

O/0282/26

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3627302

IN CLASS 3

IN THE NAME OF ISLESTARR HOLDINGS LIMITED

FOR THE FOLLOWING MARK:

EYES TO MESMERISE

AND

OPPOSITION THERETO (UNDER NO. 430970)

BY

AVON PRODUCTS, INC.

BACKGROUND

1) On 15 April 2021, Islestarr Holdings Limited ('the applicant') applied to register the mark, 'EYES TO MESMERIZE', in respect of various goods in class 3, as set out in the table at paragraph 15 of this decision.

2) The application was published in the Trade Marks Journal on 12 November 2021 and notice of opposition was later filed, on 11 February 2022, by Avon Products, Inc. ('the opponent'). The opponent claims that the application offends under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The following mark is relied upon:

i) **UKTM No. 810647960**

MESMERIZE

Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for cleaning, treating and improving the appearance of hair, dentifrices; deodorants for personal use (perfumery).

Filing date: 20 November 2015

Date of entry in the register: 24 October 2016

3) The trade mark relied upon by the opponent is an 'earlier' mark, in accordance with section 6 of the Act.¹ As it had not been registered for five years or more at the date of filing of the contested mark, it is not subject to the proof of use conditions, as per Section 6A of the Act.

4) The applicant filed a counterstatement denying the opponent's claims.

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs and IR (EU) TMs registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register and, as a consequence, have the same legal status as if they had been applied for and registered under UK law. A 'comparable trade mark (EU)/IR(EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM/EU(IR)TM from which it derives.

5) The opponent is represented by Dehns; the applicant is represented by Abion UK Limited ('Abion'). Neither party filed evidence or submissions during the evidence rounds. A hearing took place before me on 16 October 2024 at which Mr Robert Snell of Abion represented the applicant. The opponent filed written submissions in lieu of attendance.²

PRELIMINARY ISSUE

6) During the course of writing this decision, it has come to my attention that, on 24 October 2024, the applicant in the instant proceedings filed an application for cancellation on the grounds of non-use against the opponent's mark, UKTM 810647960 (under cancellation No. 507951). Due to the lack of any evidence of use being filed in those proceedings within the prescribed period, UKTM 810647960 has been declared revoked, with effect from 25 October 2021 (as per the decision of Mr Raoul Colombo, dated 24 June 2025). However, the relevant date for assessing the objection under section 5(2)(b) in the instant opposition proceedings is the filing date of the contested mark, 15 April 2021. As the opponent's mark was still extant on the register at that date, the opponent can still rely upon its earlier mark in the opposition proceedings before me.³

RELEVANCE OF EU LAW

7) 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. Accordingly, in this decision I will refer to decisions of the EU courts which predate the UK's withdrawal from the EU.

² Dated 14 October 2024.

³ See, for example, the decision of Professor Ruth Annand, sitting as the Appointed Person, in BL O/220/12 and, more recently, the decision of Mr Iain Purvis KC, sitting as the Appointed Person, in BL O/0689/25.

DECISION

8) Section 5(2)(b) of the Act states:

“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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

9) The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Relevance of EUIPO decision

10) The opponent draws my attention to a decision of the EUIPO Opposition Division which involved the same parties as those in the instant proceedings.⁴ In that decision the EUIPO found a likelihood of confusion between the contested mark, 'HYPNOTIZE', and the earlier mark, 'EYES TO HYPNOTISE', in respect of goods in class 3. The opponent draws analogies between the circumstances in those proceedings and invites me to make the same finding in the case before me. I have read the EUIPO decision. First and foremost, that decision is not binding upon me. In any event, the marks at issue were not the same as those before me (although they do share some similarities in structure) and the scope of goods covered by the contested mark in that case in class 3 was also not as broad as those in the instant case. I do not consider the EUIPO decision to be of assistance in the case before me.

Comparison of goods

11) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union ('CJEU'), Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

12) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

⁴ See the opponent's submissions in lieu, Annex 1

- (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.

13) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking..”

In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the

goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-O-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

14) Further, in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*) the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

15) The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for cleaning, treating and improving the appearance of hair, dentifrices; deodorants for personal use (perfumery).</p>	<p>Class 3: Cosmetics, make up; skin care preparations; lipsticks; lip gloss; make-up powder and foundation; moisturisers; beauty care preparations; body care preparations; preparations and products for removing make-up; lotions, creams and conditioners for the face, hands and body; beauty masks; abrasive cloth; abrasive paper; abrasives; adhesives for affixing false hair; adhesives for cosmetic purposes; almond milk for cosmetic purposes; almond oil; almond soap; aloe vera preparations for cosmetic purposes; alum stones [astringents]; astringents for cosmetic purposes; balms other than for medical purposes; bath salts, not for medical purposes; baths (cosmetic preparations for-); beard dyes; bleaching preparations [decolorants] for cosmetic purposes; breath freshening sprays; breath freshening strips; cakes of toilet soap; cleansing milk for toilet purposes; colorants for toilet purposes; color-removing preparations; colour-brightening chemicals for household purposes [laundry]; cosmetic kits; cosmetic preparations for slimming purposes; cosmetics for animals; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; creams (cosmetic-); dental bleaching gels;</p>

	depilatories; depilatory preparations; douching preparations for personal sanitary or deodorant purposes [toiletries]; dry shampoos; dyes (cosmetic-); eyebrow cosmetics; eyebrow pencils; eyelashes (adhesives for affixing false-); eyelashes (cosmetic preparations for-); false eyelashes; false hair (adhesives for affixing-); false nails; greases for cosmetic purposes; hair colorants; hair dyes; hair lotions; hair spray; hair waving preparations; hydrogen peroxide for cosmetic purposes; javelle water; lotions for cosmetic purposes; make-up preparations; make-up removing preparations; mascara; massage gels other than for medical purposes; moustache wax; nail art stickers; nail care preparations; nail polish; nail varnish; neutralizers for permanent waving; oils for cosmetic purposes; oils for toilet purposes; pencils (cosmetic-); petroleum jelly for cosmetic purposes; polishes (denture-); pomades for cosmetic purposes; pumice stone; shampoos; skin care (cosmetic preparations for-); skin whitening creams; soap; soap for foot perspiration; sunscreen preparations; sun-tanning preparations [cosmetics]; talcum powder, for toilet use; tissues impregnated with cosmetic lotions; toilet
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	<p>water; toiletries; transfers (decorative-) for cosmetic purposes; varnish-removing preparations; waving preparations for the hair; wax (depilatory-); hair care preparations; toiletry preparations.</p>
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16) For the purposes of the comparison, I will group certain of the applicant's goods together where it is appropriate to do so.

Cosmetics, make up; skin care preparations; lipsticks; lip gloss; make-up powder and foundation; moisturisers; beauty care preparations; body care preparations; preparations and products for removing make-up; lotions, creams and conditioners for the face, hands and body; beauty masks; adhesives for affixing false hair; adhesives for cosmetic purposes; almond milk for cosmetic purposes; aloe vera preparations for cosmetic purposes; alum stones [astringents]; astringents for cosmetic purposes; balms other than for medical purposes; bath salts, not for medical purposes; baths (cosmetic preparations for-); beard dyes; bleaching preparations [decolorants] for cosmetic purposes; cleansing milk for toilet purposes; colorants for toilet purposes; color-removing preparations; cosmetic kits; cosmetic preparations for slimming purposes; cosmetics for animals; creams (cosmetic-); depilatories; depilatory preparations; douching preparations for personal sanitary or deodorant purposes [toiletries]; dyes (cosmetic-); eyebrow cosmetics; eyebrow pencils; eyelashes (adhesives for affixing false-); eyelashes (cosmetic preparations for-); false hair (adhesives for affixing-); greases for cosmetic purposes; lotions for cosmetic purposes; make-up preparations; make-up removing preparations; mascara; massage gels other than for medical purposes; moustache wax; nail care preparations; nail polish; nail varnish; oils for cosmetic purposes; pencils (cosmetic-); petroleum jelly for cosmetic purposes; pomades for cosmetic purposes; skin care (cosmetic preparations for-); skin whitening creams; sunscreen preparations; sun-tanning preparations [cosmetics]; talcum powder, for toilet use; toiletries; transfers (decorative-) for

cosmetic purposes; varnish-removing preparations; wax (depilatory-); toiletry preparations

17) All of these goods fall within the opponent's broad term, 'cosmetics'. They are identical as per *Meric*.

Toilet water

18) These goods fall within the opponent's 'perfumery'. They are identical as per *Meric*.

dry shampoos; hair colorants; hair dyes; hair lotions; hair spray; hair waving preparations; hydrogen peroxide for cosmetic purposes; neutralizers for permanent waving; shampoos; waving preparations for the hair; hair care preparations

19) These goods are either identical or at least highly similar to the opponent's 'hair lotions, preparations for cleaning, treating and improving the appearance of hair' for obvious reasons (bearing in mind that hydrogen peroxide is commonly used as a hair bleach).

Almond oil; oils for toilet purposes.

20) These goods are identical to the opponent's 'essential oils'.

Almond soap; cakes of toilet soap; soap; soap for foot perspiration.

21) All of these goods are identical to the opponent's 'soaps'.

colour-brightening chemicals for household purposes [laundry]; Javelle water; abrasives.

22) These goods are all substances for the purpose of household cleaning. The opponent's 'soaps' covers not only soap for use on the body but also soap for household purposes. I find a medium degree of similarity between the opponent's 'soap' and these goods of the applicant owing to their likely shared channels of trade,

overlapping nature, purpose and method of use and that there may be some competitive relationship in play.

abrasive cloth; abrasive paper

23) The opponent contends that these goods are also similar to the opponent's 'soaps' on the basis that both parties' goods are used for laundry/cleaning purposes. The nature and method of use of the goods is different. Trade channels may be the same or overlap. The purpose overlaps to some extent as both parties' goods can be used for cleaning purposes. They are, though, not obviously complementary and neither is it clear to me that they are likely to be in competition. I remind myself that, at the hearing, Mr Snell conceded that all of the applicant's goods are similar to the opponent's goods to at least 'some degree'. Bearing this concession in mind, I find a low degree of similarity between these goods and the opponent's 'soaps'.

breath freshening sprays; breath freshening strips; dental bleaching gels; polishes (denture-)

24) I find that these goods are highly similar, if not identical, to the opponent's 'dentifrices' owing to the shared users, trade channels and overlapping purpose and methods of use.

tissues impregnated with cosmetic lotions

25) These goods are highly similar to the opponent's 'cosmetics' owing to the shared users, purpose and methods of use. They may also be in competition and/or have a complementary relationship.

pumice stone

26) I find these goods to be similar to a medium degree to the opponent's 'cosmetics'. The nature of the goods differs. However, both parties' goods will be used to improve the appearance of the skin albeit in different ways and the trade channels will be the

same. There may also be a competitive relationship in play e.g. choosing between a cosmetic exfoliant cream or a pumice stone.

nail art stickers; false nails; false eyelashes

27) These goods are similar to a medium degree to the opponent's 'cosmetics'. The respective trade channels will be the same, the purpose is similar (both being used to beautify nails or eyes). There is also a clear competitive relationship in play e.g. a customer may choose between using nail varnish or mascara (covered by the opponent's term) or using false nails, stickers or false eyelashes.

cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes

28) The opponent contends that its 'cosmetics' covers these goods. I disagree. These goods will clearly be used with cosmetics, but they are not cosmetics *per se*. That said, the trade channels will be the same or overlap significantly and the users will be the same. I cannot see that there is any complementary relationship in play in the sense described in the case law; although they will clearly be used together, they are not important for the use of the other in such a way that the consumer will believe they must come from the same source. Neither is there any obvious competitive relationship in play. Bearing in mind Mr Snell's concession that there is some degree of similarity between all of the applicant's goods and those of the opponent, I find a low degree of similarity between these goods and the opponent's 'cosmetics'.

Average consumer and the purchasing process

29) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

The average consumer for the relevant goods is the general public. The purchasing act will be primarily visual because such goods will be selected after perusal of the goods in high-street stores or from photographs/images on Internet websites or in catalogues. That is not to say, though, that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with sales representatives, for example. The goods at issue are generally inexpensive. That said, various factors such as scent, colour and/or suitability for skin type/cleaning purpose may be considered by the consumer when making the purchase. I find that a medium degree of attention is likely to be paid during the purchase for the relevant goods.

Comparison of marks

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

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

31) The marks to be compared are:

The opponent's mark	The contested mark
MESMERIZE	EYES TO MESMERISE

32) As Mr Snell pointed out, the opponent's mark is captured as a 'figurative' one on the relevant Trade Mark database and therefore, in his submission, some of the distinctiveness of the mark rests in its stylisation. However, any stylisation that this mark has is extremely minimal. The dominant and distinctive element of the mark is patently the word 'MESMERIZE' and it would be artificial to find otherwise; its stylisation plays a much lesser role. Turning to the contested mark, this consists of the plain words, 'EYES TO MESMERISE'. Whilst I bear in mind Mr Snell's point that this mark has a certain rhyme and rhythm to it, there is no getting away from the fact that, for a number of the goods at issue, the word 'EYES' at the beginning of the mark is wholly descriptive i.e. goods which are intended for use in or around the eyes (e.g. mascara, eyebrow cosmetics etc.). For that category of goods, the word 'MESMERISE', of itself, is relatively more distinctive than the word 'EYES' and, indeed, more distinctive than the two words 'EYES TO'. Furthermore, whilst 'MESMERISE' is at the end of the mark, it takes up a larger proportion of the mark as compared to the preceding words, 'EYES TO'. Bearing these factors in mind, I find that, in relation to the goods at issue which are for use on or around the eyes, it is the word 'MESMERISE' which carries the greatest weight in the overall impression with the words 'EYES TO' playing a lesser role despite their presence at the beginning of the mark. However, in relation to the goods at issue which are not for use on or around

the eyes (e.g. lipstick, toilet water etc.), I find that the distinctiveness of the mark rests in the three words as a whole with no word(s) being more dominant than the other(s) in the mark, notwithstanding 'MESMERISE' occupying the greater proportion of the mark.

33) Visually, the marks differ due to the contested mark containing the additional words, 'EYES TO', at the beginning which are absent from the opponent's mark. Whilst I bear in mind that the beginnings of marks tend to have the greatest impact on the perception, that is no more than a general rule of thumb rather than an immutable rule; each case must be assessed on its own merits. In my view, the very high degree of similarity between the word MESMERISE in the contested mark (which occupies a significant proportion of that mark) with the earlier mark, MESMERIZE, results in an above-medium degree of visual similarity between the marks overall.

34) MESMERISE and MESMERIZE will be pronounced identically. The words 'EYES TO' create an additional two syllables at the beginning of the contested mark which are absent in the earlier mark. Therefore, the contested mark contains five syllables in total, the last three of which are identical to the only three syllables in the earlier mark. Overall, I find an above- medium degree of aural similarity between the marks.

35) Conceptually, the earlier mark will be perceived as meaning 'to capture the complete attention of someone'. The contested mark will be perceived as meaning 'eyes to capture the complete attention of someone'. I find an above-medium degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

36) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

37) As the opponent has filed no evidence of use, I have only the inherent degree of distinctiveness of the earlier mark to consider. Mr Snell again made much of the fact that the earlier mark has been captured as a ‘stylised’ one. Accordingly, in his submission, some of that mark’s distinctiveness must come from its stylisation. As I have already touched upon, any stylisation that the earlier mark has is extremely minimal. I do not consider that its stylisation contributes to the distinctiveness of the mark and to find otherwise would be artificial. The distinctiveness rests in the word itself, ‘MESMERIZE’. Given how this word will be conceptualised by the average consumer, I find that it has a low degree of distinctiveness in relation to the relevant earlier goods, all of which may be used to enhance attractiveness/capture attention.

Likelihood of confusion

38) Mr Snell drew my attention to a previous decision of this tribunal in ‘FOODSMART’ (BL O/978/22). The earlier mark was a stylised one containing the words ‘SMARTWITHFOOD’ presented in the colours blue and green together with a device

element in the same colours. Suffice it to say, that case has no bearing on my considerations in the instant case. Firstly, I am not bound by earlier decisions of his tribunal. Secondly, the marks in that case were entirely different to those before me and for entirely different goods and services. Whilst I accept that that case involved marks/elements of low distinctiveness, each case must be assessed on its own merits.

39) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

40) On the matter of the low degree of distinctiveness of the earlier mark, it is also appropriate to bear in mind that in *L'Oréal SA v OHIM*, Case C-235/05 P (*'L'Oréal'*) the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

41) However, I must also be mindful that in *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] F.S.R. 33. (*Whyte and Mackay*), Mr Justice Arnold (as he then was) stated at [44] that:

“...what can be said with certainty is 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.”

42) Further, in *Nicoventures Holdings Limited v The London Vape Company Limited* [2017] EWHC 3393, in [27] Mr Justice Birss (as he then was), having agreed with Arnold J’s statement of principle cited above, stated that:

“...If the only similarity between two marks arises from common elements which have low distinctiveness (alone and as a combination) then that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive.”

In [31] he further stated that:

“The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.”

43) In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EWHC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal

- Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsforth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

44) I will first consider the likelihood of direct confusion. The respective goods are either identical or similar to varying degrees (from low to medium to high). The marks are visually, aurally and conceptually similar to an above-medium degree. Weighing all these factors, and bearing in mind the principle of imperfect recollection, I find that a ‘significant proportion’⁵ of average consumers, paying a medium degree of attention, are likely to misremember the marks as being the same in relation to goods which are

⁵ It is not necessary that all average consumers be confused. See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, [34], where the court said: “... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

for use on or around the eyes, notwithstanding the low degree of distinctiveness of the common element. To that extent, there is a likelihood of direct confusion. In reaching this view, I have borne in mind the dominance of the word 'MESMERISE' in the contested mark in relation to such goods. However, I do not consider there to be a likelihood of direct confusion in respect of other goods which are not for use on or around the eyes. In those circumstances, the overall impression of the contested mark lies in the combination of the three words within it, which is likely to reduce the likelihood of that mark being imperfectly recalled as simply the word 'MESMERISE' (or 'MESMERIZE') by an average consumer paying a medium degree of attention.

45) I now turn to consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

“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)".

46) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (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. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

47) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

48) The similarity between the marks at issue stems from the respective words MESMERISE/MESMERIZE. It is that common element which gives rise to an above-medium degree of visual, aural and conceptual similarity between the marks. That common element is one which is low in distinctiveness. This therefore points away from the consumer putting the similarities that exist between the respective marks down to the goods coming from the same/linked undertaking(s). However, I also bear in mind that the other words in the contested mark are even less distinctive in relation to certain of the goods at issue (those which are for use on or around the eyes). Weighing these factors, I come to the view that, in respect of the goods at issue which are for use on or around the eyes, a significant proportion of average consumers are

likely to put the similarities between the marks down to the respective goods coming from the same or linked source(s). There is a likelihood of indirect confusion for such goods. I do not consider that the same conclusion applies in respect of goods which are not for use on or around the eyes. This is because, in those circumstances, the words 'EYES TO' are no longer descriptive, or otherwise non-distinctive, and will not be put down to the contested mark being a logical variant, sub-brand or brand extension of the earlier mark.

OUTCOME

49) The opposition under section 5(2)(b) of the Act succeeds against the following goods, all of which are discrete terms identifying goods which are specifically for use on or around the eyes or are broad terms which cover goods for such use:

Cosmetics, make up; skin care preparations; make-up powder and foundation; moisturisers; beauty care preparations; body care preparations; preparations and products for removing make-up; lotions, creams and conditioners for the face and body; beauty masks; adhesives for cosmetic purposes; almond milk for cosmetic purposes; almond oil; aloe vera preparations for cosmetic purposes; astringents for cosmetic purposes; balms other than for medical purposes; bleaching preparations [decolorants] for cosmetic purposes; cleansing milk for toilet purposes; colorants for toilet purposes; color-removing preparations; cosmetic kits; cosmetics for animals; creams (cosmetic-); depilatories; depilatory preparations; dyes (cosmetic-); eyebrow cosmetics; eyebrow pencils; eyelashes (adhesives for affixing false-); eyelashes (cosmetic preparations for-); false eyelashes; greases for cosmetic purposes; lotions for cosmetic purposes; make-up preparations; make-up removing preparations; mascara; oils for cosmetic purposes; oils for toilet purposes; pencils (cosmetic-); petroleum jelly for cosmetic purposes; pomades for cosmetic purposes; skin care (cosmetic preparations for-); skin whitening creams; sunscreen preparations; sun-tanning preparations [cosmetics]; tissues impregnated with cosmetic lotions; toiletries; transfers (decorative-) for cosmetic purposes; wax (depilatory-); toiletry preparations.

50) The opposition under section 5(2)(b) of the Act fails against the following goods, none of which are obviously goods specifically for use on or around the eyes or broad terms covering the same:

lipsticks; lip gloss; lotions, creams and conditioners for the hands; abrasive cloth; abrasive paper; abrasives; adhesives for affixing false hair; almond soap; alum stones [astringents]; bath salts, not for medical purposes; baths (cosmetic preparations for-); beard dyes; breath freshening sprays; breath freshening strips; cakes of toilet soap; colour-brightening chemicals for household purposes [laundry]; cosmetic preparations for slimming purposes; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; dental bleaching gels; douching preparations for personal sanitary or deodorant purposes [toiletries]; dry shampoos; false hair (adhesives for affixing-); false nails; hair colorants; hair dyes; hair lotions; hair spray; hair waving preparations; hydrogen peroxide for cosmetic purposes; javelle water; massage gels other than for medical purposes; moustache wax; nail art stickers; nail care preparations; nail polish; nail varnish; neutralizers for permanent waving; polishes (denture-); pumice stone; shampoos; soap; soap for foot perspiration; talcum powder, for toilet use; toilet water; varnish-removing preparations; waving preparations for the hair; hair care preparations.

COSTS

51) As both parties have had a reasonable degree of success, I decline to favour either with an award of costs.

Dated this 30th day of March 2026

**Beverley Hedley
For the Registrar**