

O/627/21

TRADE MARKS ACT 1994

IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3486290  
BY BEAUTE LASHES  
TO REGISTER:

BEAUTE LASHES

AS A TRADE MARK  
IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001519  
BY WEI JIANG LIANG

## Background and Pleadings

1. On 2 May 2020 Beaute Lashes (“the applicant”) applied to register the trade mark shown below in the UK:

BEAUTE LASHES

The application was accepted and published in the Trade Marks Journal on 25 September 2020 in respect of the following goods:

**Class 3:** *Artificial eyelashes; False eyelashes; Magnetic false eyelashes; Cosmetic preparations for eye lashes; Eyeliners; Magnetic eyeliners; Eyelash extensions; kits consisting primarily of artificial eyelashes; adhesives and bonding agents for affixing false eyelashes and eyelash extensions.*

2. Wei Jiang Liang (“the opponent”) filed a notice of opposition on 18 November 2020 under the fast track opposition procedure on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at some of the goods in class 3 in the application, namely *Artificial eyelashes; False eyelashes; Cosmetic preparations for eye lashes; Eyeliners; Eyelash extensions*. The opponent relies on the trade mark shown below:

**UK00003483922** (“the earlier mark”)

Beaute

**Filing date:** 24 April 2020.

**Date of entry in register:** 4 September 2020.

The mark is registered for a range of goods in class 3 but the opponent relies on the following goods only:

**Class 3:** *Non-medicated cosmetics and toiletry preparations.*

3. In the TM7F the opponent refers to the goods “*Non-medicated cosmetics and toiletry preparations*” as “*Non-medicated cosmetics and toiletry preparations, including eyelash and cosmetic preparation for eyelashes*”. However, I will only consider the term as it is registered.

4. The opponent submits that there is a likelihood of confusion because the contested mark is similar to the opponent’s earlier mark and the respective goods are identical or similar.

5. The applicant filed a defence and counterstatement denying the claims made.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008 (“TMR”) but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

7. The effect of the above is that parties are required to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. The opponent attempted to file evidence within the TM7F filed on 18 November 2020, which contained a hyperlink and examples of the opponent’s mark in use. The opponent was informed by the UKIPO in a letter dated 17 March 2021 that “the Hearing Officer will not undertake any independent research” and consequently the “content of the website will not be considered”. No leave was sought by either party to file evidence in respect of these proceedings. Therefore, the opponent’s evidence will not be considered and I shall say no more about it.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken.

9. A hearing was neither requested nor considered necessary. Only the opponent filed submissions in lieu of a hearing. Although I do not intend to summarise the submissions here, I will bear them in mind and refer to them as necessary throughout the decision. Both parties represent themselves. This decision is taken following a careful reading of all of the papers.

## **Decision**

10. Section 5(2)(b) of the Act is as follows:

(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.”

11. An earlier trade mark is defined in Section 6 of the Act, the relevant parts state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

12. The opponent’s mark qualifies as an earlier mark within the meaning of Section 6(1) of the Act because it has an earlier filing date than the contested application. The earlier mark completed its registration less than five years before the application date of the contested mark and, as a result, is not subject to proof of use provisions.

13. Although the UK has left the EU, Section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **Section 5(2) - Case law**

14. 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.

(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 impression 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods

15. The goods to be compared are as follows:

Applicant's goods	Opponent's goods
<u>Class 3</u> <i>Artificial eyelashes; False eyelashes; Cosmetic preparations for eye lashes; Eyeliners; Eyelash extensions.</i>	<u>Class 3</u> <i>Non-medicated cosmetics and toiletry preparations.</i>

16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

17. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

18. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v 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”.

20. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

21. The opponent submits that both parties share the same class of goods in their specifications. However, this does not necessarily mean that the goods are similar. I will therefore proceed to compare the goods taking into account the relevant guidance.

22. Cosmetic preparations for eye lashes; Eyeliners in the applicant’s specification both fall within the broader category of *Non-medicated cosmetics and toiletry preparations* in the opponent’s specification. Therefore, these goods are identical on the principle outlined in *Meric*.

23. Artificial eyelashes; False eyelashes; Eyelash extensions in the applicant’s specification and *Non-medicated cosmetics and toiletry preparations* in the opponent’s specification coincide in users and purpose, as they will be used as part of a beautification regime. The goods share trade channels, as they are likely to be sold in the same area of the supermarket or retail store, even if they are not sold from the same shelves. The goods are complementary, for example, the opponent’s goods might include cosmetic products used to glue or remove the applicant’s eyelashes. I find the goods to be similar to at least a medium degree.

### **Average consumer**

24. As the law above indicates, it is necessary for me to determine who the average customer is for the parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J 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.”

25. The average consumer of the goods at issue will be a member of the general public with an interest in beauty or a professional in the beauty field. The selection of goods will be primarily visual, as the goods are likely to be self-selected from the shelves of high street retailers, supermarkets, department stores, beauty salons and websites. That said, as the goods may also be the subject of oral requests and consumers may be assisted by sales staff, aural considerations must not be forgotten.

26. Although the goods are relatively inexpensive and everyday purchases, the consumer selecting the goods will take into account individual taste, suitability of the product and price. As a result, I consider that the average consumer will purchase the goods with a medium level of attention.

### **Comparison of the marks**

27. The respective trade marks are shown below:

BEAUTE LASHES	Beaute
Contested trade mark	Earlier trade mark

28. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to all the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception

of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

29. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

### **Overall impression**

30. The opponent’s earlier mark consists of the word “Beaute” in title case. There are no other elements that contribute to the overall impression of this mark.

31. The contested mark is a figurative mark that consists of the words “BEAUTE LASHES” in stylised capital letters. Both elements contribute to the overall impression of the mark. However, the element “BEAUTE” is more distinctive than the element “LASHES” because it is placed at the beginning of the mark and is inherently more distinctive (as the word “LASHES” is descriptive of the goods).

### **Visual similarity**

32. The opponent submits that its mark is embedded into the applicant’s mark. I agree with the opponent, there is obviously some similarity between the marks because the opponent’s mark is clearly present in the beginning of the applicant’s mark. As a general rule, the beginnings of marks tend to make more impact than their endings,<sup>1</sup> especially as words are read from left to right. The opponent’s mark is presented in title case and stylised. The stylisation is minimal, this alongside the title case does not create a point of difference, because as a matter of law,<sup>2</sup> the registration of a word mark does not prevent its use in different scripts (fonts or typefaces). However, the additional element of “Lashes” in the applicant’s mark creates a point of visual difference. Bearing this in mind, I find the marks to be similar to a high degree.

### **Aural similarity**

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<sup>1</sup> *El Corte Ingles, SA v OHIM*, Cases T-184/02

<sup>2</sup> Case T-364/04 *Sadas SA v OHIM*

33. The word “Beaute” at the beginning of both marks will have the same pronunciation. However, the additional element of “LASHES” in the applicant’s mark creates a point of aural difference. Therefore, I consider the marks to be aurally similar to a high degree.

### **Conceptual similarity**

34. Conceptually, the word “Beaute” has no meaning in English. Some consumers, with command of the French language, may identify that “Beaute” translates from French to English as “Beauty”. However, in my view, the average consumer will view the mark as a misspelling of the word “beauty” or as a foreign word meaning “beauty” or “beautiful”. For both groups of consumers, I find the marks to have a high degree of conceptual similarity. Whilst I note the presence of “Lashes” in the applicant’s mark, which differs from the earlier mark, it is insufficient to differentiate the marks conceptually. In particular, the word “Lashes” in the applicant’s mark is descriptive of the goods for which it is used and does not introduce any distinctive concept.

### **Distinctive character of the earlier marks**

35. 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).”

36. Registered trade marks possess varying degrees of inherent distinctive character through use, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

37. The opponent has not pleaded enhanced distinctive character through use and has not filed evidence to support such a claim, therefore, I have only the inherent position to consider.

38. The earlier mark consists of the word “Beaute” which, as I have explained, is not an English word, although it will be perceived as a word meaning “beauty” or “beautiful”. Clearly the word “Beaute”, understood as “beauty” or “beautiful” is suggestive of the cosmetic goods for which the earlier mark is registered, as demonstrated by the dictionary definition of the word “cosmetic” which reads as “any preparation applied to the body, esp the face, with the intention of beautifying it”.<sup>3</sup> Therefore, I find that the mark has a low degree of inherent distinctive character.

### **Likelihood of confusion**

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises that the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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<sup>3</sup> Collins English Dictionary

40. I have found the marks to be visually, aurally and conceptually similar to a high degree. I have identified the average consumer to be the public at large and professionals who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the earlier mark to be inherently distinctive to a low degree. I have found the goods to vary from identical to similar to a medium degree.

41. Although I recognise that the earlier mark has a weak distinctive character, that does not imply that there is no likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the Court of Justice of the European Union found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

42. Taking the above factors into account, I consider that the differences between the marks are insufficient to avoid confusion, when the principle of imperfect recollection is considered. This is especially so, given the descriptive nature of the word “Lashes”, which is the only differentiating element between the marks. I consider it likely that the marks will be misremembered or mistakenly recalled as each other. Alternatively, if the differences between the marks are noted, I consider that the presence in both marks of the word “Beaute” will create an expectation on the part of the average consumer that the goods originate from the same or economically linked undertakings. There is a likelihood of confusion.

## OUTCOME

43. The opposition under section 5(2)(b) succeeds.

## COSTS

44. The award of costs in fast track proceedings are governed by TPN 2/2015. The opponent has been successful and would normally be entitled to a contribution towards his costs. However, as the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the opponent and invited him to indicate whether he intended to make a request for an award of costs. The opponent was informed that, if so, he should complete a Pro Forma, providing details of his actual costs and accurate estimates of the amount of time spent on various activities in the opposition. He was informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

45. The opponent did not file a completed Pro Forma. That being the case, I award the opponent the sum of £100 in respect of the official fee only.

Official Fee	£100
<b>Total</b>	<b>£100</b>

46. Therefore, I order Beaute Lashes to pay Wei Jiang Liang the sum of £100. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the determination of this case if any appeal against this decision is unsuccessful.

Dated this 24<sup>th</sup> day of August 2021

A Klass

For the Registrar,  
the Comptroller - General