

O/0387/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003820688

BY BOMB LASH LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 3, 8, 21, 41 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 437571

BY GLOBAL BEAUTY PRODUCTS LIMITED

Background and pleadings

1. On 16 August 2022, Bomb Lash Ltd (“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 26 August 2022 and registration is sought for the following goods and services:

Class 3: *Long lash mascaras; Cosmetics for eye-lashes; Cosmetic preparations for eye lashes; Eyelashes; Eyelash dye; Eyelashes (False -); Artificial eyelashes; Eyelash tint; False eyelashes; Cosmetic preparations for eyelashes; Eyelashes (Cosmetic preparations for -); Adhesives for affixing artificial eyelashes; Eyelashes (Adhesives for affixing false -); Adhesives for affixing false eyelashes; Adhesives for false eyelashes, hair and nails.*

Class 8: *Eyelash curlers; Eyelash separators; Curlers (Eyelash -); Artificial eyelash tweezers; Electric eyelash curlers.*

Class 21: *Eyelash combs; Eyelash brushes.*

Class 41: *Beauty school services; Educational seminars relating to beauty therapy; Educational services provided by beauty schools; Educational services in the nature of beauty schools.*

Class 44: *Beauty treatment; Salons (Beauty -); Beauty consultancy; Beauty consultation; Beauty counselling; Beauty care; Beauty salons; Beauty salon services; Beauty consultancy services; Beauty information services; Beauty therapy treatments; Beauty care services; Beauty consultation services; Beauty therapy services; Beauty treatment services; Salon services (Beauty -); Beauty advisory services; Hygienic and beauty care; Providing information about beauty; Information relating to beauty; Consultancy services relating to beauty; Human hygiene and beauty care; Advisory services relating to beauty; Beauty care for human beings; Advisory services relating to beauty treatment; Advisory services relating to beauty care; Consultation services relating to beauty care; Beauty treatment services especially for eyelashes; Hygienic and beauty care*

for humans; Services of a hair and beauty salon; Hygienic and beauty care for human beings; Eyelash extension services; Eyelash curling services; Eyelash dyeing services; Eyelash perming services; Eyelash tinting services.

2. On 18 November 2022, Global Beauty Products Limited (“the opponent”) opposed the application based upon Sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).

3. Under Sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark (“the earlier mark”):

UK00003724202

LASH BOMB

Filing date: 22 November 2021

Registration date: 25 February 2022

4. The earlier mark stands registered for the following goods, all of which are relied upon by the opponent:

Class 3: *Cosmetic and beauty preparations; non-medicated toilet preparations; depilatory preparations, lotions, waxes, oils and creams; wax treatments for removing body hair; wax strips for removing body hair; exfoliants; hair regrowth inhibitors; preparations for use before, during and after shaving or hair removal; personal care products; beauty products; makeup; makeup sets; cosmetics for use on the face; cosmetics for use on hair.*

5. The opponent’s mark qualifies as an “earlier trade mark” for the purposes of this decision since it was applied for at an earlier date than the filing date of the applicant’s mark.¹ As the earlier mark is not subject to proof of use, the opponent can rely upon all of the goods for which its mark is protected without having to show that it has been put to genuine use.

¹ See Section 6(1)(a) of the Act.

6. Under Section 5(2)(b), the opponent claims that the marks are identical or highly similar and that the goods and services are identical or highly similar, leading to a likelihood of confusion.

7. Under Section 5(3), the opponent claims that the earlier mark has a substantial reputation in the minds of the UK public in respect of the registered goods, that the contested mark is highly similar to the earlier mark and that use of the contested mark takes unfair advantage of, and is detrimental to, the distinctive character of the earlier mark.

8. Under Section 5(4)(a), the opponent claims to have used the sign LASH BOMB throughout the UK since September 2020 for the goods listed in paragraph 4 above and to have acquired goodwill under the sign. According to the opponent, use of the contested mark would constitute a misrepresentation to the public that the applicant's goods and services are those of the opponent, or are authorised by, or otherwise are within the control of, the opponent giving rise to damage to the opponent's goodwill. Consequently, use of the contested marks would be contrary to the law of passing off.

9. Under Section 3(6), the opponent claims that the applicant was aware of the opponent's use of the earlier mark as it had been contacted by the opponent in relation to its use of the contested mark prior to the filing date of the contested application. The claim is brief and so I reproduce it in full below:

“Whilst it is likely that the Applicant was aware of the Opponent and the Earlier Mark prior to commencing use of the Later Mark, it is certain that the Applicant was aware of the Earlier Mark prior the date of filing the Application, as details surrounding the Earlier Mark and the Opponent's earlier use were set out to the Applicant in writing by legal letter dated 3 August 2022.

Further, the Applicant knew (by way of the aforementioned letter) that the Opponent did not consent to the Applicant's use of the Later Mark and that any application for the Later Mark would be opposed. In this sense, the Opponent submits that the Applicant was aware of the Opponent's better claim to the reputation and goodwill attaching to the Earlier Mark and sought to file the

Application in any case, presumably with a view to unfairly target the existing rights of the Opponent.

It follows that the Application has been filed with the intention of undermining, in a manner inconsistent with honest practices, the interests of the Opponent and, therefore, that it has been filed in bad faith.”

10. The applicant filed a defence and counterstatement denying the claims. In particular, the applicant states that:

- The applicant’s business name Bomb Lash Ltd and the opponent’s business name Global Beauty Products Limited are different. The applicant checked the Companies House register before registering its business name;
- The applicant should have more rights in the contested mark because it has been running its business since December 2020, before the opponent applied for the earlier mark;
- When the applicant started trading, it believed they had registered its trade mark “Bomblash”, the reason being that a third party lead it to believe this. However, when receiving the opponent’s letter on 15 August 2022 - which, the applicant says, threatened to take its name and everything it had worked for - the applicant realised that the mark had not been registered and, on 16 August 2022, filed the contested application;
- Since 15 August 2022 the opponent applied under bad faith for 14 different trade marks all incorporating the word Bomb, including BROW LASH BOMB, THE BOMB duo THE LASH LIFT & BROW LAMINATION SYSTEM, DUO BOMB;
- Bomblash is the applicant’s business name and is used on every product the applicant sells as their brand identity. However, the applicant’s products have different names, including Lash extension box names; Hot Volumes, Electric

easy's, Foxy and Toxic L curls, Classic lashes, Drop a bomb pink lashes, Drop a bomb brown lashes;

- The applicant is a lash extension brand and training academy, the opponent is known as a Lash Lift brand, which are totally different treatments. The applicant's products are different from those offered by the opponent. The applicant provides products to qualified lash technicians and, in order to purchase the applicant's products, consumers require different qualifications from those purchasing the opponent's products, mitigating any confusion;
- The opponent discusses classes that the applicant has not applied for highlighting that the goods and services are different. The applicant requests that anything relating to classes that are not applied for should be dismissed as *"they are not relevant to the trademark"*;
- The parties' logos are not similar. The applicant's logo uses two shades of pink and some black, whereas the opponent's logo uses only black and white. The fonts are completely different, and the style is completely different;
- The opposition should be refused on the basis it has been filed in bad faith, attempted intimidation with use of threatening language, and poor business practice. The applicant requests an award of costs. It also requests compensation due to the "undue mental anguish" the opposition has put it under, and lack of revenue during this time;
- The applicant denies that the goods and services are similar and states that the parties offer different products and treatments. It also states that the brands are completely different as the word 'BOMB' in the applicant's business name represent the two business owners' names together to create a word (though there is no further information about what these names are);

- The applicant makes a series of allegations against the opponent, including that the opponent has taken notice of the success of the applicant's business and wishes to monopolise use of the word BOMB in order to expand its business;
- The applicant denies that the application was made in bad faith.

11. Only the opponent filed evidence. It also filed written submissions dated 26 May 2023. I shall refer to the evidence and submissions to the extent that I consider necessary.

12. The opponent is represented by ASENDA LAW LTD. The applicant is not represented. Neither party chose to be heard, nor did they file submissions in lieu of a hearing. I make this decision after a careful consideration of all the papers on file.

EU Law

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

The evidence

14. The opponent's evidence comes in the form of a witness statement from Colin Laphan, the opponent's general manager, with 10 exhibits, being those labelled CL1-CL10. Mr Laphan's evidence goes to the matter of showing use of the earlier mark and addresses the alleged use of the contested mark.

Preliminary remarks

15. As the opponent noted in its written submissions, some of the arguments advanced by the applicant are not pertinent to the issues in these proceedings. As I have said, the applicant seeks to rely on the claim that its use of the contested mark pre-dates the filing date of the earlier mark (or the opponent's use of the earlier mark). Tribunal Practice Notice (TPN 4/2009) "*Trade mark opposition and invalidation proceedings – defences*" explains the position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark as follows:

"4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

16. Accordingly, since the opponent's earlier mark is validly registered, the fact that the applicant might have some unregistered rights in the sign BOMBLASH as a result of the use that it has allegedly made of it (which, could, in theory, be used to challenge the validity of the earlier mark in separate invalidity proceedings) is irrelevant here, because the applicant has not applied to invalidate the earlier mark.

17. Another argument that the applicants cannot be permitted to rely on is that the parties' business names are different. Business names and trade marks give rise to separate rights and are governed by different laws, namely the Companies Act 2006

and the Trade Marks Act 1994. The consideration of similarity in trade mark proceedings is limited to trade marks, and does not extend to include use of business names. Further, the comparison between the competing trade marks and the respective goods and services must be conducted on a notional basis. This means that I must compare the earlier mark as it is registered and the later mark as it is applied for, disregarding any variant mark or logo the parties might use. Likewise, I am required to carry out the comparison of the goods and services based upon the terms before me and not how the parties use (or intend to use) their marks. In this connection, there is nothing in the applicant's specification that limits the goods to use by qualified lash technicians (or exclude sales to unqualified users) and since neither specification is limited in any way, the parties' goods and services are capable of being identical and/or similar.

18. Finally, there is no provision for a party to request compensation for "*undue mental anguish*" or loss of earning in trade mark proceedings. As the opponent correctly states in its written submissions, those are not remedies available before this Tribunal. Whilst this Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour displayed by a party during the course of the proceedings, the applicant's complaint seems to refer to the content of a pre-action letter that was sent by the opponent before the present proceedings were commenced. Firstly, this Tribunal would not intervene in matters between parties which are outside trade mark proceedings; secondly, the applicant has not filed any evidence to support the allegation that the opponent's letter was threatening. Lastly, having reviewed the file, it does not seem to me that there is anything in the opponent's conduct of this case that is out of the ordinary or abnormal, and thus of such a nature as to deliberately frustrate the applicant or cause it any mental anguish.

19. Having clarified the above, I now turn to the decision.

DECISION

Section 5(2)(b) of the Act

20. Section 5(2)(b) states:

“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.”

21. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”²

22. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the CJEU 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.

The principles

² This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

23. Section 60A of the Act states:

“Similarity of goods and services

(1) For the purposes of this Act goods and services—

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979”

24. Contrary to the applicant’s contention, the fact that goods and services may exist in different classes does not mean that they are automatically dissimilar. On this same point, section 60A also states that goods/services appearing in the same class does not necessarily make them automatically similar either.

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

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

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

29. In *Sanco SA v OHIM*, Case T-249/11, the 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. (as he was then) noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

30. 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.

31. The goods and services to be compared are as follows:

The applicant's goods and services	The opponent's goods
Class 3: Long lash mascaras; Cosmetics for eye-lashes; Cosmetic preparations for eye lashes; Eyelashes; Eyelash dye; Eyelashes (False -); Artificial eyelashes; Eyelash tint; False eyelashes; Cosmetic preparations for eyelashes; Eyelashes (Cosmetic preparations for -); Adhesives for affixing artificial eyelashes; Eyelashes (Adhesives for affixing false -); Adhesives for affixing false eyelashes; Adhesives for false eyelashes, hair and nails.	Class 3: Cosmetic and beauty preparations; non-medicated toilet preparations; depilatory preparations, lotions, waxes, oils and creams; wax treatments for removing body hair; wax strips for removing body hair; exfoliants; hair regrowth inhibitors; preparations for use before, during and after shaving or hair removal; personal care products; beauty products; makeup; makeup sets; cosmetics for use on the face; cosmetics for use on hair.
Class 8: Eyelash curlers; Eyelash separators; Curlers (Eyelash -); Artificial eyelash tweezers; Electric eyelash curlers.	
Class 21: Eyelash combs; Eyelash brushes.	
Class 41: Beauty school services; Educational seminars relating to beauty therapy; Educational services provided by beauty schools; Educational services in the nature of beauty schools.	
Class 44: Beauty treatment; Salons (Beauty -); Beauty consultancy; Beauty consultation; Beauty counselling; Beauty care; Beauty salons; Beauty salon services; Beauty consultancy services; Beauty information services; Beauty	

therapy treatments; Beauty care services; Beauty consultation services; Beauty therapy services; Beauty treatment services; Salon services (Beauty -); Beauty advisory services; Hygienic and beauty care; Providing information about beauty; Information relating to beauty; Consultancy services relating to beauty; Human hygiene and beauty care; Advisory services relating to beauty; Beauty care for human beings; Advisory services relating to beauty treatment; Advisory services relating to beauty care; Consultation services relating to beauty care; Beauty treatment services especially for eyelashes; Hygienic and beauty care for humans; Services of a hair and beauty salon; Hygienic and beauty care for human beings; Eyelash extension services; Eyelash curling services; Eyelash dyeing services; Eyelash perming services; Eyelash tinting services.	
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Class 3

Long lash mascaras; Cosmetics for eye-lashes; Cosmetic preparations for eye lashes; Eyelashes; Eyelash dye; Eyelashes (False -); Artificial eyelashes; Eyelash tint; False eyelashes; Cosmetic preparations for eyelashes; Eyelashes (Cosmetic preparations for -); Adhesives for affixing artificial eyelashes; Eyelashes (Adhesives for affixing false -); Adhesives for affixing false eyelashes; Adhesives for false eyelashes, hair and nails.

32. The applicant's goods are all types of beauty and cosmetic products for eyelashes. As such, they fall within the broad term *Cosmetic and beauty preparations; beauty*

products; makeup and cosmetics for use on the face. These goods are identical on the principle outlined in *Meric*.

Class 8 and class 21

Eyelash curlers; Eyelash separators; Curlers (Eyelash -); Artificial eyelash tweezers; Electric eyelash curlers; Eyelash combs; Eyelash brushes.

33. The applicant's goods are instruments for curling, separating, tweezing, combing and brushing eyelashes, while the opponent's goods include mascara, false eyelashes and cosmetics used on eyelashes. Although the nature of the goods is different, they share the same use and purpose, namely that of being used for the care and beautification of eyelashes, and are sold to the same class of users. The goods share trade channels as they are sold in the same stores in close proximity to each other. The goods might also be complementary 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. In this connection, it is quite common for producers of cosmetics to offer accessories or complementary products with a view of expanding their range of products. In my view, these goods are similar to a medium degree.

Class 41

Beauty school services; Educational seminars relating to beauty therapy; Educational services provided by beauty schools; Educational services in the nature of beauty schools.

34. The applicant's services in class 41 are services whose main purpose is to teach, educate and supervise beauty therapy and beauty treatments. Even if the applicant's educational services include services relating to the care and beautification of eyelashes, they are provided by professional staff such as beauticians or beauty teachers in specialised places such as beauty schools. I do not agree with the opponent that these services are commonly purchased and used by the same public who buy the opponent's class 3 goods. Although anyone, as a member of the general public, can purchase the opponent's cosmetic products, the applicant's educational services do not target specifically those who buy cosmetic products. Rather, the

applicant's services are aimed at those who run a beauty salon or provide beauty treatments and therapy to the public, or wish to undertake a career in beauty care. In this connection, the opponent's argument that nearly all large cosmetics companies operate YouTube and other social media channels providing video content and tutorials intended to educate consumers as to how to use cosmetic and beauty preparations, is misconceived, as these types of tutorials are marketing tools used by cosmetic companies to sell their own products, and are not comparable to the services of a beauty school. The users, uses, nature, purpose of the goods and services are different, the goods and services do not share trade channels, and are neither complementary nor in competition. These services are dissimilar.

Class 44

Beauty treatment; Salons (Beauty -); Beauty consultancy; Beauty consultation; Beauty counselling; Beauty care; Beauty salons; Beauty salon services; Beauty consultancy services; Beauty information services; Beauty therapy treatments; Beauty care services; Beauty consultation services; Beauty therapy services; Beauty treatment services; Salon services (Beauty -); Beauty advisory services; Hygienic and beauty care; Providing information about beauty; Information relating to beauty; Consultancy services relating to beauty; Human hygiene and beauty care; Advisory services relating to beauty; Beauty care for human beings; Advisory services relating to beauty treatment; Advisory services relating to beauty care; Consultation services relating to beauty care; Beauty treatment services especially for eyelashes; Hygienic and beauty care for humans; Services of a hair and beauty salon; Hygienic and beauty care for human beings; Eyelash extension services; Eyelash curling services; Eyelash dyeing services; Eyelash perming services; Eyelash tinting services.

35. The applicant's services are either services specifically related to the beautification of eyelashes (i.e. eyelash extension services; eyelash curling services; eyelash dyeing services; eyelash perming services; eyelash tinting services) or are sufficiently broad to include them (as there is no limited description of the services). The goods and services share the same aesthetic and beauty purpose, and target the same relevant public, given that those who buy cosmetic products for eyelashes frequently use consultancy services relating to beauty care and beauty care services. The goods are complementary, since cosmetic products are indispensable or important for the

provision of beauty services, for example, eyelashes care services would include the application of eyelashes. In addition, the goods and services share the same channels of trade because along with beauty treatments, beauty salons frequently offer consultancy services and cosmetic products, for example, to maintain or prolong the effect of the treatment. Lastly, the goods and services are in competition, as users can choose between buying false eyelashes and related products or booking eyelash consultancy and treatments in a beauty salon. These goods and services are similar to a medium degree.

36. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

37. As I found the services in class 41 to be dissimilar, the opponent’s claim under Section 5(2)(b) fails in relation to these services.

Average consumer

38. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties’ goods/services. I must then determine the manner in which the goods and 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.”

39. The average consumer for the parties’ goods and services will be a member of the general public. I accept that there will also be professional purchasers, such as salon owners or beauty therapists, for the goods in classes 3, 8 and 21.

40. Across all of the goods and services, the purchasing process is likely to be dominated by visual considerations, whether because the goods are selected from the shelves of retail outlets or their online equivalents, because brochures and websites are consulted or because of exposure to the marks in signages outside beauty salons and on advertising material. Nevertheless, aural considerations remain relevant, as all of the goods and services may be liable to word-of-mouth recommendations.

41. Although the goods and services are relatively inexpensive, the consumer selecting them will take into account factors such as suitability of the product and price, as well as professional qualifications and reliability of the providers (for the services). As a result, I consider that the average consumer will purchase the goods and services with a medium level of attention.

Comparison of marks

42. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

43. 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. The respective marks are shown below:

The applicant's mark	The opponent's mark
	LASH BOMB

Overall impression

44. The applicant's mark consists of the verbal element BOMBLASH presented in upper case letters placed at the centre of a square beige background. The word BOMB is presented in pink in a ticker font, whereas the word LASH is presented in grey in a thinner font. Despite the words BOMB and LASH being conjoined, the relevant public will have no difficulty in immediately perceiving the presence in the sign of the two words, especially given the separation created by the use of different colours and fonts.

45. The background and colours of the applicant's mark will be perceived as being mainly decorative in nature, and will be attributed little or no trade mark significance. The opponent states that the word LASH is less distinctive than the word BOMB because it will be perceived by the relevant public as referring to "eyelashes", i.e. the short curved hairs growing on the edges of the eyelids, signifying that the relevant goods and services are intended to be used for the purpose of beautifying eyelashes. I agree that since all of the goods and services which I found to be similar either relate to, or notionally cover, goods and services for the beautification of eyelashes, the word LASH will be understood as meaning eyelashes, that being one of the meanings of the word as listed in the Collins English dictionary.³ Whilst the word BOMB is visually more dominant (appearing in pink) and is, inherently, more distinctive than the word LASH, the verbal element 'BOMBLASH' will be perceived as a unit whereby the word BOMB qualifies the word LASH, and the meaning of the element 'BOMBLASH' as a whole will be – as the opponent says - that of eyelashes which appear to have "exploded" due to being bigger, bolder and more voluminous. Consequently, whilst the element LASH might be non-distinctive in isolation, the combination BOMBLASH is distinctive, and the element LASH contributes to that distinctiveness in roughly equal measure than the word BOMB.

46. The opponent's mark consists of the words LASH and BOMB presented in upper case letters. Although the words are inverted, they have the same meaning and distinctiveness, and the same considerations I made above apply to the opponent's mark. The average consumer will perceive the words LASH and BOMB as a distinctive unit signifying eyelashes which appear to have "exploded" due to being bigger, bolder and more voluminous; hence, both elements are roughly equal in terms of the overall impression.

Visual similarity

47. Visually, the marks coincide in the components BOMB and LASH, albeit in different position. The marks differ in the applicant's mark's background and stylisation, which

³ Other meaning listed in the dictionary include: 1. a sharp cutting blow from a whip or other flexible object twenty lashes was his punishment; 2. the flexible end or ends of a whip; 3. a cutting or hurtful blow to the feelings, as one caused by ridicule or scolding; 4. a forceful beating or impact, as of wind, rain, or waves against something.

have a minimal visual impact; further, that impact is also diminished when one factors in the principle that notional use of the opponent's earlier mark covers use in the same font and colour (i.e. in pink) of the applied-for mark. Therefore, the signs are visually similar to a medium to high degree.

Aural similarity

48. Aurally, the conflicting marks coincide in the pronunciation of the verbal elements BOMB and LASH, but in inverted order. Although the words are pronounced in an inverted order, this does not prevent the marks from being aurally similar overall. In my view, despite the reverse order, the marks are aurally similar to a medium to high degree.

Conceptual similarity

49. Conceptually, the marks will be both perceived as referring to eyelashes which appear to have “exploded” due to being bigger, bolder and more voluminous. The marks are conceptually identical or highly similar.

Distinctive character of earlier mark

50. 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)."

51. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

52. The opponent states that the earlier mark is highly distinctive because it is not commonly used within the cosmetics and beauty industry to indicate origin and it is not allusive. I disagree. High inherent distinctiveness is commonly associated with marks that possess no obvious meaning or are viewed as made-up words. Neither of these are the case here. Bearing in mind (a) what I have said about the opponent's mark being perceived as referring to eyelashes which appear to have "exploded" due to being bigger, bolder and more voluminous and (b) the nature of the opponent's goods that I found to be similar to the applicant's goods and services (i.e. cosmetic products for eyelashes), I conclude that the opponent's mark LASH BOMB is at least allusive, and inherently distinctive to a low to medium degree. Furthermore, whilst evidence of widespread use of a mark by different traders can reduce the distinctiveness of the mark, the contrary is not necessarily true; in other words, the absence of evidence of widespread use does not increase the distinctiveness of a mark and does not make a mark more distinctive.

53. Evidence of use can contribute to increasing the distinctiveness of a mark. In this case the opponent has not claimed that the evidence it has filed is sufficient to

establish that the distinctiveness of the mark has been enhanced through use; however, that is not fatal to the opponent's case. This is because the assessment of distinctiveness is one of the fundamental factors that needs to be assessed in every case and, as is clear from the case-law, this can come from either the inherent nature of the mark, its use, or indeed a combination of both. Therefore, if evidence has been filed, which it has in the case before me, it is incumbent upon me to factor that evidence into the assessment to decide upon the overall distinctiveness of the earlier mark.⁴ I now turn to the opponent's evidence.

54. Mr Laphan gave evidence that since its incorporation in 2015, the opponent: (a) incurred marketing spend in excess of £1,000,000 in respect of products marketed under the earlier mark within the UK; (b) generated revenue in excess of £8,000,000 in respect of sale of products bearing the earlier mark within the UK; (c) sold in excess of 4,000,000 units of cosmetic products bearing the earlier mark within the UK and (d) exhibited products bearing the earlier mark at a number of trade shows within the UK. None of the figures provided are broken down by products; this is particularly significant given that the opponent relies on a wide array of goods (i.e. those covered by the earlier mark) including terms that are very broad (for example *cosmetic and beauty preparations; non-medicated toilet preparations; personal care products; beauty products; makeup; cosmetics for use on the face; cosmetics for use on hair*). Further, it is not clear to me how much revenue was generated in each year. In particular, the relevant date for the assessment of the earlier mark's enhanced distinctive character is 16 August 2022 but I do not know what the relevant turnover was in 2022 or in the year before it. Although a turnover of £8million is not insignificant, Mr Laphan says that it was generated between 2015 and the date of his witness statement, which covers a period of 8 years; assuming that the turnover was equally spread over the full duration of the 8-year period, annual turnover would be roughly £1million, which is not indicative of a large level of use. The same criticisms can be made to the marketing figures which are similarly given without any break down. Finally, although there is no mention of other marks in the narrative of Mr Laphan's witness statement, the exhibits attached to his evidence always show the mark LASH BOMB used in conjunction with the mark BEAUTIFUL BROWS AND LASHES, which

⁴BL- O-379-19

appears to be the primary mark, as it is used on a website and email address, and on social media pages as the main identifier of the origin of the goods. Consequently, the evidence does not support the claim that the marketing figures refer to the earlier mark alone, and the exhibits show little use of the mark on the goods themselves. Finally, whilst Mr Laphan says that products bearing the earlier marks were exhibited at a number of trade shows within the UK, he gave no dates and provided no supporting documents showing how the earlier mark was displayed. Given the scarcity of evidence about the use of the earlier mark in the UK, and the defects in the evidence of turnover and marketing expenditures, I conclude that the documents filed do not support the conclusion that the distinctiveness of the earlier mark has been enhanced through use in the UK.

Likelihood of confusion

55. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, there are some identical goods, and some goods and services of medium degree of similarity.

56. Direct confusion occurs where marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind.

57. Indirect confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, 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

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).”

58. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.⁵

⁵ [2021] EWCA Civ 1207

59. Earlier in this decision I found that:

- The applicant's goods in class 3 are identical to the goods of the earlier mark, whereas the applicant's goods in classes 8 and 21 and services in class 44 are similar to a medium degree;
- The average consumer is a member of the general public or professional beauticians who would pay a medium degree of attention during the purchasing process.⁶ The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely;
- The marks are visually and aurally similar to a medium to high degree, and conceptually identical (or similar to a high degree);
- The earlier mark is inherently distinctive to a low to medium degree.

60. Bearing in mind the principle of imperfect recollection, I consider that the marks are likely to be directly confused one for the other.

61. The similarity between the signs arises mainly by the coinciding components LASH and BOMB, albeit in different position. Even considering the low to medium degree of distinctive character of the earlier mark, in my judgement, taking into account imperfect recollection, and the similarity of the marks and the goods and services, it is entirely feasible that, consumers paying a medium level of attention, may not notice the inverted order of the components LASH and BOMB in the contested mark and may overlook or fail to recall the figurative element of the contested mark, due to the banal nature of this element. This is all the more so since nothing precludes the use of the earlier mark in the same colour as the contested mark. There is a likelihood of direct confusion.

⁶ Even if the goods could be purchased by a professional users applying an above degree of attention, the likelihood of confusion must be assessed taking into account the lower degree of attention.

62. However, if I am wrong about the average consumer overlooking the contrast of colour in the applied-for mark (if the earlier mark can be presented only in pink, rather than in the same contrast of colour of the later mark), I am of the view that there is a risk of confusion, albeit indirect, as the average consumer would still misremember the words BOMBLASH and LASH BOMB for one another, and the applied-for mark would be seen as stylised version of the earlier mark.

Section 5(3)

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

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

64. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

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

66. I can deal with this ground relatively swiftly. This is on the basis that, for the same reasons as those outlined at paragraph 55, the opponent has not proved that the earlier mark had a reputation at the relevant date in the UK.

67. Furthermore, the opponent's claim under Section 5(3) as pleaded in its Form TM7 is based upon there being a likelihood of confusion. The opponent stated (emphasis added):

“As such, the Earlier Mark benefits from a substantial reputation in the mind of the relevant public and signifies, in particular, a certain prestige, allure and quality of goods marketed thereunder.

It follows that use of the Later Mark (being confusingly similar to that of the Earlier Mark, as set out above) takes unfair advantage of the repute of the Earlier Mark by riding on its coat tails in order to benefit from the power of attraction, repute and prestige of the Earlier Mark, all without paying any financial compensation to the Opponent.

Further, such use of the Later Mark without due cause is detrimental to the distinctive character of the Earlier Mark in that use of the Later Mark undermines the distinctive character of the Earlier Mark, its uniqueness and, therefore, its commercial magnetism and selling power.”

68. Hence, even if the opponent had established a reputation (which it has not), given my findings above that there is no likelihood of confusion in relation to the services in class 41, the Section 5(3) objection would also fail in relation to these services.

Section 5(4)(a)

69. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

70. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

71. The relevant date for the purposes of Section 5(4)(a) of the Act is the filing date of the contested mark: 16 August 2022.⁷

72. Again, I can deal with this ground relatively swiftly. Mr Laphan’s evidence is that the opponent has used the mark ‘LASH BOMB’ to market and promote “various cosmetic products” to the British public since November 2017 through its website www.beautifulbrowsandlasheswebsite.com. However, I note that this evidence apparently conflicts with the pleaded claim that the sign LASH BOMB was first used in the UK in September 2020. In paragraph 55 above I have already commented upon then defects in the opponent’s evidence. Even if the evidence establishes a more than trivial goodwill sufficient to sustain the opponent’s claim for passing off in relation to cosmetic kits for eyelashes (the latter being the only goods shown in evidence in relation to which the earlier mark appears to be used), it would be small. Given the size of the goodwill, the distance between the goods and services, and the low to medium degree of distinctiveness of the earlier sign, I do not consider that this ground would extend the opponent’s success beyond the level it achieved under its Section 5(2)(b) ground. This is because the distance between the remaining educational services in the applicant’s specification in class 41 and the goods for which the opponent has goodwill would be sufficient to offset the similarity of the marks and to avoid a misrepresentation and damage arising.

⁷ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander KC, sitting as the Appointed Person.

73. The opposition reliant upon Section 5(4)(a), therefore, fails to the same extent as that under Section 5(2)(b).

Section 3(6)

74. 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.”

75. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade

mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, 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 the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]."

76. A person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. the balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith.

77. As per the case law cited above, it is for the party alleging bad faith to prove it. The initial evidential burden falls upon the opponent: it must present evidence from which a rebuttable presumption of lack of good faith can be drawn.

78. 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?

79. It is 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 case is 16 August 2022.

80. The opponent's pleaded case is that "*whilst it is likely that the applicant was aware of the opponent and the earlier mark prior to commencing use of the later mark, it is certain that the applicant was aware of the earlier mark prior the date of filing the application*" because the opponent contacted the applicant prior to the application being filed, alleging infringement of its trade mark rights.

81. It is common ground that the applicant was already trading under the name BOMB LASH when the opponent contacted it to request that it stopped using the sign complained of. Against this background, it seems to me that it was not illegitimate for the applicant to file an application to register the mark with a view to protecting its business. Furthermore, there is no evidence that when the applicant chose the name BOMB LASH it had knowledge of the opponent's earlier mark (and there is no allegation of copying). Indeed, my finding that the opponent's earlier mark did not enjoy a reputation at the time when the application for registration of the contested mark was filed, points in the direction that the applicant's initial choice of the name BOMB LASH was coincidental. The opponent pleaded case is that the applicant was aware of the opponent's claim to the reputation and goodwill attaching to the earlier mark and sought to file the application with a view to "*unfairly targeting the opponent's rights*" and with the intention of "*undermining, in a manner inconsistent with honest practices, the interests of the opponent*".

82. The opponent's allegations of "unfairly targeting" and "intending to undermine in a manner inconsistent with honest practices", must be read and understood in the context of concepts which have been developed by the CJEU in the context of trade mark law. In particular in *Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO*, C-104/18, the CJEU provided the following guidance on the approach to consideration of bad faith:

"45. 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, that concept must moreover be understood in the context of trade mark law, which is that of the course of trade. In that regard, Regulations No 40/94, No 207/2009 and No 2017/1001, which were adopted successively, have the same objective, namely the establishment and functioning of the internal market (see, as regards Regulation No 207/2009, judgment of 27 June 2013, *Malaysia Dairy Industries*, C-320/12, EU:C:2013:435, paragraph 35). The rules on the EU trade mark are aimed, in particular, at contributing to the system of undistorted competition in the Union, 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 the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin (see, to that effect, judgments of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 38, and of 11 April 2019, *ÖKO-Test Verlag*, C-690/17, EU:C:2019:317, paragraph 40).

46. Consequently, the absolute ground for invalidity referred to in Article 52(1)(b) of Regulation No 207/2009 applies where it is apparent from relevant and consistent indicia that the proprietor of an EU trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or 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, in particular the

essential function of indicating origin recalled in the previous paragraph of this judgment.

47. The intention of an applicant for a trade mark is a subjective factor which must, however, be determined objectively by the competent administrative or judicial authorities. Consequently, any claim of bad faith must be the subject of an overall assessment, taking into account all the factual circumstances relevant to the particular case (see, to that effect, judgment of 11 June 2009, *Chocoladefabriken Lindt & Sprüngli*, C-529/07, EU:C:2009:361, paragraphs 37 and 42). It is only in that manner that a claim of bad faith can be assessed objectively.”

83. The same principles were reiterated in *Sky plc v SkyKick UK Ltd* C-371/18 at paragraph 74.

84. In the present case, it is clear that the filing of the contested application by the applicant was a reaction to the opponent’s threats of infringement based on its alleged claims to reputation and goodwill in a sign similar to the one associated with the applicant’s business. It seems to me, therefore, that the applicant’s aim when filing the contested mark was to protect its own business in order to continue to use the mark in accordance with essential function of indicating the origin of the applicant’s goods and services. That is a commercial and reasonable justification for the application. To the extent that, by applying for the contested mark the applicant disregarded the opponent’s alleged claims to reputation and goodwill in a similar mark, such action cannot be said to amount to targeting or be an attempt to undermine in a manner inconsistent with honest practices, the opponent’s interests; in my view, there is no incompatibility of such action with good faith. Finally, there is no evidence of the application for registration of the contested mark being part of unlawful filing strategy.

85. For all of the above reasons, I conclude that the opponent has not established a *prima facie* case of bad faith. The opposition under Section 3(6) fails.

CONCLUSION

86. The opposition has succeeded against the majority of the applicant's goods and services. Subject to any successful appeal, the applicant's mark is refused registration for the following goods and services:

Class 3: *Long lash mascaras; Cosmetics for eye-lashes; Cosmetic preparations for eye lashes; Eyelashes; Eyelash dye; Eyelashes (False -); Artificial eyelashes; Eyelash tint; False eyelashes; Cosmetic preparations for eyelashes; Eyelashes (Cosmetic preparations for -); Adhesives for affixing artificial eyelashes; Eyelashes (Adhesives for affixing false -); Adhesives for affixing false eyelashes; Adhesives for false eyelashes, hair and nails.*

Class 8: *Eyelash curlers; Eyelash separators; Curlers (Eyelash -); Artificial eyelash tweezers; Electric eyelash curlers.*

Class 21: *Eyelash combs; Eyelash brushes.*

Class 44: *Beauty treatment; Salons (Beauty -); Beauty consultancy; Beauty consultation; Beauty counselling; Beauty care; Beauty salons; Beauty salon services; Beauty consultancy services; Beauty information services; Beauty therapy treatments; Beauty care services; Beauty consultation services; Beauty therapy services; Beauty treatment services; Salon services (Beauty -); Beauty advisory services; Hygienic and beauty care; Providing information about beauty; Information relating to beauty; Consultancy services relating to beauty; Human hygiene and beauty care; Advisory services relating to beauty; Beauty care for human beings; Advisory services relating to beauty treatment; Advisory services relating to beauty care; Consultation services relating to beauty care; Beauty treatment services especially for eyelashes; Hygienic and beauty care for humans; Services of a hair and beauty salon; Hygienic and beauty care for human beings; Eyelash extension services; Eyelash curling services; Eyelash dyeing services; Eyelash perming services; Eyelash tinting services.*

87. The applicant's mark may, however, proceed to registration for those services for which I have found the opposition to have failed. Therefore, subject to any successful appeal, the applicant's mark may proceed to registration for the following services:

Class 41: *Beauty school services; Educational seminars relating to beauty therapy; Educational services provided by beauty schools; Educational services in the nature of beauty schools.*

COSTS

88. As the opponent has enjoyed the greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the present case, I consider that it is appropriate to reduce the costs award by 20% in order to reflect the degree of success enjoyed by the applicant in defending those class 41 services that have survived the opposition. In the circumstances, I award the opponent the sum of **£1,080** as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement:	£300
Preparing evidence:	£500
Written submissions:	£300
<u>Sub-total:</u>	<u>£1,100</u>
<i>20% reduction:</i>	<i>-£220</i>
Official fees (not subject to reduction):	£200
Total:	£1,080

89. I hereby order Bomb Lash Ltd to pay Global Beauty Products Limited the sum of **£1,080**. The above 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 29th day of April 2024

Teresa Perks
For the Registrar