

O/0560/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3866564
IN THE NAME OF BEAUTY BIOSCIENCES LLC
IN RESPECT OF THE TRADE MARK

GLOFACIAL

IN CLASSES 03 & 10

AND THE OPPOSITION THERETO UNDER NO. 440518
BY CALEEL + HAYDEN LLC

AND

IN THE MATTER OF REGISTRATION NOS. 801346962 & 912523932

IN THE NAME OF CALEEL + HAYDEN LLC

FOR THE TRADE MARKS



AND



IN CLASSES 3, 5 & 35 AND 3 & 35 RESPECTIVELY

AND CONSOLIDATION APPLICATIONS FOR REVOCATION THEREOF
UNDER NOS. 506308 & 506310
BY BEAUTY BIOSCIENCES LLC

Background and pleadings

1. On 11 January 2023, Beauty Biosciences LLC (“Beauty”) applied to register the trade mark application no. 3866564 for the mark GLOFACIAL in the UK. It was accepted and published in the Trade Marks Journal on 27 January 2023 in respect of the following goods:

Class 3: Body cleaning and beauty care preparations; Beauty serums; Body masks; Cosmetics; Eye cream; Creams for firming the skin; Non-medicated skin serums; Skin cleansers; Skin cream; Skin moisturisers; Cleansing creams; Cakes of toilet soap; Facial soaps; Facial scrubs [cosmetic]; Facial masks; Toners for cosmetic use; Skin lighteners; Hair lighteners; Moisturizers; Beauty care cosmetics; Colour cosmetics for the eyes; Eye pencils; Eyebrow pencils; Mascara; Lipsticks; Lip glosses; Lip liners; Cheek colors; Rouges; Loose face powder; Pressed face powder; Concealers; Make up foundations; Concealers for spots and blemishes; skin cleansing soaps, liquids, lotions, creams, foams, gels, masks, scrubs, peels, and exfoliators; pre-moistened cosmetic wipes; toners, revitalizers, and astringents; skin anti-aging liquids, lotions, creams, foams, gels and masks; non-medicated acne treatment preparations; sun screen preparations; skin shaving liquids, lotions, creams, foams, and gels; non-medicated preparations all for the care of hair and scalp; hair shampoos and conditioners; facial cosmetics and makeup; body fragrances, body sprays and scented mists; toothpaste, mouthwash, and lip balm; skin balms and powders; body massage lotions and oils; skin clarifiers; non-medicated skin care preparations.

Class 10: Medical apparatus and instruments; cosmetic skin purifying apparatus; cosmetic skin clarifying apparatus; cosmetic skin cleaning apparatus; facial pore purifying machines for cosmetic use; facial pore cleaning machines for cosmetic use; electronic devices for nonsurgical cosmetic treatments; cosmetic apparatus for hydrating; electronic aesthetic skin treatment devices using pore infusion and pore extraction; cosmetic apparatus using pore hydration, pore extraction, and light emitting diode (LED) for performing aesthetic facial treatment procedures.

2. On 27 April 2023, Caleel + Hayden LLC (“Caleel”) opposed the trade mark on the basis of section 5(2)(b) and section 3(6) of the Trade Marks Act 1994 (“the Act”). The opposition under section 5(2)(b) is on the basis of its two¹ earlier comparable trade marks² as set out below:

1. Trade mark no. 801346962 (“the “962 mark”)



Priority date: 31 August 2016

Filing date: 23 February 2017

Registration date: 3 November 2017

Relying on all goods registered, those being in classes 3, 5 & 35 set out within Annex A to this decision.

2. Trade mark no. 912523932 (“the “932 mark”)



Filing date: 22 January 2014

Registration date: 17 June 2014

¹ Originally Caleel relied on four earlier marks, however, two of those earlier marks have now been revoked with effect from 18 June 2019, and therefore may no longer be relied upon within these proceedings.

² On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 & 56 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM/IR designating the EU. As a result of Caleel’s marks being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created for each. The comparable UK marks are now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retain their original priority/filing dates.

Relying on all goods registered, those being in classes 3 & 35 set out at Annex B to this decision.

3. By virtue of their earlier priority/filing dates, the above marks constitute earlier marks in accordance with section 6 of the Act.

4. Under section 5(2)(b), Caleel argues that the respective goods and services are identical or similar and that the marks are similar, and that as such, there will be a likelihood of confusion including a likelihood of association between the same. I note Caleel also pleads it holds a family of marks, however, this pleading was made when four earlier marks were relied upon in these proceedings. At this stage only two earlier marks are relied upon, meaning a family argument can no longer be run in this respect.

5. Under section 3(6) of the Act, Caleel argues that due to a past dispute and agreement, Beauty is aware of Caleel's rights in the mark GLO and the associated family of marks, and that despite the agreed upon narrow terms of coexistence, it has filed the mark GLO followed by a non-distinctive element, knowing that this will lead to confusion between the parties. Caleel argues this "goes beyond normal and honest business practices due to the prior dealings between the companies".

6. Beauty filed a counterstatement denying the claims made and requesting that Caleel provide proof of use of its earlier trade marks relied upon.

7. On 17 July 2023, Beauty filed two applications for revocation, one against each of Caleel's earlier marks relied upon within the opposition proceedings above. These were both filed on the basis of sections 46(1)(a) and 46(1)(b) of the Act. In both revocations under 46(1)(a), Beauty pleads that no use of the marks was made for the period of five years directly proceeding the marks registration dates, and that there are no proper grounds for non-use. In both revocations based on section 46(1)(b), Beauty pleads that no use has been made of the marks for two subsequent (and overlapping) periods of five years, and there are no proper grounds for non-use. Under both grounds, Beauty submits the marks should be revoked on the basis of non-use for a continuous period of five years.

8. The effective dates for revocation under both grounds falls the day after the claimed five-year period of non-use. In respect of the “962 mark, the effective date for revocation under section 46(1)(a) is 4 November 2022. The effective dates claimed for the revocation of the mark under 46(1)(b) are either 10 January 2023 or 17 July 2023.

9. In respect of the “932 mark, the effective date for revocation under 46(1)(a) is 18 June 2019. The effective dates for revocation under 46(1)(b) are the same as in the first revocation, those being 10 January 2023 and 17 July 2023.

10. In both revocations, Caleel filed a counterstatement denying the claims, and stating that the marks, or acceptable variants of such, have been used in the last five years.

11. On 17 October 2023, the Tribunal wrote to the parties to confirm that the three sets of proceedings would be consolidated in accordance with Rule 62 of the Trade Mark Rules 2008. The three matters have proceeded as one set of consolidated proceedings thereafter.

12. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Caleel also filed written submissions during the evidence rounds which will not be summarised but will be referred to as and where appropriate during this decision.

13. A Hearing took place before me on 20 November 2024. Caleel was represented in these proceedings by Murgitroyd & Company and was represented at the hearing by Mr Steve Wain of the same. Beauty was represented in these proceedings by Beck Greener LLP and was represented at the hearing by Mr Duncan Morgan of the same.

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

15. Caleel filed its evidence in the form of a witness statement in the name of Jeremy Gurley, Chief Financial Officer of Caleel. The statement is dated 14 December 2023, and introduces 10 exhibits, namely Exhibit JG1 – Exhibit JG10. The evidence goes to the use of the marks, the trade channels of the goods, and the previous dispute and coexistence agreement between the parties.

16. Beauty filed its evidence in the form of a witness statement in the name of Duncan Morgan, a registered trade mark attorney at Beauty's representative firm. The statement is dated 19 February 2024 and introduces 10 exhibits, namely Exhibit DM1 to Exhibit DM10. The evidence goes to the meaning of the word GLOW, UK articles discussing products to use to get "glowing skin" or to make your skin "glow", examples of use of GLOW and GLO for products including skincare products by third parties, examples of other registrations including the element GLO, and finally Caleel's use (or alleged lack thereof) of its marks in the UK.

Approach

17. The opposition filed against Beauty's application relies partly on the earlier marks which are subject to revocation. If the revocation against each of the earlier marks is successful based on either section 46(1)(a), or the earlier date under 46(1)(b), the opposition based on section 5(2)(b) of the Act will fail. I will therefore begin by considering the applications for revocation, following which I will consider the opposition based on any earlier marks that may remain registered.

18. As there will be a significant overlap in the contents of the two revocation actions, I intend to consider these in tandem, whilst also keeping in mind that the marks are different, as are the relevant periods for consideration under section 46(1)(a) in each, and as such the evidence filed in these proceedings may produce different outcomes accordingly.

Revocation nos. 506308 & 506310

19. Section 46 of the Act states:

“46. –

(1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such

commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from- (a) the date of the application for revocation, or (b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”

20. As the marks are comparable marks, paragraph 8 of part 1, schedule 2A is relevant. It reads:

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

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

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

General principles of genuine use

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the

goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

21. Section 100 of the Act states that:

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

22. As the earlier rights relied upon are both comparable marks, use in the EU may be considered up until the end of the transition period on 31 December 2020. However, I note that in this instance, there does not appear to be any evidence of use relating to territories of the EU outside of the UK, and as such, wider EU use is not discussed hereafter.

Variant use

23. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

23. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

24. In this case, the evidence filed by Caleel shows use of various "GLO" marks. It is my view that the word "GLO" holds at best a low level of distinctive character in respect of the goods. I note this here because it means that the stylisation of the marks subject to revocation has a larger impact on their distinctive character and overall impression than it would if this element held a higher degree of distinctiveness. As such, changes to this stylisation will have a greater impact on the distinctive character of the earlier marks. With this in mind, it is my view that the use of the simple word GLO does not constitute use of an acceptable variant of the marks as filed, and nor does the use of the word GLO in an alternative stylisation to the one registered, as the distinctive character of the earlier marks is altered by omission of the stylisation present in the marks registered form. However, I note here, for the avoidance of doubt, the earlier marks are filed in black and white, and the use of the same in alternative block colours will constitute acceptable use of the marks as registered.

25. That said, it is nonetheless my view that use of the marks as registered alongside other descriptive elements, for example use of the "932 mark as registered alongside the word MINERALS or THERAPEAUTICS such as is mentioned within Mr Gurley's witness statement,³ will in my view constitute acceptable variant use of the mark in accordance with *Colloseum*.

³ See paragraph 7 of the witness statement of Mr Gurley

Use in evidence

26. In his statement, Mr Gurley explains that Caleel is a US based company founded in 1997.⁴ He explains that between 2002 and 2017 the company traded under the name “Glo”, and since 2017, it has traded under the name “Glo Skin Beauty”.⁵

27. Mr Gurley explains that Caleel’s primary business is skincare and cosmetics.⁶ He explains the products include an extensive collection of spa-grade exfoliants and professional peels designed for use at home.⁷ He confirms the products are available in at least 40 countries.⁸

28. Mr Gurley explains that between 2002-2017 the goods were sold under a variety of GLO marks, including the “932 mark”⁹ and that goods were sold under this mark in the UK since 2005.¹⁰ He explains that the “962 mark was adopted by Caleel in 2017, including in the UK.”¹¹

29. Exhibit JG1 provides a number of webpages from Caleel’s .com website showing products such as skincare preparations and cosmetics, as well as beauty items including make up brushes and sponges, sold under or with reference to the “962 mark. The prices on these pages are displayed in dollars, and the pages date from 2023. This exhibit also provides an image of facial exfoliants showing the “932 mark alongside the word “therapeutics” said to be from 2013, in addition to webpages said to be from 2013 showing this mark in use in relation to cosmetic items. Again, prices on the pages are all shown in dollars.

30. Exhibit JG1 also provides under the header “Exemplars of Useage (2017)”, images of products such as skin cream and eye shadow, as well as what appear to be webpages (although the address isn’t shown), with a copyright date of 2017 promoting

⁴ See paragraph 5 of the witness statement of Mr Gurley

⁵ See paragraph 5 of the witness statement of Mr Gurley

⁶ See paragraph 6 of the witness statement of Mr Gurley

⁷ See paragraph 6 of the witness statement of Mr Gurley

⁸ See paragraph 6 of the witness statement of Mr Gurley

⁹ See paragraph 7 of the witness statement of Mr Gurley

¹⁰ See paragraph 10 of the witness statement of Mr Gurley

¹¹ See paragraph 8 and 10 of the witness statement of Mr Gurley

the cosmetic items, all showing the “962 mark. Again, prices shown are displayed in dollars. Print outs of Caleel’s website showing skin serums and exfoliants are provided dating from 22 June 2020, again showing the “962 mark. The pages show a .com domain and the prices are in dollars. The commentary provided in Mr Gurley’s witness statement alongside this exhibit states that he believes GLO goods sold in the UK were also labelled with the marks shown in these examples.¹²

31. Exhibit JG2 provides webpages showing goods under the “962 mark on what appear to be UK or UK targeted websites, including Look Fantastic, Skinora, Becky Louise, and Panache London. These sites provide prices for goods such as skincare and cosmetic items under this mark in GBP, however, I note the pages themselves appear to be undated. Also at this exhibit are pages from Caleel’s website dated via the web archiving site the Wayback Machine. The pages show the “962 mark being used between 27 June 2017 – February 2020 on the site, with pages dated 2018 and 2019 also provided. No prices for the goods are shown on these pages, and there is nothing to indicate they are targeted at the UK consumer.

32. Exhibit JG3 provides three pages from Amazon.co.uk showing use of the “962 mark on products including skin serums and facial peels. The pages themselves aren’t dated, but they do provide first available dates of 4 December 2020, 26 August 2021 and 30 April 2021. The products have either one, three or thirty ratings.

33. Mr Gurley has provided sales figures which he states refer to sales of GLO goods in the UK.¹³ These figures are provided in what I take to be USD, and span 2006 – 2022. Figures for 2022 are significantly lower than the others, at around 40,000 USD, and no figures are provided for 2023 despite the statement dating from December that year. This does appear to indicate that sales may have ceased (or significantly

¹² See paragraph 9 of the witness statement of Mr Gurley

¹³ See paragraph 16 of the witness statement of Mr Gurley. Mr Gurley refers to the figures as being of a “commercially sensitive nature in that its disclosure to the public would cause serious and irreparable harm to [his] Company and its business activities in the United Kingdom.” I note no request to keep these figures confidential was made, and it was highlighted to Caleel’s representatives in the letter from the Tribunal dated 3 January 2024 that whilst Mr Gurley’s statement was noted “sales figures are routinely filed in trade mark proceedings without any apparent commercial unfairness. As a request for confidentiality has not been filed, the evidence filed is on the public record.” In light of this, I do not intend to copy the full table of figures into this decision, but I will refer to these figures to the extent that I need to in order to provide a clear and transparent decision.

reduced) in the UK at some point during 2022, at least temporarily. Prior to 2022, sales are consistently between (approximately) 150,000 and 450,000 USD year on year.

34. Mr Gurley explains that the GLO goods have been available to purchase in the UK through Caleel's website directly, in addition to the various distribution agreements in place with UK retailers.¹⁴ Mr Gurley explains that Caleel previously had a UK specific website for use by its former distributors, but that this has now been closed.

35. Exhibit JG4 comprises two articles discussing Caleel's goods. The first article is dated 17 November 2017 and is entitled "glo-minerals rebrands". It shows goods including what appear to be face powder, lipstick and blusher, in addition to what seem likely to be moisturisers and serums, however, it is not possible to tell exactly from the image provided. This talks of the change from "glo-minerals" to "glo Skin Beauty". The article talks of the UK's distributor and as such appears to be targeted at a UK audience. The second article is a review discussing "Glo Skin Beauty UK" dating from 20 June 2018. It refers to them as a "mineral makeup brand" and displays images of goods including eyeshadow, foundation, lipstick and face primer, with the foundation and lipstick clearly showing the "962 mark. The primer appears to show an alternative "glo-minerals" mark, but I note the reviewer states:

"For this post I decided to do a full face of their mineral makeup and review the quality of the products, how they wear throughout the day and whether they're worth the money. As Glo Skin Beauty are in the process of changing their packaging, you will see some of the old Glo Minerals in the pictures, however the products and their quality are the same."

36. Pages from what Mr Gurley explains is Caleel's UK specific Instagram account¹⁵ are produced at Exhibit JG5. These show posts of goods, those being cosmetic items such as concealer, blusher, eye shadow, lip stick, skin exfoliants and serums under the "962 mark. The page name on a number of the posts dating between 5 November 2017 – 5 April 2021 (5 in total) is gloskinbeautyuk. Other posts under page name gloskinbeauty (with no reference to the UK) are also provided. These show similar and

¹⁴ See paragraph 11 of the witness statement of Mr Gurley

¹⁵ See paragraph 15 of the witness statement of Mr Gurley

overlapping goods under the same mark, and posts made over the same time period. Pages are also provided from a “Glo Skin Beauty” Facebook account. This page confirms it is the official UK distributor of the products, and it has 156 thousand likes and follows. Posts are made between 19 December 2017 – 6 April 2021, and again show products such as skincare and make up items under the “962 mark. Exhibit JG6 provides further Instagram posts made by third parties and tagging glofacialuk. There are five in total between February 2018 and October 2022.

37. I have detailed the evidence provided to the extent that I deem relevant for the applications for revocation at this stage. I will refer to the additional exhibits and evidence filed in more detail during the oppositions filed should it become necessary to do so.

38. I note firstly that it is my view no use of either mark has been made in any relevant period in respect of services in class 35. I note Caleel offers its own goods for sale on its website, however, this does not equate to the offering of a retail service for goods to others, nor do I see any other class 35 services being offered under the marks. Further, I do not see any evidence that leads me to conclude that medicated products were offered to consumers in the UK, and as such I also find no use in respect of goods in class 5 as protected by the “962 mark. The marks will be revoked from the earliest effective date, that being as pleaded under section 46(1)(a) for all goods in class 5 and/or class 35.

39. That leaves only the goods registered in class 3 for consideration. I begin by considering the use made under the “932 mark in the UK within the relevant timeframes.

Section 46(1)(b) (the “932 mark)

40. The relevant five year periods for assessing the use of this mark under section 46(1)(b) of the Act are as follows:

- 10 January 2018 - 9 January 2023
- 17 July 2018 - 16 July 2023

41. I note Mr Gurley's statement that as of 2017, Caleel adopted the "962 mark. It is my view that from this statement, in addition to the sum of the evidence provided, it is reasonably safe to assume that use of the "962 mark replaced use of the older marks, including the "932 mark. I note I have not been made aware of exactly when the last use of the "932 mark took place, although I note the webpage from Caleel's .com website dated by the web archiving site the Wayback Machine as being from 27 June 2017, already shows the new branding in place. Further, I note the UK article dating from November 2017 discussing a rebrand and displaying the newer mark. With this in mind, it is my view that it is unlikely there has been any use of this mark during these periods, and if there has been, it will most likely have been at the very beginning. In any case, I note I have no evidence of goods for sale on the market in the UK during these relevant periods under this mark.

42. It is my view that the evidence as a whole is insufficient to show that this mark had been used in the relevant territory, within these relevant periods, for the purpose of creating and maintaining a market for the goods. The "932 mark will therefore be revoked (at least) from the earliest effective date pleaded under 46(1)(b) of the Act, that being 10 January 2023.

Section 46(1)(a) (the "932 mark)

43. I now consider the position in respect of this mark relating to the relevant period under section 46(1)(a), that being 17 June 2014 – 16 June 2019. It is apparent from the statement and evidence that if there is use of this mark, it will be from the first half of this period only, that being up until some point in 2017. The evidence that has been provided relating to the use of this mark in the relevant territory between June 2014 – December 2016 comprises Mr Gurley's statement that it was in use in the UK until 2017 (alongside other "GLO marks"), coupled with the UK turnover figures provided for that time. There is also an image of an eyeshadow product said to date from 2016 showing a mark similar to the "932 mark but without the circle element. I also note the images labelled as examples of use from 2013 (prior to the relevant period) comprising use of the mark on a US website, and use of the mark on tubs of facial exfoliant

photographed. Further, I note there are also a couple of examples of earlier use from 2010 and 2006, again from prior to the relevant period.

44. The evidence provided for this period is sparse, and it is my view that the word of Mr Gurley in his statement is fairly heavily relied upon, with little in the way of supporting evidence. However, considering the sum of the evidence, particularly the provision of the UK specific sales figures and the examples of the mark in use in the year prior to the relevant period, alongside Mr Gurley's statement that the mark was used in relation to the goods in the UK until 2017, it is my view that this does, on balance, show there has likely been use of the mark in relation to some cosmetic items during the relevant period. That said, I note the class 3 goods covered by this mark are as follows:

Class 3: Skin care products, namely, lighteners; hair care products, namely, leave-in conditioning aids, creams, pastes, sprays or mousse, hairsprays, shine or finishing oils, treatment oils, shine sprays, detangling sprays, heat protection sprays and pomades; chemical peel preparations for the skin.

45. I do not find the evidence sufficient to determine genuine use of the mark during this period in respect of any of the specific products covered by the registered terms above. I note a single image showing a skin lightening serum under the mark has been provided, but the date this is from is not clear. It is provided under a header saying "Exemplars of Usage (2020)" although it appears likely judging from the rest of the evidence that it dates from much earlier. There is no specific reference to skin lightening goods in the statement by Mr Gurley, and there is nothing to confirm the portion of goods sold in the UK under the mark during the relevant period that were skin lightening creams (if there were any), particularly considering these goods do not appear to be Caleel's primary goods from the evidence that has been provided. Further, there appears to be no evidence of haircare products being sold, and again these products are not mentioned by Mr Gurley.

46. Whilst I note Mr Gurley mentions "peels" amongst the list of goods sold under the various marks between 2002 – 2017, again these goods do not feature in the evidence showing the use of the "932 mark on the website images dating from 2013 shortly prior

to the relevant period, although I do note the image of something labelled as “Facial Chemical Exfoliant” from 2013, a year prior to the relevant period. I also note the images of what appears to be the US website from June 2017 onwards which (whilst I note for completeness shows the newer mark in use), also don’t appear to feature chemical peels from what can be made out in the evidence provided. I note again the article provided at Exhibit JG4 from November 2017 in which a rebrand of the goods is discussed, which includes an image of a range of makeup and what appears to be skin creams, although it is not clear enough to make out the product description on these. I also consider the description of Caleel being a “mineral makeup brand” in the UK article dating from 2018. Overall, I simply do not consider the evidence sufficient to show that a reasonable portion of the UK sales figures provided for this relevant period may be attributed to sales of chemical peels under the “932 mark, and as such, I do not consider the evidence sufficient to show genuine use of the mark in relation to the same.

47. Overall, whilst it appears the “932 mark was likely in use to an extent in the UK within the relevant period, the evidence is not sufficient to show that genuine use was made in respect of the goods for which it was registered. This mark is therefore revoked under section 46(1)(a) from the effective date of 18 June 2019.

46(1)(b) (the “962 mark)

48. The relevant five year periods for assessment under this ground in respect of the “962 mark are the same as for the “932 mark, those being:

- 10 January 2018 - 9 January 2023
- 17 July 2018 - 16 July 2023

49. Firstly, I note the evidence, including Mr Gurley’s statement, sets out that this mark was introduced (including in the UK) at some point during 2017. As mentioned previously, the evidence provided, including the sales figures for 2022, suggest that sales in the UK likely ceased, or significantly reduced at some point that year. However, up until that point I have been provided with consistent figures for sales in the UK, including for the period between 2018 – 2022 when it appears this mark was

in use. There is evidence showing that the mark was used for skincare items sold on Amazon UK, as well as on a range of cosmetic and skincare goods shown on a UK Instagram account during the relevant periods. Further, I note the use on Caleel's website during this time, which although does not appear to be targeted at the UK consumer, can be considered alongside the statement from Mr Gurley that goods have been sold in the UK under the mark shown since 2017, although I note for completeness there is nothing to indicate the full US range was necessarily available to UK consumers throughout. I also note the UK specific articles provided at Exhibit JG4 dated from just before or within the relevant periods and displaying goods showing the "962 mark on items such as makeup and cosmetics, and also confirming the rebrand that took place in 2017. Overall, it is my view that the sum of the evidence makes it clear that the "962 mark was in use in the UK across a significant portion of the relevant period, that being at least between 2018 and some point in 2022.

50. In terms of the goods for which it can be said that this use was made, I note Caleel's UK Instagram posts provided in evidence are helpful for showing the range of products available to UK consumers under the "962 mark during the relevant periods, as are the UK specific articles and the Amazon UK listings provided. The "962 mark is registered in the UK for the following goods in class 3:

Class 3: Non-medicated body care products, namely, skin cleansing gels, body lotions, dusting powder; skin care products, namely, cleansing creams, bar soap, facial soaps, facial moisture and revitalizing masks, toners, face, body and hand moisturizers, skin care preparations, namely, lotions for controlling excessive oil of the skin and for absorbing oil in the skin, hand creams, cream, liquid and powder foundations, skin creams; glamour and beauty products, namely, eye shadow, eye defining pencils, eyebrow pencils, mascara, lipsticks, lipgloss, lip liner pencils, cheek colors, rouge, loose face powder; pressed face powder, facial blush, blemish concealers, skin concealers and camouflage skin concealers, and skin conditioners; non-medicated lip protector preparations; skin lighteners; beauty creams; non medicated skin care preparations; skin care preparations, namely, chemical peels for the skin; essential oils for aromatherapy use; bath salts; body creams; body oils; body scrubs; body washes; exfoliant creams for the skin; foundation; make-up removers; non-

medicated skin care preparations; pre-moistened cosmetic wipes; skin care boosters, namely, concentrated non-medicated skin care preparations for treatment of a variety of skin conditions; skin cleansers; skin conditioners; non-medicated skin creams; skin masques; skin moisturizers; body scrubs; sun block preparations; sun care lotions; sun screen preparations and non-medicated skin blemish preparations, non-medicated facial and eye serums; beauty serums.

51. From the sum of the evidence provided, it is my view that Caleel has shown genuine use in the UK in respect of goods falling into the following categories as registered:

Class 3: Non-medicated body care products, namely, skin cleansing gels; skin care products, namely, cleansing creams; skin care preparations, namely liquid and powder foundations, skin creams; glamour and beauty products, namely, eye shadow, lipsticks, facial blush, blemish concealers, skin concealers and camouflage skin concealers, beauty creams; non medicated skin care preparations; exfoliant creams for the skin; foundation; pre-moistened cosmetic wipes; skin cleansers; non-medicated skin creams; skin moisturizers; non-medicated facial serums; beauty serums.

52. Whilst I note there is evidence of the mark in use in respect of a slightly broader range of goods than those shown above, these have been omitted where the evidence does not convey, on balance, that those particular goods were available within the relevant period and/or within the relevant territory.

53. I now consider whether the goods outlined at paragraph 51 represents a fair specification in this instance. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they

should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

54. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

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

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

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

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

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those

which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

55. Some of the terms registered as outlined in paragraph 51 are already fairly specific. However, where they are broader, for example in respect of goods such as *non medicated skin care preparations* it is my view that considering the variety of the products shown in the evidence, these categories would be considered by the consumer as fairly describing the goods for which the mark has been used. I therefore find the “962 mark will remain registered in respect of the goods in class 3 outlined at paragraph 51. The mark will be revoked from (at least) the earliest effective date under section 46(1)(b) in respect the goods not outlined above, that being from 10 January 2023.

46(1)(a) (the “962 mark)

55. I note that the relevant period for consideration under this ground is between 4 November 2017 - 3 November 2022. When looking at the evidence in relation to the 46(1)(b) ground above, I have examined the use of the mark since 2018, as well as the evidence pointing to the introduction of the mark shortly before this in 2017. This period overlaps considerably with the period I am required to consider under this ground, and having considered the evidence with the period under 46(1)(a) in mind, it is my view an assessment of the use carried out during this period results in the same outcome my assessment under section 46(1)(b).

56. The “962 mark will therefore remain registered for those goods outlined at paragraph 51 above, and be revoked from the earliest effective date under this ground of 4 November 2022 in respect of remaining goods.

57. I will now move on to consider the opposition filed, based on the goods for which protection of the earlier “962 mark has been maintained. Due to the effective dates of revocation for all other goods and services under both marks relied upon being earlier

than the filing date of the application, that being 11 January 2023, Caleel may no longer rely on the “932 mark in the opposition, or on any of the goods and services revoked under the “962 mark.

Opposition no. 440518

Proof of use

58. As the earlier mark had been registered for a period of over five years at the date on which the contested application was filed, it is subject to the use provisions set out in section 6A of the Act. Caleel must therefore prove it has used its mark for all of the goods and services relied upon within the opposition proceedings. The relevant period for this assessment is the period of 5 years ending with the date of the application for registration, which in this case is the period of 12 January 2018 - 11 January 2023. In the context of the revocation proceedings above, I have already considered whether there has been genuine use of the earlier mark for the period of 10 January 2018 - 9 January 2023. The principles of genuine use are shared across these assessments. With consideration to the evidence filed, I note the difference of two days between these assessment periods will make no material difference to my findings. I therefore find that Caleel has made genuine use of the earlier mark in the context of these opposition proceedings, in respect of all of the goods for which the mark remains registered. I will therefore proceed with the opposition on this basis.

Section 5(2)(b)

58. Section 5(2)(b) of the Act is 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 on the part of the public, which includes the likelihood of association with the earlier trade mark”.

59. Section 5A of the Act is as follows:

“5A 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.”

60. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 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

61. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

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

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

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP

TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. 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."

64. 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") confirmed there is complementarity where:

"...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".

65. In *G rard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

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

66. With the above in mind, the goods for comparison are below:

Earlier mark	Contested application
Class 3: <i>Non-medicated body care products, namely, skin cleansing gels; skin care products, namely, cleansing creams; skin care</i>	Class 3: <i>Body cleaning and beauty care preparations; Beauty serums; Body masks; Cosmetics; Eye cream; Creams for firming the</i>

preparations, namely liquid and powder foundations, skin creams; glamour and beauty products, namely, eye shadow, lipsticks, facial blush, blemish concealers, skin concealers and camouflage skin concealers, beauty creams; non medicated skin care preparations; exfoliant creams for the skin; foundation; pre-moistened cosmetic wipes; skin cleansers; non-medicated skin creams; skin moisturizers; non-medicated facial serums; beauty serums.	skin; Non-medicated skin serums; Skin cleansers; Skin cream; Skin moisturisers; Cleansing creams; Cakes of toilet soap; Facial soaps; Facial scrubs [cosmetic]; Facial masks; Toners for cosmetic use; Skin lighteners; Hair lighteners; Moisturizers; Beauty care cosmetics; Colour cosmetics for the eyes; Eye pencils; Eyebrow pencils; Mascara; Lipsticks; Lip glosses; Lip liners; Cheek colors; Rouges; Loose face powder; Pressed face powder; Concealers; Make up foundations; Concealers for spots and blemishes; skin cleansing soaps, liquids, lotions, creams, foams, gels, masks, scrubs, peels, and exfoliators; pre-moistened cosmetic wipes; toners, revitalizers, and astringents; skin anti-aging liquids, lotions, creams, foams, gels and masks; non-medicated acne treatment preparations; sun screen preparations; skin shaving liquids, lotions, creams, foams, and gels; non-medicated preparations all for the care of hair and scalp; hair shampoos and conditioners; facial cosmetics and makeup; body fragrances, body sprays and scented mists; toothpaste, mouthwash, and lip balm; skin balms and powders; body massage lotions and oils; skin clarifiers; non-medicated skin care preparations. Class 10: Medical apparatus and instruments; cosmetic skin purifying apparatus; cosmetic skin clarifying apparatus; cosmetic skin cleaning apparatus; facial pore purifying machines for cosmetic use; facial pore cleaning machines for cosmetic use; electronic devices for nonsurgical cosmetic treatments; cosmetic apparatus for hydrating; electronic aesthetic skin treatment devices using pore infusion and pore extraction; cosmetic apparatus using pore hydration, pore extraction, and light emitting diode (LED) for performing aesthetic facial treatment procedures.
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Class 3

67. The earlier mark covers *non medicated skin care preparations* as well as *skin cleansers* in class 3. These are identical to the following goods covered by the application, either self-evidently, or in accordance with the principles set out in *Meric*:

Class 3: *Body cleaning and beauty care preparations; Beauty serums; Body masks; Cosmetics; Eye cream; Creams for firming the skin; Non-medicated skin serums; Skin cleansers; Skin cream; Skin moisturisers; Cleansing creams; Cakes of toilet soap; Facial soaps; Facial scrubs [cosmetic]; Facial masks; Toners for cosmetic use; Skin lighteners; Moisturizers; Beauty care cosmetics; skin cleansing soaps, liquids, lotions, creams, foams, gels, masks, scrubs, peels, and exfoliators; toners, revitalizers, and astringents; skin anti-aging liquids, lotions, creams, foams, gels and masks; non-medicated acne treatment preparations; sun screen preparations; skin shaving liquids, lotions, creams, foams, and gels; and lip balm; skin balms and powders; skin clarifiers; non-medicated skin care preparations.*

68. The earlier mark covers the goods *pre-moistened cosmetic wipes*. These are identical to the following goods in the application:

Class 3: *pre-moistened cosmetic wipes*

69. The earlier mark covers *glamour and beauty products, namely, eye shadow, lipsticks, facial blush, blemish concealers, skin concealers and camouflage skin concealers and foundation*. These goods are identical to the following goods covered by the application, either self-evidently, or in accordance with the principles set out in *Meric*:

Class 3: *Colour cosmetics for the eyes; Lipsticks; Cheek colors; Rouges; Loose face powder; Pressed face powder; Concealers; Make up foundations; Concealers for spots and blemishes; facial cosmetics and makeup*

70. The following goods included in class 3 of the application are types of makeup for the eyes, eyebrows or lips:

Eye pencils; Eyebrow pencils; Mascara; Lip glosses; Lip liners

71. The purpose of the above goods is either identical or similar to that of *eye shadow* and *lipsticks* covered by the earlier mark. They are all used for the purpose of improving or altering the appearance of the eye/eyebrow or lip areas. There will likely be a difference in the nature of the goods, however, they are all likely to include a creamy/waxy or glossy substance that is safe for application to the face. The method of use will be similar, and there is likely to be a significant overlap in trade channels. Users, by way of the general public or beauticians, will also be shared. I also note that lip glosses and lip liners may be complementary to lipsticks where they are designed to be worn together and to colour match, as the consumer is likely to believe they derive from the same undertaking in those circumstances. The rest of the goods are unlikely to be complementary. I note the possibility for an element of competition between lip glosses and lipsticks and eye pencils and eye shadows, where the consumer is choosing between one product or another to add colour to their lips or eyes. Overall, I find lipsticks similar to lip liners and lip glosses to a high degree, and eye pencils similar to eyeshadows also to a high degree. Whilst eyebrow pencils and mascaras are slightly further apart, I still find these similar to the earlier goods outlined to between a medium and high degree.

72. The earlier mark covers the goods *skin cleansers*. These goods have some overlap in purpose to the *non-medicated preparations all for the care of hair and scalp; hair shampoos and conditioners* which are or include cleansing products for the hair. Both will be used to clean a person, although the specific purpose (for cleaning the hair vs cleaning the skin) will differ. They will also have a similar nature, being thick liquids which likely turn into a foam when used. They are likely to share trade channels such as cosmetic and beauty outlets, and be sold in similar sections in supermarkets, although they are unlikely to be placed side by side. The goods will not be complementary or in competition, but they will share users by way of the general public. The method of use will also be similar, as the liquids will be lathered into a foam

and rubbed on a person's skin or body. Overall, I find the goods similar to a medium degree.

73. The earlier goods include a range of skin and makeup products, including those such as *foundation*. The contested goods include *hair lighteners*. The goods may be of a similar consistency, however, the ingredients used in each will differ. Hair lighteners will include bleaches for use on the face, for example on the upper lip. With both being applied to the face, there will be an element of similarity in the method of use. Whilst the purpose of the goods differs in that one is for evening out skin tone and one for lightening hair, both are for the purpose of making a cosmetic change to a person's appearance, including the face. Users will overlap by way of the general public and beauticians. Whilst the goods may both be sold in cosmetic stores, and may be placed near each other in larger supermarkets, they are unlikely to be side by side in either scenario. The goods will not be complementary or in competition. Overall, I find the goods to be similar to a low degree.

74. The contested goods include *body fragrances, body sprays and scented mists*. The earlier goods include *non medicated skin care preparations*. These will include items such as scented hand and body lotions. There is an overlap in purpose between scented hand and body lotions and the contested goods as both may be for the shared purpose of making the user smell nice, although I note the lotions will have dual purpose, to also moisturise the skin. The nature of the goods will differ. The method of use will differ, as the earlier goods will be rubbed into the hands or skin, whereas the contested goods will be sprayed onto the body. Users will be shared by way of the general public. Trade channels will likely be shared with both being sold in together more varied shops, as well as in specialised fragrance outlets. Where the goods are sold in larger stores, they will often be placed together or sold as part of a set for example. There is no real complementarity, but there is a small element of competition where the consumer chooses between a spray or mist or lotion to use to smell a certain way. Overall, I find the goods similar to a medium degree.

75. The application covers the goods *toothpaste* and *mouthwash*. The earlier goods include *skin cleansers*. The contested goods are for the purpose of removing and preventing the build-up of plaque around the teeth and gums, whereas the earlier

goods are for removing dirt from the skin. Whilst the goods may occasionally be of a similar consistency, their makeup will differ significantly, and the contested goods will not be suitable and likely not safe for application on the face, whereas the earlier goods will not be safe or recommended for use in the mouth. Users may be shared to the extent that they may both be used by the general public. Trade channels may overlap only to the general extent the goods may both be found in pharmacies, but they are unlikely to be placed next to each other in the same. The method of use will differ, and the goods will not be complementary or in competition. Overall, I do not find the very general overlap in consumers and trade channels to be sufficient to result in similarity, and I find these goods to be dissimilar.

76. The earlier goods include *non medicated skin care preparations*. The contested goods include *body massage lotions and oils*. Whilst it is my view that the earlier goods will include moisturising body lotions and oils, I do not consider that it will include those designed for massage (as opposed to skin care). The goods are therefore not identical. However, I do find that the nature of the goods will likely be very similar, although massage lotions and oils are likely less absorbent than those designed to care for the skin only. They will both be rubbed into the body and so the method of use will also be shared. Whilst the purpose will differ, there may be an overlap where some massage lotions and oils also boast skin hydration properties. Users will be shared by way of the general public as well as professionals such as beauticians and those providing treatments in a spa environment. I do not find the goods complementary or in competition, but there may be an overlap in trade channels. Overall, I find the goods similar to between a medium and high degree.

Class 10

77. The contested goods include *medical apparatus and instruments*. I see no reason to consider these goods similar to the earlier goods. The nature, purpose and method of use will all differ, and they will not be in complementary or in competition with each other. Whilst users may be shared, it will only be at a very general level, in that all of the goods may be used by the general public. Where all of the goods are sold together, for example, in a pharmacy, they will be in completely separate sections of the store. Overall, I find these goods to be dissimilar.

78. The remaining contested goods in class 10 are all types of skin care apparatus, those being:

cosmetic skin purifying apparatus; cosmetic skin clarifying apparatus; cosmetic skin cleaning apparatus; facial pore purifying machines for cosmetic use; facial pore cleaning machines for cosmetic use; electronic devices for nonsurgical cosmetic treatments; cosmetic apparatus for hydrating; electronic aesthetic skin treatment devices using pore infusion and pore extraction; cosmetic apparatus using pore hydration, pore extraction, and light emitting diode (LED) for performing aesthetic facial treatment procedures.

79. The earlier goods include *non medicated skin care preparations*. The above goods will not share a nature or method of use with these goods. However, they may share a purpose to an extent, for cleaning or hydrating the skin, and improving its appearance. It is my view that the contested goods may sometimes be used alongside the earlier skincare preparations and be at least important to one another, to the extent that the consumer would believe they derive from the same entity, and as such there may be an element of complementarity. The overlap in purpose means there may occasionally be an element of competition, although it is not likely to be particularly pronounced. Users will be shared by way of the general public purchasing goods for use in their skincare routines, as well as professionals such as beauticians. I note the evidence showing skin care devices being sold alongside skin care preparations for example, as provided by Caleel at Exhibit JG8, and this accords with my own understanding that the trade channels are also likely to be shared, with both being available to purchase in specific beauty retail outlets, as well as more general stores where the goods will likely be placed near each other if not directly next to each other. Overall, I find the goods to be similar to a medium degree.

80. Where the goods are found to be dissimilar, the opposition based on 5(2)(b) of the Act must fail.¹⁶ I therefore proceed with the opposition on this ground in respect of those goods found to be similar only.

¹⁶ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Comparison of marks

81. 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 Court of Justice of the European Union 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.”

82. It would be wrong, therefore, to dissect the trade marks artificially, 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.

83. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	GLOFACIAL

84. The earlier mark comprises the word “GLO” in large, stylised letters, with the wording “SKIN BEAUTY” in much smaller, standard text underneath. The word “GLO” is the most dominant element of the mark, with its font also contributing to the overall

impression of the mark. The wording “SKIN BEAUTY” plays a very small role in the marks overall impression, although it is not entirely negligible.

85. Although it is presented as one word, the contested mark comprises two distinguishable elements, those being GLO and FACIAL. Neither element is particularly distinctive, however, I consider that GLO is at the beginning of the mark and is missing its ‘w’ making it slightly more unusual, and it therefore plays a slightly larger role the marks overall impression.

Visual comparison

86. Visually, the marks coincide through the use of the three letters “GLO”, placed in a dominant position in the earlier mark, and at the beginning of the earlier mark where elements tends to have more impact visually.¹⁷ The contested mark is filed as a word mark which protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquímica v EUIPO*, Case T-24/17, paragraph 39. The font used in the earlier mark therefore makes less visual impact in the comparison. The use of the word “FACIAL” in the contested mark acts as a significant point of visual difference, whilst the wording “SKIN BEAUTY” in the earlier mark only acts as a very small point of difference due to its size. Overall, the marks are visual similar to a medium degree.

Aural comparison

87. Aurally, the marks coincide through the single syllable word “GLO” which will be pronounced as the English word “GLOW”. They differ through the use of the word FACIAL in the contested mark, which will be pronounced in the normal way. It is my view that the small wording “SKIN BEAUTY” in the earlier mark is unlikely to be verbalised, but if it is it will also be pronounced in the normal way. In both situations, by virtue of the shared single syllable GLO, which I note again is placed at the

¹⁷ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02,

beginning of both marks where it also tends to have a greater impact aurally,¹⁸ I find the marks aurally similar to just below a medium degree.

Conceptual comparison

88. At the hearing, Mr Wain for Caleel submitted that GLO is the dominant element of each mark conceptually. Mr Morgan for Beauty submitted:

“Conceptually, it is our position that the marks are not similar. GLOFACIAL is a single word and will be perceived as a specific thing, a noun; a treatment for face which has the effect of causing it to glow.”

89. The dominant element of the earlier mark is the word GLO. It is my view this will be an obvious misspelling of the word GLOW, and it is the concept of GLOW that will be conveyed by this element to consumers. Collins dictionary provides a number of definitions of the word GLOW that accord with my understanding of the same, and it is my view that the most likely meaning construed by this element in this case is as below:¹⁹

“2. singular noun

A **glow** is a pink colour on a person's face, usually because they are healthy or have been exercising.

The moisturiser gave my face a healthy glow that lasted all day.”

90. The small wording “SKIN BEAUTY” will in my view, convey to the consumer the ordinary meanings of the words, that being of the skin that covers the human body, and beauty meaning the state of being beautiful. The word “FACIAL” in the contested mark will convey to the consumer the concept of products or a treatment designed for the face. Both of these additions will help emphasise the meaning of the word GLO as being related to a person’s complexion.

¹⁸ As above.

¹⁹ <https://www.collinsdictionary.com/dictionary/english/glow> [accessed 4 June 2025]

91. Overall, the earlier mark will convey the concept of glowing, beautiful skin, and the contested mark will convey the concept of a facial treatment or product that results in a glowing complexion. There is clearly an element of overlap, although they are not conceptually identical. I find the marks conceptually similar to a relatively high degree.

Average consumer and the purchasing act

92. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

93. 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.”

94. The average consumer of the class 3 goods will primarily comprise members of the general public. The goods themselves are all items that may be purchased fairly frequently, often at a relatively low cost. Whilst I note that some items will sit at a higher price point, for example where they are made out of particularly expensive or sought after ingredients, this does not raise the level of attention paid in respect of the category of the goods as a whole. I note some consumers will pay a higher than average level of attention to the goods on the basis of having particular skin conditions or allergies, however, for the most part the consumer will have no reason to pay a particularly high level of attention. However, the consumer will likely consider factors

such as fragrance, colour, durability and suitability for their requirements and skin type, and possibly the type of ingredients used and the ethical practices of the company responsible. Overall, I find the level of attention paid in respect of the goods to be medium.

95. The contested class 10 goods that I have found to be similar comprise different types of skin care apparatus. It is my view these may also be purchased by the general public. I note these goods are likely to sit at a slightly higher price point and be purchased slightly less frequently than the preparations themselves, and factors such as cost, quality and effectiveness may be considered. However, overall, I do not find these goods warrant a high level of attention, with purchases not being particularly expensive or high stakes, or of a medical nature for example. Overall, I find a medium degree of attention may be paid in respect of the same.

96. I note the goods in both class 3 and class 10 may also be purchased by professionals in the field of beauty or dermatology. I find that the degree of attention paid by the professional consumers will be higher than that of the general public due to the increased liability of purchasing these goods to use on others in a professional capacity. I find the level of attention paid to the goods in class 3 and 10 by these professionals will likely be above medium, as the choice of goods may directly impact their ability to do their job, their reputation and ultimately their business.

97. The purchasing process in respect of most of the goods will be primarily visual, and the goods are likely to be purchased from online or physical retail stores or pharmacies. However, I also note the goods may be recommended by beauticians, dermatologists, or peers, and that verbal assistance may be sought from retail staff. As such I cannot disregard the aural comparison.

Distinctive character of the earlier trade mark

98. 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).”

99. The earlier mark comprises the dominant word “GLO” in a stylised form, alongside what I consider to be the entirely descriptive wording “SKIN BEAUTY”. It is my view that due to their descriptive nature, the words “SKIN BEAUTY” contribute nothing to the inherent distinctive character of the earlier mark.

100. It is my view that the word GLO will be immediately viewed as a misspelling for the word GLOW. The word GLOW itself, in my view, also inherently lacks distinctiveness in the context of the goods. As shown by the definition of the word set out earlier in this decision, this word may be used to describe the desired effect of the goods themselves. Further, even if it is not considered directly descriptive, it is my view it is in any case devoid of distinctive character, due to its use alone not appearing to designate the economic origin of these sorts of goods. However, I note it is the word GLO rather than GLOW included within the earlier mark, presented in a somewhat stylised form. Whilst I note the stylisation does not add a *huge* amount to its distinctiveness inherently, and whilst I am aware that the misspelling of a word may

not always result in the word being inherently distinctive,²⁰ I also note I am not examining the registrability of this earlier mark at this stage, and I am reminded that registered marks must be afforded at least some level of distinctive character inherently.²¹ With this in mind, I find the earlier mark holds the lowest level of distinctive character afforded to a registered mark, by virtue of the somewhat stylised and misspelt word GLO.

101. I have in this instance, been provided with evidence of use of the earlier mark, which I have outlined earlier in this decision. When considering whether the distinctive character of a mark has been enhanced through use, it is the perception of the UK consumer at the relevant date, that being the filing date of the opposed application of 11 January 2023, that is key. I will not summarise the evidence filed again at this stage, however, I note in particular the UK sales figures provided, which cover the period from which this mark was introduced in 2017, up until 2022. Whilst these are not negligible, in my view they are not particularly significant, especially in the context of the UK market as a whole. I also note that the sales under the mark in the UK are particularly limited in the year leading up to the relevant date in this instance. Whilst I also note the additional evidence filed, including the small selection of UK press articles, these are also in my view, not particularly persuasive. Overall, having considered the sum of the evidence filed, it is my view it falls short of showing that the distinctiveness of the earlier mark will have been enhanced through use.

102. I note here for completeness, that I have considered in full the evidence provided by Beauty showing the use of GLOW and GLO by third parties. However, whilst this evidence acts to reaffirm my own position regarding the level of distinctiveness of word GLO in the context of the goods, considering my assessment above, this will not have any impact on my findings.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

²⁰ See *EC Brand Comércio, Importação e Exportação de Vestuário em Geral Ltda v EUIPO*, Case T-532/19, EU:T:2020:103

²¹ See *Formula One Licensing BV v OHIM*, Case C-196/11P

103. Prior to reaching a decision under Section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 60 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.²² I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods are obtained will have a bearing on how likely the consumer is to be confused.

104. In respect of section 5(2)(b) of the Act, there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.²³

105. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

²² See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

²³ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

106. In this instance, I found the marks to be visually similar to a medium degree, and aurally similar to just below a medium degree. I found the marks to be conceptually similar to a fairly high degree. I found the distinctive character of the earlier mark is inherently low, and that this had not been enhanced through the use of the earlier mark. In respect of the goods I found these to range from identical too similar to a low degree. I found the average consumer of the goods would comprise both members of the general public and professionals and that these consumers would pay level of attention ranging from medium to above medium depending on the consumers and the goods.

107. Whilst I note that a low level of distinctive character does not preclude a likelihood of confusion,²⁴ considering all of the factors outlined above it is my view in this case that the differences between the marks are too significant for the consumer to be directly confused. For the avoidance of doubt, I note at this stage that I find this would be the case even if the consumer were to be paying a lower than medium level of attention. I therefore do not find a likelihood of direct confusion between the marks.

108. I will now move on to consider whether I find the likelihood of indirect confusion between marks. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

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).

²⁴ See *L'Oréal SA v OHIM*, Case C-235/05 P

(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).”

109. I note that the examples above were intended to be illustrative and are not exhaustive. I also keep in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

110. At the hearing, Mr Morgan directed me to *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), in which Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. Mr Morgan directed me in particular to paragraph 44, in which it was said:

“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

111. I also note *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, in which Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak

components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth K.C. summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

112. With this in mind, I have carefully considered all of the factors in this case, keeping in mind that the corresponding element of the marks hold, in my view, the lowest level of distinctive character that may be attributed to a registered mark. However, I also note that despite this, this element remains the most distinctive element in each. I also note that the stylisation used by the earlier mark is not especially distinctive, and the contested mark has been filed in a word only format, meaning it is not tied to any particular presentation. I consider point (6) set out by Miss Himsworth K.C. in *Face2FaceHR* above in particular, and it is my view that where the goods are similar to a medium degree or above, the marks will, for a significant portion of consumers, likely result in indirect confusion. I find that GLO is the element in each

mark that will be relied upon in those circumstances to indicate the commercial origin of the goods, and an assumption of an economic link between the goods will be made on that basis, with the additional descriptive wording indicative of different products in the range. However, where the similarity between the goods is at a low level only, it is my view that due to the distance between the goods, in addition to the other factors in this case, use of this element across both marks will simply be put down to coincidence, and not to an economic connection between the same.

113. The opposition therefore succeeds under section 5(2)(b) in respect of the following goods:

Class 3: Body cleaning and beauty care preparations; Beauty serums; Body masks; Cosmetics; Eye cream; Creams for firming the skin; Non-medicated skin serums; Skin cleansers; Skin cream; Skin moisturisers; Cleansing creams; Cakes of toilet soap; Facial soaps; Facial scrubs [cosmetic]; Facial masks; Toners for cosmetic use; Skin lighteners; Moisturizers; Beauty care cosmetics; Colour cosmetics for the eyes; Eye pencils; Eyebrow pencils; Mascara; Lipsticks; Lip glosses; Lip liners; Cheek colors; Rouges; Loose face powder; Pressed face powder; Concealers; Make up foundations; Concealers for spots and blemishes; skin cleansing soaps, liquids, lotions, creams, foams, gels, masks, scrubs, peels, and exfoliators; pre-moistened cosmetic wipes; toners, revitalizers, and astringents; skin anti-aging liquids, lotions, creams, foams, gels and masks; non-medicated acne treatment preparations; sun screen preparations; skin shaving liquids, lotions, creams, foams, and gels; non-medicated preparations all for the care of hair and scalp; hair shampoos and conditioners; facial cosmetics and makeup; body fragrances, body sprays and scented mists; lip balm; skin balms and powders; body massage lotions and oils; skin clarifiers; non-medicated skin care preparations.

Class 10: Cosmetic skin purifying apparatus; cosmetic skin clarifying apparatus; cosmetic skin cleaning apparatus; facial pore purifying machines for cosmetic use; facial pore cleaning machines for cosmetic use; electronic devices for nonsurgical cosmetic treatments; cosmetic apparatus for hydrating; electronic aesthetic skin treatment devices using pore infusion and pore

extraction; cosmetic apparatus using pore hydration, pore extraction, and light emitting diode (LED) for performing aesthetic facial treatment procedures.

114. The opposition fails under this ground in respect of the remaining goods as follows:

Class 3: *Hair lighteners; toothpaste; mouthwash.*

Class 10: *Medical apparatus and instruments.*

Section 3(6)

115. 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.”

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

“(i) [...]

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

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

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

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

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

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

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

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

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

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

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

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

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

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

117. 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?

118. It is necessary to ascertain what the proprietor 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).

119. In respect of absolute grounds including section 3(6) of the Act, the relevant date is the date the application was filed. That is 11 January 2023.

120. 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. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

Pleadings

121. In its pleadings, Caleel sets out its case under this ground in the following terms:

“The Applicant is aware through a past dispute and concluding agreement of the Opponents rights in the mark GLO and the associated family of marks. Despite this, and the narrow terms of a coexistence agreement reached between the two parties, it has filed an application for a mark formed of GLO with a non-distinctive word attached knowing that this would lead to confusion between the parties. This goes beyond normal and honest business practices due to the prior dealings between the companies.”

122. Within its TM8, Beauty responded to Caleel’s claim above by stating that it required further particularisation in order for Beauty to be in a position to admit or deny any aspect, save for the fact that Beauty admitted there was a past dispute and agreement between the parties. The relevance of the dispute was denied.

123. It was expressed by the Tribunal in a letter dated 13 July 2023 that the Registry maintained its view that Caleel had sufficiently pleaded its case under this ground, but that Caleel would be expected file evidence to prove its case at the appropriate time. It is on this basis that I intend to proceed.

What is the objective the Beauty has been accused of pursuing?

124. I begin by considering the question above. The pleadings set out by Caleel accuse Beauty of being fully aware of its earlier rights and nonetheless filing an application in a manner that it knows would cause confusion with those earlier rights. I take from this that Beauty is accused of filing an application in such a manner so as to either intentionally or knowingly cause confusion with Caleel's rights.

125. In his witness statement, Mr Gurley elaborates on this slightly, explaining that due to Beauty's acknowledgement of its rights in the US, by way of the dispute and the agreement that was in place, Beauty was "[...] aware of [Caleel's] claim to the foregoing GLO trade marks and the importance placed upon the GLO trade marks by [Caleel]. Therefore, the filing of a trade mark such as GLOFACIAL which combines a completely descriptive term with [Caleel's] trade mark GLO, means that [Beauty] was aware that this would be in the face of [Caleel's] rights and reputation in the GLO trade marks and therefore [it is submitted] that the application was filed in bad faith."

126. At the hearing, Mr Wain further submitted:

"It is fairly set out that being aware of somebody else's trade mark is not necessarily an indication of bad faith, but where there were dealings between the two parties and, in particular, with respect to an agreement being reached between the two parties in which the Applicant was fully aware of the claim made to the GLO trade mark, we submit that this is beyond normal honest business practice."

127. On the contrary, Mr Morgan expressed he still did not find it clear exactly what the objective Beauty had been accused of pursuing was, particularly what objective Beauty was accused of pursuing by filing an application "knowing this would cause confusion between the parties".

128. I have some sympathy with Mr Morgan's position here, in that there is not, at any stage, a suggestion of what Beauty might have been hoping to achieve by owning a UK trade mark application that will "cause confusion between the parties", beyond causing confusion alone. I note Beauty is not accused of being in breach of the agreement between the parties. Further, Beauty is not strictly accused of attempting

to benefit from the goodwill or reputation of Caleel through this endeavour, although I do note Mr Gurley's comment that Beauty would be aware the filing was "in the face of" its reputation. Further, I note Beauty is not accused of trying to block or extort Caleel in any way. I accept that the objective of filing an application simply to cause confusion between the parties is a more simplistic than one which elaborates on why the party wishes to cause that confusion, which might usually be expected. However, to my mind, it is nonetheless the objective of which Beauty has been accused.

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

129. I now move on to consider the question above, that being, is the objective of filing an application in order to cause confusion alone, one in which an application cannot be properly filed. I consider that the purpose of filing a trade mark application in the UK should be to gain protection for a mark that the applicant intends to use, in order to designate that the goods or services of the applicant derive from the applicant. It is a guarantee of origin to the public, and there is a public interest in ensuring that consumers are able to distinguish between the goods of individual traders, in order to make repeat purchases where they feel they have been well served, or alternatively avoid repeat purchases or seek appropriate compensation where they feel they have been let down. Filing a trade mark in order to intentionally cause confusion with another trader, whatever the motive for that confusion, is in my view against the public interest and undermines the purpose of the trade mark register. It is therefore, in my view, inconsistent with honest practices, and is an objective for the purposes of which an application cannot be properly filed.

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

130. I now move on to consider whether it has been established that the application was filed in pursuit of that objective.

131. I consider the evidence filed in this instance. Firstly, I note Caleel has filed an agreement between the parties. This is heavily relied upon by Caleel to prove its case.

The contents of that agreement concern the two parties involved in these proceedings, along with another third party. The agreement discusses the use of the mark GLOPRO by Beauty at that time. No reference is made to any additional mark, including GLOFACIAL. There is no express confirmation given by Beauty that no other “Glo” marks will be used. There is an acknowledgement that Caleel distributes and sells skincare products under a variety of brands including GLO and GLOPROFESSIONAL, and that it owns a US trade mark and service mark. The agreement expressly states that it is for the purpose of settlement only and there is no acceptance of liability between the parties. Further, the agreement is governed by the laws of the state of Delaware. It is dated in 2017.

132. I also note the evidence filed by Beauty in these proceedings, including the internet pages provided at Exhibit DM9 from the web archiving site the Way Back Machine. These provide screenshots dating back to 16 October 2021 and up until 24 February 2024 from Caleel’s website, showing that it was only shipping its goods to the US and Canada at that time. Further, I note the evidence provided at Exhibit DM10 that Caleel’s UK Facebook and Instagram pages were no longer being maintained as of 2 November 2021, as well as Mr Morgan’s statement that when he went on to Caleel’s UK website referenced on those Facebook and Instagram accounts on 19 February 2024, it appeared to be a “parked domain” and not hosting a website.

133. The relevant date for establishing that the application was filed in bad faith is 11 January 2023. It is my view that at that time, the evidence establishes as follows:

- Both parties had been using different “Glo” marks in the US either during or prior to 2017;
- Beauty acknowledged Caleel’s use and US registered trade mark at that time;
- No admission as to liability was made by either side in 2017;
- No reference was made to the use of any other GLO marks, including the one subject to these proceedings;
- At the time that the application was filed, it appears likely there was not much use of Caleel’s marks in the UK.

134. I consider that although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12. Further, given the territorial nature of IP rights, the mere appropriation of a name registered/used abroad (for example in the USA) is not enough under UK law, there must be something else involved before this can justify a finding of bad faith: *Wright v Dell Enterprises Inc.* (HOGS AND HEFFERS), BL O/580/16,

135. Similarly, the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

136. I note an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat Trade Mark*, [2003] RPC 11, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch). However, this does not appear to have been pleaded or established in this situation.

137. Considering the sum of the evidence and the relevant case law, it is my view that the fact the parties were both using GLO marks in the US in 2017 and had come to some sort of coexistence agreement at that time in relation to an unrelated mark, cannot establish that Beauty filed its UK mark with the pleaded objective in mind, that is to intentionally or knowingly cause confusion between the marks. It appears just as likely, or in fact more likely in this case, that it simply filed the new marks in order to protect its business interests under the mark in the UK. The opposition based on section 3(6) of the Act therefore fails.

Final Remarks

138. The application for revocation filed by Beauty against Caleel's "932 mark has succeeded in its entirety, and subject to any successful appeal, the mark will be revoked from the earliest effective date of 18 June 2019.

139. The application for revocation filed by Beauty against Caleel's "962 mark was partially successful. Subject to any successful appeal, it will remain registered for the following goods only, and be revoked for the remaining goods from the earliest effective date of 4 November 2022:

Class 3: Non-medicated body care products, namely, skin cleansing gels; skin care products, namely, cleansing creams; skin care preparations, namely liquid and powder foundations, skin creams; glamour and beauty products, namely, eye shadow, lipsticks, facial blush, blemish concealers, skin concealers and camouflage skin concealers, beauty creams; non medicated skin care preparations; exfoliant creams for the skin; foundation; pre-moistened cosmetic wipes; skin cleansers; non-medicated skin creams; skin moisturizers; non-medicated facial serums; beauty serums.

140. The opposition filed against Beauty's trade mark application no. 3866564 has been partially successful based on section 5(2)(b) of the Act. Subject to any successful appeal, the application will proceed to registration in respect of the following goods only:

Class 3: Hair lighteners; toothpaste; mouthwash.

Class 10: Medical apparatus and instruments.

COSTS

141. Both parties have achieved a roughly equal measure of success across these proceedings. I therefore order that both parties bear their own costs in respect of the same.

Dated this 23rd day of June 2025

R. Le Breton

For the Registrar

Annex A

Class 3: Non-medicated body care products, namely, skin cleansing gels, body lotions, dusting powder; skin care products, namely, cleansing creams, bar soap, facial soaps, facial moisture and revitalizing masks, toners, face, body and hand moisturizers, skin care preparations, namely, lotions for controlling excessive oil of the skin and for absorbing oil in the skin, hand creams, cream, liquid and powder foundations, skin creams; glamour and beauty products, namely, eye shadow, eye defining pencils, eyebrow pencils, mascara, lipsticks, lipgloss, lip liner pencils, cheek colors, rouge, loose face powder; pressed face powder, facial blush, blemish concealers, skin concealers and camouflage skin concealers, and skin conditioners; non-medicated lip protector preparations; skin lighteners; beauty creams; non medicated skin care preparations; skin care preparations, namely, chemical peels for the skin; essential oils for aromatherapy use; bath salts; body creams; body oils; body scrubs; body washes; exfoliant creams for the skin; foundation; make-up removers; non-medicated skin care preparations; pre-moistened cosmetic wipes; skin care boosters, namely, concentrated non-medicated skin care preparations for treatment of a variety of skin conditions; skin cleansers; skin conditioners; non-medicated skin creams; skin masques; skin moisturizers; body scrubs; sun block preparations; sun care lotions; sun screen preparations and non-medicated skin blemish preparations, non-medicated facial and eye serums; beauty serums.

Class 5: Medicated skin care preparations; medicated skin blemish preparations.

Class 35: Retail store services and on-line retail store services, namely, of skin care preparations cosmetics and dietary supplements; retail store services and online retail store services namely, of skin care products; wholesale distributorship services, namely, of cosmetics, body care products, skin care products, skin care preparations and candles.

Annex B

Class 3: Skin care products, namely, lighteners; hair care products, namely, leave-in conditioning aids, creams, pastes, sprays or mousse, hairsprays, shine or finishing oils, treatment oils, shine sprays, detangling sprays, heat protection sprays and pomades; chemical peel preparations for the skin.

Class 35: Computerized online ordering services in the fields of body care products, skin care products and candles; wholesale distributorship services in the fields of cosmetics, body care products, skin care products, skin care preparations and candles.