

O/1020/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3716441
IN THE NAME OF LUSCO LTD.
IN RESPECT OF THE SERIES OF TWO TRADE MARKS**

Lusco/LUSCO

IN CLASSES 3, 10, 18, 24 & 25

AND

**THE OPPOSITION THERETO UNDER NO. 431147
BY COSMETIC WARRIORS LIMITED**

Background and pleadings

1. On 1 November 2021, Lusco Ltd. (“the applicant”) applied to register the trade mark no. 3716441 for the series of two marks Lusco/LUSCO (“the contested marks”) in the UK. The application was accepted and published in the Trade Marks Journal on 19 November 2021 in respect of the following goods:

Class 3: Shoe wax; Shoe polish; Shoe cream; Shoe polishes; Shoe sprays; Shoe cleaners [preparations].

Class 10: Orthopaedic shoe insoles; Orthopaedic footwear [shoes]; Orthopedic footwear [shoes]; Orthotic footwear; Orthopaedic footwear.

Class 18: Leather straps; Leather bags; Leather briefcases; Leather suitcases; Leather handbags; Straps (Leather -); Leather wallets; Leather laces; Leather shoulder belts; Leather bags and wallets; Leather credit card wallets; Key cases [leather goods]; Straps (Leather shoulder -); Shoulder belts [straps] of leather; Leather; Casual bags; Handbags; Gent's handbags; Ladies' handbags; Ladies handbags; Fashion handbags; Straps for handbags; Handbags for men; Handbags for ladies; Handbags, purses and wallets; Handbags made of leather; Wallets; Wallets (Pocket -); Card wallets; Pocket wallets; Credit card wallets; Card wallets [leatherware]; Luggage, bags, wallets and other carriers; Wallets for attachment to belts; Tie cases.

Class 24: Cloth; Cloths; Cloth flags.

Class 25: Shoes; Women's shoes; Athletic shoes; Training shoes; Flat shoes; Running shoes; Walking shoes; Rubber shoes; Shoe straps; Baby shoes; Dance shoes; Shoe uppers; Shoe soles; Leather shoes; Footwear; Children's footwear; Ladies' footwear; Trainers [footwear]; Leather jackets; Leather coats; Leather clothing; Clothing; Tops [clothing]; Children's clothing; Childrens' clothing; Sports clothing; Girls' clothing; Baby clothes; Infants' clothing; Linen clothing; Dance clothing; Woven clothing; Men's clothing; Boys' clothing; Bottoms [clothing]; Silk clothing; Ladies' clothing; Latex clothing; Jackets [clothing]; Shirts; Woven shirts; Short-sleeve shirts; Short-sleeved shirts;

Trousers; Trousers of leather; Trousers for children; Men's and women's jackets, coats, trousers, vests; Coats; Cotton coats; Pleated skirts; Skirts; Vests; Jackets; Sleeveless jackets; Socks; Men's socks; Slipper socks; Ankle socks; Socks for men; Men's dress socks; Boots; Infants' boots; Ladies' boots; Baby boots; Ladies' sandals; Bath sandals; Men's sandals; Baby sandals; Flip-flops; Flip-flops for use as footwear; Pyjamas; Jumpers; Jumper dresses; Jumpers [sweaters]; Jumper suits; Polo neck jumpers; Knitwear; Knitwear [clothing]; Slippers; Leather slippers; Slipper soles; Slippers made of leather; Gloves; Fingerless gloves; Cycling Gloves; Scarfs; Neck scarfs [mufflers]; Hats; Bodysuits; Baby bodysuits; Rompers; Clothes; Sandals; Underwear; Women's underwear; Men's underwear; Ladies' underwear; Thermal underwear; Babies' pants [underwear]; Underwear for women; Silk ties; Chino pants; Sweatshirts; Hooded sweatshirts; Snowsuits.

2. On 18 February 2022, Cosmetic Warriors Limited (“the opponent”) opposed the trade mark on the basis of Section 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). This is on the basis of two of its earlier UK trade marks, details of which are set out below:

LUSH

UK registration no. 3269886 (“the ‘866 mark”)

Priority date: 22 June 2017/Filing date: 10 November 2017/Registration date: 2 February 2018

Under section 5(2)(b) - relying on goods and services in classes 3, 18, 25 and 35 as set out in Annex A to this decision.

Under section 5(3) – relying on services in class 35 as set out in Annex A to this decision.

LUSH

UK registration no. 2113249 (“the ‘249 mark”)

Filing date: 19 October 1996/Registration date: 4 July 1997

Under section 5(2)(b) – relying on goods in classes 24 and 25 as set out in Annex B to this decision and opposing only goods in class 24 & 25 under the contested marks.

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

4. The opponent argues that the respective goods and services are identical or similar and that the marks are almost identical, and that the opponent's earlier marks hold a high degree of distinctive character in the UK. As such, the opponent argues that there will be a likelihood of confusion, including a likelihood of association between its two earlier marks and the contested marks, and that as such the application for the contested marks should be refused under section 5(2)(b) of the Act.

5. The opponent also argues that its '866 mark holds a reputation for its services in class 35, and that use of the contested marks would result in consumers making a link between the marks including assuming they derive from the same economic undertaking. As such, the opponent submits that use of the contested marks will result in an unfair advantage for the applicant, as well as detriment to the distinctive character and reputation of its earlier '866 mark. The opponent therefore submits that the application for the contested marks should be refused under section 5(3) of the Act.

6. The applicant filed a counterstatement stating that their "...brand "Lusco" is not selling similar goods or services" and submitting that the marks are not "...close-match brands..." and that they would not lead customers to be confused between the same. They also deny that the use of the contested marks would be taking advantage of the opponent's reputation. They also requested that the opponent file proof of use of its '249 mark in respect of Footwear only in class 25.

7. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. Only the applicant filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

8. The opponent is represented in these proceedings by D Young & Co LLP. The applicant represents itself.

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

Evidence

10. The opponent filed its evidence in the form of a witness statement in the name of Nicola Karen Dear, Senior Counsel IP & Commercial for the opponent. The statement introduces 22 exhibits, namely Exhibit NKD1 to Exhibit NKD22. The evidence goes to the use of the mark LUSH.

11. The applicant filed its evidence in the form of a witness statement in the name of Ali Fuat Atiker, director of the applicant. The statement includes a range of facts and submissions, the latter of which will not be taken as evidence of fact. It introduces 18 exhibits, namely Exhibit AF1 to Exhibit AF18, and mainly goes towards the use made of the contested marks.

12. Whilst I have not set out the evidence in detail at this stage, this has been fully considered and I will refer to it in more detail where appropriate throughout this decision.

Proof of use

13. The relevant statutory provisions are as follows:

Section 6A:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

14. 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.”

15. 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 Bunderversvereinigung 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].”

16. In this case, only the opponent’s ‘249 mark had been registered for a period of over five years at the date on which the contested marks were filed, and as such it is only this mark that is subject to the use provisions set out under section 6A of the Act. However, although the opponent relies upon a number of goods in classes 24 and 25 under this mark, the applicant has only requested that the opponent prove use of its goods *Footwear* in class 25.

17. Having reviewed the evidence filed, I can identify no instances of the opponent using its mark in relation to footwear of any kind. Whilst I note at Exhibit NKD4 the opponent has filed evidence of its mark being used in relation to socks, this does not assist the opponent for the following reason:

- The evidence filed comprises screen shots dating from 2 March 2023, after the relevant date;

- It is my view that socks fall within the broader category of clothing, not footwear. As such, any use in relation to socks cannot contribute towards a finding of genuine use in relation to footwear; and
- Even if the two issues above were not present, the evidence of use in relation to socks is minimal and would in my view not suffice in and of itself to support a finding of genuine use in relation to these goods.

18. As I have found no use genuine use of the mark in relation to footwear, the opponent may not rely on these goods under its '249 mark within this opposition. However, the opponent may rely on its '249 mark in relation to all of the remaining goods for which proof of use was not requested by the applicant within these proceedings.

Decision

Section 5(2)(b)

19. 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”.

20. 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.”

The Principles

21. 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

22. Within its pleadings, the opponent claims that all of the goods for which protection is sought under the contested marks are either similar or identical to its own goods. Within its TM8, the applicant has not explicitly denied this, although it has denied that the goods *sold* under its contested marks are dissimilar to the opponent's goods or services. The goods sold by the applicant are identified in its counterstatement as causal comfort shoes and leather sandals for men and women. Without an explicit denial of similarity between the goods and services filed and those registered, it is my view that I would be wrong to simply proceed on the basis that the similarity or identity

of the goods and services is in issue, other than in respect of those identified as being sold by the applicant.¹

23. I note however, that some of the contested goods e.g. *handbags*, as well as various clothing items, are self-evidently identical to the goods on which the opposition is based. I therefore intend to proceed at this stage on the basis that at least some of the contested goods are identical to the opponent's earlier goods. If the opposition fails even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

Comparison of marks

24. 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.”

25. 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.

¹ See paragraph 29 of BL O/044/21 *Skyclub* in which Phillip Johnson sitting as the Appointed Person stated that without an explicit denial of the similarity of the goods and services, the hearing officer was wrong to proceed on the basis that the similarity of the goods and services was in issue.

26. The respective trade marks are shown below:

Earlier trade marks	Contested trade marks
LUSH (x 2)	Lusco/LUSCO

27. Both earlier marks comprise the single, four letter word LUSH. The overall impression of the mark resides in this single element.

28. Both marks in the series of two contested marks contain the same five letter word Lusco. I note at this stage, the opponent's argument that these marks will be viewed as comprising two elements, those being LUS and CO, with CO being a known abbreviation for the word company. However, I disagree with the opponent's position on this. I accept that in many instances, the omission of a space between two known words will not make it appear to the consumer as an entirely new word separate to the sum of its parts, rather it will still present itself quite obviously as two words put together. However, in this case I do not consider LUSCO or Lusco to be the sum of two commonly known words. LUS/Lus in and of itself appears to have no relevance or meaning to the UK consumer, and whilst I am familiar with the use of CO/co as an abbreviation for the word 'company' and I believe the average consumer will be too, I do not consider in this context the consumer is likely to break the marks down in this manner, into the unknown element LUS/Lus and the abbreviation for company, as it does not appear natural to do so. 'CO/co' does not to my mind jump out from the marks, and in the absence of any evidence establishing that they will be viewed in this way, it is my view it is more likely that CO/co will simply be considered the suffix to the unknown word LUSCO. The mark as a whole appears to be either a made-up word, or possibly an unknown word of foreign origin, and it is in the single element LUSCO/Lusco that the overall impression of each mark in the series resides.

Visual comparison

29. Visually, the marks coincide through the use of the three letters LUS. These letters are positioned at the beginning of the marks, where they tend to have a greater impact on the consumer.² All being filed as word marks, the use of upper or lower case

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

lettering in the marks does not help to differentiate them visually. However, the contested marks are visually longer, and their endings comprise the letters 'CO/co' as opposed to the earlier marks' 'H'. These elements bear no visual resemblance. At best, I consider the marks visually similar to just above a medium degree.

Aural comparison

30. The earlier marks will be pronounced in the known way as the word LUSH. This is a single syllable word, ending in the soft sh sound. The contested marks will, in my view, be pronounced as LUHS-CO. Whilst they share the initial 'LUH' sound, the rest of the marks sound very different. Overall, I consider them aurally similar to a low degree.

Conceptual comparison

31. Collins dictionary provides the following definitions for the word lush:

“lush

Word forms: luses, lusher, lushest

1. adjective

Lush fields or gardens have a lot of very healthy grass or plants.

...the lush green meadows bordering the river.

The beautifully landscaped gardens sprawl with lush vegetation.

2. adjective [verb-link ADJECTIVE]

*If you describe a place or thing as **lush**, you mean that it is very luxurious.*

...a mirrored bathroom done in soft pink tiles with a lush, plush carpet.

The fabrics were lush.

3. adjective

*If you describe a person or thing as **lush**, you mean that they are very attractive or appealing.*

[informal, old-fashioned]

Supermodel Kate Moss explains how she looks lush for every party.

4. countable noun

If you describe someone as a **lush**, you mean that they drink too much alcohol.
[informal]”

32. It is my view that one of the top three meanings would be most readily construed by the consumer when viewing the mark. The contested mark holds no meaning in the English language, and as previously stated, will in my view either be considered to be an entirely made-up word, or as an unknown word of foreign origin. Due to the immediately graspable concept present in the earlier marks that is not present in the contested marks, I consider these to be conceptually dissimilar.

Average consumer and the purchasing act

33. 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.

34. 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.”

35. The relevant consumers in respect of the majority of the goods will be the general public. In respect of goods such as clothing, footwear, bags, belts and wallets for example, the consumer will consider factors such as quality, aesthetics, and

practicality, and in my view a medium level of attention will be paid. There are some goods, such as shoe creams and sprays in class 3, that will likely warrant a low level of attention, with these often being lower cost items, and with only factors such as compatibility with the material of the shoes being considered to any great extent. Items such as cloths, which in the context of class 24 will include items such as table cloths rather than cleaning cloths, will often likely be relatively low cost purchases but again aesthetics, size and practicality will be considered and as such somewhere between a low and medium degree of attention is likely to be paid to these goods. Where all of these goods are purchased by professionals, such as those stocking retail stores, a slightly higher degree of attention will likely be paid due to the impact the purchases may have on the business and sales.

36. Due to their slightly medical nature, the class 10 goods are likely to warrant a slightly higher degree of attention from the general public, that being at least above medium, and where these are purchased by professionals in the medical industry to pass on to patients for example, the increased responsibility and liability associated with this role means a high degree of attention is likely to be paid.

37. The goods are all likely to primarily be purchased visually, being stocked in retail stores and available on websites. However, where professional consumers are concerned, goods may be purchased over the phone and in all cases verbal assistance maybe sought from retail staff; as such, I cannot completely discount the aural considerations.

Distinctive character of the earlier trade mark

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

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

109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

39. The earlier marks are both simply the known word LUSH. This word has vaguely laudatory connotations, alluding to a luxurious quality to goods or services, but it is not directly descriptive or allusive of the same. It is my view that it holds a slightly below medium degree of inherent distinctive character in relation to the goods.

40. The opponent has filed use of its earlier marks, and as such I may consider if the distinctive character of its two marks LUSH has been enhanced through use. When considering enhanced distinctiveness, it is the perception of the UK consumer at the relevant date, that being the filing date of the contested mark of 1 November 2021, that is key.

41. In her witness statement, Ms Dear explains that the LUSH marks have been used by the opponent continuously in the UK since 1995.³ The brand was created that year in Poole and adopted trade name LUSH at that time.⁴ Ms Dear explains the opponent has gone from running a single store to 950 LUSH stores worldwide⁵ and currently has 118 outlets open in the UK.⁶

³ See paragraph 7 of the witness statement of Ms Dear

⁴ See paragraph 5 of the witness statement of Ms Dear

⁵ See above

⁶ See paragraph 15 of the witness statement of Ms Dear

42. Exhibit NKD2 provides a history of the brand on its website shown via the Wayback Machine dating from 1 October 2020. It describes itself as a “cosmetics company” and states that in the latest ‘WWD Beauty top 100’ it was listed as number 33. Ms Dear explains that product categories sold under the LUSH brand include bath products, shower products, body care, skincare, hair care, makeup, perfume and fragrances, gifts, spa treatments and lifestyle.⁷ Web print outs from the Wayback Machine are provided at Exhibit NDK3 showing the webpage under the mark LUSH selling a range of haircare, soaps, perfumery and lotions under the mark between 2013 – 2021, as well as t shirts and sweatshirts in 2019. A number of the pages provided, including the early pages in this exhibit and the opponent’s webpage dating from 27 October 2021, use the tagline ‘Fresh, Handmade Cosmetics’. The sum of the evidence makes it apparent that this is the opponent’s primary business under the marks. However, Exhibit NKD4 provides pages showing clothing and tote bags for sale under the mark on its website between 2019 and 2020, and ‘knot wraps’ which appear to be silk headscarves, on its social media pages between 2014 – 2019.

43. In her witness statement, Ms Dear provides the UK sales figures under the mark since 2017 as below:

LUSH UK Net Sales Figures				
2017	2018	2019	2020	2021 (Jan- Oct)
Over £145	Over £143	Over £146	Over £114	Over £74
Million	Million	Million	Million	Million

44. In addition, a breakdown by category is provided at Exhibit NKD11. This shows that bath bombs are the opponent’s most popular product, and between them, goods for the bath and shower comprise the most significant portion of the opponent’s sales, but items for the hair, hands and body and soap also make up a large portion of the sales, with make up constituting a much smaller portion. Sales under the category of ‘SWAG’, which Ms Dear explains is often used to refer to the knot wraps and clothing items,⁸ are also provided in this exhibit. Sales of knot wraps appear to be the highest of these items with UK sales of between approximately £340,000 and £640,000 each

⁷ See paragraph 8 of the witness statement of Ms Dear

⁸ See paragraph 12 of the witness statement of Ms Dear

year between 2016 – 2020, whereas items such as tees and sweatshirts show sales between approximately £2,700 up to £35,000 a year between 2016 and 2020 and sweatshirts show sales between approximately £7,000 and £94,000 for the same period. The sales do not necessarily increase in an orderly year on year fashion, and although knot wraps appear to have made the steadiest year on year increase up until 2020, the sale of tees peaked in this period in 2016. When compared to the level of sales in relation to the opponent's bath bombs for example, for which in 2020 UK net sales were £25,361,963, it is clear that this is a relatively small part of the opponent's business.

45. An article on 'design-europe.com' describing Lush as a 'standout' brand on the high street dating from 2018 is provided at Exhibit NKD13. This explains the brand's UK sales grew 13% compared to the UK health and beauty markets 2.9% growth in the same year. The article provides a quote from a Retail Analyst as below:

“Lush's iconic bath bombs are its standout product that appeals to millennial shoppers, generating a cult following and helping establish its reputation in the beauty market as a fun and unique retailer”.

46. A further article provided at this exhibit from “www.growthbusiness.co.uk” dates from 19 September 2018 and names LUSH as no. 2 on its list of “The top 50 rising stars of 2019 in the UK.” Referring to the opponent as a cosmetics retailer, the article explains it rates frequently as the UK's favourite high street store. This article puts the brand's 2017 turnover figures as £80.4 million. Further articles from business publications dating from 2019 and 2020 talking about the success of the cosmetics business run under the opponent's mark LUSH are also provided at this exhibit.

47. In her witness statement, Ms Dear explains that the opponent has a “no paid for advertising policy”,⁹ but and instead relied on “organic user generated content”,¹⁰ although she also explains that promotion of the brand is done in store (“via windows”), on its website and via the LUSH TIMES, via Google and social media.¹¹ She explains the LUSH TIMES is its own publication and in the summer of 2020 175,000 copies

⁹ See paragraph 20 of the witness statement of Ms Dear

¹⁰ See paragraph 21 of the witness statement of Ms Dear

¹¹ See paragraph 20 of the witness statement of Ms Dear

were distributed in the UK, and in winter 2020 668,000 copies were distributed in the UK.¹² Ms Dear also explains that the opponent distributes a newsletter, and distribution figures for these are provided at Exhibit NKD17. Its main distribution figures appear to range between 23,000 and 33,000 in 2018, 35,000 and 48,000 in 2019 and 48,000 and 72,000 in 2020. The frequency of the newsletters issued increased each year from 12 in 2018 to 25 in 2020. Exhibit NDK7 provides a page from Google Analytics showing the number of users of the opponent's website between 2016 – 2020. This shows that between 1 January 2016 and 31 December 2020 there were a total 21,573,181 "users", 22,555,501 "new users" and a total of 44,188,595 "sessions" on the opponent's website. For the period of 1 January 2021 – 31 October 2021, "users" are provided as 4,905,257, "new users" as 4,776,393 and "sessions" as 9,520,251.

48. Examples of third-party press coverage is provided at Exhibit NDK20. This includes three online articles, at least two of which appear to be targeted at a UK audience. There are also extracts from 8 articles from UK paper press, dated between 2014 and 2020. These include articles from the Sun, the Sunday Express and Grazia. Of the online articles, one is an article from the Daily Mail dating from 2010 which names the opponent in a list of "The very best of British beauty". Another is from Glamour UK listing the six best-selling products under the LUSH brand dating from 1 March 2021, although it is not shown in the extract provided which these are. The articles reads:

"Renowned for their bath bombs and distinctive, enticing aroma that wafts down the street of their many retail stores, Lush's quality handmade products have developed a cult following of beauty lovers – and for good reason.

Top notch customer service, ethical sourcing and sustainability distinguish Lush from the crowd, with activism being a huge part of the company's ethos since its launch in 1995.

Campaigns ranging from human rights to animal protection are a huge part of the continuous work Lush does to raise awareness of many global issues. The company continuously strives to ensure this is also reflected in their

¹² See paragraph 23 of the witness statement of Ms Dear

manufacturing process and rest assured, you can make a Lush purchase with a clear conscience as their packaging is 100% recyclable....”

49. Ms Dear provides some examples of the campaigns run in her witness statement,¹³ including:

- A 2017 campaign from the conservation charity Sumatran Orangutan Society, supported by Lush with the aim of restoring orangutan habitat. The opponent sold orangutan soaps to raise money for the campaign including in the UK;
- Over Christmas 2018 the opponent partnered with two celebrity drag queens from RuPaul’s drag race; and
- In September 2021 the opponent partnered with Zero Hour to encourage the passing of the UK Climate and Environment Emergency Bill.

50. Exhibit NKD18 provides screenshots of some of the opponent’s social media pages for the Lush brand. Screenshots showing the date 24 November 2021 show the Facebook for LUSH UK page as having over well over 400,000 likes and follows, and its Instagram page for LUSH UK as having just under 670,000 followers. Its Twitter page for LUSH UK at the same date shows over 188,000 followers. Of course, I cannot be sure exactly what portion of these followers are from the UK, but considering these are the LUSH UK pages, it is safe to assume at least a significant portion are likely to be UK based.

51. A list of the awards and accolades won by the opponent between 2004 and 2021 are provided at Exhibit NKD22. This comprises over 90 awards, ranging from featuring as no. 10 in the Sunday Times list of 100 best companies to work for, various awards issued by PETA and the RSPCA, as well being ranked as the UK’s most popular beauty brand and 5th in the world by Cosmetify Index which ranks over 200 beauty brands in 2020.

52. I have not outlined all of the evidence filed by the opponent. However, this has all been considered. It is my view that from the sum of the evidence provided that at the

¹³ See paragraph 21 of the witness statement of Ms Dear

relevant date the distinctiveness of the opponent's LUSH marks will have been increased to a high level amongst UK consumers. However, I find from the evidence that the opponent is known to the UK consumer as a cosmetics business, primarily selling goods such as bath bombs, shower and bath items and lotions for the face and body. It is my view that in relation to the goods and services relied upon, it will be the class 3 goods soaps (for the face and body) and the related class 35 retail services under its earlier '866 mark for which the distinctiveness of the mark has been enhanced. Whilst the opponent does appear to have been selling some items of clothing, I do not consider the evidence in relation to these items enough to conclude the distinctiveness of the mark has been enhanced in relation to the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

53. Prior to reaching a decision under section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 21 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.¹⁴ 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 both the degree of attention paid by the average consumer and how the services are obtained will have a bearing on how likely the consumer is to be confused.

¹⁴ 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.

54. 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.¹⁵

55. 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.

56. I have proceeded in this decision on the basis that at least some of the goods covered by the earlier marks are identical to those within the application for the contested mark. I found the marks visually similar, at best, to just above a medium degree. I found them to be aurally similar to a low degree, and conceptually dissimilar. Whilst I found the distinctiveness of the earlier marks was inherently below medium, I did find that the distinctiveness of the earlier '866 mark had been enhanced to a high degree through use in relation to some of its class 3 goods and its corresponding retail services. I found the average consumer of most of the goods would be members of the general public paying from a low to an above medium level of attention. I found the purchasing process would be primarily visual, but that I cannot completely discount the aural factors.

57. I note firstly, that there are several elements in my findings that point in favour of the opponent. For example, the identity of the goods, the high level of distinctive character in the mark for some of the opponent's goods and services, and the fact that the purchasing process will be primarily visual, which is where the highest level of similarity between the mark exists. However, I also consider the immediately graspable concept present in the earlier mark. In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

¹⁵ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

58. Whilst I note that this will not always be the case,¹⁶ it is my view that the strong conceptual differences present in this case means it will be less likely that the consumer will fail to notice or recall the differences between the marks. This, coupled with the fact that the aural and visual similarities between the marks are not particularly high, and the significant difference these factors combined make on the overall impressions of the marks, will in my view will be sufficient to ensure the consumer is not directly confused between the marks.

59. I therefore go on to consider a likelihood of indirect confusion. 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).

(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.).

¹⁶ See *Nokia Oyj v OHIM*, Case T-460/07

(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).”

60. 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.

61. I also keep in mind at this stage the factors considered and summarised in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), particularly that where an element of a mark is similar to or identical to an element in another mark, and it retains an independent distinctive role within the marks, it is possible that this may result in the average consumer being confused as a result of the identity or similarity of that sign to the earlier mark.

62. It is my view that none of the instances set out in *L.A. Sugar* apply to this particular set of marks. I therefore consider if there is an element of the contested mark that plays an independent distinctive role in the earlier mark, that would then lead the consumer to being confused as to the origin of the marks. Within its pleadings, opponent argues:

“The beginnings of marks are more memorable than their ends. Further, CO is indicative of ‘company’ so the Applicant’s Mark may be perceived as LUS Company. LUSH and LUS are clearly very close. The marks are therefore highly similar in their distinctive and dominant elements.”

63. The opponent goes on to state there is a likelihood of confusion including a likelihood of association. In respect of the argument above, I have already rejected

this point of view when considering the dominant and distinctive elements and the overall impression of the contested mark. I do not consider that the element LUS holds an independent distinctive role in the marks, which in my view will be considered as the single word LUSCO. I note that my view on this may be different if the first element of the mark was a known word, and perhaps if the presentation of the marks were to lend itself to differentiating the elements in such a way, for example if the earlier mark was LushCo. However, in the present circumstances, to break it up into the elements suggested by the opponent, would in my view amount to an artificial dissection of the marks. I therefore do not consider the average consumer will conclude that the marks are connected through some combination of dissection and subsequent indirect confusion as appears to be the basis for the opponent's argument. Further, I see no other reason that the consumer would consider that the use of the same three letters in the two different marks would indicate they are likely to derive from the same economic undertaking. In my view, there is no proper basis for finding a likelihood of indirect confusion in this instance, and as such the opposition based on section 5(2)(b) fails.

Section 5(3)

64. The relevant statutory provisions are as follows:

Section 6A:

“(1) This section applies where

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

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

65. As the earlier mark relied upon under this ground is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

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

(b) the references in section 6A(3) and (4) 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 section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

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

66. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

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

67. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements. To be successful on this ground, the opponent must prove it holds a reputation for the earlier mark relied upon amongst a significant portion of the public. It must also be established that the marks are similar. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation it must then be shown that this reputation, combined with the similarity between the marks, will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

68. The relevant date for consideration under section 5(3) of the Act is the application date of the opposed mark, that being 1 November 2021. The opponent claims to hold a reputation in respect of its '866 mark in the UK at this date for the list of retail services set out in Annex A to this decision.

Reputation

69. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

70. I have previously set out highlights of the evidence filed by the opponent. I remind myself of the opponent’s use of the mark in the UK since 1995, its UK sales figures of well over £100 million each year between 2017 and 2020 and over £74 million for the first 10 months of 2021. I also remind myself of the millions of visitors to its UK website each year, the use of words and phrases such as “iconic” and “cult following” in third-party press articles prior to the relevant date, and its presence on various third party

lists of the UK's top beauty or cosmetics companies prior to the relevant period. Although the opponent does not engage in traditional advertising methods, this is not determinative, and the various press articles filed indicate that it has nonetheless managed to convey its image as an 'ethical' beauty brand to the UK consumer. It is my view that the opponent holds a strong reputation under its mark LUSH in the UK in relation to at least the following services relied upon:

Class 35: Retail services being in store, or via the internet, connected with the sale of cosmetics, non-medicated toilet preparations, shower and bath preparations, preparations for care of the hair and bath bombs.

Link

71. I will now move on to consider if I find there will be a link made between the marks, with consideration to the relevant factors as set out in *Intel*.

The degree of similarity between the conflicting marks

72. Earlier in this decision I found the marks are visually similar at best to just above a medium degree, they are aurally similar to a low degree and they are conceptually dissimilar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

73. The services for which the opponent has a reputation under its mark are dissimilar to nearly all of the goods applied for in relation to the contested marks. They are not similar in nature, method of use or intended purpose. Further, they are not in competition or complementary. They appear unlikely to share trade channels and users will only be shared to the extent that they all include members of the general public.

74. The only possible exception to the above is in relation to the applicant's goods *shoe cleaners [preparations]* in class 3. I accept that these goods may include soaps for cleaning shoes. I have previously found that the opponent holds a reputation in

relation to the retail (online or instore) of various categories of goods which will include soaps, though the soaps retailed by the opponent are for washing the hair, face or body. There is a general overlap in users only insofar as the consumer base is the general public, and it is not obvious to me that there is an overlap in trade channels between the applicant's *shoe cleaners* and the retail services for which the opponent has a reputation. The goods and services are not complementary or in competition, and I do not consider that the specific nature, method of use or intended purpose of these particular goods and services overlaps. At best, I therefore find a very low degree of similarity in relation to the applicant's *shoe cleaners [preparations]* and the services for which the opponent has been found to hold a reputation.

The strength of the earlier mark's reputation

75. I found the earlier mark to hold a strong reputation for its services.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

76. As set out previously, I find the opponent's mark to hold a below medium level of inherent distinctive character. However, considering the evidence filed, it is my view that at the relevant date, the distinctive character of the opponent's earlier mark had been enhanced to a high degree in respect of the services for which I have found the opponent holds a reputation.

Whether there is a likelihood of confusion

77. It is possible under section 5(3) for the reputation of an earlier mark to be such that the relevant consumer is likely to believe that the use of a contested mark in relation to similar or dissimilar goods or services will be use of the same or a similar mark deriving from the same or a connected economic entity. A finding of this nature would result in a conclusion that there is a likelihood that the consumer will be confused as to the origin of the marks either directly or indirectly under this ground. However, having considered the factors in this case, particularly the differences between the marks, including conceptual dissimilarity, in addition to the differences between the

contested goods and the opponent's reputed services, I do not find a likelihood of confusion to be present (notwithstanding the strength of the reputation).

78. I remind myself at this stage that finding similarity between the goods and services, or indeed a likelihood of confusion, is not required in order to find a link would be made between the marks, although the closeness of the goods and services is one factor to take into account when considering if the use of the later mark would bring the earlier mark to mind. However, it is my view that in this instance, it is the differences between the marks, including the stark conceptual differences, that will play the biggest role in ensuring that the earlier mark would not be brought to mind by the contested marks. This is then compounded by the differences between the goods under the contested marks and the services for which the opponent holds a reputation. I therefore find no link would be made between the marks in this instance. Alternatively, if any link between the marks were made, it would be so fleeting that there could be no unfair advantage or damage caused as a result of the same.

79. As I have found no link will be made between the marks, the opposition based on section 5(3) must fail.

Final Remarks

80. The opposition has failed in its entirety. Subject to any successful appeal, the application will therefore proceed to registration in relation to all of the goods applied for.

COSTS

81. The applicant has been successful and is entitled to a contribution towards its costs. As the applicant is not professionally represented in these proceedings, the Tribunal issued a costs pro-forma to the applicant for completion on 7 February 2024. This was duly completed and returned by the applicant on 6 March 2024. It claims as follows:

Considering the TM7 (Considering forms filed by the other party)	13 hours
Filing the TM8 (Notice of Defence)	24 hours

Gathering and preparing evidence	24 hours
Considering and commenting on the other side's evidence	14 hours
Written submissions	44 hours
Total	86 hours

82. For litigants in person, the sum to be awarded per hour will be analogous to that set out in the Civil Procedure Rules, Part 46, which is currently £19 per hour. However, costs awarded in proceedings before the Tribunal are intended to be contributory and not compensatory. I consider the hours set out by the applicant within its proforma to be above what I consider to be a reasonable amount for a contributory cost award in this instance. Further, I note that whilst the applicant filed evidence in these proceedings, this was largely not relevant to the decision I had to make. I therefore consider the below cost award reasonable in the circumstances:

Considering the TM7 and preparing and filing the TM8	10 hours
Considering and commenting on the other side's evidence and preparing evidence and submissions	14 hours
Total	24 hours
£19 x 24	£456

83. I therefore order Cosmetic Warriors Limited to pay Lusco Ltd. the sum of £456. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of October 2024

Rosie Le Breton

For the Registrar

Annex A

Goods and services relied upon – Registration no. 3269886

Section 5(2)(b)

Class 3: cleaning preparations; soaps; liquid soaps.

Class 18: Articles of luggage; trunks; travel cases; backpacks; briefcases; handbags; purses; sports bags; gym bags; beach bags; bags for clothing; casual bags; holdalls; rucksacks; satchels; shopping bags; sling bags; suitcases; tote bags; trunks and travelling bags; bumbags; sports bags; casual bags; beauty cases; card cases; umbrellas; parasols and walking sticks; towelling bags; haversacks; bags for campers; attaché cases; wallets; vanity cases; briefcases portfolios; jewellery rolls for travel; make up bags and cases; pouches for holding make-up, and other personal items; toiletry bags; cosmetic bags; cosmetic cases; beauty cases; cases for carrying make up brushes; key cases.

Class 25: Clothing, namely, shirts, T-shirts, hoodies, trousers, jeans, shorts, sports shorts, swimwear, underwear, boxer shorts, robes, pyjamas, articles of outerwear, coats, jackets, jumpers and cardigans, pullovers, knitwear, leggings, headbands and wristbands, sweatshirts; footwear, namely, boots, shoes, trainers; headgear, namely, headbands, hats, caps, visors, baseball caps, beanies.

Class 35: retail services being in store, by mail order catalogues, telephone, or via the internet, connected with the sale of cleaning preparations; soaps; liquid soaps; retail services being in store, by mail order catalogues, telephone, or via the internet, connected with the sale of articles of luggage, trunks, travel cases, backpacks, briefcases, handbags, purses, sports bags, gym bags, beach bags, bags for clothing, casual bags, holdalls, rucksacks, satchels, shopping bags, sling bags, suitcases, tote bags, trunks and travelling bags, bumbags, sports bags, casual bags, beauty cases, card cases, umbrellas, parasols and walking sticks, towelling bags, haversacks, bags for campers, attaché cases, wallets, vanity cases, briefcases portfolios, jewellery rolls for travel, make up bags and cases, pouches for holding make-up and other personal items, toiletry bags, cosmetic bags, cosmetic cases, beauty cases, cases for carrying

make up brushes, key cases; retail services being in store, by mail order catalogues, telephone, or via the internet, connected with the sale of clothing, shirts, T-shirts, hoodies, trousers, jeans, shorts, sports shorts, swimwear, underwear, boxer shorts, robes, pyjamas, articles of outerwear, coats, jackets, jumpers and cardigans, pullovers, knitwear, leggings, headbands and wristbands, sweatshirts, footwear, boots, shoes, trainers, headgear, headbands, hats, caps, visors, baseball caps, beanies; retail services being in store, by mail order catalogues, telephone, or via the internet, connected with the sale of embroidered patches for clothing, heat adhesive patches, patches for clothing, embroidered badges.

Section 5(3)

Class 35: Retail services being in store, by mail order catalogues, telephone, or via the internet, connected with the sale of cosmetics, cleaning preparations, non-medicated toilet preparations, soaps, moisturising and revitalising bath soaps, toilet soaps, fragrance soaps, liquid soaps, cosmetic preparations for baths, lotions, milks, gels, powders, oils, mousses, wax and creams, perfumery, perfumes, perfumed paper, perfuming preparations for the atmosphere, toilet waters, colognes and fragrances, perfume oils, essential oils, perfumed paper for use as drawer linings, perfumed tissues, incense, pot pourri, perfumed sachets, suncare preparations (cosmetic products), dentifrices, mouth washes, depilatory preparations, shaving preparations, deodorants and anti perspirants, toilet articles, cleansing and toning preparations, face masks, shower and bath preparations, make-up, makeup articles, eye makeup, eyebrow pencils, eyeliner, eye crayons and eye shadows, mascaras, eyeshadows, false eyelashes, false fingernails, adhesives for false eyelashes, adhesives for false fingernails, lipsticks, glosses and moisturisers, nail polishes and varnishes, face powders, foundations, blushers and rouge, preparations for care of the hair, shampoos, hair rinses (shampoo-conditioners), hair conditioners, gels, sprays, mousses, balms, hair lacquers, hair colourants, dandruff creams (not for medical treatment), shampoos for dandruff treatment (not for medical treatment), dandruff lotions (not for medical treatment), hair balsams for dandruff treatment, cleaning preparations for cosmetics, abrasive preparations for use on the face, body and/or fingernails, body scrubs, body washes, bubble bath, bath foams, bath melts, bath oils, bath bombs, bath pearls, bath salts and crystals, non-medicated bath salts containing

effervescent materials, shower gels, bath gels, massage cream, massage lotions, massage oils, skin creams, skin cleaners, skin toners, complexion treatments, skin moisturisers, cosmetic preparations for skin care, nail care treatments and creams, powders, eye creams, pumice stones for cosmetic purposes, aromatherapy preparations, cleansing pads, wipes, cotton wool pads and buds, toiletry impregnated tissues and towels.

Annex B

Goods relied upon - UK registration no. 2113249

Class 24: Textiles and textile goods; fabrics; bath linen; bed linen; blankets; curtains; bed and table covers; table linen; household linen; towels; face cloths; napkins; placemats; washing mitts; handkerchiefs.

Class 25: Articles of clothing; footwear; headgear.