

O-229-13

IN THE MATTER OF THE TRADE MARKS ACT 1994

-and-

**IN THE MATTER OF APPLICATION NO. 2579244 in the name of 'Firm of ABX'
to register the Trade Mark
'irevive'**

-and-

**IN THE MATTER OF OPPOSITION NO. 102324
BY GURWITCH PRODUCTS LLC**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MS AL
SKILTON, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF
TRADE MARKS DATED 25TH JULY 2012**

DECISION

Introduction

1. The Applicant is a firm apparently trading under the name 'Firm of ABX'. It appears to be the *alter ego* of an individual called Iain Lamont. The Applicant seeks to register as a trade mark the word

irevive (written in lower case)

for the following goods and services:

Class 03: 'cosmetic and beauty products'

Class 35: 'retail services connected with the sale of cosmetic and beauty products'

2. The application is opposed by Gurwitch Products LLC under s5(2)(b) of the Trade Marks Act 1994 ('the Act'), based on the earlier Community Trade Mark

RÉ VIVE

registered in the following class:

class 03 for 'non-medicated skin products, namely, creams, lotions, gels, toners, cleaners and peels'.

3. The opposition succeeded before the Hearing Officer, Ms Al Skilton, under s5(2)(b) of the Act.
4. The opponent also opposed registration under s5(4) of the Act but this argument was not considered by the Hearing Officer and no Respondent's Notice was served in respect of it. I therefore do not need to consider it on this Appeal.
5. The parties were both content to have this appeal dealt with on the basis of written submissions only.

Uncontroversial aspects of the Decision

6. The Hearing Officer commenced her Decision by reciting the list of principles established in the case law of the CJEU which are considered to be of assistance when dealing with objections on the ground of 'likelihood of confusion'. The particular list recited was that given by Geoffrey Hobbs QC sitting as an Appointed Person in La Chemise Lacoste SA v Baker Street Clothing Ltd BL O/330/10 which was itself approved by Arnold J in Och-Ziff Management Europe Ltd. v. Och Capital LLP [2011] FSR 11. It is an extremely useful account of the correct approach to take in cases of

this kind, although it needs to be remembered that it is only a summary of some of the principles and not a complete account.

7. The Hearing Officer then turned to characterise the 'average consumer' for products of the kind covered by the application. She held that such consumers could be male or female (I am not sure why this distinction is of any significance in the present case, but it appears to have been a matter of dispute between the parties). She also held that the average consumer could be expected to pay 'at least a reasonable level of attention' to the selection of 'cosmetic and beauty products' and to the choice of retail outlets through which to purchase such products. This is not in dispute.
8. So far as identity/similarity of goods and services is concerned, the Hearing Officer concluded that the goods of the application were identical to the goods of the opponent's registration. This was plainly correct, since the category of goods of the application included all the goods covered by the opponent's registration. She also concluded that the retail services of the application were 'similar' to the goods of the opponent's registration, following the guidance of General Court in Oakley Inc. v OHIM T-116/06, since the whole purpose of the retail services was to sell the goods of the registration. Once again, this is a correct conclusion and no issue is taken with it by the applicant.

The substance of this appeal

9. The Grounds of Appeal are drafted by the lay applicant himself. They are fairly unstructured. However, the substance of the complaint is reasonably clear. Essentially he makes two related points. He says (i) that the Hearing Officer ought to have taken more account of the differences between the marks and (ii) that the result of the decision is to give the opponent a monopoly in the word 'revive' which is a normal word used for descriptive purposes in this field.

10. The appeal therefore requires consideration of whether the Hearing Officer erred in principle or was otherwise clearly wrong in the passages in the Decision where she considered the similarities between the marks (paragraphs 29-38), the distinctive character of the opponent's mark (paragraphs 39-48) and the consequent likelihood of confusion (paragraphs 46-53).

The similarities between the marks

11. The Hearing Officer considered the similarities between the marks from an aural, visual and conceptual point of view.
12. The aural similarities between the marks are dealt with in paragraphs 30 and 32 of her Decision. It was first of all necessary to decide how to pronounce the marks. In paragraph 30 she stated as follows:

'I have described the competing trade marks above. Both contain the letters 'r-e-v-i-v-e'. The opponent's mark will be pronounced 're-vive'. The average consumer will pronounce the applicant's marks as 'i-revive'.

With respect to the Hearing Officer, this was an inadequate explanation of the pronunciation of the marks. If a point is going to be made about pronunciation, clarity can only be achieved by explaining in some way (either by using some form of phonetic spelling or by using a comparator word). Simply setting out the same letters as appear in the mark leaves open the very ambiguity which one is attempting to resolve.

13. Judging by the conclusion which the Hearing Officer ultimately reached on 'aural similarity' in paragraph 32, namely that the marks were similar to a 'high degree', it would appear that she considered that the opponent's mark would be pronounced in the same way as the English word 'revive' (that is to say 'ri' with a short 'i' and 'vive' to rhyme with 'hive').

14. In my view this is not how the opponent's mark would be pronounced. The mark is presented as two separate words. The first word is RÉ with an acute accent on the 'e'. This word is plainly intended to be pronounced and indeed would be pronounced 'ray'. The second word is 'VIVE'. This is a French word derived from the verb 'vivre' and commonly used in slogans to mean 'long live' such as in the phrase 'vive la France'. It is well understood as such in English (to the extent that it appears in the Collins English Dictionary). It is pronounced to rhyme with 'sleeve'. There is no English word 'vive' and therefore no reason to suppose that the word 'vive' should be pronounced to rhyme with 'five'. The French pronunciation of the word is also suggested by the acute accent on the 'e' of the previous word, which is something one would expect to find in a word in French but not English.
15. The pronunciation of the two words in the opponent's mark is therefore 'ray veev'. The pronunciation of the applicant's mark on the other hand would be as for the ordinary English word 'revive' preceded by a long 'i' as in 'iris'.
16. I cannot therefore agree with the Hearing Officer that there is a 'high degree of aural similarity' between the two marks. The similarity is relatively low.
17. As for the visual similarity between the marks, the Hearing Officer concluded that the marks were similar to a 'moderate degree', owing to the common presence of the letters of the word 'revive' in the same order. I agree with that finding.
18. On conceptual similarity, the Hearing Officer considered that there was a 'high degree of conceptual similarity' between the marks, since 'the essential message [of both] is that of a reviving, rejuvenating quality'. I do not consider that this does justice to the actual concept of either mark. It

is true that both of them involve modifications of the word 'revive', and that the average consumer will probably recognize the word 'revive' in both of them. However, the modifications are quite different and serve to convey quite different concepts. The addition of the letter 'i' at the beginning of the word in the mark applied for conveys the idea of something electronic or connected with the Internet. Breaking up the word into two separate words and introducing an accent on the first 'e' conveys the concept of something French. These differences are important because the word 'revive' itself is entirely descriptive in this field and therefore its conceptual significance is extremely limited. See for example the decision of the Court of First Instance in Gateway Inc. v OHIM [2007] ECR II-163 (approved by the CJEU at [2009] ETMR 32). Bearing all that in mind, I believe that there can only be said to be a low degree of conceptual similarity between the marks.

19. I therefore consider that the Hearing Officer erred in her conclusions on the visual, aural and conceptual similarities between the marks. In my view the visual similarity is moderate, the aural similarity is relatively low and the conceptual similarity is low.

Distinctive character

20. Principle (h) in the Chemise Lacoste list of principles set out by the Hearing Officer at paragraph 16 of the Decision is '*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.*' The Hearing Officer considered the question of distinctive character between paragraphs 39 and 45 of the Decision.

21. In KURT GEIGER [2013 WL 617249] I said this about the 'distinctive character' issue:

'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.'*

22. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. 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.

23. The opponent itself submitted that its mark was '*prima facie not a very strong mark*'. The reason for this is that the underlying word 'REVIVE' has no inherent distinctive character in the field of 'non-medicated skin products, namely creams, lotions, gels, toners, cleaners and peels'. Such products are usually designed and promoted to rejuvenate, refresh or 'revive' the skin. This being the case, the only inherent distinctive character possessed by the mark lies in the eccentric way in which the word has been modified – splitting it into two and adding an accent to the first 'e', thus giving it a French appearance and a French pronunciation. Neither of these aspects of the opponent's mark are to be found in the mark applied for.

24. The Hearing Officer said as follows about the similarities between the marks at paragraph 51 of her Decision:

'In this case, the fact that the first letter is different, in marks which otherwise contain the word 'revive', and the fact that the opponent's mark

includes a space between the RE and VIVE elements and an acute accent over the first E are not, in my view, significant factors. The similarities between the competing marks far outweigh these minor differences.'

This analysis entirely fails to recognize the critical point that the word 'REVIVE' has no distinctive character. The facts that the applicant's mark (i) contains none of the elements which give the opponent's mark its distinctive character and (ii) also contains a new (and completely different) distinctive element of its own can hardly be called 'minor differences' in the context of trade mark law. Nor can they be 'outweighed' by the common use of a descriptive term.

25. It seems to me that this was a serious error of principle. The applicant complains that the result of the Hearing Officer's approach is effectively to give the opponent the effect of a registration for the word REVIVE itself, which plainly would not have been granted if it had been applied for as a trade mark. That may be a slight overstatement of the effect of the Decision. However, it puts the point very well. The only similarities between these marks lie in the common presence of the letters of a word which is devoid of distinctive character. As stated by Millett LJ in The European Ltd v The Economist Newspaper Ltd [1998] FSR 283 at 290: *'Where descriptive words are included in a registered trade mark, the courts have always and rightly been exceedingly wary of granting a monopoly in their use'*. In the absence of powerful evidence that the descriptive word had in fact become distinctive of the opponent as a result of the use of its mark, it is hard to imagine how a likelihood of confusion could properly have been found in the present case.

26. The Hearing Officer appears to have placed some reliance on the use of the opponent's mark in coming to her ultimate conclusion on likelihood of confusion. In paragraph 50, in the course of listing the factors which she later said she was taking into account in her finding, she said this:

'I have identified a fairly low level of inherent distinctive character in the opponent's earlier mark, which has been enhanced by the use made of it, though I cannot conclude to what extent.'

27. Where evidence is insufficient to enable the Hearing Officer to reach a conclusion as to the extent of any enhancement of distinctive character, then in my view the only proper approach is not to take it into account at all. If one imagines the test for likelihood of confusion as an equation, the introduction of an integer of unknown value will make it impossible to reach an answer, unless the value of the integer makes no difference (in which case there was no need to introduce it in the first place). I therefore consider that, to the extent that the Hearing Officer did take 'enhanced distinctive character' into account, this was another error of principle.

28. In any event, the evidence filed by the opponent was not consistent with enhanced distinctiveness through use. It showed sales of goods within the scope of its trade mark registration of between £1.3M and £1.8M per annum for the years 2006-2011. The sales apparently took place in department stores including John Lewis and Harrods. There was advertising expenditure in the period 2008-2011 of between £10K and £27K per annum.

29. The Hearing Officer remarked on the absence of any evidence as to the overall size of the market for the goods and services in issue. This was a good point. However, other points could also have been made. The number of retail outlets for the products was limited, the advertising expenditure was tiny given the nature of the industry sector, and the actual number of products sold appears to have been relatively small.¹

¹ The evidence did not say how many products were sold, but the price of the products was said to be £30-£300 (for individual products). Taking an average price of £100, the total sales would (based on turnover) be only of the order of 15,000 products per annum.

30. All in all, the evidence came nowhere near establishing that the mark had acquired enhanced distinctiveness in the mind of the average consumer through the use made of it. I would surmise that the majority of average consumers had probably never heard of the brand.

Likelihood of confusion

31. The errors which I have already identified in the decision of the Hearing Officer were central to the Hearing Officer's decision on likelihood of confusion. In my view they are sufficiently serious to overcome the reluctance with which this appeal tribunal must approach any invitation to overturn a decision on likelihood of confusion.

32. As will be apparent, I take the view that the differences between the two marks in this case are far more significant than their similarity. The only common element between the marks is that both comprise or allude to a word 'REVIVE' which is entirely descriptive in this field and would not in itself be understood by the average consumer as indicating the goods of the opponent. The inherent distinctive character of the opponent's mark lies in the eccentric presentation of the word, not the word itself. The presentation of the word in the mark applied for is completely different and there is therefore nothing from which the average consumer would be likely to confuse the two marks or to conclude that the two marks were associated. I conclude that there is no likelihood of confusion.

Conclusion

33. The appeal succeeds and I shall direct that the mark proceeds to grant.

34. So far as costs are concerned, I shall discharge the previous order made by the Hearing Officer in favour of the opponent.

35. The applicant is in principle entitled to an award in relation to the costs of the opposition and the appeal. Since it was unrepresented, those costs would ordinarily be assessed by analogy with the principles applicable under the Civil Procedure Rules at £18 per hour of time reasonably spent.
36. I have considered whether to seek further submissions on costs. However, having reviewed the documents filed by the applicant, it is obvious that very little recoverable time has been spent on the case. The Counterstatement runs to three short paragraphs, and mostly consists of irrelevant points. The only evidence is a three line witness statement from a partner in the firm. The written submissions advanced before the Hearing Officer (there was no oral hearing) were only one page long and the Notice of Appeal was two and a half pages.
37. That being the case, any costs award will necessarily be small, and indeed so small that it would be disproportionate to invite submissions on the subject. I will order the opponent to pay the applicant's costs which I assess at £100.

IAIN PURVIS QC
THE APPOINTED PERSON
14th MAY 2013