

O/1113/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 4021873
IN THE NAME OF POPILUSH, LLC

FOR THE FOLLOWING TRADE MARK:

popilush

IN CLASS 25

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 448193 BY

COSMETIC WARRIORS LIMITED

BACKGROUND AND PLEADINGS

1. On 5 March 2024, POPILUSH, LLC (“the applicant”) applied to register “popilush” as a trade mark in the United Kingdom. Registration is sought for the following class 25 goods:

Bodices [lingerie]; Corselets; Clothing; Trousers; Coats; Skirts; Underpants; Brassieres; Sports singlets; Belts [clothing]; Girdles; Underwear; Tights; Teddies [underclothing]; Adhesive bras; Pyjamas; Leggings [trousers]; Swimsuits.

2. The application was published for opposition purposes on 22 March 2024 and, on 24 June 2024, Cosmetic Warriors Limited (“the opponent”) opposed the application, in its entirety, under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. For the purpose of the opposition under section 5(2)(b), the opponent relies upon the following trade marks and the goods set out below, for which they are registered:

United Kingdom Trade Mark (“UKTM”) 3269886:

LUSH

Filing date: 10 November 2017

Registration date: 2 February 2018

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 25)

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. (Class 35)

UKTM 2113249:

LUSH

Filing date: 19 October 1996

Registration date: 4 July 1997

Articles of clothing; footwear; headgear. (Class 25)

UKTM 913135331:¹

LUSH

Filing date: 1 August 2014

Registration date: 26 December 2014

Clothing, footwear, headgear. (Class 25)

4 To support its claim under section 5(3), the opponent relies upon its mark ending '886 ("LUSH") and the goods set out below:

Cosmetics; cleaning preparations; non-medicated toilet preparations; soaps;

¹ The opponent's mark is a comparable mark based on an earlier EUTM. On 1 January 2021, comparable marks were automatically created in accordance with Article 54 of the Withdrawal Agreement between the UK and EU. They are now recorded on the UK register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

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. (Class 3)

5. Under the provisions laid out in section 6 of the Act, the opponent's trade marks clearly qualify as earlier marks. In accordance with section 6A of the Act, as each had completed its registration procedure more than five years prior to the filing date of the

applicant's mark they are, in theory, subject to the proof of use requirements. However, within its counterstatement, the applicant was asked whether it wanted the opponent to provide proof of use in respect of the earlier marks. The applicant answered "No".² As a consequence, the opponent can rely upon all earlier marks and the goods and services it has identified without providing evidence of use.

6. Under section 5(2)(b), the opponent submits that the high degree of similarity between the parties' marks, and the identity or high degree of similarity between the respective goods and services, would give rise to a likelihood of confusion. It further submits that the opponent's earlier marks enjoy a high degree of inherent and acquired distinctiveness in the UK. Under section 5(3), the opponent contends that its earlier mark has established a strong reputation in the UK and that use of the applicant's mark would take unfair advantage of its reputation and could be detrimental to the earlier mark's distinctiveness and cause reputational damage.

7. In its counterstatement, the applicant denies all of the opponent's claims, with the exception of the matter of similarity between the parties' goods, which it admits are similar. Nonetheless, the applicant submits that the marks' differences will not be overlooked by the average consumer and confusion will therefore not occur. In respect of the section 5(3) ground, the applicant puts the opponent to proof of its alleged reputation and argues that, even if the registry were satisfied that the earlier mark enjoys a reputation in the UK, the disparity between the parties' marks and the distance between the relevant goods means that the relevant public would not establish a link between them and, therefore, no damage would be incurred.

8. The opponent is represented by D Young & Co LLP and the applicant by Pawel Wowra. Only the opponent elected to file evidence during the course of the proceedings. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

² See Question 7 of the applicant's TM8

Relevance of EU Law

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's evidence comes in the form of a witness statement from Ms Gabriela Felix Francisco, an Intellectual Property Lawyer for the opponent, alongside twenty supporting exhibits (GFF1-GFF20). Ms Francisco has been employed by the opponent since October 2017 and her statement is dated 24 October 2024. I take the following from the opponent's evidence:

- The opponent licences the LUSH brand (comprising a variety of "LUSH" marks) to Lush Ltd and its affiliates.
- LUSH was created in Poole in 1995 and began use as a trading name in the same year. Since then, LUSH has expanded into over 880 LUSH branded stores in over 50 countries including Canada, America and Japan.
- A manifesto from the opponent's website indicates an interest in using natural ingredients in its products and supporting "best environmental practice". It also proudly acknowledges that none of its ingredients are tested on animals. It has raised over £8million for charities in the field of environment, human rights and animal protection and, in 2023, it contributed over £90,000 to support Ukraine charities.
- Products offered under the LUSH brand can be categorized as "*bath products*,

*shower products, body care, skincare, hair care, makeup, fragrances, gifts, spa treatments, lifestyle... and 'keep clean'.*³ A Wayback Machine print retrieved from June 2020 shows website⁴ headings including *bath & shower, face, body, hair and fragrances*. A selection of archived screenshots with dates ranging from 2011 to 2024 show products for sale such as body lotion, cleanser, soap, shampoo, lip scrubs and, in its 'Lifestyle' section of the website, sweatshirts, t-shirts and tote bags⁵.

- From the opponent's site <https://lush.com/uk/en>, users can select their appropriate 'setting' according to their region. 'United Kingdom' is shown at the top of the drop-down menu, with other regions beneath displayed in alphabetical order (Austria, Bahrain, Belgium, for example). The opponent owns domain names including *lush.com* and *lush.co.uk*. UK consumers have been able to access these sites since 1999, with LUSH products continuously available for purchase in the UK from this period onward⁶. Between 1 January 2016 and 31 December 2020, the opponent's UK site attracted over 21.5 million users and over 44 million "sessions" were engaged. Between 1 January 2021 and 31 October 2021, the site attracted over 4.9 million users and over 9 million "sessions".⁷ Total users of the UK LUSH website between October 2022 and May 2024 stands at 48,436 with a total of 69,286 sessions.⁸

- UK consumers are also able to purchase the opponent's products via its mobile application, which has been available for download since 2019 and, between 2022 and 2024, received over 390,000 downloads in the UK.⁹ In Google Play, the app is described as "With early access to products and exclusive content, the Lush app is where you can be inspired to connect and explore a range of fresh handmade cosmetics. Shop and save your favourite items and discover new ones, all whilst enjoying a rich content experience." The landing page for the app in the Apple Store is

³ See paragraph 7 of Ms Francisco's witness statement

⁴ www.lush.com

⁵ Jan 17, 2022 (Wayback Machine)

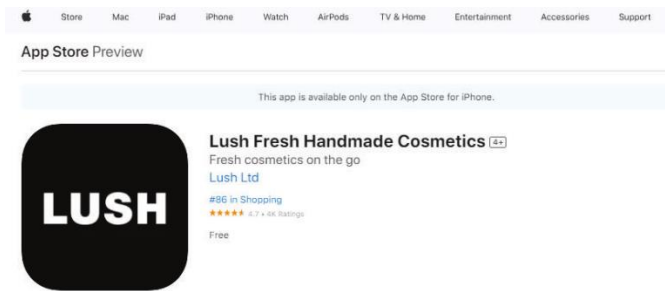
⁶ An order form dated "SUMMER 1999" displays a list of available products (under headings such as soap and hair care, for example) and reads "ORDER ONLINE AT www.lush.co.uk"); GFF5

⁷ See Google Analytics data enclosed at Exhibit GFF6

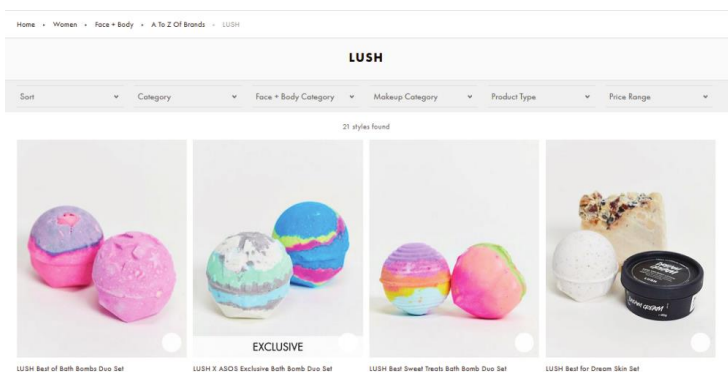
⁸ Data generated by the Google Analytics 360 tool

⁹ See Exhibit GFF7

reproduced below:



- In June of 2021, LUSH collaborated with online retailer ASOS to sell a selection of its products. At this time, ASOS had over 24 million active users. A quote from the brand in an article from COSMETICS BUSINESS¹⁰ reads: “Even if we only turn 1% of Asos’ unique users into Lush customers, that’s hundreds of thousands of new people using our wonderful, effective Lush products with embedded values”. An image of the opponent’s goods sold via ASOS is shown below:



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- The opponent’s products have been available in UK retail stores since 1995, with 100 “LUSH” outlets currently in operation, selling identical products to those which are available online. A list of its outlets, as of February 2024, shows a fairly generous nationwide distribution.¹² Locations include, for example, London, Glasgow and

¹⁰ An article in COSMETICS BUSINESS dated 7 June 2021 is headed “Lush chases Asos’ 24 million users with new retail link up”: GFF8

¹¹ 14 June 2021 (Wayback Machine). An article announcing the collaboration in *Refinery 29* from June 2021 shows an example of the available goods on ASOS, with prices displayed in GBP.

¹² Enclosed at Exhibit GFF9

Cardiff. A FASHION NETWORK article¹³ from 5 April 2022 announced the launch of a trial run of an automated “micro store” in King’s Cross, which is essentially a vending machine from which consumers may purchase, for example, haircare products, room sprays and shower products.¹⁴

- An article published in November 2020 reports that the brand which “started with one shop”... “ has a group turnover of more than half a billion pounds”.¹⁵ Ms Francisco also presents the below table detailing the net sales figures of all LUSH branded products in the UK between the years 2017 and 2024:

LUSH UK Net Sales Figures							
2017	2018	2019	2020	2021	2022	2023	2024 (Jan – March)
Over £151 Million	Over £150 Million	Over £154 Million	Over £117 Million	Over £133 Million	Over £141 Million	Over £142 Million	Over £25 Million

- The opponent’s sales figures over the same period are broken down by product type.¹⁶ The “bath bombs” category, for example, shows consistently high sales figures, exceeding £30million in 2017 and 2019 and exceeding £25million in 2018, 2020, 2021 and 2022. Other categories showing consistently high sales include, for example, ‘Bubble Bars’, ‘Face’, ‘Fragrance’, ‘Gifts’, ‘Hair’ and ‘Shower’. Figures from 2009 to 2015 also show sales of various ‘knot-wraps’, as well as jumpers and t-shirts¹⁷. From January to December 2023, net sales of the opponent’s knot-wraps were £388,780.07 and, between January and March 2024 it was £62,440.42.

- Ms Francisco encloses various articles¹⁸ detailing the growth of the Lush brand. An article published in June 2018 describes Lush as a ‘standout’ brand which offers

¹³ GFF9
¹⁴ See paragraph 19 of Ms Francisco’s witness statement
¹⁵ *Dorset Biz News*, 13 November 2020
¹⁶ See GFF10
¹⁷ In 2015
¹⁸ Exhibit GFF12

“iconic bath bombs”, helping to “establish its reputation in the beauty market”.¹⁹ In an article from *Growth Business* in September 2018, Lush UK is listed at number 2 of the ‘Top 50 rising stars of 2019 in the UK’, stating that “The cosmetics retailer... frequently rates as the UK’s favourite high street store”.²⁰

- An article from Statista published in February 2024 reflects on the brand profile of LUSH in the UK in 2023. The article indicates that the data was collated on the basis of 1,039 respondents between 18 and 64 years of age. The article shows that LUSH enjoys a 75% brand awareness in the UK, with 39% of these respondents saying they like the brand. As for customer loyalty, the data shows that “Around 17 percent of health and beauty and health online shop users in the UK say they are likely to use LUSH again. Set in relation to the 20 percent usage share of the brand, this means that 85 percent of their customers show loyalty to the brand.”

- LUSH relies on “organic user generated content” to promote its brand and organises campaigns to support social, environmental and animal causes. In 2018, for example, LUSH partnered with two celebrity drag queens to create photo campaigns, as seen below.



Lush unveils holiday campaign with 'RuPaul's Drag Race' stars

By
AFP-Relaxnews

Published
Nov 01, 2018

Lush is going all-out on the glamour front this holiday season, with a campaign starring no fewer than three queens from the TV show "RuPaul's Drag Race."

- The opponent uses its own publication, the “LUSH TIMES”, to publicise its products and campaigns. Copies are free and distributed alongside online orders and via its retail outlets across the UK. In 2020, it distributed 175,000 copies of its Summer

¹⁹ Cosmeticsdesign-europe.com

²⁰ www.growthbusiness.co.uk

Edition and 210,000 copies of its Winter Edition; in 2021, it distributed 61,000 copies of its Buying Issue, 90,000 copies of its Invention Issue and 177,620 copies of its Winter Issue; in 2022, it issued 90,000 copies of its Summer Edition and 155,000 copies of its Winter Edition and, in 2023, it issued 104,800 copies of its Spring Edition and 177,230 copies of its Winter Edition. These issues were available online and in hard copy. The opponent also distributes newsletters via email, with over 1 million UK subscribers receiving newsletters between 2018 to 2022. I reproduce below a sample of extracts from its newsletters and LUSH TIMES publications:

YOUR TOP 10

THE OLIVE BRANCH (PAGE 15)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

DRAGON'S EGG (PAGE 16)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

HELLO GORGEOUS (PAGE 17)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

DREAM CREAM (PAGE 18)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

SEX BOMB (PAGE 19)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

HONEY I WASHED THE KIDS (PAGE 20)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

KARMA (PAGE 21)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

ANGELS ON BARE SKIN (PAGE 22)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

THE COMFORTER (PAGE 23)
This hair oil is a beautiful blend of olive oil and essential oils. It's perfect for dry, damaged hair and helps to restore its natural shine.

CULTIVATING COMMUNITY

THE RETURN OF FAN FAVOURITES

When you have been in the business of inventing iconic, effective and industry-challenging cosmetics for over twenty five years (since 1995 to be precise!), products come and go. We sometimes need to clear shelf space to show off our latest creations and sadly that means that some products go onto the dreaded "discon" list and are retired never to be seen again.

Luckily, Lush listens! We have always valued the opinions of our customers. They are passionate, discerning and vocal. If they tell us something isn't working, or want us to explore different product ideas or that they miss a product we have discontinued, we take note. The voices of the Lush community and Lush staff were united in particular for the return of these four beloved products.

SPASS DID YOU KNOW? Antioxidants can be ingested or applied to the skin.

KARMA DID YOU KNOW? Our best selling Karma perfume is Lush's longest running fragrance.

HONEY I WASHED THE KIDS DID YOU KNOW? Babies have a gently smoothing effect on the skin.

GREEN DID YOU KNOW? Jasmine blooms and is picked before dawn.

Got Super Milk?

“Believe the hype! This turned my hair from straw to silk.”

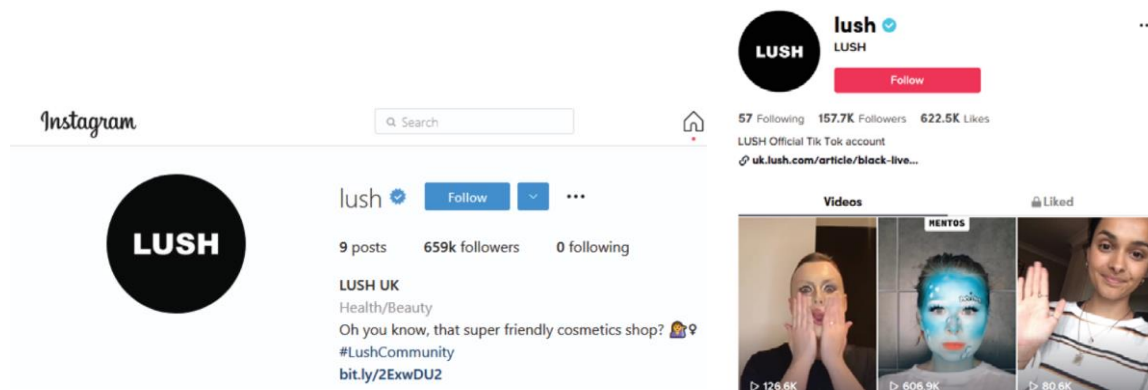


The freshest cosmetics delivered to your door
For the first time, Lush customers will be able to get their favourite fresh handmade cosmetics delivered, directly to their door in as little as two hours!
45 Lush shops - are collaborating with Stuart to offer delivery within a 5 mile radius.

- In 2022, LUSH expanded its promotional efforts to incorporate licensing and brand 11

collaborations. These included, for example, LUSH x “Stranger Things” and LUSH x “Barbie”.²¹

- I enclose below examples of the LUSH brand’s social media platforms:



- An article from *Marketing Week*²² notes that Lush withdrew from Facebook, Instagram, TikTok and Snapchat as part of its ‘Anti-Social Media Policy Pledge’. Ms Francisco explains that the LUSH Group operates a “no advertising policy” and does not expend resource on mediums such as TV advertising, print media or celebrity endorsements. It does, however, promote its products online (via “LUSH TIMES”, its website and online marketing, for example) and through its retail outlets (via window displays). By way of example, the opponent spent over £250k in financial year 2022 and over £400k in 2023 on its window displays and, in the same years, over £2m on paid ads.

- The same article explains that the opponent’s priorities are captured in its “Lush Cosmetics Master Plan” which aims to provide products for “every need”, to be number one in every category and create a “cosmetic revolution” to “save the planet”.

- The “LUSH” brand has headlined articles in a number of high-profile UK publications

²¹ Articles discussing these collaborations are enclosed at GFF17.

²² It is not clear when this was published, but as the article discusses the financial year 2021/22, it seems reasonable to conclude that this must have been 2022 at the earliest.

including the Daily Mail²³ and GLAMOUR²⁴, with its goods featuring in articles from the magazines of The Sun²⁵ and Sunday Express²⁶ and the pages of Grazia²⁷.

- Ms Francisco draws my attention to a number of accolades awarded to the opponent between the years 2004 and 2024. Some of these go to the opponent's role as an employer²⁸, some to its standard of customer service²⁹ and some its sustainable and environmental initiatives³⁰. Other awards recognise the opponent's success as a retailer and brand, as well as celebrating some of its specific products. For example, in 2020 the opponent was ranked as the UK's most popular beauty brand by Cosmetify Index ranking. Its "Super Milk" was the winner of Best New Styling Product at the Pure Beauty Global Awards 2021 and its "Sleepy Body Lotion" was voted the "Hero Product" at the Bella Beauty Awards in 2022. In the same year, Lush was awarded Best Vegan Skincare in the VegNews Veggie Awards and it received the Glamour Beauty Power List Award for Best Sustainable Brand in 2023.

11. That concludes my summary of the opponent's evidence, insofar as I consider it necessary.

DECISION

Section 5(2)(b)

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

²³ An article headed "The very best of British beauty" includes LUSH in its shortlist; 29/12/21

²⁴ "These are Lush's 6 best-selling products (and they're all under £18!); 01/03/21

²⁵ "Sleepy" body lotion is featured in an article identifying "SIX OF THE BEST STEM SELLERS"; 27/09/18 ("Circulation: ABC 1447959 Daily)

²⁶ "CYNTHIA" shampoo is featured alongside a handful of third party cosmetics; 31/12/17 (Circulation: ABC 330816 Weekly)

²⁷ "What's new beautiful?" features the opponent's Olive Tree Gourmet Soap; 05/02/18 (Circulation: ABC 110031 Weekly)

²⁸ Number 10 on The Sunday Times' 25 Best Big Companies to Work For in 2016, for example. It was also listed in the Forbes "best employer list" in 2022

²⁹ "Top Retailer in Which? Customer Service annual survey of the top 100 big brands" in 2014, for example

³⁰ Winner of *Sustainable Packaging and Sustainable Leadership* in the 2020 Sustainability Awards

“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”.

13. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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:

- (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

14. The competing goods are laid out at paragraphs 1 and 2 to this decision.

15. As for when goods (or services) can be considered identical, in *Gérard Meric v Office for Harmonisation in the Internal Market*,³¹ the General Court (“GC”) stated that:

“29. In addition, the 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.”

16. As indicated earlier in my decision, the applicant has admitted that the parties’ class 25 goods are similar, though it does not identify a particular degree. The opponent’s mark ending ‘249 is registered for *articles of clothing* at large and its ‘331 mark is registered for *clothing* at large. To my mind, these terms are encompassing of the goods for which the applicant seeks registration and they are, therefore, identical.³² In the opponent’s mark ending ‘886, a number of specific clothing and footwear goods are relied upon, some of which are identical to the applied-for goods (*trousers* or *leggings*, for example). I will therefore proceed on the basis that, in respect of all marks relied upon, at least some of the parties’ goods are identical. If the opposition fails where the goods are identical, it follows that the opposition will also fail where the goods (or services) are similar to a lesser degree.

Comparison of marks

17. 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

³¹ Case T- 133/05

³² *Merici*

Court of Justice of the European Union stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,³³ 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.”

18. 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.

19. The competing trade marks are laid out for ease in the table below:

Opponent’s marks ³⁴	Applicant’s mark
LUSH	popilush

20. The opponent’s mark comprises a single four-letter word (LUSH). The marks’ overall impression therefore resides solely in the word itself.

21. The applicant’s mark comprises a single word of eight letters. With no additional components within the mark, its overall impression resides solely in the word *popilush*.

³³ Case C-591/12P

³⁴ The representation of all three of the opponent’s earlier marks is the same. For the purpose of the comparison, I therefore intend to make a single finding in respect of each of the relevant factors

22. Visually, the marks coincide in four-letter sequence L-U-S-H. Little hangs on the variation in casing as protection of a word mark would naturally allow for its presentation in a variety of typefaces and letter casings. The four letters where the marks coincide represent the only letters in the opponent's mark and the final four (of eight) in the applicant's mark. The remaining letters in the applicant's mark (p-o-p-i-) have no counterpart in the opponent's mark. Keeping in mind that it is the *beginnings* of marks which generally have the greatest effect on consumers,³⁵ I find the visual similarity between the marks is of a fairly low degree.

23. Aurally, the opponent's mark is likely to be expressed in a single syllable; LUSH. The applicant's mark will likely comprise three syllables; vaguely POP-IH-LUSH, though I accept that there may be some variation in how consumers articulate the second syllable. Even so, whilst the marks respectively share a syllable in LUSH, there are two additional syllables preceding this element in the applicant's mark, with no counterpart in those relied upon. Particularly in light of what I have said regarding the beginnings of marks, I find the marks are aurally similar to a fairly low degree, notwithstanding the identical syllable.

24. Conceptually, the earlier mark "LUSH" is likely to evoke a readily retrievable meaning. To my mind, the term is commonly used in colloquial terms to mean something which is aesthetically pleasing or alternatively rich in health (it could be used to describe thriving vegetation, for example). Turning to the applicant's mark, to my mind "popilush" is likely to be perceived as an invented word and, consequently, it will not convey any meaning. Whilst I acknowledge that, within the word itself, are identifiable elements such as "pop" and "lush", from which consumers would naturally derive some meaning, I nonetheless take the view that the average consumer will perceive the mark simply as an invented word, absent of any concept. On this basis, I find the marks' conceptual position is neutral.

25. In the alternative, were the consumer to identify and derive any concept from the

³⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

“lush” element within the applicant’s mark, it will take on the same meaning as it does in the opponent’s marks. However, this line of reasoning would indicate that the consumer may also derive some meaning from the mark’s “pop” element, which will be awarded its ordinary definition, so “lush” would not be the mark’s sole concept. Even in these circumstances, the applicant’s mark in its entirety will still be perceived as an invented word which does not offer a clear meaning, in its entirety at least. Were the consumer to take any meaning away from “lush” within the applicant’s mark, in light of my above findings, I find the marks’ conceptual similarity would be of no more than a fairly low degree.

26. As a final point, I must make clear that I have considered the opponent’s submissions concerning the consumer’s perception of the applicant’s mark (particularly the POPI element), though I keep in mind that the submissions were made in the context of distinctiveness. The opponent submits:

“... “POPI-” is reminiscent of the word “poppy” in sound, appearance, and meaning to the average consumer. The average consumer would likely perceive the “POPI” element of the Application as describing a characteristic of the Contested Goods – such as clothing decorated with poppies or having a scent or appearance reminiscent of poppies or flowers, or as having a “pop” of colour, such that the clothing is attractive and stands-out.”³⁶

For completeness, I find these interpretations of the applicant’s mark, at least its “popi” element, highly unlikely. The consumer will readily identify that “popi” is a distinct word from “poppy” and it is not (to my mind) a common misspelling or alternative way of expressing it and, even so, the average consumer is unlikely to be naturally inclined to make an association between poppies and clothing. I also find it unlikely that the mark’s “pop” element will be perceived as a “pop of colour”. On this basis, my earlier conclusions stand.

³⁶ See paragraph 26 of the opponent’s submissions in lieu

Average consumer and the purchasing act

27. 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*³⁷.

28. In *New Look Limited v OHIM*,³⁸ the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase.

³⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

³⁸ Joined cases T-117/03 to T-119/03 and T-171/03

Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

29. The average consumer of the goods at issue in the present proceedings is a member of the general public. As indicated in the above extract, the goods are typically self-selected from the shelves of a traditional retail environment or an online equivalent. This suggests that the marks’ visual impression is likely to carry the greatest weight, though I do not discount the significance of the marks’ aural impression as recommendations may be made amongst peers, or advice may be sought from retail professionals, for example. The consumer is likely to be alive to considerations such as quality, compatibility and aesthetic impact when approaching its purchase. To my mind, the goods are purchased fairly frequently, though the cost can vary quite widely. Weighing all considerations, I find the average consumer is generally likely to apply a medium degree of attention to its purchase.

Distinctive character of the earlier trade mark

30. *Lloyd Schuhfabrik Meyer*, 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).”

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

32. I have already found that the opponent’s “LUSH” marks will be perceived, conceptually, as a word with which the average consumer will be familiar and, generally, is used to describe things which are aesthetically pleasing (or, in some contexts, healthy and thriving). In the present case, LUSH could be seen to have some laudatory meaning, alluding to aesthetically pleasing clothing products, for example. That being said, the mark is not directly descriptive nor allusive of the goods themselves, more so a possible nod toward their quality or appearance. Weighing these findings, I find the marks are inherently distinctive to between a low and medium degree.

33. I turn now to consider whether the evidence shows that the distinctiveness of the earlier marks 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 5 March 2024, that is key.

34. The opponent’s evidence is extensive and shows the evolution of a longstanding and consistent brand which has been in operation since 1995 and generated a

significant turnover in what I expect to be a crowded market. The net sales figures referred to above are particularly impressive. Articles enclosed in evidence describe some of the opponent's goods as "iconic" and its retail outlets have been frequently rated as "the high street's favourite store"³⁹. The brand enjoys a 75% awareness in the UK with 85% of customers showing loyalty. Whilst it may not employ all traditional means of promotion, there is evidence of means such as, for example, social networks, window displays, distribution of the "LUSH TIMES" and newsletters shared with its subscribers (with over 1 million newsletters issued between 2018 to 2022). The opponent invested over £2million on paid advertisements alone in 2022 and 2023. Its UK website attracted over 21.5 million users between January 2016 and December 2020. The brand at large, and its goods, have featured in high-profile UK publications boasting a significant circulation. It has also been awarded a number of recognitions and accolades as detailed above. I am satisfied that the evidence shows that, by the relevant date, the distinctiveness of the earlier mark(s) had been enhanced to a fairly high degree.

35. With all that being said, I find the marks' distinctiveness has been enhanced only in respect of (in broad terms) its cosmetic goods, which are proper to class 3. However, for the purpose of its claim under section 5(2)(b), the opponent relies upon its goods in class 25. As I have acknowledged, there is evidence of the opponent's marks being used in relation to items of clothing. Screenshots of the opponent's website from 2023 and 2024, for example, show an "Apparel" section, with goods such as socks, t-shirts and pyjamas available to purchase.⁴⁰ There is also a small number of sales shown via invoices of goods such as sweaters and t-shirts, for example,⁴¹ but the sales are on a much smaller scale. I also acknowledge the exhibited promotion, and consistent sales⁴², of the opponent's knot-wraps which, whilst the evidence seems to show are usable as scarves or accessories, are at least in part marketed as an alternative to

³⁹ 2019

⁴⁰ GFF3

⁴¹ See GFF11 showing sales of goods such as an "I Believe in Snow Fairies Sweater" and "No Nukes T-shirt" (for example).

⁴² See, for example, GFF10

traditional giftwrap.⁴³ Even so, its social media platforms and the taglines for its mobile apps, for example, seem to indicate that the opponent is predominantly identified as a *cosmetics* brand. All things considered, to my mind, the evidence falls short of establishing that the distinctiveness of the marks has been enhanced in respect of the opponent's class 25 goods. For the purpose of the present proceedings therefore, it is the marks' inherent distinctiveness to which I must be mindful.

Likelihood of confusion

36. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods and services down to the responsible undertakings being the same or related.

38. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,⁴⁴ where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

⁴³ GFF15: “REUSABLE GIFT WRAP... Don't wrap your presents in wasteful paper wrapping this year, try this beautiful furoshiki Knot-wrap instead!” and “Knot-wraps: beautiful fabrics that make a stylish alternative to gift wrap, paper tape and ribbon... Within a few seconds your knot wrap turns into a bag... Need a quick updo? Knot to worry, you can wrap it easily around your hair. You can also use it as a scarf to complete your outfit”.

⁴⁴ Case BL O/375/10

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

39. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,⁴⁵ Arnold LJ approved Mr Purvis's formulation but added:

⁴⁵ [2021] EWCA Civ 1207

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

40 To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

41. Throughout the course of my decision I have found the earlier marks visually and aurally similar to a fairly low degree. I have found the marks’ conceptual position to be neutral or, in the alternative, there is no more than a fairly low degree of conceptual similarity between the marks. The parties’ respective specifications share at least some terms which are identical. The average consumer of the relevant goods will be members of the general public. The marks’ visual impression is likely to carry the greatest weight in the selection process, though the relevance of the marks’ aural impression cannot be overlooked. The average consumer is likely to apply a medium degree of attention to its selection. I have found the earlier marks are inherently distinctive to between a low and medium degree and, whilst the marks’ distinctiveness may have been enhanced through use, it has not been enhanced in respect of the goods which are relied upon for the purpose of its objection under section 5(2)(b).

42. I will begin by considering a likelihood of direct confusion. Earlier in my decision I elected to proceed on the basis that each of the earlier marks share at least some identical terms with the applied-for specification. Even where this is the case, I do not consider the parties’ marks to be sufficiently similar, visually or aurally, to give rise to

a likelihood of direct confusion. The marks clearly share an identical series of four letters (L-U-S-H), however, these are the final four letters in the applicant's mark, with its preceding four letters having no counterpart in the earlier "LUSH" marks. The average consumer is highly unlikely to overlook the introduction of these additional letters in the applicant's mark, particularly given that they are positioned at the beginning of the mark, or vice versa. In addition, I have found the opponent's marks offer the consumer an instantly familiar concept, whereas the applicant's mark does not and will be perceived instead as an invented word. Weighing all these findings, I am satisfied that the consumer will readily distinguish one mark from the other. In other words, there is no likelihood of direct confusion.

43. I turn now to consider a likelihood of indirect confusion. I have already identified that what the marks have in common is the word, or letter sequence, L-U-S-H. This represents the entirety of the opponent's marks and the final four letters of eight in the applicant's mark. In the applicant's mark, the additional element (p-o-p-i-) which precedes it, to my mind, is not consistent with what will be perceived as a brand extension or sub-brand, for example. Instead, the difference between the marks will be indicative of different marks originating from distinct undertakings. The shared use of L-U-S-H within the respective marks, if identified, will simply be seen as coincidental. Even if one mark were to bring the other to mind on the basis of their shared element this is, in my view, is as far as it will go, and is not sufficient to reach a finding of confusion.⁴⁶ I find this is the position regardless of whether or not the consumer derives any concept from the "lush" element in the applicant's mark (and where this element consequently takes on an identical meaning to the opponent's marks). I can see no proper basis to support a likelihood of indirect confusion.

Section 5(3)

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

⁴⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

“5(3) A trade mark which –

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

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

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

46. For the purpose of its claim under section 5(3), the opponent relies upon its mark ending '886 ("LUSH") and the class 3 goods set out at paragraph 4 to this decision.

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

Reputation

48. In *General Motors*,⁴⁷ 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.

⁴⁷ Case C-375/97

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.”

49. I have already summarised the opponent’s evidence and considered its weight in respect of enhanced distinctiveness. In that context I found that, whilst the marks’ distinctiveness had not been enhanced in respect of the class 25 goods relied upon under section 5(2)(b), it had been enhanced to a fairly high degree in respect of (at least some) cosmetic goods, proper to class 3. I do not intend to reproduce those considerations here but I do revisit some key points of the opponent’s evidence; its UK sales, for example, have exceeded £100million every year between 2017 and 2023. The opponent’s UK website has been viewed by a high number of consumers in the years leading up to the relevant date and the brand has featured in a number of publications, reporting on its growth, licencing deals and collaboration with online retailer ASOS, for example, which (at the time) boasted over 24 million users. Within such articles, the opponent’s goods are described as “iconic” and the LUSH brand a “favourite” and a “rising star”. This degree of popularity amongst consumers is reflected in its 85% brand loyalty, with a 75% brand awareness in the UK. The opponent has also enjoyed a number of notable awards and recognitions which celebrate its role as a sustainable brand and retailer, as well as the quality of its goods. It also seems clear from the evidence that the opponent has made a concerted effort to operate sustainably and ethically and supported various charities and political initiatives. Whilst Ms Francisco has admitted that the opponent does not engage in traditional means of advertisement or promotion, this is not determinative.

The mediums it has utilised throughout the years, as set out in its evidence, have clearly been effective in establishing its position as a leading cosmetics brand amongst UK consumers. The evidence as a whole, to my mind, shows that the opponent has built a strong reputation in respect of, at least, *cosmetics; soaps; shower and bath preparations; preparations for care of the hair and bath bombs*.

Link

50. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

51. Earlier in my decision I found that the parties' marks were visually and aurally similar to a fairly low degree. My primary finding concerning the marks' conceptual similarity is that the position is neutral, on the basis that one mark will readily evoke a concept and the other will not. If I am considered incorrect on this point, in the alternative, I have found the conceptual similarity will be of no more than a fairly low degree.

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.

52. The applicant seeks registration for a variety of clothing goods in class 25 and the opponent has established a reputation in respect of its class 3 cosmetic goods. As for whether these goods are similar, I keep in mind, for example, the factors laid out in *Treat*⁴⁸. The respective goods are not used for the same purpose, are not similar in physical nature, they are unlikely to utilise the same trade channels and they are not competitive. Whilst I accept that, broadly speaking, cosmetic goods and

⁴⁸ [1996] R.P.C. 281

items of clothing may be used to create a cohesive, overall aesthetic, I do not consider the goods complementary.⁴⁹ Weighing all factors, I do not consider the goods are similar. I keep in mind, however, that there is likely to be an overlap in the relevant section of the public selecting the parties' goods, meaning that there is a degree of closeness between them in this regard.

The strength of the earlier mark's reputation.

53. The opponent's marks enjoy a strong reputation for (at least) the goods I have highlighted above.

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

54. As set out previously, I find the opponent's mark to hold between a low and medium degree of inherent distinctive character. I am satisfied, however, that the opponent's evidence shows that the mark's distinctiveness has been enhanced in respect of goods such as those for which I have found it has a reputation to a fairly high degree.

Whether there is a likelihood of confusion

55. 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 regard to the present proceedings, particularly the differences between the parties'

⁴⁹ In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means: "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

marks, as well as the difference between the applied-for goods and the opponent's reputed goods, I do not consider there to be a likelihood of confusion (notwithstanding the strength of the opponent's reputation).

56. I remind myself at this stage that finding similarity between the goods, or indeed a likelihood of confusion, is not required in order to find that a link would be made between the respective marks, although the closeness of the goods is one factor to take into account when considering whether 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 a distinction in the respective conceptual positions, that will diminish the opportunity for the earlier mark to be brought to mind by the contested mark. This is compounded by the distance between the goods for which registration is sought and those for which the opponent holds a reputation. With this in mind, and regardless of any overlap in the relevant public selecting the goods at issue, I reach the view that no link would be made between the parties' marks. Alternatively, if any link between the marks *were* made, on account of their shared element, it would be so fleeting that there could be no unfair advantage or damage caused as a result of the same.

57. As I have found that no link will be made between the marks, there can be no damage. Consequently, the opposition based on section 5(3) must fail.

CONCLUSION

58. The opposition has failed in its entirety. Subject to any successful appeal against my decision, the application will be registered for all goods applied for.

COSTS

59. The applicant has been successful and is therefore entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2023. In accordance with that TPN, I award the applicant costs as follows:

Considering the Notice of Opposition and preparing a counterstatement:	£300
Considering the opponent's evidence:	£450 ⁵⁰
Total:	£750

60. I hereby order Cosmetic Warriors Limited to pay POPILUSH, LLC the sum of £750. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of November 2025

Laura Stephens
For the Registrar

⁵⁰ This amount has been adjusted to reflect that the applicant did not comment on the opponent's evidence