

O/0957/24

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 3866451 BY
SHENZHEN MINYOU DIGITAL TECHNOLOGY CO., LTD
TO REGISTER THE TRADE MARK:**



IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO. 440282
BY
COSMETIC WARRIORS LIMITED**

BACKGROUND & PLEADINGS

1. Shenzhen Minyou Digital Technology Co., Ltd (“**the applicant**”) applied to register the (figurative) trade mark shown on the front page of this decision in the United Kingdom on 10 January 2023. It was accepted and published in the Trade Marks Journal on 20 January 2023 in respect of the following goods:

Class 9: Microphones; computer hardware; scanners [data processing equipment]; video screens; Global Positioning System [GPS] apparatus; navigational instruments; intercommunication apparatus; electrical adapters; smartphones; baby monitors; tablet computers; smartwatches; rearview cameras for vehicles; electric sockets; cables, electric; headgear being protective helmets; loudspeakers; microscopes; distance recording apparatus; video baby monitors; horns for loudspeakers; computer peripheral devices; transformers [electricity]; optical lenses; eyeglasses; accumulators, electric; alarms; mileage recorders for vehicles; battery chargers; headphones; camcorders; cases for smartphones; detectors; microscopes; padlocks, electronic; megaphones; selfie sticks [hand-held monopods]; solar batteries; solar panels for the production of electricity; inverters [electricity]; monitors [computer hardware]; monitors [computer programs]; integrated circuit cards [smart cards]; black boxes [data recorders]; processors [central processing units].

2. On 14 April 2023, Cosmetic Warriors Limited (“**the opponent**”) opposed the application on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks

Act 1994 (“the Act”)¹. The Section 5(2)(b) and 5(3) grounds are based upon the following earlier UK registered mark:

Trade Mark no.	UK00003269886 ('886)
Trade Mark	LUSH
Registered Goods & Services	Classes 3, 4, 9, 16, 18, 25, 26, 35, 38, 41, 42, 44 & 45
Dates	Filing date: 10 November 2017
	Date of entry in register: 2 February 2018
Priority Details	Priority date: 22 June 2017 Priority country: Malaysia TMs from which priority claimed: 2017061663; 2017061676; 2017061702; 2017061711; 2017061720; 2017061729; 2017061741; 2017061736; 2017061746; 2017061751; 2017061655; 2017061658

3. Under Section 6(1) of the Act, the opponent’s trade mark clearly qualifies as an earlier trade mark. Further, as protection of the earlier mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

4. For the purposes of the Section 5(2)(b) proceedings, the opponent relies upon the following goods and services:

Class 9: Podcasts; digital music (downloadable); pre-recorded disks; recording disks; compact discs; computer games programmes; telephone ring tones; music recordings; downloadable music files; musical video recordings; downloadable musical sound recordings; digital music downloadable from the internet; musical recordings in

¹ 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.

the form of discs; digital music downloadable provided from mp3 internet web sites; downloadable publications; publications in electronic format; downloadable biographies; talking books; downloadable image files; sunglasses; cases, straps and chains for sunglasses; camera cases; mobile phone covers and cases; laptop carrying cases; cases adapted for tablet computers; computer mouse pads; decorative magnets; fridge magnets; mobile applications; mobile apps; animated cartoons; pre-recorded videos; computer software; computer games programmes; computer hardware and firmware; computer servers; network servers.

Class 35: Retail services being in store, by mail order catalogues, telephone, or via the internet, connected with the sale of podcasts, digital music (downloadable), pre-recorded disks, recording disks, compact discs, computer games programmes, telephone ring tones, music recordings, downloadable music files, musical video recordings, downloadable musical sound recordings, digital music downloadable from the internet, musical recordings in the form of discs, digital music downloadable provided from mp3 internet web sites, downloadable publications, publications in electronic format, downloadable biographies, talking books, downloadable image files, sunglasses, cases, straps and chains for sunglasses, camera cases, mobile phone covers and cases, laptop carrying cases, cases adapted for tablet computers, computer mouse pads, decorative magnets, fridge magnets, mobile applications, mobile apps, animated cartoons, pre-recorded videos, computer software, computer games programmes, computer hardware and firmware, computer servers, network servers.

5. Under Section 5(2)(b) of the Act, the opponent in its notice of opposition claims that the competing marks are highly similar, and the respective goods are identical and/or similar. In this regard, registration of the contested mark should be refused under Section 5(2)(b) of the Act.

6. Under Section 5(3), the opponent claims a reputation in its mark for all the goods listed in Class 3, shown in paragraph 68 of this decision, such that the relevant public will believe the applicants' goods are from an economically linked undertaking. The opponent also contends that the use of the applied for mark in relation to the contested goods will be detrimental to the earlier mark's allure and attraction, and erode the distinctiveness of its earlier mark, causing reputational damage, and give an unfair advantage to the applicant.
7. In response, the applicant filed a counterstatement, denying the grounds of opposition under Sections 5(2)(b) and 5(3) of the Act. It made lengthy contentions in relation to the differences between the competing marks and the goods and services under Section 5(2)(b). The applicant requested that the opposition be refused in its entirety and that costs be awarded in its favour.
8. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that I consider necessary. None of the parties filed submissions during the evidence rounds.
9. Only the opponent filed written submissions in lieu of a hearing. Thus, this decision has been taken following a careful consideration of the papers.
10. In these proceedings, the opponent is represented by D Young & Co LLP and the applicant by Paweł Wowra.

EVIDENCE

Opponent's Evidence

11. The opponent filed a witness statement dated 25 September 2023 of Nicola Karen Dear, Senior Counsel IP & Commercial at Cosmetic Warriors Limited, who has held this position since September 2016. Ms Dear's evidence is accompanied by 21 Exhibits (NKD1-NKD21).

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act states:

“A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

13. The principles considered in this opposition stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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

- 14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned [...], 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 complementary.”

- 15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

16. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

17. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

19. The competing goods and services to be compared are shown in the following table:

Opponent’s goods and services	Applicant’s goods
<p>Class 9: Podcasts; digital music (downloadable); pre-recorded disks; recording disks; compact discs; computer games programmes; telephone ring tones; music recordings; downloadable music files; musical video recordings; downloadable musical sound recordings; digital music downloadable from the internet; musical recordings in the form of discs; digital music downloadable provided from mp3 internet web sites; downloadable publications; publications in electronic format; downloadable biographies; talking books; downloadable image files; sunglasses; cases, straps and chains for sunglasses; camera cases; mobile phone covers and cases; laptop carrying cases; cases adapted for tablet computers; computer mouse pads; decorative magnets; fridge magnets; mobile applications; mobile apps; animated cartoons; pre-recorded videos; computer software; computer games programmes; computer hardware and firmware; computer servers;</p>	<p>Class 9: Microphones; computer hardware; scanners [data processing equipment]; video screens; Global Positioning System [GPS] apparatus; navigational instruments; intercommunication apparatus; electrical adapters; smartphones; baby monitors; tablet computers; smartwatches; rearview cameras for vehicles; electric sockets; cables, electric; headgear being protective helmets; loudspeakers; microscopes; distance recording apparatus; video baby monitors; horns for loudspeakers; computer peripheral devices; transformers [electricity]; optical lenses; eyeglasses; accumulators, electric; alarms; mileage recorders for vehicles; battery chargers; headphones; camcorders; cases for smartphones; detectors; microscopes; padlocks, electronic; megaphones; selfie sticks [hand-held monopods]; solar batteries; solar panels for the production of electricity;</p>

<p>network servers.</p> <p>Class 35: Retail services being in store, by mail order catalogues, telephone, or via the internet, connected with the sale of podcasts, digital music (downloadable), pre-recorded disks, recording disks, compact discs, computer games programmes, telephone ring tones, music recordings, downloadable music files, musical video recordings, downloadable musical sound recordings, digital music downloadable from the internet, musical recordings in the form of discs, digital music downloadable provided from mp3 internet web sites, downloadable publications, publications in electronic format, downloadable biographies, talking books, downloadable image files, sunglasses, cases, straps and chains for sunglasses, camera cases, mobile phone covers and cases, laptop carrying cases, cases adapted for tablet computers, computer mouse pads, decorative magnets, fridge magnets, mobile applications, mobile apps, animated cartoons, pre-recorded videos, computer software, computer games programmes, computer hardware and firmware, computer servers, network servers.</p>	<p>inverters [electricity]; monitors [computer hardware]; monitors [computer programs]; integrated circuit cards [smart cards]; black boxes [data recorders]; processors [central processing units].</p>
--	--

20. In its notice of opposition, the opponent claims identity and similarity between the respective goods, a point which is reiterated in the submissions in lieu. In addition, with its submissions, the opponent provided direct comparisons as to the identity or similarity between the competing goods and services, which I have taken into account.

21. The applicant, in its notice of defence, asserts that there are clear distinctions that differentiate the nature, intended purpose, method of use,

and competition of the competing goods, providing reasons for each of these points, which I will refer to where it is necessary.

22. For the avoidance of doubt, pursuant to Section 60A of the Act, goods and services are not to be regarded as similar or dissimilar simply because they fall in the same or different Class.
23. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²

Cases for smartphones; computer hardware

24. The contested terms are self-evidently identical to the opponent's "*mobile phone covers and cases*" and "*computer hardware*".

Computer peripheral devices; monitors [computer hardware]; processors [central processing units]; cables, electric; loudspeakers; microphones; video screens; scanners [data processing equipment]

25. The contested terms are either the physical components of a computer or detachable items that are used in conjunction with a computer. I consider that the earlier term "*computer hardware*" to be the physical parts of a computer system which would include the CPUs, screen(s), and peripherals, including hardware which enables the user to hear sound, whether that is inbuilt or in the form of additional hardware. Therefore, the earlier term is broad enough to cover such peripheral items, and, as such, the goods are *Merici* identical. However, even if I am wrong in that interpretation, the trade channels would be the same. There is a very high degree of complementarity in that computer hardware is indispensable to peripherals as they cannot function other than in conjunction with a

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

computer that consists of such hardware. The nature of the relationship is one where the average consumer may think the responsibility for those goods lies with the same undertaking. I consider these goods to be highly similar.

Monitors [computer programs]

26. I note that the contested term includes ‘computer programs’ in square brackets, this is merely for classification purposes to define more precisely the term ‘monitors’ indicating that the contested goods are a form of software. In this regard, the opponent “*computer software*” is a broad term that would encompass the contested term. Therefore, the competing goods are identical as per *Meric*.

Eyeglasses

27. The opponent’s “*sunglasses*” are included in the broader category of the contested goods and, thus, are *Meric* identical.

Optical lenses

28. The contested term is a broad term that may also include prescription or non-prescription lenses. The closest comparable term in the opponent’s specification is “*sunglasses*”. I accept that optical lenses may be a component in the opponent’s goods, but I recall that the General Court in *Les Éditions Albert René v OHIM*, Case T-336/03, found that:

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

In this regard, the earlier goods are finished products as opposed to the contested goods which are components of the earlier goods. Therefore,

their nature, purpose, and method of use are different. However, the goods may share the same users and trade channels. In addition, there might be a degree of complementarity where users may need, for example, corrective lenses when wearing sunglasses. However, they are not in competition. I find that the respective goods are similar to between a low and medium degree.

Smartphones; smartwatches; tablet computers

29. The contested goods are portable touchscreen devices that enable the users to connect to the Internet and run applications. In addition, smartphones and smartwatches often include features that monitor the user's physical activity, such as step count, walking stability, and heart rate. I also note that smartwatches are wearable devices designed to be worn on the wrist, which can extend the capabilities of the wearer's smartphone to the watch. The contested goods are similar to the opponent's "*computer hardware*", defined earlier in this decision. The respective goods may share the same users, nature, and purpose of enabling users to run applications and perform various functions. However, they may differ in the method of use. There appears to be a complementary relationship between the goods as the computer hardware is indispensable for the use of the contested goods. Therefore, the consumers may believe that the goods originate from the same undertaking. However, there is no degree of competition between the goods. I find them to be similar to a high degree.

Headphones

30. The contested goods are output devices typically used with other devices, such as computers or smartphones, to listen to audio. These are similar to the opponent's "*computer hardware*". As delineated above, the earlier goods, being physical parts of a computer system, enable, *inter alia*, the users to hear sound, whether that is inbuilt or in the form of additional hardware. On that basis, it is my view that there is a degree of

complementarity with the opponent's "*computer hardware*", where the average consumer would assume that the responsibility for these types of goods lies with the same undertaking. Although the competing goods may differ in nature and purpose, they may share the same users, and they would likely be sold through the same channels of trade. There is no apparent competition between the competing goods. I find them to be similar to a low degree.

Global Positioning System [GPS] apparatus; navigational instruments

31. The goods in question are navigation systems/instruments that provide location, velocity and time synchronisation, facilitating the determination of the location. Whilst the above goods are considered to be types of hardware, I still consider that the contested goods are similar to the opponent's "*Computer software; mobile applications; mobile apps*". This is because the opponent's software is essential for the use and functionality of the products in question, as they would not work without it, making them indispensable to each other. The consumer is, therefore, likely to believe that the same undertaking will provide both, and thus, they are complementary. There would also likely be an overlap in trade channels and users. Consequently, the goods are similar to between a low and medium degree.

Selfie sticks [hand-held monopods]

32. I consider that the closest comparable terms in the earlier specification are "*cases adapted for tablet computers; mobile phone covers and cases*". Although the competing goods are different in nature, purpose, and method of use, they will overlap in users and trade channels sold in the same sections of retail outlets, such as phone accessories, in close proximity to each other. There is no degree of competition or complementarity. I find that the respective goods are similar to a low degree.

Camcorders

33. The closest comparable term in the earlier specification is “*camera cases*”. Although the goods differ in nature and purpose, they will be sold in the same department stores possibly close to each other. The users will be the same, and it is possible that the same undertaking will produce both products. Although the goods can be used together, I do not consider that they are indispensable to each other. Therefore, there is no complementary relationship. I find that the goods are similar to a low degree.

Distance recording apparatus; mileage recorders for vehicles; rearview cameras for vehicles; detectors; baby monitors; video baby monitors; alarms; black boxes [data recorders]; headgear being protective helmets; integrated circuit cards [smart cards]; intercommunication apparatus; microscopes; padlocks, electronic; solar batteries; solar panels for the production of electricity; accumulators, electric; inverters [electricity]; transformers [electricity]; electrical adapters; megaphones; horns for loudspeakers; electric sockets; battery chargers

34. In the case of the contested goods, when considered against the terms relied upon by the opponent, I find the respective uses are distinct and any correlation in the respective users is likely to be on a fairly artificial level. The nature of the goods/services is not similar, and the trade channels are unlikely to be shared. I cannot identify a competitive nor complementary relationship with any of the goods or services relied upon. Whilst I acknowledge that software/apps, for example, may be used in some circumstances in conjunction with some of the above goods, or to manage the information captured by those goods, I do not find sufficient overlap in the relevant factors to reach a finding of similarity. The above goods are dissimilar to the goods and services relied upon by the opponent.

35. The likelihood of confusion does not arise in relation to the contested goods which are dissimilar to the earlier mark's goods and services.³ **The invalidation action cannot succeed against dissimilar goods and services and, therefore, is dismissed insofar as it concerns the following terms:**

Class 9: Distance recording apparatus; mileage recorders for vehicles; rearview cameras for vehicles; detectors; baby monitors; video baby monitors; alarms; black boxes [data recorders]; headgear being protective helmets; integrated circuit cards [smart cards]; intercommunication apparatus; microscopes; padlocks, electronic; solar batteries; solar panels for the production of electricity; accumulators, electric; inverters [electricity]; transformers [electricity]; electrical adapters; megaphones; horns for loudspeakers; electric sockets; battery chargers.

Average Consumer and the Purchasing Act

36. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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

³ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

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.”

37. The goods at issue cover a wide range of items purchased by members of the general public. Such goods are usually offered for sale in physical retail outlets, through brochures and catalogues, and online. In retail premises, the goods will be displayed on shelves and racks, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. The cost of such goods ranges, in my experience, from fairly low, such as cases for smartphones and selfie sticks, to medium, such as camcorders, and smartphones. Even for those at the inexpensive end of the scale, the average consumer may examine the products to ensure that the goods are suitable for their intended use, compatible, and possess the desired features and aesthetic appearance. In this regard, and whilst there may be slight variations depending on the exact goods, the average consumer is likely to pay a medium degree of attention heightened slightly for more expensive goods.


Comparison of Trade Marks

38. 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.”

39. 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.

40. The marks to be compared are:

Opponent's Mark	Applicant's Mark
<p>LUSH</p>	

Overall Impression

41. The contested mark is a composite mark consisting of figurative and word elements in grey and black colour. The figurative elements create the impression of a prominent geometrical device with rounded rectangular lines connecting intermittently at the top of the mark and a triangle-shaped device at the bottom. The word element “LUSHENG” appears in an upper case and standard typeface, positioned at the top of the triangle device. Overall, based on the structure of the mark, the word element “LUSHENG”

and the geometrical device are both equally dominant. I note that the word element “LUSHENG” will be more distinctive as the eye will also be drawn to the verbal element of the mark as the average consumer more easily refers to marks by the word than by describing a figurative element.⁴ Therefore, the word element has the greatest weight in the overall impression, whereas the device has some but slightly less weight in the overall impression.

42. The earlier mark is a word only mark presented in a standard typeface and upper case. Registration of a word mark protects the word itself.⁵ The overall impression of the mark lies in the word itself.

Visual comparison

43. The earlier mark is four letters long, while the verbal element of the contested mark is seven. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,⁶ the competing marks share the first four letters, i.e. “LUSH-”, but differ in the presence/absence of the letters “-ENG”. Another point of difference is the presence of the prominent geometrical device in the contested mark with no counterpart in the earlier mark. Weighing all the factors and taking into account the overall impressions, I find that they are visually similar to between a low and medium degree.

Aural comparison

44. The earlier mark is the monosyllabic word “LUSH”, whereas the only element of the contested mark that will be articulated is a two-syllable word, which will be pronounced as “LUSH-ENG”. Although the marks share the first syllable, “LUSH”, a phonetic difference is by the second syllable, “-ENG”, in the contested mark for which there is no phonetic

⁴ *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

⁵ See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

⁶ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

counterpart in the earlier mark. Therefore, I find that the degree of aural similarity is greater than the degree of visual similarity.

Conceptual comparison

45. The opponent submits that:

“Conceptually, the identical element in the respective marks, being the word “LUSH” has the same or a highly similar meaning. The term “LUSH” being an English word, has its etymological roots in the word “luscious” and would be understood as such by English speaking consumers in the UK. The suffix “ENG” in the Application will likely be perceived as an abbreviation for the term ‘England’. The Applicant concedes this point at paragraph 17 of its Counterstatement, where it states that ‘ENG’ is frequently used as an abbreviation for various terms, such as ‘English’. Thus, conceptually LUSH and LUSH ENG/ENGLAND are similar to a high degree, as ENG/ENGLAND will simply act as a geographical indication that the goods branded as LUSH emanate from England. In the alternative, if the Office does not follow this train of thought, given that the term LUSHENG in totality is not an English word; a conceptual comparison is not possible.”

46. The applicant claims that *“the two marks also have distinct meanings that contribute to their differentiation. The word ‘LUSH’ in English connotes something rich, luxurious, or abundant. On the other hand, ‘LUSHENG,’ presumably of non-English origin, doesn’t carry a predefined meaning for English-speaking consumers and thus, it can create a unique conceptual impression different from ‘LUSH’.”*

47. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

48. I consider that the earlier word mark “LUSH” will be understood as a slang term referring to something luxurious or appealing, conveying a laudatory connotation in relation to the quality of the registered goods and services.
49. I disagree with the opponent’s submissions as to the conceptual analysis of the contested mark. In the absence of evidence, I am not ready to accept that the average consumer will break down the word element “LUSHENG” into “LUSH-” and “-ENG”, with each bearing its own meaning. Importantly, I do not consider that the average consumer will immediately grasp that the ending of the mark is the abbreviated form of the word ‘England’. It is my view that the opponent’s claim goes one step further in the conceptualisation process, which requires intellectual analysis or time to reflect on the mark in order to extract a meaning from the suffix “-ENG”. In this regard, I consider that the consumers would not treat the contested mark as a combination of two words and would most likely perceive the entirety of the contested mark as an invented word with no particular meaning. I do not consider that the average will attempt to interpret the geometrical device or its individual elements. Taking all of the above into account, I find no conceptual similarity between the marks.

Distinctive Character of The Earlier Trade Mark

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

51. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

52. The opponent submits that:

“36. The mark LUSH holds a high degree of inherent distinctive character, including for the goods and services relied on in these proceedings. The conventional meaning of LUSH relating to ‘luscious’ does not allude to electronics, media or retail services.

37. The mark LUSH has also acquired an enhanced distinctive character through use in connection with the goods and services relied on. The Opponent’s Witness Statement includes details of the Opponent’s use of the LUSH Registrations in the UK. Further details regarding the reputation of the LUSH brand will be elaborated upon in the subsequent sections of these submissions. However, for the purposes of this section, the Opponent submits that the enhanced distinctive character of the LUSH mark must be taken into consideration when assessing whether confusion exists.”

53. I disagree that the earlier mark holds a high degree of inherent distinctiveness. As shown above in this decision, the earlier mark is the word “LUSH”, which is a well-known dictionary word. When considered against the goods/services relied upon, I find that it will be viewed as indicating that the goods/services offered are luxurious or of a high quality, having laudatory connotations. The earlier mark is, therefore, inherently distinctive to a low degree.⁷

Enhanced Distinctiveness

54. I note that in order to consider whether the earlier mark has acquired enhanced distinctive character through use, the opponent must show use for the relevant goods and services in Classes 9 and 35, respectively. That said, the opponent admits in its submissions that the distinctiveness of the earlier mark has been enhanced through use in connection with Class 3 goods. Therefore, even though the opponent has adduced evidence showing the sales and promotion of Class 3 goods, which I will address later in this decision, this is not conducive to a finding of enhanced distinctiveness for the purposes of this opposition in connection with the Section 5(2)(b) ground.

55. Nevertheless, I note that there is only minimal evidence as to the sales and promotion of the relevant Class 9 goods and Class 35 services. In more detail, Exhibit NKD3 includes the following screenshots obtained from the WayBack Machine Internet archive from the opponent’s website:

- an image of the speaker “BATH BOT” dated 13 March 2023;
- an image of the CD “SYNAESTHESIA” dated 21 June 2021; and
- an unclear image described as a vinyl with USB and titled as “HARD DAYS NIGHT” dated 15 June 2021.

⁷ *Formula One Licensing BV v OHIM*, Case C-196/11P.

Further, Exhibit NKD10 features screenshots from the opponent's website displaying a 2021 press release promoting the digital launch of the 'Karma' album at the 'Lush Music Pop Up Shop' in London. Additionally, the Exhibit includes screenshots from *eventbrite.co.uk* showing details for the aforementioned event.

56. Taking into account the evidence and the opponent's admission, I find the evidence insufficient to demonstrate that the mark has acquired an enhanced degree of distinctive character through use in the UK for the relevant goods/services. Although significant turnover figures are provided, totalling over £800million between 2017 and March 2023, they are not broken down or explained as relating to any particular goods and services in Classes 9 and 35, and there is no indication of the market share held by the mark for the relevant goods and services. Also, no evidence of promotional material indicates any extensive media coverage, intensive advertising, or promotional activities in the UK for the relevant goods and services. Therefore, I do not consider that the use shown establishes enhanced distinctiveness for the average consumer as a whole or even for a significant enough subset of average consumers. Overall, the evidence is insufficient to demonstrate enhanced distinctiveness.

Likelihood of Confusion

57. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁸ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to

⁸ See *Canon Kabushiki Kaisha*, paragraph 17.

make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁹

58. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the marks are different, but concludes, due to the similarities between them, that the later mark is another brand of the owner of the earlier mark or a related undertaking (or vice versa).
59. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., 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.”

60. 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:

⁹ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

“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.”

61. Earlier in this decision I have concluded that:

- the goods at issue range from being similar to a low degree to identical;
- the average consumer is a member of the general public, who will select the goods by predominantly visual means, but without dismissing the aural means, and will pay a medium degree of attention heightened slightly for more expensive goods;
- the contested mark and the earlier mark are visually similar to between a low and medium degree, aurally similar to a greater degree than the visual similarity, and there is no conceptual similarity between the marks;
- the earlier mark is inherently distinctive to a low degree, and the use is not sufficient to establish enhanced distinctiveness of the marks.

62. Although I have found earlier in this decision that the inherent distinctiveness of the earlier mark is of a low degree, this does not preclude a finding of a likelihood of confusion.¹⁰ However, taking into account the above factors and considering the principle of imperfect recollection, I am persuaded that there is no likelihood of direct confusion. I do not consider

¹⁰ See *L'Oréal SA v OHIM*, Case C-235/05 P.

that the average consumer would overlook the difference in the word elements “LUSH”/“LUSHENG” and the presence/absence of the prominent geometrical device between the marks. Notably, the absence of the conceptual ‘hook’ between the marks will enable the average consumer to distinguish between the marks. Therefore, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other and do not find there is a likelihood of direct confusion.

63. Turning now to indirect confusion, I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. I see no reasonable basis on which the consumer would be induced to believe that the competing marks are variants or sub-brands of each other nor that the goods and services in question are from the same or economically linked undertakings. Even if the average consumer recalls the points of similarity between the marks, such as that they share common beginnings “LUSH-”, I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,¹¹ James Mellor QC (as he then was) stated:

“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹² in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

In light of the above rationale, the average consumer will recall that the word element in the contested mark is the invented term “LUSHENG” as opposed to “LUSH”, which is a known English word and which I do not find to be so strikingly distinctive that the average consumer would think that

¹¹ Case BL O/547/17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017).

¹² In *L.A. Sugar*.

only the opponent would use it in a mark. Further, the device element in the contested mark is not, in my view, a non-distinctive addition of a kind that one would expect to find in a sub-brand or brand extension. Furthermore, if the opponent's mark is brought to mind, this will be a mere association, not confusion.¹³ I see no other reason why a common origin or an economic connection would be assumed, and so I find that, even where the goods are identical, there is no likelihood of indirect confusion. This finding applies to the goods I have found to be similar to any degree, including those of low similarity.

Section 5(3) of the Act

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

“(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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

65. 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:

¹³ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.

(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*).

66. The conditions of Section 5(3) are cumulative. First, the opponent must show that the marks are similar. Second, the opponent must show that the mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Third, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of Section 5(3) that the goods and services be similar, although the relative distance

between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

67. The opponent relies on the same mark here as it did under its Section 5(2)(b) ground, although it relies on goods in Class 3 for Section 5(3) ground as follows:

Class 3: Cosmetics; cleaning preparations; non-medicated toilet preparations; soaps; moisturising and revitalising bath soaps; toilet soaps; fragrance soaps; liquid soaps; cosmetic preparations; cosmetic preparations for baths; lotions, milks, gels, powders, oils, mousses, wax and creams, all for use on the skin; perfumery; perfumes; perfumed paper; perfuming preparations for the atmosphere; toilet waters; colognes and fragrances; perfume oils; essential oils; perfumed paper for use as drawer linings; perfumed tissues; room fragrances; incense; pot pourri; perfumed sachets; suncare preparations (cosmetic products); dentifrices; mouth washes; depilatory preparations; shaving preparations; deodorants and anti perspirants; toilet articles; cleansing and toning preparations; face masks; shower and bath preparations; make-up; makeup articles; eye makeup, eyebrow pencils; eyeliner, eye crayons and eye shadows; mascaras; eyeshadows; false eyelashes, false fingernails and adhesives therefor; lipsticks, glosses and moisturisers; nail polishes and varnishes; face powders, foundations, blushers and rouge; preparations for care of the hair; shampoos; hair rinses (shampoo-conditioners); hair conditioners; gels, sprays, mousses, balms and fixatives for hair styling and hair care; hair lacquers; hair colourants; dandruff creams (not for medical treatment), shampoos for dandruff treatment (not for medical treatment), dandruff lotions (not for medical treatment), hair balsams for dandruff treatment; cleaning preparations for cosmetics; abrasive preparations for use on the face, body and/or fingernails; body scrubs; body washes; bubble bath; bath foams; bath melts; bath oils; bath bombs; bath pearls; bath salts and crystals; non-medicated bath salts containing effervescent materials; shower gels;

bath gels; massage cream; massage lotions; massage oils; skin creams; skin cleaners; skin toners; complexion treatments; skin moisturisers; cosmetic preparations for skin care; nail care treatments and creams; powders; eye creams; pumice stones for cosmetic purposes; aromatherapy preparations; cleansing pads, wipes, cotton wool pads and buds; toiletry impregnated tissues and towels; decorative transfers and skin jewels for cosmetic purposes.

68. I note that the applicant denied the opponent's claim regarding Section 5(3) without providing any particular counterclaims or submissions.
69. As delineated earlier in this decision, the first condition of similarity between the marks is satisfied as I have already found under Section 5(2)(b) the marks to be visually and aurally similar,¹⁴ although there is no conceptual similarity. I will proceed to consider the next condition - that of reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. The relevant date for the assessment under Section 5(3) is the filing date of the contested application, namely 10 January 2023.

Reputation

70. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

¹⁴ See paragraphs 43-44 above.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

The opponent’s evidence

71. The opponent claimed a reputation for the goods in Class 3. Ms Dear provides evidence that the earlier mark is used by the opponent’s licensees, including the ‘LUSH Group’, and that the LUSH Brand was established in Poole in 1995, with the earlier mark being in continuous use since then. It is also submitted that the earlier mark has been used “*in relation to a wide range of goods and services and has a strong reputation in respect of the following Class 3 goods: perfumes, fragrances, bath products, face and skin masks, lotions, gels, sprays, powders, creams, toners, shampoos, conditioners, other hair care products, soaps, makeup, lip products and essential oils.*”
72. Ms Dear exhibits news articles (Exhibit NKD13) dated between 2017 and 2023 that include information in relation to the market growth of the LUSH brand in the UK and on a global scale. It is noteworthy that the news pieces highlight the LUSH brand’s achievement in fostering customer loyalty, attaining the second position in the ‘Top 50 Rising Stars’ in 2018, and its substantial growth both domestically and internationally. Further, Exhibit NKD11 demonstrates that the opponent’s UK sales figures between 2017 and March 2023 (inclusive) are extensive:

Category	Total
Bath Bombs	Over £176 million
Bath Melts& Oils	Over £7.9 million
Bubble Bars	Over £60 million
Digital Features (Between 2020 – March 2023)	Over £1.5 million
Experiences	Over £10 million
Face	Over £88 million
Flowers & Plants (Between 2019 – March 2023)	Over £200k
Fragrance	Over £47 million
Fun	Over £4 million
Gifts	Over £158 million
Hair	Over £91 million
Hand & Body	Over £51 million
Make Up	Over £4 million
Massage	Over £6 million
Media	Over £100k
Merchandise	Over £1.6 million
Mouth	Over £20 million
Shipping (Between 2021 – March 2023)	Over £1.6 million
Shower	Over £84 million
Soap	Over £23 million
Sundries	Over £5 million
Vouchers	Over £15 million

73. The turnover figures for each of the above products are quite significant, excluding shipping costs, which I have not taken into account. In addition, I note that there is no evidence or submissions explaining what is precisely covered by the terms ‘digital features’, ‘experiences’, ‘media’, ‘merchandise’, ‘sundries’, and ‘fun’ when seen against the Class 3 goods as relied upon. The law is clear that any reputation must be in goods (and/or services) covered by the trade mark registration.¹⁵ Therefore, I am unable to determine whether the above terms will be covered by the specification relied upon. Nevertheless, I am satisfied that the terms that are self-evidently cosmetics fall within the scope of Class 3 goods of the earlier mark. Lastly, it is noted that the terms “Flowers & Plants” and “Vouchers” are not cosmetics, while it can be reasonably assumed that the

¹⁵ *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16.

term “Gifts” refers to gift boxes containing a variety or combination of products.

74. Ms Dear provides redacted sample invoices with Exhibit NKD12 showcasing the sales of a diverse range of products, including bath bombs, soaps, shower gels, body lotions, hair moisturizers, gift cards, face and body masks, and more. The sample invoices also indicate the geographical spread of sales across the UK, including areas such as London, Surrey, Durham, Dorset, Leeds, Surbiton, Birmingham, Edinburgh, York, and Sittingbourne. Exhibit NKD9 also demonstrates the presence of retail stores in the UK, which further supports the argument that the opponent has been selling a range of cosmetic products nationwide by operating both physical and online stores (see also Exhibits NKD11 and NKD4-7).

75. Ms Dear highlights that although the LUSH Group abstains from traditional advertising methods such as TV commercials, print media, and celebrity endorsements, it actively promotes its products through online channels and its own retail stores. In support of this, Ms Dear presents Exhibit NKD14, which includes tables displaying the total UK promotional expenses from 2016 to February 2023, amounting to over £6,4million. These expenses cover in-store and online promotional activities, including display, window, Lush Times, and public relations. In addition to these figures, I note that the Google Ads UK figures for 2022 amounted to over £900k and for 2023 (up to March) amounted to over £140k.

76. Further, Ms Dear explains that “the LUSH Brand relies on organic user-generated content, which includes social media fan accounts, bloggers, and vloggers” but also runs campaigns for various causes, such as environmental causes. Exhibit NKD15 provides news articles showing examples of such campaigns with the following titles:

- ‘*Sending out an SOS for Sumatra’s forests and wildlife*’ (2017) from orangutans-sos.org;

- ‘Lush unveils holiday campaign with ‘RuPaul’s Drag Race’ stars’ (12 November 2018) from *us.fashionnetwork.com*;
- ‘Time to PICK UP THE BILL’ (2021) from *experienceguildford.co.uk*; and ‘Lush and Galop call on MPs to ban ‘conversion therapy’ – with no exemptions’ (2022) from the opponent’s website.

I note that the first two news articles are from non-UK websites, and it is unclear whether they would have been seen by the UK public. In addition to the above, Ms Dear also mentions that the opponent distributes newsletters via email¹⁶ and publishes the LUSH TIMES magazine¹⁷, through which LUSH products and charity campaigns are promoted.



It is said that 175,000 copies of the Summer 2020 edition and 668,000 copies of the Winter 2020 edition were distributed in the UK. I note that promotional activities also include collaborations with other brands, such

¹⁶ Example copies are exhibited with Exhibit NKD17

¹⁷ Example copies are exhibited with Exhibit NKD16.

as a clothing brand and a Netflix Series,¹⁸ social media, and third-party press and media coverage.

77. Although Ms Dear clarifies that the opponent stepped away from some social media channels in 2021, Exhibit NKD19 provides a selection of screenshots showing the opponent's accounts on various social media platforms, including Twitter, Facebook, and Instagram, promoting its products and retail stores. Exhibit NKD20 shows that the goods under the earlier mark have been promoted in several popular press outlets between 2010 and 2022, including the Daily Mail, the Sun, Glamour, Sunday Express, and Grazia. I note that Exhibit contains online articles and images of what appears to be scanned pages of printed articles¹⁹. Lastly, Ms Dear provides a list of the awards that the LUSH products and its social justice initiatives/campaigns won between 2004 and 2022, to name a few from year 2022: "*Sustainable Product for Naked Mascara at the Sustainable Beauty Awards 2022 - Runner up for Sustainability Pioneer*"; "*Lush won Best Vegan Skincare in the VegNews Veggie Awards*"; "*Cosmopolitan Summer Beauty Awards: Winner of Best Curl Defining Cream with Curl Power*".
78. In light of the above evidence, I am satisfied that the earlier mark had a strong reputation in the UK for cosmetics, soaps, bath oils, fragrances, toilet waters, shampoos, face masks, shower and bath preparations and preparations for care of the hair at the relevant date.

Link

79. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

¹⁸ See Exhibit NKD18.

¹⁹ See for example pages 7-16 of NKD20.

The degree of similarity between the conflicting marks

80. As detailed above in this decision, the marks are visually similar to between a low and medium degree, aurally similar to a greater degree than the visual similarity, and there is no conceptual similarity between the marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

81. As shown above, the opponent has clearly shown it holds a reputation in the UK in relation to Class 3 goods. However, I consider that the goods for which the opponent has shown a reputation are dissimilar to the contested Class 9 goods. Taking into account the relevant factors set out in *Treat* and *Canon*, namely the nature, purpose, trade channels and method of use, there will be no obvious overlap between the competing goods, and there is no evidence to suggest otherwise. Moreover, there is no complementary relationship nor an element of competition. While there may be some overlap in users, as the competing goods could all be used by members of the general public, this is not a sufficient factor to find similarity.

The strength of the earlier mark's reputation

82. I found that the earlier mark had a strong reputation at the relevant date for cosmetics, soaps, bath oils, fragrances, toilet waters, shampoos, face masks, shower and bath preparations and preparations for care of the hair at the relevant date.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

83. I have found earlier in this decision that the earlier mark is inherently distinctive to a low degree. Given the evidence and the extensive use of the mark in relation to Class 3 goods, I do consider that the distinctiveness of the mark has been enhanced through use for at least a significant

enough subset of average consumers. Therefore, I find that the earlier mark is distinctive to a medium degree overall.

Whether there is a likelihood of confusion

84. The opponent submitted that:

“54. [...] Further, the Opponent regularly collaborates with third party brands, resulting in the Opponent selling products outside of its core range (see Exhibit NKD18). As such, consumers are used to seeing the Opponent’s Registration used in combination with a third party brand or collaborator. This raises the likelihood of the Opponent’s earlier mark LUSH being called to mind when presented with the Application as used on the Contested Goods.

55. In the event that the Office finds the Contested Goods to be distinguishable from the Opponent’s Class 3 goods, or similar to a lesser degree, a link between use of the Application and the Opponent’s Registration is still probable. Taking into account the Opponent’s reputation, the Opponent could offer for sale or collaborate with a third party to offer the Contested Goods for sale. After all, third party collaborations outside of the Opponent’s core product range already exist. Thus, a consumer, upon seeing the Contested Goods branded as LUSHENG will link this use to the Opponent and the Opponent’s LUSH brand or be enticed to purchase the Applicant’s Contested Goods believing them to be connected in some way with the reliable and trusted goods of the Opponent.”

85. Generally, a finding that the respective goods are not similar would mean that there could be no likelihood of confusion. That would certainly be the case under Section 5(2)(b) of the Act. However, some marks are so highly distinctive and well-known that there is likely to be some confusion almost irrespective of the goods or services in relation to which they are used. In an earlier decision, Mr Allan James in *Lazard & Co., Holdings Ltd v Lazard*

*Consulting Ltd*²⁰ gave the example of the use of MICROSOFT for table lights. In those circumstances, he said, the public would probably expect the user to have some economic connection to the software company, such as a licence or the kind of collaboration that the opponent submits that it regularly undertakes.

86. It is important to recall that Section 5(3) of the Act requires me to take account of all the relevant factors, including the distinctiveness and repute of the earlier mark, and to decide whether in this particular case the public may be caused to believe that the use of LUSH for goods in Class 3 is connected to LUSHENG in relation to Class 9 goods. After considering these factors and the opponent's submissions, I have no evidence before me to suggest that the significant proportion of the public would be confused by the use of the contested mark, even in the context of collaboration between the undertakings, for goods that are so far from the opponent's goods. Therefore, I find that there is no likelihood of confusion.

Conclusion on link

87. My finding of no likelihood of confusion does not in itself mean that there will be no link in the mind of the public. However, given the differences between the marks, combined with the distinct goods of the respective parties, I do not consider it likely that a link will be made in the minds of the relevant public, notwithstanding the strength of the opponent's reputation. Even if a link was made, it would be too fleeting to give rise to damage. Therefore, the opposition based upon Section 5(3) of the Act is dismissed.

CONCLUSION

88. **The opposition under Sections 5(2)(b) and 5(3) has failed.** Therefore, subject to appeal, the application may proceed to registration.

²⁰ See BL O/359/15, paragraph 55.

COSTS

89. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs to the applicant as a contribution towards the cost of the proceedings on the following basis:

Preparing a counterstatement and considering the Notice of opposition	£300
Total	£300

90. I, therefore, order Cosmetic Warriors Limited to pay to Shenzhen Minyou Digital Technology Co., Ltd the sum of £300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 7th day of October 2024

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General