BL O/0595/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICTION NOS. 3764413, 3764415 AND 3866998 IN THE NAME OF SHENZHEN HAISHUN NETWORK CO., LIMITED

AND IN OPPOSITION NOS 434587, 434589 AND 440472 RESPECTIVELY THERETO BY COSMETIC WARRIORS LIMITED

DECISION

Introduction

1. This is an appeal by Cosmetic Warriors Limited ("***the opponent***") against a decision by Beverley Hedley, on behalf of the Registrar of Trade Marks, dated 14 November 2024 (O-1082-24)("***the Decision***"), in which the oppositions were dismissed, and the opponent was ordered to pay to Shenzhen Haishun Network Co., Ltd ("***the applicant***") £600 as a contribution to its costs.

2. On 11 March 2022 the applicant applied to register the marks 'Lushforest excellenz' (application number 3764413)("***the '413 application***") and 'Lushforest forkidd' (application number 3764415)("***the '425 application***") (together "***the first two applications***"). A further application was filed on 12 January 2023 for the mark 'Lushforest' (application number 3866998) ("***the '998 application***"). All three applications were made for various items of clothing in Class 25.

3. All three applications were advertised and subsequently opposed by the opponent on the basis of section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 ("***the 1994 Act***").

4. In support of the opposition under section 5(2)(b) the opponent relied upon three registered trade marks (together "***the earlier marks***"):

   (1) UKTM 3269886 ("***'886***")

   LUSH

   Registered with respect to all goods in classes 3, 18 and 25 and some services in class 35 (as set out in the Annex to the Decision).

   (2) UKTM 2113249 ("***'249***")

   LUSH

All goods in class 25 (as set out in the Annex to the Decision).

(3) UKTM 913135331 ("***'331***")

LUSH

All goods in classes 18 and 25 and all services in class 35 (as set out in the Annex to the Decision) are relied on against the first two applications. Only the goods in classes 18 and 25 are relied upon against the third application.

5. In support of the opposition under section 5(3) the opponent relied upon the '866 mark in respect of the goods in class 3 shown in the Annex to the Decision. It was claimed that the '866 mark has a reputation in the UK in relation to the goods relied upon and that use of the contested marks would take unfair advantage or be detrimental to the reputation and/or distinctive character of the earlier mark.

6. The trade marks relied upon were all earlier marks in accordance with section 6 of the 1994 Act. The '249 and '331 marks were subject to proof of use in accordance with section 6A of the 1994 Act.

7. The applicant filed a counterstatement.

8. The opponent was represented by D Young & Co LLP and the applicant by Axis Professionals Ltd. Both parties filed evidence. Neither side requested a hearing and only the opponent filed written submissions in lieu. Therefore, the oppositions were determined on the basis of the relevant papers before the Hearing Officer.

9. For the reasons set out in the Decision the Hearing Officer rejected both grounds of opposition with respect to each of the trade mark applications.

The Grounds of Appeal

10. In a TM55P dated 11 December 2024 the opponent appealed the Decision. It did so on the basis of a number of grounds that were identified in the skeleton of argument on appeal as follows. It was maintained that the Hearing Officer erred in finding that:

(1) the aural similarity between the earlier marks and the '413 application and '415 application was below medium;

(2) the aural similarity between the earlier marks and the '998 application was below medium;

(3) there was no or only low conceptual similarity between the earlier marks and the applications;

(4) the earlier marks had only a low degree of inherent distinctive character which was said to flow from the error identified in ground 3; and

(5) there was thus no likelihood of indirect confusion i.e. on the basis of the errors in grounds 1 to 4.

11. It was made also clear in the skeleton of argument filed on behalf of the opponent that the Hearing Officer had correctly set out the principles of law to be applied to the assessment under section 5(2)(b) of the 1994 Act at paragraph [12] of the Decision; and with respect to the principles to be applied to the issue of indirect confusion at paragraph [37] of the Decision.

12. It was further helpfully confirmed in the skeleton of argument that:

(1) For the purposes of the appeal, it was only necessary to consider one of the three earlier trade marks relied upon namely the '249 mark for the word LUSH ("***the Earlier Mark***") registered *inter alia* with respect to '*articles of clothing*' in Class 25 ("***the Earlier Goods***").

(2) There was no appeal against the finding that the '249 mark had not acquired distinctiveness through use.

(3) There was no appeal against the finding that '*dressing gowns; pullovers; jumpers [pullovers]; sweaters; clothing; trousers; bath robes; children's clothing; singlets; shirts; tee-shirts; underwear; tights; suits; skirts outerclothing*' in Class 25 and '*T-shirts*' in Class 25 were identical to the Earlier Goods (paragraph [16] of the Decision).

(4) There was no appeal against the finding that the applications were dominated by the 'Lushforest' element (paragraph [22] of the Decision).

(5) There was no appeal against the finding that the Applications are visually similar to a below medium degree (paragraphs [23], [24], [26] and [27] of the Decision) or medium degree (the '998 Application)(paragraphs [29] and [30 of the Decision).

(6) There was no appeal against the finding of no direct confusion.

13. No Respondent's Notice was filed.

14. At the hearing of the appeal, which took place via video link, the opponent was represented by Mr Jamie Muir Wood instructed by D Young & Co LLP. The applicant did not appear.

The Standard of Review

15. The Supreme Court most recently restated the approach to appeals of this kind in its judgment in Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc [2025] UKSC 25 at [93] to [95] as follows:

93. The question whether there is a trade-mark infringement under section 10(2)(b) of the Act is a classic example of what has come to be known as a multi-factorial assessment. It involves the finding of primary facts, the application of relevant principles or rules of law to those facts and the evaluative decision whether, thus considered, something has happened which falls within (here) a statutory definition. In the present case those definitions are similarity and confusion, and the existence of the requisite causative link between the two, as required by section 10(2)(b), as well as the artificial (largely judge made) construct of the average consumer, through whose eyes similarity and confusion have to be gauged.

94. It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions. While of course the decision of an appellate court trumps that of the court below, the law has imposed structured constraints designed to prevent a free for all in a higher court whenever a party (with the necessary resources) wishes to challenge the first instance decision of the trial judge. The reasons for these constraints are set out in a string of well-known authorities including, in the intellectual property context, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] FSR 29, per Lewison LJ at para 114. The reasons there set out relevantly include the following:

> (i) The trial is not a dress rehearsal. It is the first and last night of the show.
>
> (ii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court.
>
> (iii) In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.

95. In *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8; [2024] Bus LR 532 this court reviewed those constraints in a trade mark context. After citing from the *Fage* case this court in a joint judgment said, at paras 49-50:

> "49. That does not, however, mean the appeal court is powerless to intervene where the judge has fallen into

> error in arriving at an evaluative decision such as whether an activity was or was not targeted at a particular territory. It may be possible to establish that the judge was plainly wrong or that there has been a significant error of principle; but the circumstances in which an effective challenge may be mounted to an evaluative decision are not limited to such cases. Many of the important authorities in this area were reviewed by the Court of Appeal in *In re Sprintroom Ltd* [2019] 2 BCLC 617, paras 72–76. There, in a judgment to which all members of the court (McCombe, Leggatt and Rose LJJ) contributed, the court concluded, at para 76, in terms with which we agree, that on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.
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> 50. On the other hand, it is equally clear that, for the decision to be 'wrong' under CPR r 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."

16. I have kept these principles in mind when considering the present appeal.

Decision

Grounds 1 and 2 – incorrect finding with respect of aural similarity

17. These grounds of appeal concern the Hearing Officer's assessment of the aural similarity between the marks in issue.

18. Ground 1 is concerned with the finding by the Hearing Officer in paragraphs [24] and [27] of the Decision that the aural similarity between the Earlier Mark and the '413 Application and the '415 Application was below medium in circumstances where the applicant had admitted that the aural similarity was medium.

19. The Counterstatement included with each of the relevant TM8s stated in identical terms as follows '*We find the marks to be aurally similar to no more than a medium degree'*. That the applicant took that position was expressly referred to in paragraph [7] of the Decision and was therefore something that the Hearing Officer had in mind when reaching her conclusions.

20. It seems to me that the wording set out above is not clearly an admission that the marks were aurally similar to a medium degree but rather a statement that it was the applicant's position that they were similar to no more than a medium degree. Against that background it seems to me that it was appropriate for the Hearing Officer to make the relevant assessment for herself which she did in paragraphs [24] and [25] of the Decision.

21. The opponent has not suggested that any of the factors that the Hearing Officer referred to in reaching her own conclusions in those paragraphs were wrong in principle and therefore I dismiss Ground 1 of the appeal.

22. As to Ground 2 the Hearing Officer found that the aural similarity between the Earlier Mark and the '998 Application was medium. No admission was made by the applicant with respect to the aural similarity of this mark. It was maintained by the opponent that the Hearing Officer should have found that the aural similarity was above medium. However, the only basis put forward for this was by reference to a successful finding on Ground 1. No error of principle as to the assessment made by the Hearing Officer in paragraph and therefore, I dismiss Ground 2 of the appeal.

23. Further and in any event, if all that the opponent is seeking to do by way of Grounds 1 and 2 is to replace a finding of a below medium aural similarity and/or medium aural similarity between the marks with a finding of a medium or above medium degree of aural similarity this argument cannot be accepted. See the reasoning set out in paragraph [35] of TVIS Ltd v. Howserv Services Ltd [2024] EWCA Civ 1103:

> 35. The second and more fundamental reason is that, while it is conventional for first instance tribunals in trade mark cases to articulate their assessment of the degree of visual and aural similarity between signs and trade marks using words such as "high", "medium" or "low", there is no legal requirement for tribunals to do so. All that is required is for the tribunal to assess the nature and extent of any similarities. This is because what matters is not the verbal label that is applied to the assessment, but whether the similarities in conjunction with the other factors which must be taken into account lead to a likelihood of confusion. It is possible for there to be no likelihood of confusion despite a relatively high degree of visual and aural similarity. Equally it is possible for there to be a likelihood of confusion despite a relatively low degree of visual and aural similarity. It depends on the other factors that are in play.

Ground 3 – incorrect finding with respect to conceptual similarity

24. At the forefront of this ground of appeal was the proposition that the Hearing Officer failed of carry out a proper analysis as to the available meaning that the word LUSH would convey to the average consumer. What was maintained was that the Hearing

Officer wrongly found at paragraph [25] of the Decision that the sign LUSH as indicating something luxurious or appealing and nothing more.

25. In paragraph [25] of the Decision the Hearing Officer found as follows:

> Conceptually, the opponent contends that the word, LUSH, in the earlier mark may be 'perceived as being associated with vegetation, green landscapes or cultivated fields'. I consider this to be unlikely in the absence of other words in the mark to lead the consumer to immediately perceive such a meaning (such as 'lush garden', 'lush vegetation' or 'lush field', for example). In my view, the word LUSH, on its own, will be recognised, immediately, as a slang term meaning something luxurious or appealing and nothing more. That is the sole concept of the earlier mark. The term 'Lushforest' in the later mark will be perceived as meaning a luxurious/appealing forest or a forest which has an abundance of healthy, green plants. Either way, the concept of 'lushforest' is different to that of 'lush' solus. The word 'excellenz' has little role to play in the conceptual comparison because it will send a laudatory and non-distinctive meaning of 'excellence' and, as such, does not introduce a distinctive conceptual difference between the marks. Overall, I find the marks to be conceptually different. If I am wrong about that, any conceptual similarity stemming from the common use of 'lush' is low.

26. The equivalent findings were made with respect to the other applications in paragraphs [28] and [31] of the Decision.

27. It is not said, on this appeal, that it was not open to the Hearing Officer to find that the word LUSH would be recognised by the average consumer as meaning luxurious or appealing. What is said, is that (1) the Earlier Mark would not be perceived solely as the slang term meaning luxurious or appealing but also as an adjective commonly used to describe green or verdant scenery; and (2) given the finding that the Earlier Mark would be perceived solely as the slang term the finding by the Hearing Officer that the word LUSH in the applications would not be seen solely as the slang term was '*nonsensical and confused*'.

28. I do not agree. It seems to me to be clear that the Hearing Officer considered that the perception of the average consumer would be different depending on whether the work LUSH was used on its own i.e. *solus* as opposed to in circumstances where it was used in combination with another word, in the present case the word 'forest'. The fact that the Hearing Officer found that 'lushforest' could be perceived by the average consumer as either a luxurious or appealing forest or a forest which has an abundance of healthy green plants i.e. a green or verdant forest is one that it was clearly open to her to make.

29. The words ‘excellenz’ and ‘forkidd’ were found by the Hearing Officer not to introduce a distinctive conceptual difference to the marks and no complaint is made about those findings.

30. On the basis of those findings, it seems to me that it was plainly open to the Hearing Officer to conclude that the applications were conceptually different from the Earlier Mark or alternatively that any conceptual similarity was low; rather than at least medium as contended for by the opponent.

Ground 4 – incorrect findings in respect of inherent distinctive character

31. With regard to the findings with respect to inherent distinctive character of the Earlier Mark it is said that the Hearing Officer’s conclusion that the inherent distinctive character was low was wrong and that she could and should have found that the inherent distinctive character was at least medium.

32. Two bases were put forward for this contention. The first is that the average consumer would primarily recognise the Earlier Mark as the adjective commonly used to describe green or verdant scenery; and secondly that the Hearing Officer failed to take into account that the Earlier Mark is unlikely to be used to describe clothing and accordingly its inherent distinctiveness is higher for clothing in class 25.

33. The first point has already been rejected under Ground 3. As to the second point:

    (1) It is not suggested that the Hearing Officer did not set out the correct legal principles to be applied to the assessment that she had to make in paragraph [32] of the Decision in which the relevance of making the assessment by reference to the goods or services the subject of the specification is set out.

    (2) Whilst the finding in paragraph [33] of the Decision does not expressly refer to clothing (a) the laudatory message would apply to any and all goods and/or services; and (b) the Hearing Officer went on in paragraph [34] of the Decision to consider use including with respect to clothing such that it cannot be said that the Hearing Officer did not have such goods in mind.

    In the circumstances to the extent that the absence of an express reference to clothing in class 25 in paragraph [33] of the Decision can be said to be an error it cannot be regarded as a material error. Therefore, I dismiss Ground 4.

Ground 5 – incorrect findings in respect of likelihood of indirect confusion

34. This was not a freestanding ground of appeal. No separate error in the Hearing Officer’s reasoning as to her assessment of the likelihood of indirect confusion was identified. Given that, for the reasons set out above, Grounds 1 to 4 above have been dismissed it follows that Ground 5 should also be dismissed.

Conclusion

35. On the basis of my findings set out above it does not seem to me that the opponent has identified any error of principle or material error in the Hearing Officer’s Decision.

Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the conclusions that she did. In the result the appeal fails and is dismissed.

36. As the appeal has been dismissed the applicant is entitled to a contribution towards the costs of the appeal. However, the applicant has not participated in any way in this appeal. It therefore seems to me that the appropriate costs order on appeal is to make no order as to costs.

37. With respect to the cost order made by the Hearing Officer below in accordance with paragraph [63] of the Decision the sum of £600 should be paid by Cosmetic Warriors Limited to Shenzhen Haishun Network Co., Ltd within 21 days of the date of this decision.

EMMA HIMSWORTH KC

Appointed Person

30 June 2025