

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3425624 FOR A SERIES OF
TWO TRADE MARKS

UK LASH GLOBAL

AND

UK Lash Global

IN THE NAME OF UK LASH LTD

IN CLASSES 3, 16, 41 AND 44

AND

AN APPLICATION FOR INVALIDATION

UNDER NO. 503342

BY UK SKINLABS LTD

Background and pleadings

1. The trade marks shown on the cover page of this decision stand in the name of UK Lash Ltd (“the proprietor”). The mark was applied for on 3 September 2019 and entered in the register on 13 December 2019.
2. The registration covers the following goods and services:

Class 3 Adhesives for cosmetic purposes; Eyelashes; Eyelashes (Adhesives for affixing false -); Eyelashes (Cosmetic preparations for -); Eyelashes (False -); Cosmetics; Cosmetics for eye-lashes; Cosmetic preparations for eyelashes; Eyelashes (Cosmetic preparations for -).

Class 16 Instruction manuals; Instructional manuals for teaching purposes; Printed promotional material.

Class 41 Academy services (Education -); Education and training; Providing courses of training; Teaching of beauty skills; Organisation of beauty competitions; Educational seminars relating to beauty therapy; Educational and training services; Beauty school services; Educational services in the nature of beauty schools.

Class 44 Beauty therapy services; Eyelash extension services; Beauty treatment services especially for eyelashes; Eyelash extension services; Beauty treatment services especially for eyelashes.

3. On 24 September 2020, UK Skinlabs Ltd (“the applicant”) filed an application under section 47(2) of the Trade Marks Act 1994 (“the Act”) to invalidate the contested marks. The cancellation application, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the

goods and services in the registration. The applicant relies upon the following European Union Trade Marks (“EUTMs”):¹

UKLASH

EU registration no. 016451585

Filing date: 9 March 2017

Registration date: 22 June 2017

Goods:

Class 3 - Make-up

Mark 2: UKLASH

EU registration no. 018007520

Filing date: 8 January 2019

Registration date: 25 May 2019

Goods:

Class 3 - Toiletries; cosmetics; body cleaning and beauty care preparations; skin, eye and nail care preparations; adhesives for false eyelashes and false nails; artificial eyelashes; false eyelashes; false nails; eyelash mascara, eyelash serum, eyelash make-up; eyelash extension make-up; nail gels; nail gel removers; cosmetic kits; filled cosmetic kit bags containing skin, eye and nail care preparations, false eyelashes and false nails and adhesives for false eyelashes and false nails.

4. The applicant argues that there is a likelihood of confusion, including a likelihood of association, because the respective marks are highly similar, and the goods and services are identical or highly similar. The proprietor filed a counterstatement denying the grounds of cancellation.

1. Although the UK has left the European Union (“EU”), section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

5. The applicant is represented by Forresters IP LLP and the proprietor is represented by Neil Edward Chambers. Both parties filed evidence which I will mention to the extent I consider appropriate. A hearing was held before me on 7 September 2022. Mr Mark Bhandal of Forresters IP LLP appeared on behalf of the applicant. The proprietor chose not to attend the hearing.

Evidence

UKLASH

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7. The current proceedings are based on the applicant's valid EU earlier marks and concern a different mark owned by the proprietor, namely, UK Lash Global. Therefore, the proprietor's evidence and submissions concerning the sign "UK Lash Institute" have no bearing on the decision I have to make.
8. The applicant's evidence consists of a witness statement of Ms Nima Habib together with 6 exhibits. Ms Habib is the director and owner of the applicant company. I will return to Ms Habib's evidence later in the decision.

DECISION

Sections 47(2) and 5(2)(b)

² O/134/22

9. Section 47. – [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion of the part of the public, which includes the likelihood of association with the earlier trade mark”.

11. The trade marks upon which the applicant rely qualifies as earlier trade marks under section 6 of the Act. As those trade marks have not completed their registration process more than five years before the application date of the contested marks, the earlier marks are not subject to the proof of use provisions under section 6A of the Act. The applicant can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

12. The following principles are gleaned from the judgments 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 C3/03, *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.

The principles:

- (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 the 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

14. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (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.

15. 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”.

16. 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 Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] 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”.

17. In *Sanco SA v OHIM*, Case T-249/11, the General Court (“GC”) indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the

goods in question must be used together or that they are sold together”.

18. In *Gérard Meric v OHIM*, the GC held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application - and vice versa.³

19. The respective parties' goods and services are as follows:

Applicant's goods	Proprietor's goods and services
EU registration no. 016451585 Class 3 - Make-up	Class 3 - Adhesives for cosmetic purposes; Eyelashes; Eyelashes (Adhesives for affixing false -); Eyelashes (Cosmetic preparations for -); Eyelashes (False -); Cosmetics; Cosmetics for eye-lashes; Cosmetic preparations for eyelashes; Eyelashes (Cosmetic preparations for -).
EU registration no. 018007520 Class 3 - Toiletries; cosmetics; body cleaning and beauty care preparations; skin, eye and nail care preparations; adhesives for false eyelashes and false nails; artificial eyelashes; false eyelashes; false nails; eyelash mascara, eyelash serum, eyelash make-up; eyelash extension make-up; nail gels; nail gel removers; cosmetic kits; filled cosmetic kit bags containing skin, eye and nail care preparations, false eyelashes and false nails and adhesives for false eyelashes and false nails.	Class 16 - Instruction manuals; Instructional manuals for teaching purposes; Printed promotional material. Class 41 - Academy services (Education -); Education and training; Providing courses of training; Teaching of beauty skills; Organisation of beauty competitions; Educational seminars relating to beauty therapy; Educational and training services; Beauty school services; Educational services in the nature of beauty schools.

³ case T-133/05

	Class 44 - Beauty therapy services; Eyelash extension services; Beauty treatment services especially for eyelashes; Eyelash extension services; Beauty treatment services especially for eyelashes.
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20. The proprietor concedes that the conflicting goods in Class 3 are identical.⁴ I agree. The respective goods are either identically contained in both specifications or identical under the *Meric* principle.

21. In respect of the goods and services in Classes 16, 41 and 42, the applicant makes the following submissions:

“Class 16

Bearing in mind how the Registrant uses its marks, it is clear that the goods will be used in relation to eye cosmetic products, be that training guides or promotional brochures. Given that the intended use for these goods will be use in relation to eye cosmetic products, given to identical consumers, sharing identical distribution channels, the goods in Class 16 should be considered complimentary and therefore similar goods.⁵

Class 41

Bearing in mind how the Registrant uses its marks, it is clear that these services will be used in relation to training and education services relating to eye beauty treatments. Given that the intended use for these services will be use in relation to eye beauty training, given to identical consumers, sharing identical distribution channels, alongside identical goods in Class 3, these services in Class 41 should be considered complimentary and therefore similar services.

Class 44

⁴ Proprietor's submission, para 23.

⁵ Applicant's submissions dated 22 February 2021, para 35.

Bearing in mind how the Registrant uses its marks, it is clear that these services will be used in relation to eye beauty treatments. Given that the intended use for these services will be use in relation to eye beauty treatments, given to identical consumers, sharing identical distribution channels, alongside identical goods in Class 3, these services in Class 44 should be considered complimentary and therefore similar services.”

22. In response, the proprietor submits:

“24. Beyond the above, the Proprietor does not dispute what is stated in paragraph 38 which reiterates its own statement that there is no immediate distinction in the Goods/Services covered by the Proprietor’s and the Applicant’s rights, but it cannot be agreed that distribution channels for goods and services are necessarily the same and may require further consideration.”⁶

23. It appears that the only point the proprietor disagrees with is the distribution channels of the goods and services. Although the proprietor admits a certain degree of similarity between the goods and services, the parties have not made submissions on the extent of similarity. Therefore, I will make my own assessment.

24. I agree with the applicant that instructional and teaching materials in Class 16 may be about cosmetics as its subject matter. I am of the view that there may be a degree of similarity between the applicant’s cosmetics and the proprietor’s goods in Class 16, as the manufacturers of cosmetics may also publish materials concerning those products. To that extent, there may be an overlap in the channels of trade, particularly when goods are sold online. However, the goods would be placed in different shelves and clearly separated in retail outlets. While the users are also likely to be the same, I disagree with the applicant that the intended purpose of the goods is the same. Cosmetics are intended to enhance a person’s appearance, while printed matters in Class 16

⁶ Proprietor’s submissions dated 22 April 2021.

are intended to disseminate information. Considering all the factors, I find that the conflicting goods are similar to a low degree.

25. There is an intrinsic difference between the nature and purpose of the applicant's goods and the proprietor's educational services in Class 41 as is the case with any goods and services. However, I am of the view that there is a degree of similarity between those goods and services as producers of cosmetics can also provide educational services on the benefits and use of those goods, for example. The goods and services also coincide in users. Weighing up all the factors, I find that the conflicting goods and services are similar to a low degree.

26. Beauty treatment services in Class 44 can include procedures such as eye-lash services involving false eyelashes which are covered by the applicant's specification. In that regard, I consider that the competing goods and services are complementary as the applicant's goods are important in order to provide the proprietor's services and the consumers would think that the goods and services come from the same undertaking. The goods and services at issue may compete as the average consumer may, for example, elect to purchase false eyelashes to use at home instead of obtaining the proprietor's services. Their overall purpose is also the same as both are aimed to provide enhanced beautification to the use. Their channels of trade are also likely to coincide as the entities that offer beauty treatment services often sell cosmetic products used for such treatments. Considering these factors, I find the competing goods and services are similar to a medium degree.

The average consumer and the nature of the purchasing act

27. It is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer.

28. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,*

[2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

29. The average consumer of the conflicting goods and services is a member of the general public. The average consumer is likely to obtain the goods through self-selection from a shelf, catalogue or online equivalent. The service providers are most likely to be selected after perusal of the internet or visiting traditional outlets. Visual considerations are, therefore, likely to dominate the selection process for both goods and services. I do not discount that there may be an aural aspect to the selection process, such as word-of-mouth recommendation. When selecting the goods, the average consumer will pay some attention to factors such as the compatibility of the cosmetic products with their skin or the quality of cosmetic tools. These factors suggest that the average consumer is likely to pay a medium degree of attention when selecting these products. When choosing the service provider, the consumer will pay attention to customer reviews, the qualifications and experience of the staff, costs etc. In respect of beauty treatment/therapy services, the customer may also book a consultation with the service provider before making the final decision. However, the services do not strike me as either especially costly or as frequently purchased. These factors suggest that the consumer will pay a medium degree of attention when making their selection.

Comparison of marks

30. 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in 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.”

31. It would be wrong, therefore, artificially to 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.

32. The trade marks to be compared are as follows:

Applicant's trade marks	Proprietor's trade marks
UK LASH	UK LASH GLOBAL
UK LASH	UK Lash Global

33. The applicant relies on two marks. However, as they are identical, I will consider them together.⁷ The applicant's marks comprise of the word “UK LASH”. The marks have no additional stylisation. Although presented as a single word, the marks appear to be created by the combination of the words “UK” and “LASH”

⁷ See *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00

which the average consumer would perceive within the mark. The overall impression and the distinctiveness of the marks lie in the words of which the marks are comprised.

34. The proprietor's marks are a series of two word marks. The notional use would entitle the proprietor to use those marks in upper, lower, title or sentence-case letters. That being the case, there is no material difference between the two marks and I consider them together. I also note that the words Lash and Global are presented in an identical letter case in both marks. Considered overall, I am of the view that all the words in the marks contribute equally to the overall impression of the proprietor's marks.

35. Visually all the words in the applicant's mark are contained in the proprietor's marks. In terms of differences between the marks, the earlier mark is presented as a single word, while the proprietor's marks are presented as three separate words. The proprietor's marks also end in the word 'Global' which is absent from the applicant's mark. The proprietor submits that the "operative part" of its marks is 'UK Lash' which is "practically identical" to the applicant's mark.⁸ The proprietor's concession on the identity of the marks appears to have been made in support of its invalidation action discussed earlier in the decision. However, I have already found that the overall impression of the proprietor's marks lies in the whole of the mark. Considering all these factors, I find that the marks are visually similar to a high degree.

36. The respective marks would be pronounced entirely conventionally. The average consumer will likely articulate the applicant's mark as two words and the proprietor's mark as three words. The marks coincide in the pronunciation of the words 'UK Lash'. The word 'Global' in the proprietor's marks introduce the aural difference between the marks. Considering these factors, I find that the marks are similar to a high degree.

37. As regards the conceptual comparison, UKLASH/UK Lash appear to be a play on the words UK and Lash. The word 'lash' refers to the shorthand for an

⁸ Proprietor's submission, para 19.

eyelash and 'UK' signifies the geographic origin of the goods. Together the words are likely to signify lash from UK. The conceptual difference is introduced by the word Global in the proprietor's mark. I think that the average consumer is likely to consider the word global as perhaps indicating the worldwide reach of the goods and services. With that in mind, I find that the marks are conceptually similar to a high degree.

Distinctiveness of the earlier marks

38. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods/services have the lowest. Distinctiveness can be enhanced through the use of the mark. The applicant filed evidence. However, none of that evidence is relevant to my assessment of enhanced distinctiveness. There is no information on the revenue generated under the mark, marketing expenditure or any other relevant details based on which I can make an assessment of an enhanced distinctive character. Therefore, I will proceed based on the inherent position.

40. I have already concluded that the earlier mark is a play on the words created by conjoining the words “UK” and “LASH”; however, the average consumer would readily identify those words in the earlier mark and construe it accordingly. When considered as a whole, the mark is highly allusive of and possesses a low degree of inherent distinctive character in relation to products applied on eyelashes or services related to those goods. It is less allusive in relation to the remainder of the goods and services, and possesses a distinctiveness that is likely to be between low and medium.

Likelihood of confusion

41. The applicant has provided some evidence of confusion. The evidence consists of either promotional correspondence or enquires from third-parties about products the applicant claims to have not sold. Out of 5 documents filed from 2020, only 2 documents refer to UK Lash Global.⁹ One of the references is in the form of a leading question wherein the customer was specifically asked, “Did you confuse us with uklashglobal” to which the customer responds, “yes I think so sorry.” The second document concerns a purported enquiry made in a foreign language and contains a picture of a bottle labelled UK Lash Institute. I consider that the applicant’s evidence is far from satisfactory to tip in its favour a conclusion on actual confusion. Nonetheless, the lack of evidence of actual confusion is immaterial as the test is one of normal and fair use of the marks.

⁹ Exhibit NH5.

42. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e., a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon* at [17]). As I mentioned above, it is also necessary for me to bear in mind the distinctive character of the opponent's trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

43. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

44. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

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

of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

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

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

They are only examples, and every such case must be decided on its merits.

45. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,¹⁰ Arnold L.J. referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*¹¹ 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 L.J. 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.

¹⁰ [2021] EWCA Civ 1207

¹¹ BL O/219/16

46. Earlier in the decision, I concluded that the marks are visually, aurally and conceptually similar to a high degree. I also concluded that the purchasing process will be dominated by visual considerations, and the consumer will pay a medium degree of attention to the selection of goods and services. I found that the goods and services are similar to varying degrees.

47. I am of the view that the presence of the word global in the proprietor's marks is noticeable and that difference is likely to avoid a likelihood of direct confusion between the marks. I now move on to consider the likelihood of indirect confusion. I think the high degree of visual, aural and conceptual similarity between the competing marks arising from the shared words 'UK Lash' is sufficient to lead to a likelihood of indirect confusion. Although the coinciding words possesses only a weak degree of distinctive character and is a factor that points away from likelihood of confusion, that is offset by the fact that the non-coinciding word global merely indicates the worldwide reach of the goods and services. It also appears that the proprietor also uses the term "global" in its marks descriptively to "reflect the global reach of the proprietor".¹² When encountered with the proprietor's mark, the consumers are likely to think that the applicant might have diversified its business globally, hence the trade mark – UK Lash Global. Although I acknowledge that there is presentational difference between UKLASH/UK Lash in the respective marks, I bear in mind that the consumers do not make a side-by-side comparison. They are, therefore, unlikely to recall those differences and likely to consider the proprietor's marks as variants of the applicant's marks. My findings also applies where the earlier marks are distinctive to a degree that is between low to medium. Even though some goods and services are similar only to a low degree, the degree of similarity between the marks is such that there is a likelihood of indirect confusion.

48. The application for invalidation succeeds under section 5(2)(b).

Conclusion

¹² Witness statement, para 32.

49. The application for invalidation has succeeded and the contested mark may hereby declared invalid in respect of all the goods and services for which it was registered. Under section 47(6) of the Act, the registration may deem never to have been made.

Costs

50. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I award costs to the applicant on the following basis:

Preparing statements and considering the proprietor's statement:	£200
Filing evidence and considering the other party's evidence:	£500
Preparing for and attending hearing:	£600
Official fee	£200
Total	£1500

51. I, therefore, order UK Lash Ltd to pay UK Skinlabs Ltd the sum of £1500. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of October 2022

Karol Thomas
For the Registrar
The Comptroller-General