mark must come from its stylisation as per *Formula One* and this stylised typeface is not replicated in the opponent's mark . Moreover, the difference between the "SKXN" and "Skin" elements in the parties' marks also takes on a greater significance for the average consumer. This is especially the case as I have found that the unique spelling of "SKXN" is where the distinctiveness of the opponent's mark lies.

72. I note that the spelling of "SKXN" is not present within the applicants' mark, and the purchasing process for the goods is predominantly visual. On this basis, I do not consider that the average consumer paying a medium degree of attention during the purchasing process would overlook the letter "X" in "SKXN", nor would they misremember it for the letter "I". This is especially the case as the letters are not visually similar, and the words "SKXN" and "Skin" create an aural point of difference between the marks. Therefore, taking all of the above into account, I find that the "SKXN" element in the opponent's mark is a distinguishing feature which becomes more significant due to both of the parties' marks being lower in distinctiveness. Consequently, I do not consider that there is a likelihood of direct confusion.

73. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

> "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 recognized 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)".

74. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

75. Mr Purvis QC *in L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall in one of them (paragraphs 16 & 17).

76. I consider that having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Even though the marks share the common (and identical) conceptual element; “rich skin”, as highlighted above, this element simply describes the use and purpose of the goods (cosmetics that are applied to and used to enhance the appearance of the skin). Therefore, I do not consider this common element is of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it in relation to cosmetics. It is more likely to be viewed as a coincidence that the opponent’s “RICH SKXN” mark conveys the same descriptive concept as the applicants’ mark. Moreover, as noted above, the unique spelling of “SKXN” is where the distinctiveness of the opponent’s mark lies and this is not present in the applicants’ mark. On this basis category a) cannot be satisfied. A non-distinctive addition has not been added to either mark as per category b), as the differences between them are placed in the third letter of the second word of both marks (X vs i). I also do not consider that the change of “SKXN” to “Skin” is consistent with a brand extension as per category c), especially as, again, I have found that the distinctiveness lies in the unique spelling of “SKXN” in the opponent’s mark.

77. While I bear in mind that the examples set out by Mr Purvis are not exhaustive, I cannot see any other basis upon which indirect confusion should be found, nor has the opponent identified any in its written submissions. I do not consider there to be a likelihood of indirect confusion.

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

Section 5(3)

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

> “5(3) A trade mark which –
>
> > (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark

or international trade mark (EC), 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 repute of the earlier trade mark."

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

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

81. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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 Saloman, 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/services, the extent of the overlap between the relevant consumers for those goods/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 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/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/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(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 of the earlier mark; *L'Oreal v Bellure NV, 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 (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

82. I can deal with this ground relatively swiftly.

83. Earlier in my decision, I found that the distinctive character of the opponent's mark had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.

84. As noted above, when considering the relevant cosmetic goods and their market, the turnover of £502,084 between 2019 to 2023 is relatively low. Furthermore, without a breakdown of these figures, I cannot conclude with any certainty what goods were sold, if they were class 3 cosmetic goods, and if they were sold displaying the RICH SKXN mark. The turnover figures are also not supported by any invoice evidence showing "RICH SKXN" goods being sold to consumers geographically spread across the UK. The only evidence which shows cosmetic goods bearing the opponent's mark, that being RICH SKXN suncream and coconut and mango body butter, is undated or dated after the relevant date.

85. Whilst I have been provided with some of the opponent's marketing spend before the relevant date, I find that these payments/figures are also relatively low. Moreover, there is no supporting dated evidence to show what these advertisements looked like (and the undated Facebook Ad did not show use of the mark on class 3 goods). I also bear in mind that the majority of the social media evidence provided is undated, and for those which are dated before the relevant date, I am unable to determine how many UK customers were exposed to these posts.

86. Therefore, the evidence is, for the reasons set out above in relation to enhanced distinctiveness, insufficient to establish a reputation in the UK. Consequently, the opposition based upon section 5(3) falls at the first hurdle.

87. The opposition based upon section 5(3) of the Act is dismissed.

Section 5(4)(a)

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

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> > a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > aa)…
> >
> > b) …
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

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

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

90. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Relevant date

91. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: '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.'"

92. As the applicants have filed no evidence of use of its mark, I have only the prima facie relevant date to consider i.e. 21 June 2023.

Goodwill

93. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

94. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by BALI Trade Mark [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

95. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

96. Goodwill arises as a result of trading activities, and it is clear from the turnover figures provided that the opponent has been trading since 2019. However, this figure has not been broken down into the different cosmetic goods that the opponent claims to have sold before the relevant date. The only goods that use the "RICH SKXN" sign are dermaplaning face razors, coconut and mango body butter and skincare and makeup bags. However, the evidence which pertains to these goods are either undated or dated after the relevant date. I also do not have any supporting invoice evidence to show that "RICH SKXN" goods were sold to consumers geographically spread across the UK. The only evidence that pertains to the location of its subscribers is undated, and I am also unable to determine if the subscribers purchased any of the opponent's "RICH SKXN" branded goods. I am, therefore, unable to determine the geographical spread of its marks and its customers across the UK. Furthermore, while I have been provided with the opponent's marketing costs, there is no supporting dated evidence to show what these advertisements looked like (and the Facebook Ads clearly do not show or contain the goods which use its sign). As such, I consider the opponent's evidence of trading activities to be vague and imprecise and incapable of leading to a finding that the opponent enjoyed any protectable goodwill in its business in the UK at the relevant date. Therefore the opponent's reliance upon 5(4)(a) of the Act fails as, without goodwill, there can be no misrepresentation or damage.

97. However, even if I was wrong in my above finding, and I was able to find that the opponent did have a small but protectable goodwill in relation to the goods it relies upon under section 5(4)(a), and its sign was distinctive of the opponent's business, I still nonetheless find that there would be no misrepresentation.

98. I recognise that 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”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

99. Under section 5(4)(a), the opponent relies upon its “RICH SKXN” sign, which mirrors the opponent’s earlier mark that it relies upon under section 5(2)(b). The evidence that the opponent relies upon for section 5(4)(a) is also the same evidence as summarised in paragraphs 44 to 57 above.

100. Therefore, even proceeding on the basis that the opponent had a small but protectable goodwill at the relevant date and that the sign relied upon was distinctive of that goodwill (which represents the opponent’s best case), I consider that the differences between the opponent’s sign and the applicants’ mark would be sufficient to avoid a substantial number of the opponent’s customers and potential customers purchasing the applicants’ goods in the mistaken belief that they are provided by the opponent’s business. As there is no misrepresentation, there can be no damage.

101. The opposition under section 5(4)(a) is unsuccessful.

CONCLUSION

102. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

103. The applicants have been successful and would normally be entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

104. However, as the applicants are unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicants and invited them to indicate whether they

intended to make a request for an award of costs. The applicants were informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

105. The applicants did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 23rd day of October 2025

L FAYTER

For the Registrar