

**O/1220/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00004014659**

**IN THE NAME OF DR RASHA CLINIC LONDON LTD**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**DR RASHA**

**IN CLASSES 3, 35 AND 44**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. OP000447224**

**BY YIWU RASHEL TRADING CO. LTD**

## BACKGROUND AND PLEADINGS

1. On 15 February 2024, DR RASHA CLINIC LONDON LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 1 March 2024 in respect of the goods and services listed below.

Class 3 Adhesives for cosmetic use; Artificial tanning preparations; Baby oils; Baby wipes; Bath and shower gels; Bath preparations; Beauty creams; Body cleaning and beauty care preparations; Body wash; Collagen for cosmetic purposes; Concealers; Cosmetic skin enhancers; Cosmetics; Essential oils and aromatic extracts; Essential oils; Exfoliants; Eye makeup; Eyebrow pencils; Eyeliner; Eyeshadows; Face powders; Face wash; Facial cleansers; False eyelashes; Foundation; Hair conditioner; Hair preparations and treatments; Hand washes; Lip balm; Lipstick; Make-up removing preparations; Make-up; Makeup; Massage oil; Moisturizer; Non-medicated skincare preparations; Shampoo; Skin care cosmetics; Soap; Tanning preparations; Toiletries; Tooth whitening preparations; Toothpaste.

Class 35 Administration of loyalty rewards programs; Administration of the business affairs of franchises; Advertising services; Advertising; Advice in the running of establishments as franchises; Advisory services relating to publicity for franchisees; Assistance in business management within the framework of a franchise contract; Assistance in franchised commercial business management; Assistance in product commercialization, within the framework of a franchise contract; Business administration services; Business advertising services relating to franchising; Business advice and consultancy relating to franchising; Business advice relating to franchising; Business advisory services relating to franchising; Business advisory services relating to the establishment and operation of franchises; Business advisory services; Business assistance relating to franchising; Business assistance relating to the establishment of franchises; Business consultancy in relation to

franchising; Business consultancy services; Business management advisory services relating to franchising; Business management assistance in the field of franchising; Business management; Dissemination of advertisements; Dissemination of advertising matter online; Dissemination of business information; Dissemination of commercial information; Electronic order processing; Management advisory services related to franchising; Marketing services; Office functions; Online advertisements; Online advertising on a computer network; Online ordering services; Ordering services for third parties; Procurement of goods on behalf of other businesses; Promoting the goods and services of others by means of a loyalty rewards card scheme; Providing assistance in the field of business management within the framework of a franchise contract; Providing assistance in the field of product commercialization within the framework of a franchise contract; Providing assistance in the management of franchised businesses; Provision of business advice relating to franchising; Provision of business information relating to franchising; Public relations services; Publicity services; Services rendered by a franchisor, namely, assistance in the running or management of industrial or commercial enterprises; Retail services, wholesale services, mail order services or internet retailing services in relation to Adhesives for cosmetic use, Artificial tanning preparations, Baby oils, Baby wipes, Bath and shower gels, Bath preparations, Beauty creams, Body cleaning and beauty care preparations, Body wash, Collagen for cosmetic purposes, Concealers, Cosmetic skin enhancers, Cosmetics, Essential oils and aromatic extracts, Essential oils, Exfoliants, Eye makeup, Eyebrow pencils, Eyeliner, Eyeshadows, Face powders, Face wash, Facial cleansers, False eyelashes, Foundation, Hair conditioner, Hair preparations and treatments, Hand washes, Lip balm, Lipstick, Make-up removing preparations, Make-up, Makeup, Massage oil, Moisturizer, Non-medicated skincare preparations, Shampoo, Skin care cosmetics, Soap, Tanning preparations, Toiletries, Tooth whitening preparations, Toothpaste, Collagen for medical purposes, Dietary supplements, Implants comprising living tissue, Injectable dermal fillers, Medicated

skin care preparations, Mineral supplements, Natural remedies, Pharmaceuticals, Skin care lotions [medicated], Vitamin supplements, Artificial implants, Breast implants, Implants [prosthesis], Massage appliances, Medical apparatus, Medical devices, Medical implants, Medical instruments, Prosthetic implants, Prosthetics and artificial implants, Silicone preparations for cosmetic implantation, Surgical and wound treating equipment, Suture and wound closing materials and products, Parts for the aforesaid, Fittings for the aforesaid, Accessories for the aforesaid; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

Class 44 Advice relating to cosmetics; Anti-wrinkle treatments; Beautician services; Beauty consultancy; Beauty consultation; Consultancy services relating to prosthetic implants; Consultation services relating to skin care; Cosmetic and plastic surgery clinic services; Cosmetic facial and body treatment services; Cosmetic laser treatment of skin; Cosmetic laser treatment of unwanted hair; Cosmetic surgery services; Cosmetic treatment services; Cosmetics consultancy services; Dental surgery; Dermal filling services; Dermatological services for treating skin conditions; Facial beauty treatment services; Facial treatment services; Hair implantation; Hair replacement; Hair restoration; Hair styling; Hair treatment; Haircare services; Health advisory services; Health spa services for health and wellness of the body and spirit; Healthcare services; Human healthcare services; Human hygiene and beauty care; Injectable filler treatments for cosmetic purposes; Laser skin rejuvenation services; Laser skin tightening services; Light therapy services; Liposuction services; Make-up services; Medical advisory services; Medical services; Microneedling treatment services; Permanent makeup services; Plastic surgery services; Semi-permanent makeup services; Services for the care of the skin; Skin care salons; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

2. On 29 April 2024, YIWU RASHEL TRADING CO. LTD (“the opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following two marks:

# DR·RASHEL

UK Registration no. UK00917942366 (“the first earlier mark”), relying upon the goods listed below in order to oppose all of the goods and services in the application.

Filing date: 14 August 2018

Date of registration: 11 December 2018

Relying upon the following goods:

Class 3: Cosmetics; Skin care (Cosmetic preparations for -); Beauty masks; Make-up powder; Eyebrow cosmetics; cosmetic pencils; Lipsticks; Mascara; Perfumes; Nail polish; Hair spray; Skin whitening creams; Depilatories; Cakes of toilet soap; Shampoos; Aromatics [essential oils]; Dentifrices; Cosmetics for animals; Cleaning preparations; potpourris [fragrances].

# DR·RASHEL

UK Registration no. UK00003421907 (“the second earlier mark”), relying upon the services listed below to oppose only the applicant’s Class 35 services.

Filing date: 16 August 2019

Date of registration: 8 November 2019

Relying upon the following goods:

Class 35: Publicity; advertising/publicity; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses; Marketing; An online marketplace for buyers and sellers of goods and services; On-line advertising on a computer network; Rental of

advertising time on communication media; Presentation of goods on communication media, for retail purposes; Advertising script writing.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's first earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register and have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.<sup>1</sup>
4. By virtue of their earlier filing dates, both the above marks constitute earlier marks in accordance with section 6 of the Act.
5. As the first earlier mark UK00917942366 was registered more than five years prior to the date the contested mark was filed, the mark is subject to proof of use in accordance with section 6A of the Act.
6. The second earlier mark UK00003421907 was registered less than five years prior to the date the contested mark was filed and is therefore not subject to proof of use in accordance with section 6A of the Act. The opponent can, therefore, rely upon all of the services for which this mark is registered without having to demonstrate use of the mark.
7. The opponent submits that the marks are similar to a high degree and that the relevant goods and services are either identical or highly similar to one another. The opponent further submits that "where there is any dissimilarity between the goods and services, that dissimilarity is negligible in light of the extreme similarity of the marks in question".<sup>2</sup>
8. The applicant filed a counterstatement within which it denies the opponent's claims.

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<sup>1</sup> See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

<sup>2</sup> Opponent's Form TM7 and statement of grounds, paragraph 106.

9. Both parties filed evidence during the proceedings and the opponent filed evidence and submissions in reply. Neither party requested a hearing, nor filed submissions in lieu. This decision is taken following a careful consideration of the papers.
10. The applicant is represented by ImPrint. The opponent is represented by Handsome I.P. Ltd.
11. 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.

## **Evidence**

12. The opponent filed evidence in the form of the witness statement of Li Yulan, manager of YIWU RASHEL TRADING CO. LTD, signed and dated 14 September 2024. The opponent also filed the witness statement of Alexandria Lovell, of Handsome I.P. Limited, signed and dated 16 September 2024. The witness statements are accompanied by exhibits A - D.
13. The applicant filed evidence in the form of the witness statement of Bernard Whyatt, of Brand Protect Limited, signed and dated 16 October 2014. The witness statement is accompanied by exhibits entitled Figure 1 – Figure 22.
14. The opponent filed evidence in reply in the form of a second witness statement of Alexandria Lovell of Handsome I.P. Limited, signed and dated 17 January 2024, and I assume the date the witness intended to record was 17 January 2025, this being the date on which the statement was filed. The witness statement is accompanied by exhibits E - F.
15. The opponent also filed submissions in reply, dated 16 January 2025.

## **DECISION**

### **Proof of use**

16. I will begin by assessing whether there has been genuine use of the first earlier mark.

### **The law**

17. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if – (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes – (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

18. As the first earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7. (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) [...]

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day –

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

19. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made in the relevant period. The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the contested mark, i.e. 16 February 2019 to 15 February 2024. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the period up to IP Completion Day (i.e. 31 December 2020).

21. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

22. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13

*P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a subcategory of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns:

*Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

11. Arnold LJ followed his summary of the principles to be applied when assessing proof of use with the following paragraph:

“107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard

to the interests of the proprietor, the opponent and, it should be said the public.””

### Form of the mark

12. There are numerous instances of the first earlier mark appearing as registered in photographs of the opponent’s products offered in evidence.

### The opponent’s evidence of use

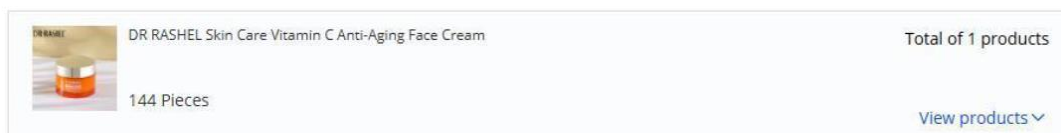
13. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>3</sup>

14. I remind myself that the relevant period is 16 February 2019 to 15 February 2024 for use in the UK and that period up to IP Completion Day (i.e. 31 December 2020) for use in the EU.

15. Li Yulan’s witness statement covers exhibits A to C.

16. Li Yulan says that the mark was first used in the UK in 2020 and has been used in the UK for all of its goods and that “the mark has been used on the goods in all parts of the United Kingdom.”

17. Exhibits A to C consist of three shipping receipts for Dr Rashel products going from China to buyers in the United Kingdom. For example, Exhibit B shows the following goods:



<sup>3</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

18. It is not possible to identify from the first receipt which organisation arranged the shipping, the other two receipts being from Alibaba.

19. The units shipped, the amounts of money in total for each receipt and the dates are as follows:

Receipt	Units	Amount in USD	Date
1	192	299.52	20 June 2021
2	144	330.40	24 July 2023
3	100	No subtotal provided	7 June 2023
3	960	3042.00	7 June 2023

20. All of the above dates are within the relevant period.

21. At paragraph 8 of their witness statement, Li Yulan supplies a table as follows:

8. Annual sales of the goods before the date of application were as follows:

2020 CNY 2296549.62 (approx. £246,000)

2021 CNY 2503542.22 (approx. £268,000)

2022 CNY 3442067.36 (approx. £369,000)

2023 CNY 2166861.99 (approx. £232,000)

2024 to-date CNY 2987916.53 (approx. £320,000)

22. While Li Yulan does not explicitly state in the above paragraph that these sales were made in the United Kingdom, the preceding and succeeding paragraphs of the witness statement refer to economic activity in the United Kingdom.

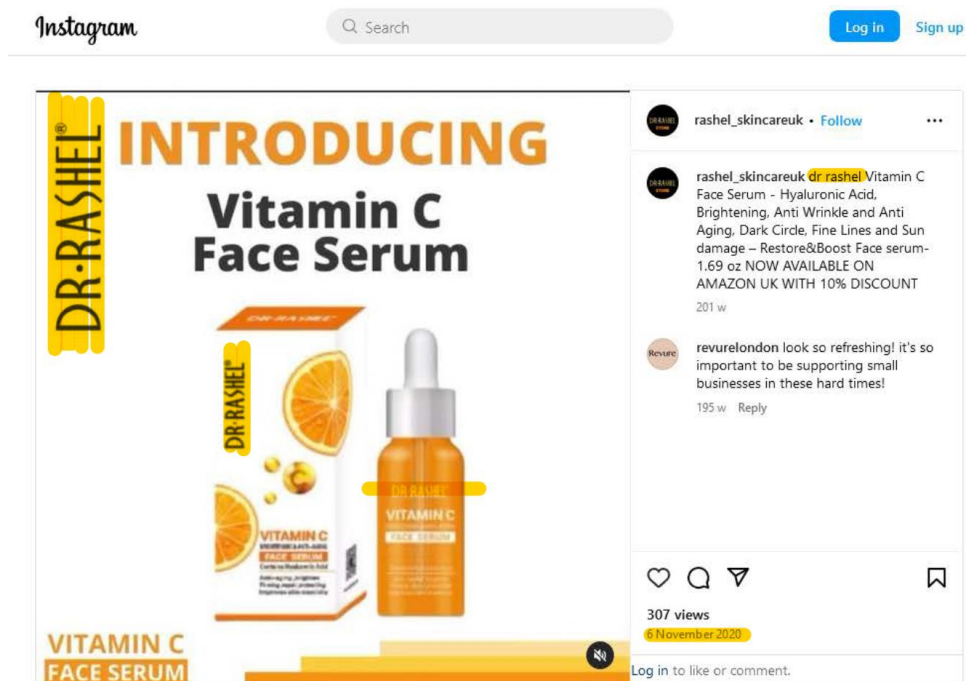
23. Alexandria Lovell's witness statement covers exhibit D.

24. The exhibit features a number of extracts from Instagram and instances of the opponent's goods being offered for sale.

25. The Instagram extracts are all from the rashel\_skincareuk account with this icon:



26. The Instagram posts are all from within the relevant period and clearly show Dr Rashel products affixed with the mark as registered. Some of the posts include a link for making purchases and one of the posts, dated 6 November 2020, refers to a Dr Rashel product as “NOW AVAILABLE ON AMAZON UK WITH 10% DISCOUNT” as per the image below.



27. However, the number of likes on the Instagram posts is very small, ranging from 3 to 14. There are 2 posts with the number of views recorded, being 43 and 307.

28. The exhibit also features archived web pages from forevercosmetics.co.uk, all within the relevant period, showing Dr Rashel products being offered for sale. For example, “Dr Rashel Rose & Collagen Infused Make Up Wipes” offered for sale for £24.99 on 7 August 2020, “Dr Rashel Gold Bio Collagen Essential Oil Soap”, offered for sale for £24.99 on 20 August 2022, and “Dr Rashel Vitamin C

Brightening, Anti Ageing Face Serum 50ml & Gold Collagen Face Masks”, offered for sale for £15.99 on 29 November 2023.

29. There are also archived extracts from mywholesalewarehouse.com, all within the relevant period, showing Dr Rashel products being offered for sale. Alexandria Lovell says that “The website is based in and directed to customers in the UK as evidenced by its phone number on page 26 [of the evidence]” and I can confirm that it is a UK mobile number.
30. There is an in-date extract from the Fougées Beauty website listing a Dr Rashel product set – the Dr Rashel Vitamin C Body & Face 4 in 1 Set (Dr Rashel Vitamin C Brightening & Nourishing Body Lotion, Dr Rashel Vitamin C Whitening Exfoliating Silky Shower Gel, Dr Rashel Vitamin C Nourishing & Repairing Body Oil and Vitamin C Brightening & Anti-Aging Face Cream). This is priced at £50.00. It is not possible to see the full domain name of the website.

#### The applicant’s evidence

31. Part of the witness statement of Bernard Whyatt is devoted to a critique of the applicant’s evidence of use.
32. Bernard Whyatt says that “much of the evidence is redacted to the point that it is not comprehensible” (paragraph 7 b)), but the example he uses to illustrate his point is a page from exhibit D where the opponent has highlighted the use of the mark in yellow. I have no difficulty in reading these yellow highlighted sections. I do, however acknowledge that the shipping receipts – exhibits A to C – are redacted, but it is still possible for me to see what the goods are, how many units have been shipped and at what price, and that the goods were shipped to the UK. Further, I do not agree that the shipping receipts can simply be dismissed as “internal documentation” (paragraph 7 d)).
33. I agree with Bernard Whyatt that the Instagram evidence shows “minimal interaction” from Instagram users and that the evidence from third party websites shows goods being offered for sale, but does not show sales having been achieved (paragraph 7 e) i) and paragraph 7 e) ii)).

34. Bernard Whyatt goes on to comment on the opponent's evidence in respect of [forevercosmetics.co.uk](https://forevercosmetics.co.uk) and [mywholesalewarehouse.com](https://www.mywholesalewarehouse.com):

- f) The Opponent makes several references to "Forever Cosmetics" (<https://forevercosmetics.co.uk/>). At Figure 21 I provide some research into Forever Cosmetics:
  - i) <https://forevercosmetics.co.uk/> has no UK contact details, aside from an email address [info@global-fulfillment.co.uk](mailto:info@global-fulfillment.co.uk);
  - ii) Forever Cosmetics has very small number of reviews on Trust Pilot. Many of those views are very poor;
  - iii) Forever Cosmetics' refund policy refers to US dollars, not GB pounds.
  - iv) The company FOREVER BEAUTY COSMETICS LTD (company number 13872195) was incorporated in 2022 and dissolved in 2024.
  - v) The website therefore appears to have a very small following with the UK public if at all. The suggestion that this website shows use of the mark is denied.
- g) The Opponent also makes reference to <https://www.mywholesalewarehouse.com/> "My Wholesale Warehouse". At Figure 22 I provide some research into My Wholesale Warehouse:
  - i) My Wholesale Website's website states "My Wholesale Warehouse' is a trading name of Global Fulfillment Ltd".

35. Looking at the reviews of Forever Cosmetics, I have counted six bad reviews, but eleven good ones.

#### The opponent's submissions and evidence in reply

36. Having considered the opponent's original evidence, the applicant's evidence, and the opponent's evidence in reply, I am satisfied that Forever Cosmetics and My Wholesale Warehouse were based in the UK during the relevant period. For example, exhibit F of the opponent's evidence in reply includes evidence that the Forever Cosmetics website's Terms of Service are governed by the laws of the United Kingdom and that the "About us" page of the My Wholesale Warehouse website shows that it is based in Birmingham, West Midlands, UK.

37. Bernard Whyatt's witness statement and supporting evidence show that there was a company called FOREVER BEAUTY COSMETICS LTD that was dissolved in 2024. I assume that Bernard Whyatt is seeking to show that the company that owned the Forever Cosmetics website has been dissolved. The opponent has filed evidence to show that Global Fulfillment Ltd, whose company email account is used for the contact email address for Forever Cosmetics and for which My Wholesale Warehouse is a trading name, was incorporated in 2013 and remains active. In any event, I am satisfied that both websites were trading at the points during the relevant period when the opponent's goods were being offered for sale.

#### Sufficient use

38. The opponent has provided no evidence as to marketing expenditure, nor has it furnished me with any information as to the size of the UK cosmetics market or as to its market share. While social media posts are indicative of economic activity, the number of likes and the viewership of the opponent's UK Instagram account posts are very small.

39. In the paragraph with the table setting out annual sales, which exceed a quarter of a million pounds for each of the years covered by the relevant period, Li Yulan does not explicitly state that these sales were made in the United Kingdom. However, the preceding and succeeding paragraphs of the witness statement refer to economic activity in the United Kingdom and Li Yulan attests to the opponent's mark having been first used in the UK in 2020 and having been used in the UK for all of its goods in all parts of the United Kingdom.

40. I have no proof before me of any individual sales of the opponent's products having been made to end consumers. However, I do have evidence of the opponent's products being offered for sale to individual consumers during the relevant period on two third party websites and having been referred to as being offered for sale direct and via Amazon on its UK Instagram account.

41. The opponent's goods are shown as offered for sale on a wholesale basis on one website and there are three wholesale shipping receipts during the relevant period which amount to 1,396 units totalling 3,671.92 US dollars.

42. Considering all of the evidence in the round, I regard the use shown to be sufficient such that it is more than merely token. The evidence before me denotes real commercial exploitation of the mark on the market in accordance with the commercial raison d'être of the mark, which is to create an outlet for the goods that bear the mark and hence I consider genuine use to have been demonstrated.

### **Fair specification**

43. Having determined that the opponent has shown use of its goods under its mark, I must now set out what I consider to be a fair specification having reviewed the use shown against its current specification.

44. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

45. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation (which also applies to proof of use cases), as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in

relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

46. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

47. The approach in *Merck* was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

“261. ... save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.”

48. I remind myself that the opponent's first earlier mark stands registered for:

Class 3: Cosmetics; Skin care (Cosmetic preparations for -); Beauty masks; Make-up powder; Eyebrow cosmetics; cosmetic pencils; Lipsticks; Mascara; Perfumes; Nail polish; Hair spray; Skin whitening creams; Depilatories; Cakes of toilet soap; Shampoos; Aromatics [essential oils]; Dentifrices; Cosmetics for animals; Cleaning preparations; potpourris [fragrances].

49. The goods that are shown in the evidence are “brightening and anti-ageing” serum for the face and for the eyes, face cream, face masks, make up wipes, soap in liquid form (“to fight ageing signs and give the skin freshness and vitality”), exfoliating shower gel, body oil, and body lotion. This usage is sufficient to justify the retention of “Skin care (Cosmetic preparations for -)” and “Beauty masks”.

50. The usage demonstrated does not warrant the retention of “Cosmetics” at large.

51. Make up wipes appear in the evidence, but they do not fall within the definition of “cosmetic preparations”, preparations being substances, and make up wipes being made of synthetic cloth. Nor can such goods be said to be “cleaning preparations” which in any event I interpret as goods that are used for cleaning objects, not cleaning the skin. Furthermore, the opponent does not have goods for the removal of make up in its specification.

52. The liquid soap and shower gel shown in the evidence do not fall within the definition of “Cakes of toilet soap” nor of “Shampoos”.

53. I consider a fair specification to be:

Class 3 Skin care (Cosmetic preparations for -); Beauty masks.

### **Section 5(2)**

54. The opposition is based upon Sections 5(2)(b) of the Act, which read as follows:

“5(2) A trade mark shall not be registered if because -

(a) ...

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

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

55. 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 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 the goods and services

56. The goods and services for comparison are as follows:

Opponent's goods and services	Applicant's goods and services
<p>The goods for the first earlier mark, being relied upon to oppose all of the applicant's goods and services:</p> <p><u>Class 3:</u> Skin care (Cosmetic preparations for -); Beauty masks.</p>	<p><u>Class 3:</u> Adhesives for cosmetic use; Artificial tanning preparations; Baby oils; Baby wipes; Bath and shower gels; Bath preparations; Beauty creams; Body cleaning and beauty care preparations; Body wash; Collagen for cosmetic purposes; Concealers; Cosmetic skin enhancers; Cosmetics; Essential oils and aromatic extracts; Essential oils; Exfoliants; Eye makeup; Eyebrow pencils; Eyeliner; Eyeshadows; Face powders; Face wash; Facial cleansers; False eyelashes; Foundation; Hair conditioner; Hair preparations and treatments; Hand washes; Lip balm; Lipstick; Make-up removing preparations; Make-up; Makeup; Massage oil; Moisturizer; Non-medicated skincare preparations; Shampoo; Skin care cosmetics; Soap; Tanning preparations; Toiletries; Tooth whitening preparations; Toothpaste.</p>

The services of the second earlier mark, being relied upon to oppose only the applicant's Class 35 services:

Class 35:

Publicity; advertising/publicity; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses; Marketing; An online marketplace for buyers and sellers of goods and services; On-line advertising on a computer network; Rental of advertising time on communication media; Presentation of goods on communication media, for retail purposes; Advertising script writing.

Class 35:

Administration of loyalty rewards programs; Administration of the business affairs of franchises; Advertising services; Advertising; Advice in the running of establishments as franchises; Advisory services relating to publicity for franchisees; Assistance in business management within the framework of a franchise contract; Assistance in franchised commercial business management; Assistance in product commercialization, within the framework of a franchise contract; Business administration services; Business advertising services relating to franchising; Business advice and consultancy relating to franchising; Business advice relating to franchising; Business advisory services relating to franchising; Business advisory services relating to the establishment and operation of franchises; Business advisory services; Business assistance relating to franchising; Business assistance relating to the establishment of franchises; Business consultancy in relation to franchising; Business consultancy services; Business management advisory services relating to franchising; Business management assistance in the field of franchising; Business management; Dissemination

	<p>of advertisements; Dissemination of advertising matter online; Dissemination of business information; Dissemination of commercial information; Electronic order processing; Management advisory services related to franchising; Marketing services; Office functions; Online advertisements; Online advertising on a computer network; Online ordering services; Ordering services for third parties; Procurement of goods on behalf of other businesses; Promoting the goods and services of others by means of a loyalty rewards card scheme; Providing assistance in the field of business management within the framework of a franchise contract; Providing assistance in the field of product commercialization within the framework of a franchise contract; Providing assistance in the management of franchised businesses; Provision of business advice relating to franchising; Provision of business information relating to franchising; Public relations services; Publicity services; Services rendered by a franchisor, namely, assistance in the running or management of industrial or commercial enterprises; Retail services, wholesale services, mail order services or internet retailing services in relation to Adhesives for cosmetic use, Artificial tanning</p>
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	preparations, Baby oils, Baby wipes, Bath and shower gels, Bath preparations, Beauty creams, Body cleaning and beauty care preparations, Body wash, Collagen for cosmetic purposes, Concealers, Cosmetic skin enhancers, Cosmetics, Essential oils and aromatic extracts, Essential oils, Exfoliants, Eye makeup, Eyebrow pencils, Eyeliner, Eyeshadows, Face powders, Face wash, Facial cleansers, False eyelashes, Foundation, Hair conditioner, Hair preparations and treatments, Hand washes, Lip balm, Lipstick, Make-up removing preparations, Make-up, Makeup, Massage oil, Moisturizer, Non-medicated skincare preparations, Shampoo, Skin care cosmetics, Soap, Tanning preparations, Toiletries, Tooth whitening preparations, Toothpaste, Collagen for medical purposes, Dietary supplements, Implants comprising living tissue, Injectable dermal fillers, Medicated skin care preparations, Mineral supplements, Natural remedies, Pharmaceuticals, Skin care lotions [medicated], Vitamin supplements, Artificial implants, Breast implants, Implants [prosthesis], Massage appliances, Medical apparatus, Medical devices, Medical implants, Medical instruments, Prosthetic implants,
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	<p>Prosthetics and artificial implants, Silicone preparations for cosmetic implantation, Surgical and wound treating equipment, Suture and wound closing materials and products, Parts for the aforesaid, Fittings for the aforesaid, Accessories for the aforesaid; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.</p>
	<p><u>Class 44:</u>  Advice relating to cosmetics; Anti-wrinkle treatments; Beautician services; Beauty consultancy; Beauty consultation; Consultancy services relating to prosthetic implants; Consultation services relating to skin care; Cosmetic and plastic surgery clinic services; Cosmetic facial and body treatment services; Cosmetic laser treatment of skin; Cosmetic laser treatment of unwanted hair; Cosmetic surgery services; Cosmetic treatment services; Cosmetics consultancy services; Dental surgery; Dermal filling services; Dermatological services for treating skin conditions; Facial beauty treatment services; Facial treatment services; Hair implantation; Hair replacement; Hair restoration; Hair styling; Hair treatment; Haircare services; Health advisory services; Health spa services for health</p>

	<p>and wellness of the body and spirit; Healthcare services; Human healthcare services; Human hygiene and beauty care; Injectable filler treatments for cosmetic purposes; Laser skin rejuvenation services; Laser skin tightening services; Light therapy services; Liposuction services; Make-up services; Medical advisory services; Medical services; Microneedling treatment services; Permanent makeup services; Plastic surgery services; Semi-permanent makeup services; Services for the care of the skin; Skin care salons; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.</p>
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57. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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”.

58. 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:

“In assessing the similarity of the goods or services concerned, as the

French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.

59. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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.

60. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“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”.

61. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

62. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

63. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary

and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

### Comments from the parties

64. For the applicant, paragraph 5 of Bernard Whyatt's witness statement refers to an EUIPO goods and services comparison tool and provides extracts of comparisons as between Class 3 goods and Class 35 services at exhibit Figure 19 and Class 3 goods and Class 44 services at exhibit Figure 20.

65. At paragraph 25 of the opponent's submissions, the opponent says that the EUIPO comparison tool is not "legally definitive" and also cites examples from the extracts offered in evidence that are not relevant to the goods and services at hand.

66. In any event, I must conduct my own comparative analysis of the goods and services which I proceed to do below.

### Class 3

67. The applicant's "Skin care cosmetics" are identical to the opponent's "Skin care (Cosmetic preparations for -)".

68. The applicant's "Body cleaning and beauty care preparations" are *Merit* identical to the "Skin care (Cosmetic preparations for -)".

69. The applicant's "Cosmetics" are *Merit* identical to the "Skin care (Cosmetic preparations for -)".

70. The applicant's "Toiletries" are *Merix* identical to the "Skin care (Cosmetic preparations for -)".
71. Given that the opponent's "Skin care (Cosmetic preparations for -)" are goods that cleanse or are otherwise applied to the skin in order to improve its appearance, I find that the applicant's "Baby oils", "Beauty creams", "Cosmetic skin enhancers", "Exfoliants", "Facial cleansers", "Moisturizer", and "Non-medicated skincare preparations" are *Merix* identical to the opponent's goods. Further, the applicant's "Bath and shower gels", "Bath preparations", "Body wash", "Collagen for cosmetic purposes" (which can take the form of a skin care preparation), "Face wash", "Hand washes" and "Soap" are at least highly similar.
72. While the applicant's "Baby wipes" are not skin care preparations in themselves, typically being made of synthetic cloth, they are impregnated with cleansing skin care preparations. Both these goods and the opponent's "Skin care (Cosmetic preparations for -)" would be sold in close proximity and I find them to be of medium similarity.
73. I compare the applicant's "Make-up removing preparations" with the opponent's "Skin care (Cosmetic preparations for -)". While they are not complementary or in competition, both are typically liquid in nature and applied to the skin and both could be used as part of an evening skin care routine whereby make up is removed and then skin care preparations are applied. Furthermore, these goods will be shelved close together in a pharmacy or supermarket. Overall, I find these goods to be of medium similarity.
74. The applicant's "Massage oil" is principally intended for use so that the skin feels pleasant when being massaged, but it can have the secondary effect of improving the appearance of the skin whereas that is the primary purpose of the opponent's "Skin care (Cosmetic preparations for -)". Both are typically in liquid form, and both are applied to the skin. Both may be sold in relatively close proximity through outlets such as pharmacies and spas. They are not complementary, nor are they in meaningful competition. Overall, I find them to be of medium similarity.

75. The applicant's "Make-up" and "Makeup" are similar to the opponent's "Skin care (Cosmetic preparations for -)" in that both are applied to the face by hand, and both are intended to improve the appearance. They could also form part of a routine of cleansing and beautification. Both are sold through pharmacies and department stores, often in close proximity. However, they are not in direct competition, nor are they strictly complementary. Overall, I find these goods to be of medium similarity. I make the same finding for the applicant's "Artificial tanning preparations", "Concealers", "Eye makeup", "Eyebrow pencils", "Eyeliner", "Eyeshadows", "Face powders", "Foundation", "Lip balm", "Lipstick" and "Tanning preparations".

76. The applicant's "Hair conditioner", "Hair preparations and treatments" and "Shampoo" are similar to the opponent's "Skin care (Cosmetic preparations for -)" in that both are applied to the body by hand, and both are intended to improve the appearance. Both sets of goods also typically come in the form of liquid or gel. However, the applicant's goods are applied to the hair, whereas the opponent's goods are applied to the skin. Both are sold through pharmacies, albeit they would not be shelved together. They are not in competition, nor are they complementary. Overall, I find these goods to be of a low level of similarity.

77. The applicant's "Adhesives for cosmetic use" and "False eyelashes" are temporarily applied to the body for cosmetic purposes, the adhesives also being used for false nails. Their natures and methods of use differ from the opponent's "Skin care (Cosmetic preparations for -)". They are not in competition, nor are they complementary. I do not consider their very broad purpose of improving the appearance and the fact that both sets of goods could be found in a pharmacy to be a sufficient basis for a finding of similarity and I find these goods to be dissimilar.

78. I compare the applicant's "Essential oils and aromatic extracts" and "Essential oils" with the opponent's "Skin care (Cosmetic preparations for -)". These goods can be an ingredient in skin care preparations with a view to them providing a pleasant sensation or aroma, but I remind myself that ingredients are not complementary on the grounds that one is used in the manufacture of another: "... raw materials subject to a transformation process are essentially different from the finished

products which incorporate, or are covered by, those raw materials...”.<sup>4</sup> As such, the goods differ in that the applicant’s goods are ingredients and the opponent’s goods are finished products. Furthermore, essential oils and aromatic extracts have other uses that bear no relation to skin care, such as being burnt in a diffuser for the purposes of aromatherapy. The applicant’s goods may not be sold in close proximity to those of the opponent and could also be sold through entirely separate trade channels. The goods are also not in competition and, overall, I find them to be dissimilar.

79. The applicant’s “Tooth whitening preparations” and “Toothpaste” have different methods of use to the opponent’s “Skin care (Cosmetic preparations for -)” and are applied to different parts of the body. They are not in competition, nor are they complementary. I do not consider their very broad purpose of improving the appearance and the fact that both sets of goods could be found in a pharmacy (but would not be shelved in close proximity) to be a sufficient basis for a finding of similarity and I find these goods to be dissimilar.

### Class 35

80. The opponent’s “advertising ...” services are identical to the applicant’s “Advertising services” and “Advertising”.

81. The opponent’s “Publicity” services are identical to the applicant’s “Publicity services”.

82. The opponent’s “Marketing” services are identical to the applicant’s “Marketing services”.

83. The opponent’s “On-line advertising on a computer network” is identical to the applicant’s “Online advertising on a computer network”.

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<sup>4</sup> T-288/12 *El du Pont de Nemours and Company v OHIM*, paragraph 43

84. The opponent's "Procurement services for others [purchasing goods and services for other businesses]" is identical to the applicant's "Procurement of goods on behalf of other businesses".
85. The opponent's "advertising ..." services are *Merit* identical to the applicant's "Business advertising services relating to franchising", "Dissemination of advertisements", "Dissemination of advertising matter online" and "Online advertisements."
86. The opponent's "Sales promotion for others" is *Merit* identical to the applicant's "Administration of loyalty rewards programs" and "Promoting the goods and services of others by means of a loyalty rewards card scheme".
87. The opponent's "Publicity" services are highly similar to the applicant's "Advisory services relating to publicity for franchisees".
88. The applicant's "Public relations services" improve a company's image by evaluating how it is currently viewed and then seeking to present the company and its products in a favourable light via paid advertising or press releases. Consequently, these services are similar to the opponent's "Marketing" services as they overlap in their nature, method of delivery, and purpose. The services are highly similar.
89. I compare the opponent's "Procurement services for others [purchasing goods and services for other businesses]" with the applicant's generic business management services. The purpose of these services is to help companies in the day-to-day running of their businesses. I consider there to be an overlap in nature and purpose with the opponent's services since procurement is a core activity of running a business. The channels of trade may be the same and the services target the same end consumer – standalone businesses or franchisees. On that basis, I consider there to be a medium level of similarity in respect of "Business administration services", "Business advisory services", "Business consultancy services", "Business management" and "Office functions" and in respect of "Administration of the business affairs of franchises", "Advice in the running of

establishments as franchises”, “Assistance in business management within the framework of a franchise contract”, “Assistance in franchised commercial business management”, “Business advice and consultancy relating to franchising”, “Business advice relating to franchising”, “Business advisory services relating to franchising”, “Business advisory services relating to the establishment and operation of franchises”, “Business assistance relating to franchising”, “Business assistance relating to the establishment of franchises”, “Business consultancy in relation to franchising”, “Business management advisory services relating to franchising”, “Business management assistance in the field of franchising”, “Dissemination of business information”, “Dissemination of commercial information”, “Management advisory services related to franchising”, “Providing assistance in the field of business management within the framework of a franchise contract”, “Providing assistance in the management of franchised businesses”, “Provision of business advice relating to franchising”, “Provision of business information relating to franchising” and “Services rendered by a franchisor, namely, assistance in the running or management of industrial or commercial enterprises.”

90. I compare the opponent’s “Marketing” services with the applicant’s “Assistance in product commercialization, within the framework of a franchise contract” and “Providing assistance in the field of product commercialization within the framework of a franchise contract”. Marketing is an integral part of product commercialisation and given that the services are both aimed at businesses, which include franchisees, there would be some overlap of trade channels. Overall, I find the services to be of a medium level of similarity.

91. I compare the opponent’s “An online marketplace for buyers and sellers of goods and services” with the applicant’s “Electronic order processing”, “Online ordering services” and “Ordering services for third parties”. The applicant’s services are provided to a retailer so that consumers can purchase its goods securely, with orders being logged accurately and goods being successfully delivered in a timely manner. An online marketplace was originally offered for the benefit of individual buyers and individual sellers, but nowadays it is not unknown for businesses to place their goods on such marketplaces. Goods are ordered securely from sellers such that the order is logged accurately, and the seller is provided with the

necessary information for them to fulfil the order successfully and in a timely manner. As such, the respective services share some characteristics in terms of nature, purpose and method of use. The services are not complementary, but there are shared trade channels and a degree of competition as retailers seek different ways of getting support with processing orders. Overall, I consider the respective services to be similar to a medium degree at most.

92. I compare the opponent's "An online marketplace for buyers and sellers of goods and services" with the applicant's "Retail services, wholesale services, mail order services or internet retailing services in relation to ...". The opponent's term is a broad term with no limitation as to the goods and services available through the online marketplace, whereas the applicant's services relate to specific goods. An online marketplace was originally offered for the benefit of individual buyers and individual sellers, but nowadays it is not unknown for businesses to place their goods on such marketplaces and for those goods to be available at a discount for bulk purchase. As such, both the opponent's and the applicant's services provide a convenient basis for the purchase of goods, and they share some characteristics in terms of nature, purpose and method of use. The trade channels only overlap where the applicant's services are internet-based. The services are not complementary, but they are in competition as between a buyer choosing to purchase goods direct or via a marketplace platform. Overall, I consider the respective services to be similar to a medium degree at most for those day-to-day goods specified by the applicant as follows:

"... Adhesives for cosmetic use, Artificial tanning preparations, Baby oils, Baby wipes, Bath and shower gels, Bath preparations, Beauty creams, Body cleaning and beauty care preparations, Body wash, Collagen for cosmetic purposes, Concealers, Cosmetic skin enhancers, Cosmetics, Essential oils and aromatic extracts, Essential oils, Exfoliants, Eye makeup, Eyebrow pencils, Eyeliner, Eyeshadows, Face powders, Face wash, Facial cleansers, False eyelashes, Foundation, Hair conditioner, Hair preparations and treatments, Hand washes, Lip balm, Lipstick, Make-up removing preparations, Make-up, Makeup, Massage oil, Moisturizer, Non-medicated skincare preparations, Shampoo, Skin care

cosmetics, Soap, Tanning preparations, Toiletries, Tooth whitening preparations, Toothpaste, Dietary supplements, Medicated skin care preparations, Mineral supplements, Natural remedies, Skin care lotions [medicated], Vitamin supplements, Massage appliances”.

93. However, where the applicant has specified goods that are subject to regulatory oversight of some sort, I do not consider these goods to be typically sold on marketplace platforms and so the applicant’s retail and wholesale services of these goods are dissimilar to the opponent’s Class 35 services as follows:

“... Collagen for medical purposes, Implants comprising living tissue, Injectable dermal fillers, Pharmaceuticals, Artificial implants, Breast implants, Implants [prosthesis], Medical apparatus, Medical devices, Medical implants, Medical instruments, Prosthetic implants, Prosthetics and artificial implants, Silicone preparations for cosmetic implantation, Surgical and wound treating equipment, Suture and wound closing materials and products, Parts for the aforesaid, Fittings for the aforesaid, Accessories for the aforesaid”.

94. For completeness, I should also say that I consider the applicant’s retail and wholesale services in respect of the above goods to be dissimilar to the opponent’s Class 3 goods.

95. I make the same findings as above in respect of the applicant’s information, advice and consultancy services relating to each of its Class 35 services.

#### Class 44

96. The opponent’s “Skin care (Cosmetic preparations for -)” and “Beauty masks” and the applicant’s beauty services are provided through the same trade channels to the same users. It is not uncommon for beauty salons and spas to sell both the services and the goods that they use in the course of providing those services. The goods and the services are complementary, and they are in competition as between a consumer choosing to purchase and apply the opponent’s goods

themselves at home or choosing to have them applied by a beauty therapist. As such, I find the following of the applicant's services to be of a medium level of similarity:

"Advice relating to cosmetics; Anti-wrinkle treatments; Beautician services; Beauty consultancy; Beauty consultation; Consultation services relating to skin care; Cosmetic facial and body treatment services; Cosmetic treatment services; Cosmetics consultancy services; Dermatological services for treating skin conditions; Facial beauty treatment services; Facial treatment services; Health spa services for health and wellness of the body and spirit; Human hygiene and beauty care; Services for the care of the skin; Skin care salons".

97. While the opponent's goods are not strictly complementary to the applicant's "Make-up services", they are often used together with make-up in preparation for its application. Further, the goods and the services are both sold through beauty salons and spas. I also find these services to be of a medium level of similarity.

98. While their method of delivery differs by comparison with that of the opponent's goods, I find the following of the applicant's non-surgical services to be of low similarity, all sharing trade channels and being in competition to a limited extent, and all being applied to the skin with a view to improving its appearance:

"Cosmetic laser treatment of skin; Dermal filling services; Injectable filler treatments for cosmetic purposes; Laser skin rejuvenation services; Laser skin tightening services; Light therapy services; Microneedling treatment services".

99. The applicant's "Permanent makeup services" and "Semi-permanent makeup services" also differ in terms of their method of delivery by comparison with that of the opponent's goods, but further differ in that they are permanent or semi-permanent as opposed to temporary, and they are not intended to improve the appearance of the skin. These services are dissimilar.

100. I find applicant's surgical services, carried out by medical professionals, to be dissimilar to the opponent's Class 3 goods as follows:

"Consultancy services relating to prosthetic implants; Cosmetic and plastic surgery clinic services; Cosmetic surgery services; Dental surgery; Liposuction services; Plastic surgery services."

101. I make the same finding for the applicant's general healthcare and medical services:

"Healthcare services; Human healthcare services; Medical advisory services; Medical services".

102. The fact that both the opponent's Class 3 goods and the applicant's services in respect of hair are aimed at improving one's appearance is not a sufficient basis for a finding of similarity. The following services are dissimilar to the opponent's goods:

"Cosmetic laser treatment of unwanted hair; Hair implantation; Hair replacement; Hair restoration; Hair styling; Hair treatment; Haircare services."

103. I make the same findings as above in respect of the applicant's information, advice and consultancy services relating to each of its Class 44 services.

104. As some degree of similarity between the goods and services is required for there to be a likelihood of confusion,<sup>5</sup> the opposition must fail in respect of the following goods and services in the applicant's specification:

Class 3 Adhesives for cosmetic use; Essential oils and aromatic extracts; Essential oils; False eyelashes; Tooth whitening preparations; Toothpaste.

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<sup>5</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Class 35 Retail services, wholesale services, mail order services or internet retailing services in relation to Collagen for medical purposes, Implants comprising living tissue, Injectable dermal fillers, Pharmaceuticals, Artificial implants, Breast implants, Implants [prosthesis], Medical apparatus, Medical devices, Medical implants, Medical instruments, Prosthetic implants, Prosthetics and artificial implants, Silicone preparations for cosmetic implantation, Surgical and wound treating equipment, Suture and wound closing materials and products, Parts for the aforesaid, Fittings for the aforesaid, Accessories for the aforesaid; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

Class 44 Consultancy services relating to prosthetic implants; Cosmetic and plastic surgery clinic services; Cosmetic laser treatment of unwanted hair; Cosmetic surgery services; Dental surgery; Hair implantation; Hair replacement; Hair restoration; Hair styling; Hair treatment; Haircare services; Health advisory services; Healthcare services; Human healthcare services; Liposuction services; Medical advisory services; Medical services; Permanent makeup services; Plastic surgery services; Semi-permanent makeup services; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

### **Average consumer and the purchasing act**

105. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

106. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 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:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

107. For the Class 3 goods that are in conflict – skincare products, make-up related goods, haircare products, and massage oil – they require some consideration on the part of the average consumer, a member of the public, as to their properties and price that they are more than just impulse buys. As such, I consider that the level of attention paid during the purchasing process for these goods would be of a medium level. The purchasing process would be primarily a visual one as goods are selected virtually or from the shelves of a pharmacy, but I do not rule out verbal factors coming into play should the consumer require advice from a shop assistant.

108. For some of the Class 35 services that are in conflict – advertising, general business services and order processing – the typical consumer is a businessperson, and the level of attention paid would be medium. Marketplace platforms and retail and wholesale services would be used by both members of the public and businesspeople, again at a medium level of attention. In these cases, visual factors would predominate during the purchasing process, with verbal considerations playing a part where the purchase involved follow up queries.

109. The typical consumer for the Class 44 services at issue – beauty services and non-surgical skin treatments – is a member of the public who will pay close attention to the precise nature of these services and so the level of attention will be

at least medium. Verbal factors will be important during the purchasing process, but verbal factors will also play a key role where beauticians are asked about specific aspects of their services.

### Comparison of the marks

110. The trade marks at issue are:

The opponent's marks	The applicant's mark
The first earlier mark  <b>DR·RASHEL</b>	<b>DR RASHA</b>
The second earlier mark  <b>DR·RASHEL</b>	

### Overall impression

111. The opponent's marks are identical, consisting of the two letters "DR" followed by the word "RASHEL", both elements being in block capitals with an Art Deco-style font. The two elements of the mark are separated by a dot which simply serves to demarcate them. I will find later in this decision that the two letters will be seen by the average consumer as an abbreviation for the word "DOCTOR" followed by the surname "RASHEL". On that basis, they would see the opponent's mark as a unit in line with the example set out at paragraph 20 of *White & Mackay* "...where the meaning of one of the components is qualified by another component,

as with a surname and a first name (e.g. BECKER and BARBARA BECKER),”<sup>6</sup> in this case the surname being qualified by the abbreviation “DR”. The overall impression made by the mark lies overwhelmingly in that unit, the stylised font and the demarcating dot making a very minor contribution.

112. The applicant’s mark is a plain word mark that consists of the two letters “DR” followed by the word “RASHA”, both elements being in block capitals. I will find later in this decision that the two letters will be seen by the average consumer as an abbreviation for the word “DOCTOR” followed by the surname “RASHA”. On that basis, they would see the applicant’s mark as a unit per *White & Mackay*, in this case the surname being qualified by the abbreviation “DR”. The overall impression made by the mark lies in that unit.

#### Visual comparison

113. Visually, the principles of normal and fair use would allow the applicant’s plain word mark to be rendered in a highly similar font to that of the opponent’s marks. The marks share the identical abbreviation “DR” and the next four letters in the words in the marks are identical, being “RASH-”. Therefore, the marks only differ in terms of their endings, being “-EL” and “-A”, and the addition of the demarcating dot in the opponent’s marks. Given that they read from left to right, it is widely recognised that the average consumer pays more attention to the beginnings of marks than to the ends. Overall, I find that the marks are highly similar visually.

#### Aural comparison

114. Aurally, the marks are pronounced “DOCTOR RASH-EL” versus “DOCTOR RASH-AH”. They are highly similar aurally.

#### Conceptual comparison

115. The applicant has filed evidence (at paragraphs 3 and 4 of Bernard Whyatt’s witness statement with supporting exhibits Figures 1 to 18) to show that Rasha and

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<sup>6</sup> *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] FSR 33

Rashel are female forenames, including that these names are respectively of Arabic and Hebrew origin.

116. In the opponent's submissions, the opponent says, at paragraph 15, that "... it is submitted that an Arabic or Hebrew etymological meaning would not be understood by the average UK consumer because the average UK consumer does not speak Arabic or Hebrew."

117. The opponent goes on to say:

16. Furthermore, paragraphs 3 and 4 of the Witness Statement of Bernard Whyatt imply that both "Rasha" and "Rashel" are feminine names originating with a foreign language. This conceptual interpretation would only increase the similarity between the Application Mark and the Earlier Marks '366 and '907 in the mind of the average UK consumer.
17. Page 3 of Figure 1 shows that the name "Rasha" has variations such as "Rashad", "Ra'shawn", and "Rashard". Therefore, it is submitted that, contrary to the Applicant's assertion that the marks in question are not similar, similar names to "Rasha" contain the root "Rash" with varying endings; "Rashel" would therefore be perceived as similar to "Rasha" on this basis.
18. It is submitted that evidence of the existence of people around the world with the names "Rasha" or "Rashel" has no relevance to these proceedings as, further to Case C-404/02 *Nichols plc*, names are to be assessed for similarity in the same manner as other trademarks.
19. Additionally, it is submitted that many of the Figures relate to countries other than the UK and are therefore irrelevant to these proceedings, as follows.
  - e. Figure 4 shows trademarks which designate Brazil, Canada, Japan, and the USA, as well as one international registration with unknown designations.
  - f. Figure 6 references people in Sudan, Syria, Egypt, Lebanon, the UAE, Kuwait, the USA, Germany, Canada, Beirut, and Palestine.
  - g. Figure 8 shows an Indian socialite and an Arabian-Indian actor.
  - h. Figure 15 appears to feature a person from Bangladesh, and Figure 17 shows people in Albania and Mexico.
20. It is submitted that the allegedly popular people of Figures 8 and 15 would not be widely known in the UK and, therefore, no added distinctiveness can be afforded to the Application Mark on this account.

118. While I do not doubt the veracity of the applicant's evidence as to the origins of the names Rasha and Rashel and as to instances of the usage of those names, I do not consider that either name would be known to the average UK consumer as female forenames. On encountering the marks, the average UK consumer, noting

the prefix “DR”, would consider “RASHEL” and “RASHA” to be surnames, but not surnames that they recognise as being in common usage in the UK.

119. I remind myself that Philip Harris, sitting as the Appointed Person in *Georgine Ratelband v Walmart Apollo, LLC* (BL O/1212/23) considered the question of the conceptual comparability of names. He held that conceptual comparison between names is perfectly possible, even where the names do not give rise to a concept over and above that of their being recognised as names.

120. Both the opponent’s marks and the applicant’s mark give rise to the concept of doctors whose surnames are not recognised by the average UK consumer as being in common usage in the UK. I consider the marks to be conceptually similar to a medium degree.

#### **Distinctive character of the earlier trade marks**

121. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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).”

122. Registered trade marks possess varying degrees of inherent distinctive character, being lower where 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 distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

123. In respect of the first earlier mark and the opponent’s Class 3 skincare goods, the earlier mark is mildly suggestive of these goods, hinting at there being some medical expertise behind the formulation of the opponent’s products. However, the second earlier mark is not suggestive of the Class 35 services for which it is registered. Nevertheless, the name “DR RASHEL” is uncommon, and I find both marks to be of a medium level of inherent distinctiveness.

124. I will now assess whether the evidence before me is sufficient to justify giving the first earlier mark an enhanced level of distinctiveness. I remind myself that the requirement for a finding of an enhanced level of distinctive character is considerably more onerous than that of what needs to be established for a finding of genuine use: a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking.

125. The opponent has provided no evidence as to marketing expenditure, nor has it furnished me with any information as to the size of the UK cosmetics market or as to its market share. The likes and viewership of its UK Instagram account posts are very small.

126. In the paragraph with the table setting out annual sales, which exceed a quarter of a million pounds for each of the years covered by the relevant period, Li Yulan does not explicitly state that these sales were made in the United Kingdom. However, the preceding and succeeding paragraphs of the witness statement refer to economic activity in the United Kingdom and Li Yulan attests to the opponent's mark having been first used in the UK in 2020 and having been used in the UK for all of its goods in all parts of the United Kingdom.

127. I have no proof before me of any individual sales of the opponent's products having been made to end consumers, but there is some evidence of the opponent's products being offered for sale to UK consumers and of wholesale orders having been placed.

128. Overall, I do not consider the evidence before me to justify a finding of an enhanced level of distinctiveness for the first earlier mark such that it would be at a higher level than the medium level that I have found to be inherent.

### **Likelihood of confusion**

129. 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 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

130. Except where I have found the goods and services to be dissimilar, they range from being of low similarity to being identical.
131. I have found the marks to be highly similar visually and aurally, and conceptually similar to a medium degree.
132. I have found the earlier marks to possess a medium level of inherent distinctive character, the evidence before me not justifying a finding of enhanced distinctive character.
133. The level of attention paid by the average consumer would be of a medium level for the Class 3 goods and Class 35 services, with visual factors predominating and verbal considerations playing a part. For the Class 44 services, the level of attention paid would be at least medium, with verbal factors being important, but verbal factors playing a key role where beauticians are asked about specific aspects of their services.
134. The principles of normal and fair use would allow the applicant's plain word mark to be rendered in a highly similar font to that of the opponent's marks. The marks share the identical abbreviation "DR" and the next four letters in the words in the marks are identical, being "RASH-". Therefore, the marks only differ in terms of their endings, being "-EL" and "-A", and the addition of the relatively insignificant demarcating dot in the opponent's marks.
135. Given that they read from left to right, it is widely recognised that the average consumer pays more attention to the beginnings of marks than to the ends. On encountering the marks, the average UK consumer, whether a member of the public or a businessperson, noting the prefix "DR" (which they would take to be an abbreviation for the word "DOCTOR") would consider "RASHEL" and "RASHA" to be surnames, but not surnames that they recognise as being in common usage in the UK. Noting 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, the marks could very easily be mis-recalled and so there is a likelihood of direct confusion. This is the case

even where the level of attention paid during the purchasing process is at least medium and my finding applies to all of the goods and services that I have found to be similar to any degree.

## **CONCLUSION**

136. Subject to appeal, the opposition has succeeded in relation to the following goods and services, for which the application is refused:

Class 3 Artificial tanning preparations; Baby oils; Baby wipes; Bath and shower gels; Bath preparations; Beauty creams; Body cleaning and beauty care preparations; Body wash; Collagen for cosmetic purposes; Concealers; Cosmetic skin enhancers; Cosmetics; Exfoliants; Eye makeup; Eyebrow pencils; Eyeliner; Eyeshadows; Face powders; Face wash; Facial cleansers; Foundation; Hair conditioner; Hair preparations and treatments; Hand washes; Lip balm; Lipstick; Make-up removing preparations; Make-up; Makeup; Massage oil; Moisturizer; Non-medicated skincare preparations; Shampoo; Skin care cosmetics; Soap; Tanning preparations; Toiletries.

Class 35 Administration of loyalty rewards programs; Administration of the business affairs of franchises; Advertising services; Advertising; Advice in the running of establishments as franchises; Advisory services relating to publicity for franchisees; Assistance in business management within the framework of a franchise contract; Assistance in franchised commercial business management; Assistance in product commercialization, within the framework of a franchise contract; Business administration services; Business advertising services relating to franchising; Business advice and consultancy relating to franchising; Business advice relating to franchising; Business advisory services relating to franchising; Business advisory services relating to the establishment and operation of franchises; Business advisory services; Business assistance relating to franchising; Business assistance relating to the establishment of franchises; Business consultancy in relation to

franchising; Business consultancy services; Business management advisory services relating to franchising; Business management assistance in the field of franchising; Business management; Dissemination of advertisements; Dissemination of advertising matter online; Dissemination of business information; Dissemination of commercial information; Electronic order processing; Management advisory services related to franchising; Marketing services; Office functions; Online advertisements; Online advertising on a computer network; Online ordering services; Ordering services for third parties; Procurement of goods on behalf of other businesses; Promoting the goods and services of others by means of a loyalty rewards card scheme; Providing assistance in the field of business management within the framework of a franchise contract; Providing assistance in the field of product commercialization within the framework of a franchise contract; Providing assistance in the management of franchised businesses; Provision of business advice relating to franchising; Provision of business information relating to franchising; Public relations services; Publicity services; Services rendered by a franchisor, namely, assistance in the running or management of industrial or commercial enterprises; Retail services, wholesale services, mail order services or internet retailing services in relation to Adhesives for cosmetic use, Artificial tanning preparations, Baby oils, Baby wipes, Bath and shower gels, Bath preparations, Beauty creams, Body cleaning and beauty care preparations, Body wash, Collagen for cosmetic purposes, Concealers, Cosmetic skin enhancers, Cosmetics, Essential oils and aromatic extracts, Essential oils, Exfoliants, Eye makeup, Eyebrow pencils, Eyeliner, Eyeshadows, Face powders, Face wash, Facial cleansers, False eyelashes, Foundation, Hair conditioner, Hair preparations and treatments, Hand washes, Lip balm, Lipstick, Make-up removing preparations, Make-up, Makeup, Massage oil, Moisturizer, Non-medicated skincare preparations, Shampoo, Skin care cosmetics, Soap, Tanning preparations, Toiletries, Tooth whitening preparations, Toothpaste, Dietary supplements, Medicated skin care preparations, Mineral supplements, Natural remedies, Skin care lotions [medicated],

Vitamin supplements, Massage appliances, Parts for the aforesaid, Fittings for the aforesaid, Accessories for the aforesaid; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

Class 44 Advice relating to cosmetics; Anti-wrinkle treatments; Beautician services; Beauty consultancy; Beauty consultation; Consultation services relating to skin care; Cosmetic facial and body treatment services; Cosmetic laser treatment of skin; Cosmetic treatment services; Cosmetics consultancy services; Dermal filling services; Dermatological services for treating skin conditions; Facial beauty treatment services; Facial treatment services; Health spa services for health and wellness of the body and spirit; Human hygiene and beauty care; Injectable filler treatments for cosmetic purposes; Laser skin rejuvenation services; Laser skin tightening services; Light therapy services; Make-up services; Microneedling treatment services; Services for the care of the skin; Skin care salons; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

137. The application will proceed to registration in respect of the following goods and services:

Class 3 Adhesives for cosmetic use; Essential oils and aromatic extracts; Essential oils; False eyelashes; Tooth whitening preparations; Toothpaste.

Class 35 Retail services, wholesale services, mail order services or internet retailing services in relation to Collagen for medical purposes, Implants comprising living tissue, Injectable dermal fillers, Pharmaceuticals, Artificial implants, Breast implants, Implants [prosthesis], Medical apparatus, Medical devices, Medical implants, Medical instruments, Prosthetic implants, Prosthetics and artificial implants, Silicone preparations for cosmetic implantation, Surgical and wound treating equipment, Suture and wound closing materials and products, Parts for

the aforesaid, Fittings for the aforesaid, Accessories for the aforesaid; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

Class 44 Consultancy services relating to prosthetic implants; Cosmetic and plastic surgery clinic services; Cosmetic laser treatment of unwanted hair; Cosmetic surgery services; Dental surgery; Hair implantation; Hair replacement; Hair restoration; Hair styling; Hair treatment; Haircare services; Health advisory services; Healthcare services; Human healthcare services; Liposuction services; Medical advisory services; Medical services; Permanent makeup services; Plastic surgery services; Semi-permanent makeup services; Information relating to the aforesaid; Advice relating to the aforesaid; Consultancy services relating to the aforesaid.

## **COSTS**

138. The opponent has been the more successful of the two parties and is entitled to a proportionate award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 1 of 2023. Applying the guidance in the TPN, I consider the following to be fair:

Official fees:	£100
Preparing a statement and considering the other side’s statement:	£250
Preparing evidence and considering and commenting on the other side’s evidence:	£800
Preparation of submissions:	£350
<b>Total:</b>	<b>£1500</b>

139. I therefore order DR RASHA CLINIC LONDON LTD to pay YIWU RASHEL TRADING CO. LTD the sum of £1500. This 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 30<sup>th</sup> day of December 2025**

**John Williams**  
**For the Registrar**