

O/1072/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003978026

BY LUMI GLO LIMITED

TO REGISTER:

Lumi Glo Skin

AS A TRADE MARK IN CLASSES 3 & 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP600003168 BY

KAREN WOOD

BACKGROUND AND PLEADINGS

1. On 10 November 2023, LUMI GLO LIMITED (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published for opposition purposes on 15 December 2023 and registration is sought for the goods and services set out in the **Annex 1** of this decision.
2. On 12 January 2024, the applicant’s mark was opposed under the fast track procedure by Karen Wood (“the opponent”). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following trade mark:

Lumi Glow

UK registration no. 3815929

Filing date 2 August 2022; registration date 21 October 2022

Relying on all goods, namely those set out in **Annex 2** of this decision.

(“the opponent’s mark”)

3. The opponent argues that the goods and services applied for are identical or highly similar to her own goods and that the marks at issue are more than sufficiently similar. As a result, the opponent claims that there exists a likelihood of confusion between the parties’ marks.
4. The applicant filed a counterstatement denying the claims made against it. It is noted that the counterstatement made a denial in relation to section 5(3) of the Act. However, as set out above, the opponent relies solely on the section 5(2)(b) ground.
5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. On this point, it is noted that in its counterstatement, the applicant sought to file evidence of its own use of its mark in another country. However, this evidence was not admitted into proceedings and the reasons for this were set out in the Tribunal’s correspondence dated 4 April 2024, which stated as follows:

“Please note the applicant’s evidence has not been admitted into the proceedings. In choosing to file a fast track opposition the opponent has elected to use a procedure which does not include the routine filing of evidence (other than evidence of use of the earlier registered or protected mark(s) where that earlier mark was registered/protected 5 years or more before the date of publication of the opposed mark). Therefore, applicants should not expect to have the automatic right to file evidence in a fast track opposition.”

7. This correspondence went on to confirm that should either party wish to seek leave to file evidence, it was to do so within 14 days of that letter. No leave was sought by either party. Therefore, the evidence filed by the applicant is not before me in these proceedings and it will have no impact upon my decision.
8. I note that while these proceedings have been ongoing, separate fast track opposition proceedings have run alongside them, being those under number 600003167. That opposition was brought by the opponent in the present proceedings against a separate mark of the applicant. The Tribunal did not consider it appropriate or necessary to consolidate these proceedings. While I have been assigned both of these proceedings, I do not consider it necessary or appropriate to issue a joint decision because the proceedings have not been consolidated. I will, instead, issue two separate decisions, both of which to be issued on the same date.

9. The opponent is represented by Cloch Solicitors and the applicant is represented by GCS Europe Ltd.¹ Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary and I note that only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
10. 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.

PRELIMINARY ISSUE

11. As discussed above, the applicant sought to file evidence in filing its counterstatement. Even though the evidence was not admitted, the comments in respect of the point the applicant sought to raise remain in the counterstatement. I will deal with them briefly.
12. The applicant argues that it began using its mark in a different country well before the application date of the opponent's mark. As such, the applicant claims that it has invested time, efforts and funds for the promotion, advertising and popularizing of its brand amongst the relevant consumers in different countries all over the world. As a result, the applicant claims that there is no risk of confusion on the part of the consumers. Even if it was proven that the applicant had used its mark in another country and that consumers in that country were aware of the mark, this is of no assistance to the present proceedings. I say this because the assessment I

¹ I note that there are submissions from the opponent as to the identity of the applicant's representative, namely that this company does not exist as a registered entity. For the avoidance of doubt, these submissions have no bearing on the decision I must make here and I will say no more about them.

must make is based on consumers in the UK and if the applicant had validly raised a defense of honest concurrent use to the point that it was a factor that pointed away from confusion, the indication seems to be that the 'concurrent use' took place in a jurisdiction outside of the UK. Again, it is the UK consumers that are at issue here so such an argument would have been of no assistance to the applicant.

13. In addition to the above, I note that the counterstatement contained a claim that there was no confusion since the applicant's mark, in practice, matches the company name 'LUMI GLO'. The applicant claims that this is a distinctive corporate and brand identity of the applicant. As such, it argues that the goods and services offered by the applicant will be recognised by the consumers as coming from the applicant. While this argument is noted, it is of no assistance. The fact that a trade mark may share the same name as the corporate entity that owns it (which is different from the name of the entity that owns the opposing mark) is of no impact in proceedings before the Tribunal under section 5(2)(b) grounds. In short, there is nothing before me to indicate that consumers would see the parties' marks and be aware of the undertakings that own them. Instead, the assessments I must make throughout this decision are based on the trade marks as they appear before me and how they will reach the market, not the corporate structures behind them.

DECISION

Section 5(2)(b): legislation and case law

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

“(2) A trade mark shall not be registered if because-

(a) ...

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

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

15. Section 5A of the Act states as follows:

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

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

17. The opponent’s mark qualifies as an earlier trade mark under the above provisions. As the opponent’s mark had not completed its registration process more than five years before the filing date of the applicant’s mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the goods highlighted in his notice of opposition.

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. The parties' goods and services are set out in the annexes of this decision.

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

23. In its counterstatement, the applicant seeks to focus its defence on three points. The first being the fact that the marks at issue are not similar, the second relating to a claim that it has its own corporate identity that will be recognised by consumers and the third relating to its own use of its marks in other countries. I have dismissed the second and third arguments above and will address the comparison of the marks at issue below. In respect of the goods and services at issue, the applicant has made no mention of their similarity (or lack thereof) throughout these proceedings. It can, therefore, be taken that the applicant accepts the opponent’s claim as to identity/high similarity between the goods and services at issue.

24. In light of the above, I consider that I am entitled to proceed with this decision on the basis that the goods and services are identical or highly similar. However, if I

am wrong to take this approach, I will proceed to consider the goods and services in the ordinary way and I do so on the basis that I can deal with them relatively briefly.

Class 3

25. While the applicant's class 3 list of goods contains a significant number of terms, I do not consider it necessary to discuss each one for the purpose of this comparison.² I say this because, having considered the specification, it solely covers various types of cosmetic products for use on the skin and hair. The opponent's specification is also made up of a broad range of cosmetic products. While some of these are inevitably self-evidently identical with the applicant's goods, the approach I take here is to rely on the principle outlined in the case of *Meric* and find that the applicant's goods all fall within the broad term of "cosmetics", which sits in the opponent's specification.

26. On the basis that the above approach is too broad, then I rely on the fact that the opponent's specification also includes a range of more specific skincare/haircare terms such as "skincare cosmetics", "cosmetic soaps", "cosmetic moisturisers", "skin cleansers [cosmetic]", "hair cosmetics", "hair shampoos", "hair conditioners", "eyebrow cosmetics" and "cosmetic sunscreen preparations", to name just a few. Therefore, if the applicant's terms are to be categorised as specific types of cosmetics, then they all fall within the aforementioned terms of the opponent and are considered identical under the principle outlined in *Meric*.

Class 35

27. In considering the applicant's class 35 services, I note that they are retail services covering a broad range of goods. While presented as one term, I consider that the services can be broken down into four different categories of retail services and I will deal with them separately below.

² On this point I refer to the case of *Separode Trade Mark* BL O-399-10 wherein Mr Geoffrey Hobbs Q.C. set out that it was permissible to group goods and services together for the purpose of goods and services comparisons.

Retail and online retail services relating to beauty care cosmetics, beauty serums, lotions, creams, soap, milks, gels, cosmetic products in the form of aerosols for skincare, beauty creams for body care, beauty balm creams, distilled oils for beauty care, beauty masks, beauty serums with anti-ageing properties, beauty tonics for application to the body, beauty care preparations, beauty tonics for application to the face, cosmetic products for the shower, facial beauty masks, natural cosmetics, skincare cosmetics, body cleaning and beauty care preparations, beauty preparations for the hair, hair shampoo, dye, relaxers, pomades, texturizers, conditioners, mousse, mascara, lighteners, bleaches, colourants, serums, lotions, rinses, creams, styling gels, powder, emollients, oils, and cosmetics, baby hair conditioner, hair balm, hair liquid, glaze, and rinses [for cosmetic use], cosmetic preparations for the hair and scalp, beard balm, oil, dyes, lotions, and care preparations, lipstick, eyelines, mascara, eyeshadow, lip cosmetics, blusher, blush pencils, make-up palettes containing cosmetics, nail makeup, makeup, nail paint [cosmetics], make-up foundation, anti-ageing moisturiser, cream, and serum, moisturising creams.

28. While the opponent's specification does not include any retail services, this does not mean that goods and the retail of those goods (or similar goods) are not capable of being similar to one another. On this point, I refer to the case of *Oakley, Inc v OHIM*, Case T-116/06 wherein, at paragraphs 46 to 57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. I also refer to the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, wherein Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services vs. goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of

determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

29. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

30. In light of the case law and principles outlined above and on the basis that the services listed above cover the retail of cosmetic goods, I am of the view that the

applicant's retail services overlap in user and trade channels with the opponent's term of "cosmetics". Clearly, a user looking to buy cosmetics will seek the retail of the same and, further, it is common in the trade for the producer of cosmetic goods to also offer a range of such goods via its own retail services, be that online or via their own branded stores. The goods and services are plainly important to one another in the eyes of the consumers and they are likely to believe that the responsibility for the goods and the retail of the same lies with the same undertaking. The goods and services are, therefore, complementary in the way described by the case law.³ While the goods and services differ in nature, method of use and purpose, the above overlaps are sufficient to give rise to a finding that they are similar to a medium degree.

Retail and online retail services relating to cosmetic and cosmetic brushes, sponges, and spatulas, shaving brushes, shampoo brushes, hair brushes, bath brushes.

31. The goods covered by the above retail services are all types of cosmetic implements used in the application of various cosmetic products. While they do not directly describe the same goods as those in the opponent's specification, I remind myself that, as per the case law cited above, it is not necessary for retail services cover identical goods to those relied upon. In my view, the close association and importance of the goods covered by the above retail services to the goods in the opponent's specification is such that I consider there to be an overlap in user, trade channels and a complementary relationship between them. As a result, I consider that the above services are similar to a medium degree with the opponent's "cosmetics".

Retail and online retail services relating to perfumery products, perfumery and fragrances, oils for perfumes and scents.

32. The above services cover the retail of perfumes. It is my understanding that perfumes are classified as a type of beauty preparation to enhance the user's scent or to eliminate body odours. In light of this, I consider that perfumes fall within the

³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

term “cosmetic preparations” which is present in the opponent’s specification. Following the same logic discussed at paragraph 30 above, I find that there exists an overlap in user and trade channels between these goods and services and, further, they share a complementary relationship. These goods and services are, therefore, similar to a medium degree.

33. In the event that I am wrong to find that perfume is a type of cosmetic preparation, I still consider that the overlaps in user and trade channels apply. So while the goods and services may not be complementary to each other, the aforementioned overlaps are, in my view, sufficient to give rise to a finding that they are similar to a low degree.

Retail and online retail services relating to sanitary preparations and articles, wipes impregnated with disinfectants for hygiene purposes, disinfectants for hygienic purposes, absorbent sanitary articles.

34. In my view, the goods covered by the above retail services can include those such as cleansing wipes for the skin. Such wipes are to be used for disinfecting the skin and for the sanitation of the same. On this point, I note that the opponent’s specification includes the term “cosmetic facial packs”. This term can cover a pack that includes wipes or other sanitary articles that are impregnated with disinfectants in order to cleanse the user’s skin. Additionally, the opponent’s term can cover absorbent sanitary articles that absorb germs/bacteria from the user’s skin. I say this because facial packs can include articles for the removal of germs from the skin that can be used in order to reduce blemishes or spots and, therefore, aid in the beautification of the user’s skin. Given that the above services of the applicant cover goods within the opponent’s specification, I again find that these goods and services not only overlap in user and trade channels but share a complementary relationship with one another for the same reasons as discussed throughout my comparison of the class 35 services. As a result, I find that these goods and services are similar to a medium degree.

35. As an alternative, I wish to consider the applicant’s services on the basis that the goods covered by the applicant’s term are not cosmetic products but are, instead,

goods such as antibacterial surface wipes or sanitary towels. In such a scenario, my finding above would not apply due to the lack of complementarity between these goods and services (retail of non-cosmetic products are not important to the cosmetic goods). That being said, I do not consider that this results in a finding of no similarity. I say this because the goods and services will be sought by the same consumer meaning that there is an overlap in user. Further, the goods of the opponent and the applicant's services are likely to be provided by the same undertakings. In respect of the latter point, I consider that retailers commonly produce their own cosmetic goods but also sell a range of other goods such as sanitary towels and antibacterial wipes (be that their own brands or not). I appreciate that this only really applies to large undertakings such as supermarkets so I do not find that the trade channels directly overlap. However in the present case, I consider that the goods of the opponent and the goods covered by the applicant's retail services are likely to be found in close proximity to one another in said stores. As a result, I only consider that there is a slight degree of overlap in trade channels. Taking all of this into account,⁴ I consider that if my above finding of medium similarity is wrong then the goods and services are similar to a very low degree.

The average consumer and the nature of the purchasing act

36. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

⁴ On this point, I also remind myself of the lack of denial in respect of the similarity between the goods and services at issue.

by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

37. The goods at issue are ordinary consumers goods that will be selected by the general public at large. They will all be available via general or specialist retailers (such as beauticians, hair dressers and perfume or make-up shops) and their online equivalents (where available). In physical stores, the goods will be displayed on shelves where they will be self-selected by the consumer. When the selection takes place online, the goods will be selected after viewing an image of it on a webpage. Clearly, the visual component will dominate such selection processes, though I do not discount the aural component entirely as suggestions may come via word of mouth recommendations or advice from sales assistants, especially in beauticians or hair dressers where the goods may be selected after a discussion with the beautician or hair dresser. Regardless of the importance of the aural component, the consumer will still view the goods. As for the retail services, these are likely to be selected having considered, for example, promotional material (in hard copy or online) or signage appearing on the high street. Regardless of what goods and services are being selected, I consider that the selection process will be primarily visual but I do not discount an aural component playing a role by way of word of mouth recommendations or advice from sales assistants.

38. Both the goods and the services are likely to be selected on a fairly frequent basis and at a relatively low cost. In respect of the level of attention paid, I am of the view that when selecting the goods, the consumer is likely to consider factors such as the ingredients used, the desired effects on the skin/hair (for skincare and haircare goods), scent (mainly for perfume goods but may equally apply to skincare goods) and whether the goods have been tested on animals. As for the services, these will be selected after the consumer gives consideration to factors such as stock, delivery methods and price of goods. Regardless of whether the consumer is selecting goods or services, I am of the view that the factors set out above will result in the consumer paying a medium degree of attention.

Comparison of the marks

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

40. 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.”

41. 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.

42. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
Lumi Glow	Lumi Glo Skin

43. I have comments in its counterstatement from the applicant as to the similarity of the marks at issue. As for the opponent, I note that she has filed written submissions wherein she sets out why she considers the marks to be similar. I do

not intend to discuss these submissions here but can confirm that I have given them due consideration in making the following comparison.

Overall impression

44. The applicant's mark is a word only mark that consists of three words, being 'Lumi Glo Skin'. While not all of the goods and services for which the applicant seeks to protect its mark for are those applied to the skin, I consider that the consumer will still make this connection (i.e., they are goods for the skin) and, therefore, place less weight on the word 'Skin'. Therefore, I find that 'Lumi Glo' play the strongest role in the overall impression of the mark with 'Skin' playing a lesser role.

45. As for the opponent's mark, this is a word only mark consisting solely of the words 'LUMI GLOW'. I do not consider that either word dominates the other meaning that the overall impression of the mark lies in the words themselves.

Visual comparison

46. In its counterstatement, the applicant argues that the difference in the number of words in each mark determines the difference in the overall impression of the marks. While the different words present in the marks will contribute to the visual comparison of the mark, the fact that one mark is two words long and the other is three words long is not, by itself, enough to result in a finding that consumers will perceive the marks as being dissimilar.

47. The marks share the common use of the word/letters 'Lumi Glo'. They differ in the presence of the letter 'W' at the end of this shared element in the opponent's mark and in the presence of the word 'Skin' at the end of the applicant's mark. While I have found the word 'Skin' to play a lesser role in the applicant's mark, it is still a point of visual difference. Taking all of this into account and bearing in mind the overall impression of the marks, I consider that the marks are visually similar to between a medium and high degree.

Aural comparison

48. The opponent's mark will be pronounced as 'LOO-ME-GLOW'. As for the applicant's mark, I appreciate that I have found that 'Skin' to play a lesser role in its overall impression, however, I still consider that it will be pronounced.⁵ Further, despite the lack of the letter 'W' in the applicant's mark, I consider that 'GLO' will be pronounced the same as 'glow'. As such, the applicant's mark will be pronounced as 'LOO-ME-GLOW-SKIN'. The first three syllables of both marks are identical with the only difference coming in the last syllable of the applicant's mark. Taking all of this into account, I find that the marks are aurally similar to a high degree.

Conceptual comparison

49. The opponent's mark consists solely of the words 'Lumi Glow'. While I appreciate that, as per the case of *EMILIANA*,⁶ conceptual comparisons are usually done without reference to the goods or services at issue, I am of the view that, in the present case, the consumer will look to the goods and services at issue to inform the meaning of the mark. As such, I find that 'Lumi' will be viewed as being short for 'luminous', which will be understood as '*radiating or reflecting light; shining; glowing*'.⁷ As for 'Glow', I am of the view that in the context of cosmetic goods, this will be understood as a '*brightness of complexion*'.⁸ When these words are taken together, I consider that the opponent's mark will be understood as a reference to goods that aim to give the consumer a 'luminous glow' to their skin or hair.

50. As for the applicant's mark, I am of the view that when considering it from a conceptual standpoint, 'GLO' will be perceived as an obvious misspelling of the word 'glow'. As such, I find that the conceptual impact of the words 'Lumi Glo' will be the same as that associated with the opponent's. That being said, the word

⁵ On this point, I apply a similar logic to that of Mr Phillip Harris, sitting as the Appointed Person, in the case of *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein he stated that descriptiveness of an element does not render it aurally invisible.

⁶ Case BL O/052/22

⁷ <https://www.collinsdictionary.com/dictionary/english/luminous>

⁸ <https://www.collinsdictionary.com/dictionary/english/glow>

'Skin' will contribute to the point that the consumer will understand that the luminous glow applies to the skin.

51. In comparing the marks, I remind myself that the meaning associated with the opponent's mark assessed above will be understood as applying to the skin also. As such, the addition of the word 'Skin' will not be viewed as a significant point of conceptual difference between the marks. In my view, the only difference it creates is more specificity when it comes to the part of the body the 'luminous glow' will apply to. Overall, I consider that it only takes away from the conceptual identity of the marks to a very slight degree and I hereby find that the marks are conceptually similar to a very high degree.

Distinctive character of the opponent's mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

53. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness and, being fast track proceedings, no evidence has been filed to that effect. Therefore, I have only the inherent position to consider.

54. As set out above, ‘Lumi Glow’ will be understood as a reference to the fact that the opponent’s goods can be used by the user in order to give them a *luminous glow*. I consider this to be a strongly allusive and laudatory statement. As a result, I am of the view that the inherent distinctiveness of the opponent’s mark sits on the lower end of the scale. That being said, the mark is not directly descriptive and, in my view, the shortening of ‘Luminous’ to ‘Lumi’ does impart upon the mark some distinctive character. As a result, I am of the view that the opponent’s mark is inherently distinctive to between a low and medium degree.

Likelihood of confusion

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so,

I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

56. In respect of the goods and services at issue, I note that the applicant has not denied the identity or high similarity between its goods and services and the goods of the opponent. Having said that, I have conducted a comparison and found that the goods and services at issue are either identical or similar to a medium degree (though I have made a backup finding that some services may only be similar to a low or very low degree). The average consumer base is formed of members of the general public at large who will select the goods and services by primarily visual means, although I do not discount an aural component, especially in certain retail environments. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods and services at issue. I have found the marks are visually similar to between a medium and high degree, aurally similar to a high degree and conceptually similar to a very high degree. I have found the opponent's mark to possess between a low and medium degree of inherent distinctive character. In respect of the latter point, I remind myself that an earlier mark having a weaker degree of distinctive character does not preclude the existence of a likelihood of confusion.⁹

57. Taking all of these factors into account and bearing in mind the principle of imperfect recollection, I consider that the differences between the marks are likely to be overlooked, thereby leading consumers to misremember or inaccurately recall the marks for one another. Given that the majority of the goods and services at issue relate to products that can be used on the skin, I consider that consumers will overlook the word 'Skin', especially given its placement at the end of the mark.¹⁰ For the avoidance of doubt, I consider that this applies even where the consumers consider the marks at issue on goods that relate to hair care. This is because goods for use on the hair can still have benefits to the user's skin in that they may offer moisturising benefits to the user's scalp, for example. As a result of the overlooking

⁹ *L'Oréal SA v OHIM*, Case C-235/05 P

¹⁰ On this point, I remind myself that as per the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 wherein the GC set out that consumers tend to focus on the beginnings of marks, being where these marks are identical.

of the word 'Skin', I consider that consumers will look to place their attempt at recollecting the marks upon the words 'Lumi Glo' and 'Lumi Glow'. Given the aural and conceptual identity between these elements, I am of the view that consumers will not be able to recall which one spelt the second word as 'Glow' and which one spelt it was 'Glo'. Consequently, I consider that there exists a likelihood of direct confusion between the marks regardless of the degree of similarity between the goods and services at issue. In respect of the latter point, I remind myself of the interdependency principle and hereby rely on the higher levels of similarity between the marks to overcome any low (or very low) degree of similarity between the goods and services at issue.¹¹

58. For the avoidance of doubt, I will proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

¹¹ I make reference to this point here for the sake of completeness as, in my view, the correct approach to this assessment is to proceed as if the goods and services are identical/highly similar in light of the applicant's lack of denial of the opponent's claim on this point.

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

59. When considering the issue of indirect confusion, I remind myself that it is not always that case that *all* differences between marks will be noticed. In the present case, I consider it likely that the only point of difference that can be said to assist consumers in identifying that the marks are different will be the word 'Skin'. For the avoidance of doubt, the difference between 'Lumi Glo' and 'Lumi Glow' will still be overlooked. In my view, I consider that the addition of the word 'Skin' will be seen as a logical indicator of a sub-brand or brand extension of the 'Lumi Glo'/'Lumi Glow' branding. For example, if consumers see 'Lumi Glo'/'Lumi Glow' on a haircare product and then view 'Lumi Glo Skin'/'Lumi Glow Skin' on a skincare product, they will automatically believe that the 'Lumi Glo'/'Lumi Glow' brand has extended into producing and selling skincare products. This is a classic example of indirect confusion and one directly covered by the non-exhaustive list of categories wherein indirect confusion would ordinarily occur (being those set out in the case of *L.A. Sugar*, cited above). Consequently, I consider that there exists a likelihood of indirect confusion between the marks regardless of the degree of similarity between the goods and services at issue. For the same reasons discussed above, I consider that this finding extends to circumstances wherein the

marks may be viewed on goods and services that are only similar to a low (or very low) degree.

CONCLUSION

60. The opposition succeeds in full and, subject to any successful appeal, the applicant's mark is refused registration for all goods and services for which protection was sought.

COSTS

61. As the opponent has been successful in opposing the applicant's mark, she is entitled to a contribution towards her costs, based upon the scale published in Tribunal Practice Notice 1/2023 which governs costs in Fast Track proceedings issued after 1 February 2023. In the circumstances, I award the opponent the sum of £700 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement:	£250
Written submissions in lieu:	£350
Official fee:	£100
Total	£700

62. I therefore order LUMI GLO LIMITED to pay Karen Wood the sum of £700. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 13th day of November 2024

A COOPER
For the Registrar

ANNEX

Class 3

Beauty care cosmetics; Beauty serums, lotions, creams, soap, milks, gels; Cosmetic products in the form of aerosols for skincare; Beauty creams for body care; Beauty balm creams; Distilled oils for beauty care; Beauty masks; Beauty serums with anti-ageing properties; Beauty tonics for application to the body; Beauty care preparations; Beauty tonics for application to the face; Perfumery products; Cosmetic products for the shower; Facial beauty masks; Natural cosmetics; Skincare cosmetics; Body cleaning and beauty care preparations; Beauty preparations for the hair; Hair shampoo, dye, relaxers, pomades, texturizers, conditioners, mousse, mascara, lighteners, bleaches, colourants, serums, lotions, rinses, creams, styling gels, powder, emollients, oils, and cosmetics; Baby hair conditioner; Hair balm; Hair liquid, glaze, and rinses [for cosmetic use]; Cosmetic preparations for the hair and scalp; Beard balm, oil, dyes, lotions, and care preparations; Lipstick; Eyelines; Mascara; Eyeshadow; Lip cosmetics; Blusher; Blush pencils; Make-up palettes containing cosmetics; Nail makeup; Makeup; Nail paint [cosmetics]; Make-up foundation; Anti-ageing moisturiser, cream, and serum; Moisturising creams; Perfumery and fragrances; Oils for perfumes and scents; Anti-wrinkle creams [for cosmetic use]; Facial creams [for cosmetic use]; Facial creams [cosmetic]; Anti-ageing creams [for cosmetic use]; Anti-aging creams [for cosmetic use]; Anti-wrinkle cream [for cosmetic use]; Cosmetic massage creams; Facial cream [for cosmetic use]; Facial lotions [cosmetic]; Cosmetic facial lotions; Facial creams [cosmetics]; Facial moisturisers [cosmetic]; Skin hydrators being injectable dermal fillers; Self tanning creams [cosmetic]; Facial creams; Facial toners [cosmetic]; Anti-wrinkle creams; Cosmetic creams; Creams (Cosmetic -); Anti-aging serum for cosmetic use; Hair care creams [for cosmetic use]; Cosmetic creams for the skin; Skin creams [cosmetic]; Skin creams [for cosmetic use]; Facial cleansers [cosmetic]; Body and facial creams [cosmetics]; Facial serum for cosmetic use; Facial scrubs [cosmetic]; Cosmetic facial masks; Facial masks [cosmetic]; Anti-ageing creams; Anti-aging creams; Cosmetic hair lotions; Cosmetics for use in the treatment of wrinkled skin; Skin cream [for cosmetic use]; Anti-ageing serums for cosmetic purposes; Facial concealer; Skin relief serum [cosmetic]; Facial washes [cosmetic]; Acne cleansers,

cosmetic; Skin care creams [cosmetic]; Cosmetic creams for skin care; Self tanning lotions [cosmetic]; Toning creams [cosmetic]; Moisturising skin creams [cosmetic]; Wrinkle resistant creams [for cosmetic use]; Cosmetic creams for firming skin around eyes; Eyebrow cosmetics; Creams for cellulite reduction; Cosmetic creams and lotions; Hair care lotions [for cosmetic use]; Anti-wrinkle cream; Anti-ageing serum; Cleansing creams [cosmetic]; Facial makeup; Hair tonic [for cosmetic use]; Hair rinses [for cosmetic use]; Facial lotions; Cosmetics for eye-brows; Facial packs [cosmetic]; Cosmetic facial packs; Anti-aging cream; Anti-aging moisturizers used as cosmetics; Lotions for cellulite reduction; Sunscreen creams [for cosmetic use]; Sun creams [for cosmetic use]; Face creams for cosmetic use; Cosmetic breast firming preparations; Facial gels [cosmetics]; Facial cream; Skin recovery creams [cosmetics]; Hair tonics [for cosmetic use]; Skin balms [cosmetic]; Cosmetic moisturisers; Cosmetic face powders; Face powders [for cosmetic use]; Moisturising skin lotions [cosmetic]; Hair desiccating treatments for cosmetic use; Cosmetic suntan lotions; Lip cosmetics; Cosmetic creams for dry skin; Creams for tanning the skin; Skin care lotions [cosmetic]; Skin toners [cosmetic]; Facial moisturizers; Hair serums; Skin whitening preparations [cosmetic]; Creams (Skin whitening -); Skin whitening cream; Beauty serums with anti-ageing properties; Skin cleansers [cosmetic]; Facial lotion; Dermatological creams [other than medicated]; After-sun lotions [for cosmetic use]; Cosmetic preparations for skin firming; Cosmetic nourishing creams; Hair creams; Cosmetic pencils for cheeks; Hydrating creams for cosmetic use; Anti-ageing moisturizer; Cosmetics containing hyaluronic acid; Collagen preparations for cosmetic application; Facial serum for cosmetic use; Facial emulsions.

Class 35

Retail and online retail services relating to cosmetic and beauty products, hair products, sanitary preparations and articles, wipes impregnated with disinfectants for hygiene purposes, disinfectants for hygienic purposes, absorbent sanitary articles, cosmetic brushes, sponges, and spatulas, shaving brushes, shampoo brushes, hair brushes, bath brushes, beauty care cosmetics, beauty serums, lotions, creams, soap, milks, gels, cosmetic products in the form of aerosols for skincare, beauty creams for body care, beauty balm creams, distilled oils for beauty care, beauty masks, beauty serums with anti-ageing properties, beauty tonics for

application to the body, beauty care preparations, beauty tonics for application to the face, perfumery products, cosmetic products for the shower, facial beauty masks, natural cosmetics, skincare cosmetics, body cleaning and beauty care preparations, beauty preparations for the hair, hair shampoo, dye, relaxers, pomades, texturizers, conditioners, mousse, mascara, lighteners, bleaches, colourants, serums, lotions, rinses, creams, styling gels, powder, emollients, oils, and cosmetics, baby hair conditioner, hair balm, hair liquid, glaze, and rinses [for cosmetic use], cosmetic preparations for the hair and scalp, beard balm, oil, dyes, lotions, and care preparations, lipstick, eyelines, mascara, eyeshadow, lip cosmetics, blusher, blush pencils, make-up palettes containing cosmetics, nail makeup, makeup, nail paint [cosmetics], make-up foundation, anti-ageing moisturiser, cream, and serum, moisturising creams, perfumery and fragrances, oils for perfumes and scents.

ANNEX 2

Class 3

Cosmetics; Cosmetics and cosmetic preparations; Milks [cosmetics]; Eyebrow cosmetics; Cosmetic dyes; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetic pencils; Pencils (Cosmetic -); Nail cosmetics; Functional cosmetics; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic powder; Eye cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Multifunctional cosmetics; Dyes (Cosmetic -); Cosmetic kits; Kits (Cosmetic -); Tonics [cosmetic]; Natural cosmetics; Cosmetic rouges; Cosmetic moisturisers; Cosmetic masks; Cosmetic oils; Hair cosmetics; Mousses [cosmetics]; Decorative cosmetics; Colour cosmetics; Lip cosmetics; Organic cosmetics; Skin balms [cosmetic]; Cosmetic bath salts; Cleansing creams [cosmetic]; Non-medicated cosmetics; Cosmetic eye pencils; Suntan lotion [cosmetics]; Body paint (cosmetic); Bath powder [cosmetics]; Cosmetic massage creams; Cosmetic eye gels; Cosmetic hand creams; Facial washes [cosmetic]; Cosmetic facial lotions; Facial masks [cosmetic]; Cosmetic facial packs; Body scrubs [cosmetic]; Facial gels [cosmetics]; Cosmetic body mud; Cosmetic stamps, filled; Cosmetic tanning preparations; Cosmetic face powders; Sun block [cosmetics]; Skin care cosmetics; Nail hardeners [cosmetics]; Moisturising concentrates [cosmetic]; Powder compacts [cosmetics]; Skin creams [cosmetic]; Nail primer [cosmetics]; Facial creams [cosmetics]; Facial lotions [cosmetic]; Cosmetic sunscreen preparations; Cosmetic facial masks; Cosmetic nail preparations; Lip stains [cosmetics]; Humectant preparations [cosmetics]; Cosmetic skin enhancers; Facial cleansers [cosmetic]; Skin masks [cosmetics]; Night creams [cosmetics]; Nail tips [cosmetics]; Nail paint [cosmetics]; Toning creams [cosmetic]; Moisturising gels [cosmetic]; Cosmetic cotton wool; Skin fresheners [cosmetics]; Cosmetic nourishing creams; Face wash [cosmetic]; Facial scrubs [cosmetic]; Cosmetic suntan lotions; Face packs [cosmetic]; Suntan oils [cosmetics]; Tanning oils [cosmetics]; Cosmetics containing keratin; Smoothing emulsions [cosmetics]; Cosmetic mud masks; Acne cleansers, cosmetic; Body creams [cosmetics]; Sun barriers [cosmetics]; Lip protectors [cosmetic]; Mineral oils [cosmetic]; Facial moisturisers [cosmetic]; Cosmetic-impregnated tissues; Cosmetics for animals; Facial toners [cosmetic]; Lip coatings [cosmetic]; Cosmetics for suntanning; Skin cleansers [cosmetic]; Skin toners [cosmetic]; Cosmetic skin fresheners; Henna [cosmetic dye]; Body care cosmetics;

Tanning milks [cosmetics]; Tanning gels [cosmetics]; Facial creams [cosmetic]; Cosmetic sun oils; Cosmetic suntan preparations; Tanning preparations [cosmetics]; Facial packs [cosmetic]; Suntanning oil [cosmetics]; Beauty care cosmetics; Cosmetic hair lotions; Hair permanent treatments; Hair treatment preparations; Hair preparations and treatments; Hair strengthening treatment lotions; Wax treatments for the hair; Hair preservation treatments for cosmetic use; Hair desiccating treatments for cosmetic use; Non-medicated hair treatment preparations for cosmetic purposes; Hair mascara; Hair lighteners; Hair wax; Hair cream; Hair shampoo; Hair pomades; Hair sprays; Hair bleaches; Hair color; Hair mousses; Hair chalks; Hair emollients; Hair oils; Hair creams; Hair texturizers; Hair gels; Hair dye; Hair dyes; Hair colorants; Hair frosts; Hair masks; Hair liquids; Hair glaze; Hair moisturisers; Hair conditioners; Hair shampoos; Hair relaxers; Hair spray; Hair lacquers; Hair nourishers; Hair colouring; Hair colourants; Hair powder; Hair liquid; Hair serums; Hair neutralizers; Hair balm; Hair oil; Hair balms; Hair glazes; Hair moisturizers; Hair conditioner; Hair lacquer; Hair balsam; Hair fixers; Hair bleach; Hair decolorants; Hair rinses; Hair lotion; Hair lotions; Hair tonic; Hair tonics; Hair gel; Hair mousse; Neutralizing hair preparations; Hair care preparations.