# O/0857/25

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003886742**

**BY JOANNA KOMISARCZYK**

**TO REGISTER THE TRADE MARK:**


**IN CLASS 44**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 441364**

**BY LAURA MOCANU**

## BACKGROUND AND PLEADINGS

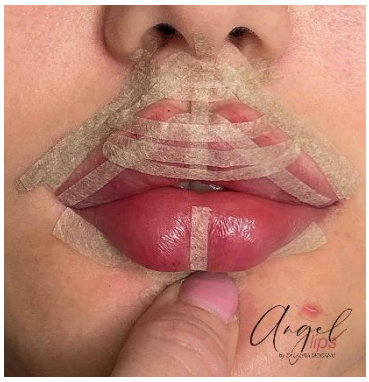
1. On 8 March 2023, Joanna Komisarczyk ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 21 April 2023. The applicant seeks registration for the following services under the above application:

Class 44 Beauty care services, namely lip enhancement using tape.

2. The application was opposed in full by Laura Mocanu ("the opponent") on 15 June 2023 based upon sections 5(2)(b) and 3(6) of the Trade Marks Act ("the Act").

3. Under section 5(2)(b), the opponent relies upon the following trade marks:

UK registration no. UK00003857372
Filing date 8 December 2022; Registration date 3 March 2023.
**("The First Earlier Mark")**



UK registration no. UK00003857320
Filing date 8 December 2022; Registration date 2 June 2023.
**("The Second Earlier Mark")**

4. The opponent relies upon all of the services for which both of the earlier marks are registered, namely:

Class 35 Advertising; advertising in all forms and media; making advertising clips; scheduling services; posting of advertising posters; organisation of exhibitions for commercial or advertising purposes; the presentation of products in the media for retail marketing purposes.

Class 41 Education and training services; Training in the art of beautification (training); training services on injection and lip reconstruction techniques; organisation of conferences, symposia and seminars in the field of aesthetics and beauty; training of specialised personnel in human facial aesthetic care (training); organisation and support of training courses on facial beauty services.

Class 44 Plastic surgery; Cosmetic dentistry; Cosmetic and plastic surgery; Cosmetic and plastic surgery clinic services; beauty services for people; Beauty consultancy; Advisory services relating to beauty treatment; beauty treatment services, especially for the lips.

5. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are "confusingly similar" and the services are identical.

6. Under section 3(6), the opponent claims that the application was filed in bad faith on the basis that the applicant "was aware of the activities of the opponent" as they were a student of the opponent in November 2022, which was during a time that the opponent asserted their trade mark rights. As part of the condition of attending the masterclass, the applicant signed an agreement not to use the opponent's marks without their consent. The opponent therefore submits that the "applicant is knowingly attempting to obtain a registration of a mark confusingly similar to that of the opponent

to cause confusion in the marketplace, which the opponent believes is in breech [sic] of the agreement between the opponent and the applicant, which was signed by the applicant on the 15 November 2022".

7. The applicant filed a counterstatement denying the claims made.

8. The opponent is represented by Alpha & Omega and the applicant is unrepresented. Neither party requested a hearing, however, both parties filed evidence in chief. I note that neither party provided written submissions or submissions in lieu of a hearing. I make this decision having taken full account of all the papers.

9. 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**

10. The opponent's evidence includes the witness statement of Dr Laura Mocanu dated 20 May 2024, and her statement is accompanied by 5 exhibits (lm1-lm5).

11. The opponent's evidence also includes the witness statement of Michael Stanley Brown of Alpha & Omega dated 20 May 2024. His statement is not accompanied by any exhibits, but has been filed to draw my attention to a submission made in the applicant's counterstatement.

12. The applicant's evidence consists of the witness statement of Joanna Komisarczyk dated 12 July 2024 and her statement is accompanied by 8 exhibits (JK1-JK8).

13. Whilst I do not propose to summarise it here, I have taken all of the evidence into consideration in reaching my decision and will refer to them where necessary below.

**DECISION**

**Section 5(2)(b)**

14. Section 5(2)(b) reads 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."

15. Due to their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. The earlier marks had not completed their registration process more than five years before the relevant date (the filing date of the applicant's mark). Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the services it has identified without demonstrating that it has used the marks.

**Section 5(2)(b) - case law**

16. In making this decision, I bear in mind the following principles 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 services**

17. The competing services are as follows:

| **Opponent's services** | **Applicant's services** |
|---|---|
| Class 35<br>Advertising; advertising in all forms and media; making advertising clips; scheduling services; posting of advertising posters; organisation of exhibitions for commercial or advertising purposes; the presentation of products in the media for retail marketing purposes.<br><br>Class 41<br>Education and training services; Training in the art of beautification (training); training services on injection and lip reconstruction techniques; organisation of conferences, symposia and seminars in the field of aesthetics and beauty; training of specialised personnel in human facial aesthetic care (training); | Class 44<br>Beauty care services, namely lip enhancement using tape. |

| | |
|---|---|
| organisation and support of training courses on facial beauty services.<br><br><u>Class 44</u><br>Plastic surgery; Cosmetic dentistry; Cosmetic and plastic surgery; Cosmetic and plastic surgery clinic services; beauty services for people; Beauty consultancy; Advisory services relating to beauty treatment; beauty treatment services, especially for the lips. | |

18. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

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

19. I find that the applicant's class 44 "beauty care services, namely lip enhancement using tape" would fall within the broader categories of "beauty services for people" and "beauty treatment services, especially for the lips" in the opponent's First and Second Earlier Marks class 44 specification. The services are identical on the principle outlined in *Meric.*

**The average consumer and the nature of the purchasing act**

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

*Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

21. The average consumer for the services will be members of the general public. The cost of the services in question is likely to vary. Whilst the beauty services can cover cosmetic surgery procedures, as it only pertains to the lips which is a smaller area of the face, the cost of the services is not likely to be at the very highest end of the scale. The frequency of purchase is also likely to vary. Nonetheless, the average consumer will take various factors into consideration, such as the cost, the location, reputational standing of the provider and the suitability of the services for their specific needs. I also bear in mind that the parties' beauty services are used to enhance the user's appearance. Therefore, the level of attention paid during the purchasing process for the services will be at least a medium degree.

22. The services may be purchased following perusal of advertisements or signage on physical premises of a beautician or an aesthetician clinic. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a beautician or aesthetician, or via word-of-mouth recommendations.

**Comparison of the trade marks**

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

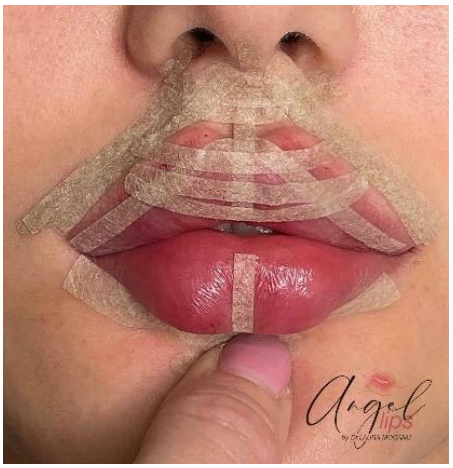
impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

25. The respective trade marks are shown below:

| **Opponent's trade marks** | **Applicant's trade mark** |
|---|---|
|  **("The First Earlier Mark")** |   |

| | |
|---|---|
|  <br><br>**("The Second Earlier Mark")** | |

Overall impression

26. The First Earlier Mark consists of a vertical image of a human pair of lips which have thin beige pieces of tape that fully surround them, as well as a piece of tape going vertically down both the top and bottom lip to the centre of the chin. On the vertical piece of tape on the bottom lip is a golden butterfly. On the top lip are 2 pieces of tape placed diagonally from the inner corner of the lips to the centre piece of vertical tape at the cupid's bow, with another 4 pieces of tape fanning across the top part of the lip, pushing it upwards. I also note that there 2 pieces of tape which curve from the outer point of the nostrils, dipping towards the cupid's bow. I find that the overall impression lies in the combination of these elements.

27. The Second Earlier Mark consists of a vertical image of a human pair of lips which have thin pieces of tape that fully surround them, as well as a piece of tape going vertically from the septum, down both the top and bottom lip. At the bottom of the vertical piece of tape is a finger placed underneath the bottom lip. On the top lip, are 3 pieces of tape placed horizontally across it, with two pieces of tape placed diagonally from the inner corner of the lip to the cupid's bow, all of which push the lip upwards. I

also note that there are 2 pieces of tape which curve from the outer point of the nostrils, dipping towards the cupid's bow. At the bottom right hand side of the image are the words "angel lips", with a depiction of a pink pair of lips above the letter "g". I note that there appears to be wording underneath the words "angel lips", however, as the words are quite small I am unable to read them. I find that the use of the words "angel lips" alongside the depiction of the taped lips means that the average consumer will understand that the mark as conveying that the taped lips are "angel lips" (that this is the name of the lips or this is how angel lips look). I also bear in mind that although the eye is naturally drawn to the element of the mark that can be read, given the size and positioning of the taped lips, I consider that the lips plays an equal role in the overall impression of the mark with the words "angel lips".

28. The applicant's mark consists of a horizontal image of a human pair of lips (angled in a diagonal manner) which have thin beige pieces of tape that fully surround them, as well as a piece of tape going vertically from the septum down both the top and bottom lip, to the chin. On the top lip are 2 pieces of tape placed diagonally from the inner corner of the lips to the centre piece of vertical tape at the cupid's bow, with two pieces of tape on top, stacked on top of one another, going diagonally across the top lip, all of which push the lip upwards. I also note that there are 2 pieces of tape which curves from the outer point of the nostrils, dipping towards the cupid's bow. On the bottom right hand side of the mark are the words "Lips with tapes technique" presented in a small standard white typeface. I find that this wording describes the depiction of the taped lips, and the applicant's services, that being lip enhancement using tape. Consequently, I find that both elements play an equal role in the overall impression of the mark.

Visual Comparison

*The First Earlier Mark and the applicant's mark*

29. The First Earlier Mark and the applicant's mark both consist of an image of a human pair of lips which are surrounded by thin pieces of tape, as well as a vertical piece of tape going directly down both the top and bottom lip. I also note that the top lips in both of the parties' marks have 2 pieces of tape placed diagonally from the inner

corner of the lips to the centre piece of vertical tape at the cupid's bow. Both marks also consist of 2 pieces of tape which curve from the outer point of the nostrils, dipping towards the cupid's bow. These all act as visual points of similarity. However, I note that there is more tape on the top lip in the First Earlier Mark, with 4 pieces of horizontal tape fanning across the top lip, whereas only 2 horizontal pieces of tape which are stacked on top of one another go diagonally across the applicant's top lip. There is also the golden butterfly on the bottom lip of the First Earlier Mark. I also bear in mind that the applicant's mark includes the wording "Lips with tapes technique", and that the Second Earlier Mark is a vertical picture of taped lips, whereas the applicant's mark is a horizonal picture whereby the lips are presented at a diagonal angle. These therefore all act as visual points of difference. Consequently, I find the marks are visually similar to no more than a medium degree.

*The Second Earlier Mark and the applicant's mark*

30. The Second Earlier Mark and the applicant's marks both consist of an image of a human pair of lips, which are surrounded by thin pieces of tape, as well as a vertical piece of tape going directly down both the top and bottom lip. The top lips in both of the parties' marks have 2 pieces of tape placed diagonally from the inner corner of the lips to the centre piece of vertical tape at the cupid's bow. I also note that both marks consist of 2 pieces of tape which curve from the outer point of the nostrils, dipping towards the cupid's bow. These all act as visual points of similarity. However, I note that there is more tape on the top lip in the Second Earlier Mark, with 3 pieces of tape placed horizontally across it, whereas the applicant's top lip only has 2 horizontal pieces of tape stacked on top of one another, going horizontally across it. The Second Earlier Mark also includes a finger placed underneath the bottom lip, with the wording "angel lips" placed next to it in the bottom right hand corner of the mark, with the depiction of a pink pair of lips. The applicant's mark also includes the wording "Lips with tapes technique" placed at the bottom right hand corner of the mark. Lastly, I bear in mind that the Second Earlier Mark is a vertical picture of taped lips, whereas the applicant's mark is a horizonal picture whereby the lips are presented at a diagonal angle. These all act as visual points of difference. Taking all of the above into account, I find that the marks are visually similar to no more than a medium degree.

Aural Comparison

*The First Earlier Mark and the applicant's mark*

31. I note that in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, the GC stated:

> "46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks."

32. I therefore find that the First Earlier Mark cannot be articulated. I also find that the depiction of the taped lips in the applicant's mark cannot be articulated. However, the wording "Lips with tapes technique" will be given their ordinary dictionary pronunciation in the applicant's mark. On this basis, I find the marks are aurally dissimilar.

*The Second Earlier Mark and the applicant's mark*

33. The only elements that can be articulated in the parties' marks is the words "angel lips" in the Second Earlier Mark and the words "Lips with tapes technique" in the applicant's mark. Therefore the marks only overlap in the word "lips", which I bear in mind have different placements within the sentences (the beginning vs the end). On this basis, I find that the marks are aurally similar, but only to a low degree.

Conceptual Comparison

*The First Earlier Mark and the applicant's mark*

34. Conceptually, the First Earlier Mark evokes a pair of lips which have been taped in a particular shape, fanning the top lip, pushing it upwards, creating an enlarged

effect. The golden butterfly also adds to the conceptual meaning of the mark. The applicant's mark also evokes a pair of lips which have been taped in a particular shape, creating an enlarged effect. This alongside the words "Lips with tapes techniques" evokes a meaning that the tapes are a technique, most likely used to make the lips look bigger. Therefore, on the basis that both marks evoke the meaning of a taped pair of lips, I find that they are conceptually similar to between a medium and high degree.

*The Second Earlier Mark and the applicant's mark*

35. Conceptually, the Second Earlier Mark evokes a pair of lips which have been taped in a particular shape, pushing the top lip upwards, creating an enlarged effect. As this is presented alongside the wording "angel lips", I find that the average consumer will view this as the name of the taped lips. As noted above, the applicant's mark also evokes a pair of lips which have been taped in a particular way, creating an enlarged effect. This alongside the words "Lips with tapes techniques" evokes a meaning that the tapes are a technique, most likely used to make the lips look bigger. Therefore, again, on the basis that both marks evoke the meaning of a taped pair of lips, I find that they are conceptually similar, but only to a medium degree.

**Distinctive character of the earlier trade marks**

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

37. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and 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.

38. I will begin by assessing the inherent distinctive character of the opponent's First and Second Earlier Marks.

39. As noted above, the First Earlier Mark consists of a pair of taped lips. I note that the tape is placed in a way which enlarges them. I find that taped lips clearly depicts the opponent's "beauty treatment services, especially for the lips". I therefore consider that this element is descriptive of the opponent's services, making it non-distinctive. However, the golden butterfly placed on the lower lip is neither descriptive or allusive of the services. Therefore, bearing in mind that as per *Formula One Licensing BV v OHIM*[1] the earlier mark must be considered to have at least some distinctive character, I find that the mark is inherently distinctive to a very low degree.

40. The Second Earlier mark also consists of a pair of taped lips alongside the wording "angel lips". As noted above, I find the average consumer will understand the mark as conveying that the name of the taped lips is "angel lips". Again, I find the image of the

[1] Case C-196/11P

taped lips clearly depicts the opponent's "beauty treatment services, especially for the lips" and therefore it is descriptive of the opponent's services, making it non-distinctive. However, as per *Formula One*, the earlier mark must be considered to have at least some distinctive character, and I consider that the distinctiveness of the Second Earlier Mark lies in the wording "angel lips". Nonetheless, I find that the mark is inherently distinctive to a low degree.

41. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

42. In her witness statement, Dr Mocanu has listed her 6 years of studies at medical universities, and has evidence of the qualifications and certifications that she has gained in relation to aesthetics.[2] As a result of her research and practice she innovated "new injection techniques" including the "STRIPP LIPS" injection technique "in order to treat cases of lips with diseases caused by wrong injections, the migration of hyaluronic acid, to restore the shape of the lips".

43. At **exhibit LM4**, Dr Mocanu has provided the following posts from her Instagram account dated 20 September 2021, 16 August 2022 and January 2023:




[2] **Exhibits LM1** and **LM2**

44. The exhibit also includes a screenshot of Dr Mocanu's Instagram following, being 87.2K followers. However, the screenshot is undated and therefore I am unable to determine the amount of followers this page had at the relevant date. I am also unable to determine how many followers were from the UK.

45. The rest of Dr Mocanu's evidence pertains to the bad faith claim, which I will assess in the relevant section later in this decision. It also pertains to 3 further trade marks of taped lips which she has exhibited in **LM3**, however, these marks are not being relied upon under section 5(2)(b) (as they were not listed within the opponent's Form TM7). On this basis, I find that this evidence does not assist the opponent.

46. When providing evidence of enhanced distinctive character, typically parties provide evidence of turnover figures and invoices showing the sale of services to customers geographically spread across the UK. I would also expect to see marketing figures and examples of advertising in the UK. I have not been provided with any of this evidence, which is plainly information which should have been available and relatively easy to provide. I therefore find that the opponent's evidence is not sufficient to establish enhanced distinctiveness through use.

**Likelihood of confusion**

47. 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 services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the 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 he has retained in his mind.

48. The following factors must be considered to determine if a likelihood of confusion can be established:

The First Earlier Mark

- I have found the marks to be visually similar to no more than a medium degree.
- I have found the marks to be aurally dissimilar.
- I have found the marks to be conceptually similar to between a medium and high degree.
- I have found the First Earlier Mark to be inherently distinctive to a very low degree.
- I have identified the average consumer as members of the general public, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process.
- I have found the parties' services to be identical.

49. I also bear in mind that in Mr Brown's witness statement, he draws my attention to the applicant's counterstatement which says:

> *"I am not denying that the trademark is similar or for similar treatment and as that is the case in my opponent's claim".* [sic]

50. However, in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion. Therefore, taking all of the above case law into account, I consider that it is important to ask, 'in what does the distinctive character of

the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

51. In this instance, the common elements between the marks, that being the taped lips, is low in distinctiveness because it descriptive (and therefore non-distinctive) for the parties' class 44 services, that being beauty care and treatment services for the lips. Therefore, even bearing in mind the principle of imperfect recollection, the differences between the two marks will take on a greater significance for the average consumer than they might have otherwise.[3] The way that the lips are taped are different, for example, there is more tape on the top lip in the First Earlier Mark, which has 4 pieces of horizontal tape fanning across the top lip, whereas only 2 horizontal pieces of tape which are stacked on top of one another go diagonally across the applicant's top lip. There is also the golden butterfly on the bottom lip of the First Earlier Mark, and the applicant's mark includes the wording "Lips with tapes technique". Moreover, the First Earlier Mark is a vertical photo, whereas the applicants' mark is a horizontal photo whereby the lips are at a diagonal angle. These, therefore, all act as visual points of difference. I also bear in mind that the marks are aurally dissimilar, and that whilst they are conceptually similar to a between a medium and high degree, this is created by the marks sharing a common element which is descriptive. As highlighted above, the marks have distinguishing features between them which become more significant due to the common elements of both marks being descriptive and/or non-distinctive for the services. Therefore, taking all of the above into account, I do not consider that there is a likelihood of direct confusion.

52. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

[3] *Nicoventures Holdings Ltd v. The London Vape Co Ltd* [2017] EWHC 3393 (Ch) Paragraph 36

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

53. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. Mr Purvis KC in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall in one of them.[4] I note that the opponent has not provided any submissions as to what category this case would fall within.

55. I also bear in mind that the examples set out by Mr Purvis are not exhaustive. However, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings.

56. Even though the marks consist of a pair of taped lips, as highlighted above, this element is highly descriptive and non-distinctive for the opponent's and applicant's applied for/registered services. Therefore, I do not think that the common element is of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it in relation to beauty care and treatment services for the lips. Consequently, I do not consider that the average consumer would think that the

[4] Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10

applicant's trade mark was connected with the opponent, or vice versa. Even if the opponent's mark is brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion.

The Second Earlier Mark

- I have found the marks to be visually similar to no more than a medium degree.
- I have found the marks to be aurally similar to a low degree.
- I have found the marks to be conceptually similar but only to a medium degree.
- I have found the earlier mark to be inherently distinctive to a low degree.
- I have identified the average consumer as members of the general public, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process.
- I have found the parties' services to be identical.

57. Bearing in mind the case law of *Whyte and Mackay* and *Nicoventures Holdings Ltd*, I do not consider that the Second Earlier Mark and the applicant's mark will be mistakenly recalled or misremembered as each other.

58. The common elements between the marks, that being the taped lips, is low in distinctiveness, because it descriptive (and therefore non-distinctive) for the parties' class 44 services, that being beauty care and treatment services for the lips. There are also many visual differences between how the taped lips are presented. For example, there is more tape on the top lip in the Second Earlier Mark, with 3 pieces of tape placed horizontally across it, whereas the applicant's top lip only has 2 horizontal pieces of tape stacked on top of one another, going horizontally across it. The Second Earlier Mark also includes a finger placed underneath the bottom lip, with the wording "angel lips" placed next to it in the bottom right hand corner of the mark, with the depiction of a pink pair of lips. The applicant's mark also includes the wording "Lips with tapes technique" placed at the bottom right hand corner of the mark. Lastly, the

Second Earlier Mark is a vertical picture of taped lips, whereas the applicant's mark is a horizonal picture whereby the lips are at a diagonal angle. As highlighted above, the marks have distinguishing features between them which become more significant due to the common elements of both being descriptive and/or non-distinctive for the services. I therefore find that there is no likelihood of direct confusion.

59. I also do not consider there to be a likelihood of indirect confusion for the same reasons provided in paragraphs 55 and 56 above. The common elements are highly descriptive and non-distinctive for the parties' class 44 beauty care and treatment services for the lips, and therefore it is not of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it in relation to these services. I therefore do not consider that the average consumer would think that the applicant's trade mark was connected with the opponent, or vice versa. Even if the opponent's mark is brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Therefore, I consider there is no likelihood of indirect confusion.

60. The opposition under section 5(2)(b) fails.

**Section 3(6)**

61. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

62. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

63. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

64. It is also necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16). The relevant date in this decision is 8 March 2023.

**What, in concrete terms, was the objective that the applicant has been accused of pursuing?**

65. As noted in paragraph 6 above, the opponent claims that the application was filed in bad faith on the basis that the applicant was a student of the opponent in November 2022 who had attended their masterclass. The applicant had signed an agreement on 15 November 2022 not to use the opponent's marks without their consent, and therefore not only had the applicant been aware of the activities of the opponent but the opponent believes that they are attempting to obtain a registration of a mark confusingly similar to that of the opponent, which is in breach of their agreement. Dr Mocanu also claims that the applicant is knowingly attempting to obtain the registration of a mark confusingly similar to her own to cause confusion in the market place,[5] and that she is concerned that any association of confusion between the parties could bring her services "into disrepute and damage [her] reputation by association".

**Was that objective for the purposes of which the contested mark could not be properly filed?**

66. I bear in mind that the filing of a mark with the knowledge that the opponent owns it, in isolation, may not be compelling because mere knowledge of another party's use of a mark (either in the UK or elsewhere) does not establish bad faith.[6] The applicant may have also reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani.*

[5] Paragraph 7 of her witness statement
[6] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12 and *Lindt, Koton* (paragraph 55).

However, the opponent's argument that this prior knowledge, in combination with a breach of the agreement, could be the basis of a bad faith objection, if proven. Therefore, the key question is whether the opponent has satisfied the burden of proving the existence of an agreement, whether it was breached, and in what capacity.

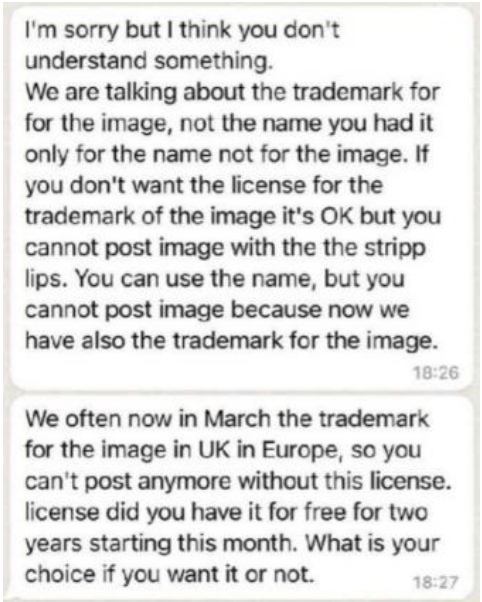
**Was it established that the contested mark was filed in pursuit of that objective?**

67. In **exhibit LM5** Dr Mocanu has provided a 2 page document titled "confidentiality agreement for Loran Lips Masterclass". I note the following terms are contained on the first page of the agreement:

1. The patients in the masterclass cannot be photographed.
2. The techniques are trade marked, and "you can't post/use images with our technique without using the trademark LORÁN Lips".
3. The techniques cannot be used for the student's own purposes (such as teaching, posting or promoting) without mentioning the "by LORÁN Lips" trade mark.
4. The student cannot associate their name with the techniques without using the brand "LORÁN Lips".
5. The student shall not disclose any confidential information that they learn and come into contact with during the masterclass, and during and after the training period.
6. The student will not use any confidential information for their own self-interest, or the interest of others, during or after the term of training, unless permission to do so is expressly given, in writing, by LORÁN Skin Company.
7. A 4 month period is imposed during which the student is not permitted to teach or promote teaching LORÁN Lips techniques.
8. The student, clinic or practitioner cannot promote the techniques without mentioning LORÁN Lips in front of the method (e.g. LORÁN Stripp Lips by…. LORÁN Butterfly Lips by…).
9. Any violation of the agreement gives LORÁN Skin Company the right to seek legal recourse.
10. The techniques being Stripp Lips, Melting Lips and Michelangelo Lips, are trade marks which cannot be used without their consent.

68. At the end of the second page of the agreement, the phrase “I read all the information above and agree to respect all the obligations from this Agreement. By not respecting the mentioned, I assume any legal consequences” is clearly written by the applicant. The agreement is also signed and clearly dated 15 November 2022.

69. I bear in mind that the same first page of this agreement is also contained within **exhibit JK2**. However, in her witness statement, Ms Komisarczyk draws my attention to a text message she received 4 months after the training, from Dr Mocanu, which stated that she had introduced a licence for “Loràn Stripp Lips”, “Michelangelo” and “Figurative (image) trademark Loràn Stripp Lips”. Dr Mocanu states that her students would need a licence to use the above marks in order to promote their work. In response to this, Ms Komisarczyk highlighted that she did not sign nor agree to such a term in the aforementioned contract. Dr Mocanu therefore responded with the following messages:




70. I consider that the end sentence of the first message highlights that the registration of the First and Second Earlier Marks happened post the contract being signed by Ms Komisarczyk. This is also reflected by their filing and registration dates.[7] Consequently, any reference to the trademarked techniques within the contract would

[7] The filing date of both marks was 8 December 2022, the registration date of the First Earlier Mark was 3 March 2023, and the Second Earlier Mark was registered on 2 June 2023.

not cover the First and Second Earlier Marks. Furthermore, at paragraph 9 of her witness statement, Ms Komisarczyk states that once she was informed that Dr Mocanu owed a trade mark for a picture of lips with tapes, it made her develop her own technique based on her personal experience and attendance of more than 50 medical and aesthetic courses. This includes a course she attended in Russia where she trained in "stripp lips" which was "first introduced in Russia by Braude".[8]

71. Throughout her witness statement, Ms Komisarczyk states that she does not use tapes in the same way as Dr Mocanu, and that her technique is "significantly different", as it is the "Russian lips technique". She also states in paragraph 6 of her witness statement that:

> "*My trade mark may be similar to the opponent's trade mark because it is in the same aesthetic industry and the work involves the lips, but our works are not identical and differ in many visible details. Dr Laura has created several trade marks for lips with tapes for this reason because each work is different in other details like mine."*

72. This is plainly the case where the parties had an agreement in place prior to the relevant date. This is not in dispute between the parties. Whilst I bear in mind that the First and Second Earlier Marks had not been applied for when the agreement was signed, and therefore the agreement cannot specifically pertain to these marks, term 2 clearly states that *the signee cannot post or use images of the opponent's technique without using the trade mark "LORÁN Lips".* In this case, it could follow that if Ms Komisarczyk's mark is an image of Dr Mocanu's "LORÁN Lips" technique, or if she intended it to be, then its registration would be in breach of the agreement, because it would amount to use without crediting the opponent. However, it is also important to note that you cannot trade mark a technique. A technique is a method of doing an activity, which in this case is the method of taping lips in a particular way. Therefore the applicant's mark does not show a "technique" or "method", it instead shows the end results of said method/technique.

[8] **Exhibit JK4**

73. Nonetheless, throughout Ms Komisarczyk's statement, she clearly denies that the technique that she uses is the same as Dr Mocanu's. Whilst the techniques used by both of the parties' results in lips being taped in some capacity, Ms Komisarczyk repeatedly refers to her technique as "Russian", including in her own personal correspondence via Instagram to Dr Mocanu exhibited in **JK6**. I also bear in mind that Dr Mocanu has not provided any rebuttal to Ms Komisarczyk's statement and accompanying evidence.

74. Taking all of the above into account, I am satisfied that, based on the evidence before me, Ms Komisarczyk did not intend to register a mark that used an image of Dr Mocanu's technique, but instead, her intention was to register a mark using her own technique, being the "Russian lips technique". I have also found under section 5(2)(b) that the way that the lips are taped in the parties' marks are different (and are different enough not to result in a likelihood of confusion). I therefore do not consider that the applicant's mark is use of an image of Dr Mocanu's technique. The opponent has not filed any other evidence as to the motivation of the applicant in filing the application. It is obviously wrong to expect the party bringing the claim to give direct evidence of the motivation of someone else, in this case the applicant,[9] however, there is nothing before me to conclude that the mark was filed in order to intentionally cause confusion with another trader. Ms Komisarczyk reasonably believed that she was entitled to apply to register the mark which demonstrated her "Russian lips technique". Consequently, I find that applicant's intention at the time of filing was not dishonest, nor does it breach the terms of the agreement signed on 15 November 2022.

75. I bear in mind that an allegation of bad faith is a serious one, and the burden of proof is on the opponent. The opponent has failed to establish a prima facie case of bad faith. As such, the application based upon section 3(6) of the Act is dismissed.

**CONCLUSION**

76. The opposition is unsuccessful, and the application may proceed to registration.

[9] *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, BL O/0052/25, paragraph 27

## COSTS

77. The applicant has been successful and would normally be entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

78. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

**Dated this 18th day of September 2025**

**L FAYTER**

**For the Registrar**