O/1044/24

SUPPLEMENTARY DECISION

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

1. On 25 October 2024, a decision in the above opposition proceedings was published under reference number BL O/1020/24 ("my decision"). The outcome of my decision was to dismiss the opposition filed by Cosmetic Warriors Limited ("the opponent") in its entirety. As a result, subject to any successful appeal, I determined that application number 3716441 for the series of two marks shown on the cover page of this decision may proceed to registration in its entirety.

2. Following the issuance of my decision, it has been brought to my attention that I did not have all the papers filed in these proceedings before me when reaching that decision. Whilst I reference at paragraph 7 of my decision that only the applicant filed written submissions in the proceedings, it transpires that the opponent also filed final written submission in lieu of a hearing on 6 March 2024, which, by way of a procedural irregularity, did not make it onto the relevant file. These submissions were therefore not considered within my decision. The opponent has requested that the matter be reviewed based on all of the papers filed, and has asked for a new decision to be issued. I agree that it is reasonable and proper in the circumstances to review my decision, having regard to the full complement of papers filed. Whilst I do not consider it appropriate to set aside my decision in its entirety, I issue this supplementary decision in accordance with Rule 74 of the Trade Mark Rules 2008 in order to rectify the procedural irregularity that has occurred.

Supplementary decision

3. The opponent's final submissions are 34 pages long. The first four pages set out the background to the proceedings. The opponent then moves on to raise what it refers to as 'Preliminary Points'.

4. The first preliminary point raised by the opponent is that the applicant has included submissions within its witness statement. The opponent correctly points out that a witness statement should only include evidence of fact. The

opponent has then highlighted several statements made by the applicant in its witness statement that are submission, rather than fact.

5. Whilst the opponent's point is valid, it was in my view sufficiently addressed within my decision. I stated at paragraph 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.*"

6. The next issued raised under the opponent's preliminary points refers to irrelevant, incorrect and/or unsubstantiated points within the applicant's counterstatement and witness statement. Firstly, the opponent raises that the applicant's statements concerning its own business plan/use/advertising strategy are not relevant to the matter. I agree, and I have not taken this into account within my decision. The opponent has also highlighted that the applicant's rights in Turkey (which the applicant has referenced) are not relevant to the UK proceedings. Again, I agree, and these rights have not played a part in influencing my decision. The opponent continues in this manner, highlighting further sections of the applicant's counterstatement or witness statement that it deems to be irrelevant or incorrect. However, I note that none of the statements highlighted by the opponent had any influence on my decision.

7. The opponent then refers to what it considers to be illegible or incomprehensible evidence. This is in reference to the applicant's exhibit AFA18 and AFA8. It is my view that the opponent should have raised any concerns it had regarding illegible evidence earlier on in the proceedings, so that the applicant may have been given an opportunity to provide a copy that is legible to the opponent, as I note this appears to be legible at my end. However, in any case, this ultimately had no bearing on my decision.

8. The opponent then goes on to make submissions regarding proof of use of its earlier mark. I have now reviewed these submissions. As with all the opponent's

submissions, I have considered these from the same viewpoint I would have if I were yet to issue a final decision in this matter. However, having now considered these, it is my view I would again make the same assessment and reach the same conclusion on proof of use as I have done within my decision.

9. The opponent then makes submissions in relation to the 5(2)(b) section the opposition. I note and have read the submissions made regarding the similarity of the goods and services, but I do not need to address them here. This is because the analysis in my decision was on the basis of identical goods and I would have taken the same approach had I considered the opponent's particular submissions prior to writing my decision.

10. The opponent then goes on to file submissions regarding the similarity of the marks. The opponent highlights that the marks begin with the same three letters. This was taken into account within my decision. The opponent also repeats its argument that the contested marks may be interpreted as Lus-Company. I dismissed this argument within my decision, and I do not consider that the submissions filed by the opponent would have changed my view on this point. The opponent's submissions regarding the aural similarity of the marks, whilst noted, also would not have changed my assessment of or conclusion on the same.

11. The opponent made submissions on the conceptual similarity of the marks, stating that it is quite plausible that the word 'lus' would be interpreted as an informal or abbreviated form of 'luscious'. I disagree with this position, and had these submissions been before me when writing my decision, I would have dismissed these arguments, explicitly or otherwise, prior to reaching my decision. The opponent goes on to argue that in the alternative, given that LUSCO is not an English word, a conceptual comparison is not possible. This statement from the opponent is incorrect.[1] I am confident that had I considered

[1] See *The Picasso Estate v OHIM*, Case C-361/04 P in which the Court of Justice of the European Union found that where the meaning of at least one of the two marks is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those marks may counteract the visual and phonetic similarities between them. It is clear therefore,

the opponent's final written submissions regarding the conceptual similarity of the marks prior to making my decision, I would still have reached the conclusion that the marks are conceptually dissimilar (or not similar).

12. The opponent directs me to various established principles, all of which were taken into account when reaching my decision. The opponent submits that the attention paid by the relevant consumer in relation to the identical and similar goods will vary from average to high. In my decision, I have put the opponent in a slightly more favorable position, finding that the level of attention paid by the consumer will, in respect of some of the goods, be low. If I had reviewed the opponent's submissions prior to making my decision, I may have accepted the opponent's position that the level of attention paid to the goods and services was at least average in this instance, but this would have ultimately had no impact on the outcome of my decision. The opponent notes that the visual comparison will be particularly important but that aural considerations will also play a role, due to the purchasing process of the goods. These submissions align with the findings I made in my decision.

13. The opponent submits that an enhanced distinctive character must be taken into consideration when assessing whether confusion exists. This has been done within my decision.

14. The opponent submits I must keep in mind the interdependency principle when making my decision. This has also been done.

15. With regards to the opponent's comments that the contested mark may be considered part of the LUSH 'family of marks', if this was intended to be a true 'family argument', it is clear that this is not justified in the circumstances. The reliance on two identical earlier marks cannot form the basis of a 'family' of marks. If I had read the opponent's reference to a family of marks within its final submissions prior to reaching my decision, I would have dismissed this.

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that a conceptual comparison is both possible and indeed very relevant even where one mark has no obvious meaning.

16. I have reviewed the opponent's arguments regarding the likelihood of direct and indirect confusion made within its final submissions. None of what has been said would have changed my view, as expressed in my decision, that there will be no likelihood of direct or indirect confusion between the marks.

17. The opponent's submissions go on to address its opposition based on section 5(3) of the Act. The opponent provides its own evidence summary and submits it holds a strong reputation "in relation to the class 3 goods relied upon in these proceedings". Having reviewed this statement, I note that I have, in error, failed to outline the opponent's reliance on its goods in class 3 under section 5(3) of the Act, under its '886 mark. This was an oversight on my part when drafting the decision. However, I now have the opportunity to correct this oversight, and ensure that the reliance on the class 3 goods is outlined and reference is made to the same. I set out here for completeness, that under section 5(3) of the Act, the opponent also relies upon all goods in class 3 under its '866 mark and these are set out at Annex A to this supplementary decision. I note here, for the reasons set out at paragraph 70 of my decision, that I find the opponent also holds a strong reputation (and a high degree of enhanced distinctive character) under its mark in relation to the class 3 goods *cosmetics, non-medicated toilet preparations, shower and bath preparations, preparations for care of the hair and bath bombs* in addition to the retail services in relation to the same, as outlined within my decision. However, I do not consider this significantly increases the similarity with the contested goods, and I do not consider it makes any impact overall on the outcome of my decision, within which I found it was the differences between the marks, including the clear conceptual difference, that play the biggest role in ensuring the earlier mark will not be brought to mind by the use of the later mark. The opponent's reliance on its class 3 goods under this ground does not alter my conclusion.

18. I have reviewed the opponent's submissions made in respect of 'link' under section 5(3) of the Act, and find that had I reviewed these prior to making my decision, they would have had no impact on my finding that there will be no link

made between the marks. It remains my view that the marks simply are not similar enough, in the circumstances, for a link to be made. Whilst I note the opponent's submissions regarding its previous collaborations with other entities, this does not change my view that the earlier mark would not be brought to mind by the use of the contested mark, or linked in anyway. As I found no link, it is not necessary to outline the opponent's submissions on damage at this stage, although I have read and considered these for completeness.

Conclusion

19. It is my view that the fact that the opponent's written submissions were not before me when drafting my decision, and my failure to outline the opponent's reliance on its class 3 goods under its section 5(3) ground, were irregularities in procedure, albeit ones that ultimately made no material impact to the outcome of my decision. It is my view that these are irregularities that can be rectified under Rule 74 of the Trade Mark Rules 2008. Consequently, I give the parties notice that this supplementary decision corrects the irregularities that have occurred.

20. The appeal period in opposition no. 431147 will therefore be reset, and begins from the date of this supplementary decision.

Dated this 5th day of November 2024

Rosie Le Breton

For the Registrar

Annex A

Class 3: Cosmetics; cleaning preparations; non-medicated toilet preparations; soaps; moisturising and revitalising bath soaps; toilet soaps; fragrance soaps; liquid soaps; cosmetic preparations; cosmetic preparations for baths; lotions, milks, gels, powders, oils, mousses, wax and creams, all for use on the skin; 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; room fragrances; 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 and adhesives therefor; 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 and fixatives for hair styling and hair care; 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; decorative transfers and skin jewels for cosmetic purposes.