

O/620/21

Trade Mark Act 1994

**IN THE MATTER OF UK TRADE MARK REGISTRATION NO. 3117343
IN THE NAME OF YASMIN MAJID FOR THE TRADE MARK**

The logo for 'Shades bare minerals' is centered. The word 'Shades' is written in a large, light grey, cursive-style font. Below it, the words 'bare minerals' are written in a smaller, light grey, sans-serif font.

IN CLASS 3

AND

**THE APPLICATION FOR INVALIDATION THEREOF UNDER NO. 503362
BY SHISEIDO AMERICAS CORPORATION**

Background and pleadings

1. Yasmin Majid (“the proprietor”) applied to register the trade mark no. 3117343



for the mark  in the UK on 11 July 2015. It was accepted and published in the Trade Marks Journal on 31 July 2015, and subsequently registered on 9 October 2015. The trade mark is registered in respect of the following goods:

Class 3: Makeup; Makeup remover; cosmetics; nail colour; nail polish remover.

2. SHISEIDO AMERICAS CORPORATION (“the cancellation applicant”) applied to invalidate the trade mark registration on the basis of section 47(2)(a) and relying on section 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The application for invalidation was filed on 30 September 2020. The invalidation is filed against all of the registered goods, and relies on the two trade mark registrations outlined in the table below:

Trade Mark	Territory	Registration no/filing date/ registration date	Goods relied upon
BAREMINERALS/ bareminerals (series of two)	UK	2371897/31 August 2004/6 May 2005	Class 3: Cosmetic skin creams, lotions and gels, perfumes, essential oils used as cosmetics, body lotions, creams and gels, bath lotions, hair shampoos and hair conditioners, colognes and toilet waters, and

			cosmetic powders for the skin and eyes.
BAREMINERALS	EU ¹	11286812/23 October 2012/6 March 2013	Class 3: Cosmetics and non-medicate skin care preparations.

3. The marks relied upon by the cancellation applicant both hold filing dates that predate that of the contested registration. By virtue of the earlier filing dates, the trade marks upon which the cancellation applicant relies qualify as earlier trade marks pursuant to section 6 of the Act.
4. Under section 5(2)(b), the cancellation applicant argues that the marks are highly similar, and that the goods are identical or similar, and that as such there will be a likelihood of confusion. The cancellation applicant also states it has “acquired a considerable reputation” within its pleadings under this ground.
5. Under section 5(3) of the Act, the cancellation applicant states that the earlier marks have been in use since 2004, and that extensive use and promotion means that the marks have acquired a significant reputation in respect of the goods relied upon. The cancellation applicant argues that use of the contested mark would cause confusion in the minds of the consumer, and cause association with the cancellation applicant’s mark, stating that the consequence of this is “at the very least eroding the distinctiveness of the applicant for cancellation’s earlier mark and thus damaging the distinctive character of the mark”.
6. The proprietor filed a counterstatement denying all of the claims made and stating that the use of “bare minerals” in its mark is descriptive of its goods, due to its product being a mineral compound free from any additives. The proprietor argues that the earlier marks are descriptive, and that the marks are different.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

The proprietor also states there have been no instances of confusion between the marks in the almost five years it has been trading.

7. Only the cancellation applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. The cancellation applicant is represented by Ladas & Parry LLP. The proprietor is representing itself in these proceedings.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

10. The cancellation applicant's evidence comprises a witness statement in the name of Mr Gregory Boursier, described as the Marketing Director for the cancellation applicant. The witness statement introduces 7 exhibits, namely Exhibit GB1 to Exhibit GB7.
11. Mr Boursier explains that the cancellation applicant offers a wide range of skincare and beauty products under its "bareMinerals" trade mark, listing a number of make up, skin care and cleansing products for which he explains the mark has been used. Mr Boursier confirms:

"The bareMinerals mark has been used on or in association with foundations, concealers, finishing powders, primers, blush, bronzer, highlighters, eyeshadows, mascara, eyeliner, eyebrow makeup, eye primer, lipstick, lip gloss, lip liner, makeup brushes, brush cleaners, non-medicated skincare products, facial cleansers, facial scrubs, facial creams, moisturisers, toner, body lotions, acne serums, beauty serums,

beauty masks, skin lotions, cleansing wipes, eye creams, facial masks, cosmetic bags, makeup kits, and other related products.”

12. Mr Boursier states that details about its products are available the cancellation applicant’s website www.bareminerals.co.uk, and that the products he identified can be found in numerous retail stores and online retail stores. Mr Boursier lists Boots, Debenhams, John Lewis, Selfridges, House of Fraser, Look Fantastic, Feel Unique and ASOS as stores where products under the marks can be found. Exhibit GB5 provides a screenshot of the cancellation applicant’s website both in its “current” form (dated 26 August 2020), and also dating back to 25 January 2019, 4 January 2018, 5 September 2017. The images of the site shows use of the mark bareMinerals clearly displayed at the top of the page and on products, with items including foundations, lipsticks, skin serums and creams available for purchase, with prices displayed in GBP. The exhibit also shows items for sale in GBP on the site debenhams.com, both in the “current” form (26 August 2020), and dating from 25 January 2019, 12 January 2018, 24 February 2017. The pages show the mark bareMinerals used in relation to foundations, skin serums, brushes, lipsticks, skin cleansers, moisturisers, primers, mascaras and eyeshadows. Pages from Selfridges.com are also provided, again, this includes the page in its “current” form (from 26 August 2020), as well as from 6 February 2017. Although the images are not showing on the page from 2017, use of the mark bareMinerals, and descriptions of products including lipglosses, brushes, serums, concealers, foundations and powders are clearly shown, with prices given in GBP.

13. Mr Boursier explains that products are sold in the UK and Ireland, Poland, Germany, France, the Netherlands, Italy and Spain, but he does not confirm when trading in each territory began. Mr Boursier has given sales figures for the UK as below:

BareMinerals £m	2014	2015	2016	2017	2018	2019	2020
Gross Sales in UK	45.6	51.1	47.4	46.4	40.0	38.3	23.2

14. In addition, Mr Boursier provides figures for advertising spend as below:

BareMinerals £m	2014	2015	2016	2017	2018	2019	2020
Advertising	1.5	2.2	2.5	1.9	1.1	0.9	1

15. Examples of the mark being used in stores and on promotional material is provided at Exhibit GB1, showing use of the mark 'bareMinerals'. Mr Boursier confirms this use is from the UK between 2015 – 2019. Some of the promotional material is dated in 2015 including a make-up kit offer with an end date of 15 March 2015, and an offer for a free sample of foundation ending 12 June 2015.

16. Multiple flyers and various promotional materials are provided at Exhibit GB2. These show the mark 'bareMinerals' and are advertising various make up and cosmetic products, including foundations, skin creams, lip colours and lip glosses. Mr Boursier explains in his witness statement that this use is in the UK between 2015 – 2019. Exhibit GB4 comprises online promotional material showing the mark, and Mr Boursier explains this is also from the UK in the same period. This includes a flyer offering '20% off everything*' at bareMineral boutiques between 2nd – 6th July 2015, with the addresses for the boutiques given in London, Windsor, Brighton, Glasgow and St Albans.

17. Exhibit GB6 provides copies of press releases referring to a 2019 product launch. The release talks about bareMinerals being the no.1* mineral foundation brand in the UK, having the no. 1 prestige tinted moisturiser*, and the no.1 foundation stick* and the no. 1 loose mineral foundation* on the UK market (*NPD UK market: October 2019 YTD).

18. Exhibit GB3 provides images of the cancellation applicant's social media account, namely its UK Instagram account. The images show use of the mark and date back to 2013, providing posts at regular intervals up until the evidence was gathered, which appears to be in 2020. The posts show images of various makeup and skincare products. An undated image of the UK Instagram homepage shows over 171 thousand followers, and the homepage for its global page shows 1.1 millions followers.

19. Exhibit GB7 provides examples of the awards won under the bareMinerals mark. The screenshots provided show details of the Cosmopolitan or 'COSMO' Awards in 2013, 2014, and 2018, which appear to be issued in the form of online articles which list 'best undereye brightener', 'best alphabet cream' and 'best blusher' respectively as 'BareMineral' products. All the awards seem to be UK based with the UK appearing in the corner of the screenshot and in the URL shown. An article referring to the 'Marie Clare Best Beauty Products of 2015' on marieclare.co.uk was published on 25 February 2016 and lists bareMinerals complexion rescue as 'the winner'. An article on harpersbazaar.com lists a bareMinerals foundation in a list of its top 10 mineral foundations on 5 June 2017. This article lists the price in dollars. The website brownthomas.com details 'The Brown Thomas Beauty Awards 2019' naming a bareMinerals foundation as the 'best foundation with skincare benefits'. The price of the item is displayed in euros. The 'Irish Tatler Beauty Awards' are listed on irishtatler.com and are dated 23 July 2019. They name a 'Bare Minerals' foundation as a winner. A 'Bare Minerals' foundation is listed as a winner on the 'Glamour Beauty Power List 2019' with the price shown in GBP. The website womenshealthmag.com/uk listed a 'BareMinerals' lipstick as the Best Vegan Make-up Hero in 2019 in an article dated 4 November 2019. The price is shown in GBP. An article from the telegraph.co.uk dated 4 August 2019 listed a 'bareMinerals' lipstick as one of the beauty desks 75 favourite products of the year, again listing the price in GBP. A 'bareMinerals' foundation stick was named as #16 Best Innovation at the woman&home beauty awards 2020 names on womanandhome.com in an article dated 24 August 2020. The price of the product is given in GBP. Finally, an undated page from harpersbazaar.co.uk lists the bareMinerals foundation stick as the best stick formula, with a price listed in GBP.

Preliminary issues

20. Within its counterstatement, the proprietor has made the following comments:

"The Shades bare minerals trademark was first filed on the 11th July 2015 and entered into the register on the 9th October 2015. No objections were raised during the publication period, following the

Intellectual Property Office guidelines the trademark was successfully registered without any opposition.”

21. Within its written submissions, the cancellation applicant states:

“The Registered Proprietor explains the registration process gone through in order to secure registration. The registration obtained was liable to be challenged based on earlier rights for the period of five years from the date on which the mark entered on the Register. The Cancellation Applicant brought the cancellation application within that five year period but only after giving the Registered Proprietor the opportunity to withdraw the registration.”

22. The contested registration was filed on the 11 July 2015 and registered on 9 October 2015. The invalidation action was filed by the cancellation applicant on 30 September 2020, and the cancellation applicant states it first notified the proprietor of its intention to seek invalidation of the contested registration on 12 July 2017. It is well established that an application for invalidation of a trade mark registration may be filed against a trade mark registration that was not previously challenged during the initial opposition period. Notwithstanding this, there are limits on the timescales for filing an application for invalidity of a registered mark in the case of acquiescence to the use of a mark by an earlier right holder, as set out in Section 48 of the Act. However, as the cancellation applicant filed the application for invalidation prior to the contested registration being five years old, the provisions under Section 48 cannot apply in this instance.² I therefore find the application for invalidation to be valid.

23. The proprietor also submits in its counterstatement and in its written submissions that the earlier mark is “too generic to copyright” due to its descriptive nature. However, no challenge to the validity of the earlier registrations has been filed, and as such I must accept the earlier registrations

² These provisions may not apply in any case, as they are dependent on the cancellation applicant having known of the use of a registered mark for a continuous period of five years.

as valid, and to hold at least some distinctive character for the purpose of this decision.³ That said, the distinctiveness of the earlier marks is a relevant consideration within this decision, and this will be addressed accordingly.

24. I note that the proprietor also asserts this element is descriptive in its own mark. Whilst again, the distinctive and dominant elements of the contested mark must be considered for the purpose of this decision, and I will consider these in due course, I find from the case law, particularly noting the comments of the General Court (“GC”) in the appeal of the decision of the Fourth Board of Appeal at the EUIPO in *Sona Nutrition Ltd v EUIPO*⁴ that attributing no distinctive character to a standalone element of a composite mark, that is in turn the entire earlier mark, amounts to a finding that the earlier mark is invalid. As such this is contrary to the established principle that a registered mark must be assumed to have at least some degree of distinctive character. As I find the element ‘bare minerals’ in the later mark to be identical⁵ to the earlier marks, I cannot for the purpose of this decision find that element to be entirely devoid of distinctive character by way of being descriptive, as is submitted by the proprietor.

Proof of use

25. Both earlier marks had been registered for a period of over five years at the date on which the application for invalidation was filed, and so they are both subject to the use provisions under section 47(2A)(c) and (2B) of the Act. However, no proof of use was requested by the proprietor in these proceedings. The consequence of this is that the applicant is entitled to rely upon all of the goods for which its earlier marks are registered.

³ *Formula One Licensing BV v OHIM*, Case C-196/11P

⁴ See case T-152/18

⁵ Whilst I note the additional space between the element in the later mark, I do not find these difference to be insignificant and the marks to be identical within the definition set out by the CJEU in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00

Decision

Legislation

Section 47

26. Section 47 of the Act states as follows:

“47. –

(1) [...]

(2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5 (4) is satisfied

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

The Principles

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

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

30. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

32. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

33. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that goods may be considered “complementary” where:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

34. The case law provides further guidance on how the wording of goods and services as registered and filed should be interpreted within the comparison. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

35. With these factors in mind, the goods for comparison are below:

Earlier registrations	Contested registration
Class 3: Cosmetic skin creams, lotions and gels, perfumes, essential oils used as cosmetics, body lotions, creams and gels, bath lotions, hair shampoos and hair conditioners, colognes and toilet waters, and cosmetic powders for the skin and eyes. (UK Registration no. 2371897)	Class 3: Makeup; Makeup remover; cosmetics; nail colour; nail polish remover.
Class 3: Cosmetics and non-medicate skin care preparations (EU Registration no. 11286812)	

Earlier EU Registration no. 11286812

36. The earlier EU mark covers the goods *Cosmetics and non-medicate skin care preparations*. The contested goods *makeup; makeup remover; cosmetics; nail colour; nail polish remover* all either fall within the categories of goods covered by the earlier mark, rendering them identical within the meaning of *Meric*, or, as is the case for *cosmetics*, are self-evidently identical.

Earlier UK Registration no. 2371897

37. The cancellation applicant's earlier goods *cosmetic powders for the skin and eyes* fall within the categories of *makeup* and *cosmetics* covered by the contested mark. These goods are therefore identical within the meaning of *Meric*.

38. The contested goods *nail colour* will fall within the meaning of the earlier goods *cosmetic [...] gels* under the earlier UK mark. These goods are therefore identical within the meaning of *Meric*. If I am wrong, I find the goods *nail colour* to share a broad purpose with *cosmetic powders for the skin and eyes* covered by the earlier UK mark, with them both being for applying to the body to change or improve the colour of the same. I also find they will share users, those being members of the general public, will be sold near or next to each other in the cosmetics section of larger stores, and will share trade channels. If the goods are not identical, I find them to be similar to at least a medium degree.

39. It is my view that *makeup remover* will fall within the meaning of *cosmetic lotions* covered by the UK mark, with make up remover often taking a lotion form. However, if I am wrong, I find these goods will share a nature, users, those being members of the general public, and trade channels, and they will be placed next to or near each other in shops. I find they will share the broad purpose of skincare, and that they will both either be, or will include goods for applying to the face. If these goods are not identical, I find they will be similar to at least a medium degree.

40. I do not find *nail polish remover* to be covered identically under the earlier UK mark, however, as this covers ‘cosmetic ..gels’, which I find to include nail gels, I find these goods will share users and trade channels and will be placed on the same shelves in retail stores as the earlier goods. Further, the broader purpose of the products for nail care will be shared, even if the specific purpose, for either applying or removing a colour or shine to the nails will differ. I find these goods to be similar to at least a medium degree.

Comparison of marks

41. 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 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.”

42. 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.

43. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
BAREMINERALS / bareminerals	

44. The earlier UK mark is filed as a series of two word marks, one in uppercase and one in lower case lettering. The earlier EU mark is filed as a word mark in uppercase lettering. Fair use of word marks allows for their use in both upper and lower case lettering, as well as for their use in a variety of standard fonts. The earlier UK and EU marks are identical for the purpose of the marks comparison, and for this reason I will refer to the earlier marks as BAREMINERALS and consider these as one for the same purpose.

45. The earlier mark is filed as one word, but it is made up of two clearly identifiable elements, namely the English words BARE and MINERALS. However, despite these two elements being identifiable separately, these hang together as a unit and the overall impression resides in the mark as a whole.

46. The contested mark is made up of different elements, namely the word 'Shades', which features subtle stylisation on the letters, and the two smaller and more simply stylised words 'bare minerals'. The stylised word 'Shades' is the most dominant element of the earlier mark due to its size, position, and additional stylisation. Both elements make reference to the goods in some way, with SHADES appearing to reference skin or make up colours, and BARE MINERALS making reference to product ingredients. However, as the element 'bare minerals' is much smaller in size it plays a lesser role in the mark overall. No element of the contested mark is negligible.

Visual comparison

47. The contested mark is dominated visually by the stylised word 'Shades' which doesn't appear at all in the earlier mark. However, the marks coincide visually

through the use of the identical words BARE MINERALS, although they are presented slightly differently as a single word in the earlier mark, and as two separate words in the contested mark. As previously mentioned, the use of lower case and a slightly different standard font does not separate these elements further visually, due to the earlier mark being filed as a word mark. Considering the points of visual similarity and the points of visual difference, overall I find the marks are visually similar to a low degree.

Aural comparison

48. Aurally, the earlier mark reads BARE-MIN-ER-RALS. The later mark reads SHAYDES BARE MIN-ER-RALS, although I acknowledge that some consumers may not pronounce the smaller 'bare minerals' element of the contested mark due to its size and less dominant position. Where consumers do not pronounce the element 'bare minerals' in the contested mark, there will be no aural similarity. Where this element is pronounced by consumers, the marks will be aurally similar to a medium degree.

Conceptual comparison

49. The earlier mark includes the two identifiable English words 'bare' and 'minerals' within the single word BAREMINERALS. The word 'bare' alone will be understood by the consumer to mean something that is without any additions. A mineral will be understood by the consumer as a type of solid matter found in nature. Together and within the context of the earlier mark, the concept will be understood as meaning minerals without addition, namely minerals that are pure.

50. The contested mark also includes the element 'bare minerals', and this will convey the same meaning to the consumer as they do in the mark above. The word SHAYDES will convey the meaning of a range of tones in a colour spectrum, ranging from pale and subtle tones to rich and dark tones. In the context of the goods I find that the consumer will view this as a reference to shades of skin tone or make up or nail colour, depending on the product offered.

Whilst I note for a few it might convey the concept of sunglasses, or of something that blocks out light, I find this unlikely.

51. The marks coincide conceptually through the use of the words bare minerals but differ through the use of the word SHADES. Neither concept is particularly strong in the context of the goods. I find the marks to be conceptually similar to a medium degree.

Average consumer and the purchasing act

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

53. 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.”

54. Before making a decision on the likelihood of confusion, I must first identify the relevant consumer of the goods. The goods themselves are all items that may be purchased fairly frequently, often at a relatively low cost. Whilst I note that

some items will sit at a higher price point, this does not raise the level of attention paid in respect of the whole categories of goods. Whilst it might be true that some consumers will pay a higher than average level of attention to the goods on the basis of having particular skin conditions or allergies, for the most part the consumer will have no reason to pay a particularly high level of attention. That being said, the consumer will likely consider factors such as shade, consistency, durability and suitability for their requirements and skin type. I find the level of attention paid in respect of the goods to be mostly average, although I find that only a low level of attention will be paid in respect of nail polish remover, as there will be significantly less factors to consider when purchasing the same.

55. I note the goods may also be purchased by professionals in the field of beauty. I find that the degree of attention paid by the professional consumers will be higher due to the increased liability of purchasing these goods to use on others in a professional capacity. I find the level of attention paid by professionals will likely sit at above average.

56. I find the goods will be primarily purchased following visual inspection, on the shelves in shops or online. However, aural considerations cannot be discounted as the goods may be purchased with the assistance of retail staff and may be the subject of word of mouth recommendations, or in the case of professionals, they may be ordered over the phone.

Distinctive character of the earlier trade mark

57. 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).”

58. The earlier mark comprises two known English words bare minerals. When combined these words allude to the fact that the goods will contain minerals without additives. I find the earlier mark to be inherently distinctive to only a low degree.

59. The cancellation applicant has filed evidence of the use of its mark in the UK market. The evidence shows significant UK sales figures for products between 2014 and 2020, in addition to advertising spend for the same period. In addition, the cancellation applicant has provided details of promotional material and awards spanning this time, including very visible advertising campaigns. Whilst I have no details of the opponent’s actual share of the UK market for the goods, it appears from the sum of the evidence, particularly the significant turnover under the mark, and the requirement for a huge volume of goods to be sold in the UK market to reach that level, that by the time the application for invalidation was filed, the distinctiveness of the earlier marks will have been enhanced in the UK market to an above average level. However, the outcome of a successful invalidation is the removal of the contested registration from the register entirely, and I must therefore consider the position of the opponent to

object to the contested registration at the date on which it was filed. If the mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion at the date on which the contested registration was filed, the application for invalidation will not succeed.⁶ It is therefore important for me to consider the level of distinctiveness held by the earlier mark at this time.

60. I therefore consider the level of distinctive character held by the earlier marks on the filing date of the 11 July 2015. There is some promotional material provided from prior to the relevant date, however, this is fairly limited. The most convincing evidence that the distinctive character may have been enhanced through use in the UK are the sales figures provided for 2014 and 2015. In 2014, the cancellation applicant states that over 45 million GBP worth of sales took place in the UK. Whilst 2015 only partially falls within the relevant period, the sales figures for this period are even higher at over 50 million GBP for that year, and I find it reasonable to assume at least a significant portion of these sales took place prior to 11 July 2015. I also note that advertising spend for these periods have been provided as 1.5 million GBP in 2014, and over 2 million GBP in 2015, and again it is reasonable to assume at least a significant portion of the figures for 2015 will fall prior to the relevant date. This is a fairly significant spend. The sales figures are not broken down into particular products sold, but the UK social media pages from 2013 – 2015 (before the relevant date), along with the limited promotional material from this time gives a good idea of the product range and the use of the mark 'bareMinerals'⁷ consistently on or in relation to the same. I note there are two cosmopolitan awards issued to products under the mark prior to the relevant date, in 2013 and 2014. No figures have been provided for the size of the market or the cancellation applicant's market share for its goods in the UK, and I assume that the cosmetics market in the UK is very large. However, despite not knowing the exact size of the market, I am still able to recognise that sales figures at the level stated are significant, and I find it safe to assume that the cancellation applicant held at least a reasonable market share under its goods in the UK during this time. Due

⁶ See sections 47(2G) and (2H)(b) and of the Act

⁷ I find the use of the mark in upper and lower case, including where the capitalised 'M' is used to be use of the word mark as filed.

in part to the limited promotional material provided prior to the relevant date, and in part to the shorter time period for which sales and advertising figures have been provided, I am unable to find that the distinctiveness of the earlier mark has been enhanced to above an average degree. However, considering the evidence as a whole, I find that the distinctiveness of the earlier mark was enhanced through use in the UK prior to the relevant date in respect of cosmetics and non-medicate skin care preparations, including in respect of cosmetic skin creams and lotions, and cosmetic powders for the skin and eyes, and I find the earlier mark to have held a medium degree of distinctive character at the relevant date by virtue of the use made of the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

61. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 29 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier marks will have an impact on the likelihood of confusion. I must consider that the likelihood of confusion may be increased where the distinctive character held by the earlier mark is high and may be less likely where it is low. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.⁸ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a

⁸ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods or services are obtained will have a bearing on how likely the average consumer is to be confused.

62. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁹

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

64. I found the earlier marks to be inherently distinctive to a low degree, but that the distinctiveness of both earlier marks has been enhanced through use in the UK to an average level in respect of some of the goods. I found that where the relevant consumer is the general public they will pay an average level of attention in respect of most of the goods covered by both earlier marks and the contested mark, although only a low level of attention will be paid in respect of nail polish remover. I found that the professional consumers' level of attention will be higher, at above average. I found that the purchasing process is primarily visual, but that aural considerations cannot be completely ignored. I found the goods under the contested mark to be identical to the goods covered by the earlier EU mark, and to be identical or similar to at least a medium degree in

⁹ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

respect of the UK mark. I found the marks to be visually similar to a low degree, and conceptually similar to a medium degree. Where 'bare minerals' is not verbalised in the contested mark, I found the marks are aurally dissimilar. Where this is verbalised, the marks are aurally similar to a medium degree.

65. Considering all of the factors above, and keeping in mind that the consumer will not have the opportunity to compare the marks side by side and will have to rely on their imperfect recollection, it is my view that the consumer will recall the differences between the marks in this instance, and will not be directly confused, even where the level of attention is low and the goods are identical. I therefore do not find a likelihood of direct confusion between the marks.

66. In respect of indirect confusion, I consider again the factors outlined above, and whether I find that the use of 'bare minerals' in the contested mark will lead the consumer to believe that the goods derive from the same economic undertaking as the earlier marks.

67. I note that I did not find the element 'bare minerals' to be the most dominant element in the contested mark. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are

situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

68. Considering the layout and composition of the contested mark, and considering that the elements ‘Shades’ and ‘bare minerals’ in the contested mark do not hang together to form a unit with a separate meaning, is my view that the element ‘bare minerals’ maintains an independent role in the mark as a whole. Further, it is my view that the consumer will be accustomed to sub brands being used in conjunction with a house brand in respect of these goods, and that the use of the wording ‘Shades bare minerals’ in the contested mark, lends itself to being a sub brand of the bare minerals range. Considering again all of the relevant factors above, I find in this instance that the consumer, having previously come across the mark BAREMINERALS, may easily assume that the contested mark represents a line of goods in the BAREMINERALS range

that offers a broad range of colours or shades, or that is suitable for many skin tones, and as such derives from the same undertaking as the earlier marks.

69. However, before reaching my final conclusion under this ground, I note the following comments within the proprietor's counterstatement:

"In almost five years of trading there has not been a single encounter of doubt or confusion from our customers, it is clear to the consumer that we are not associated with bare minerals."

70. The cancellation applicant has responded to this point within its written submissions, stating:

"The Registered Proprietor says that in five years of trading there has not been a single encounter of doubt of confusion from her customers. The Registered Proprietor has given no evidence whatsoever of any sales made by the Registered Proprietor. The Cancellation Applicant was not able to find any evidence of sales by the Registered Proprietor and therefore was not in a position to put in evidence of its own actual confusion. The reason there has not been any actual confusion in the time that the challenged registration has been on the Register would be because there has been insufficient use of the registration by the Registered Proprietor."

71. Further, I note in its written submissions, the proprietor has confirmed that its trade mark is no longer in use, stating:

"Unfortunately, my trademark is not currently in use as my company is dormant ..."

72. Sitting as the appointed person in *BAREFACE COSMETICS LIMITED v SHISEIDO AMERICAS CORPORATION* BL O/304/21, Dr Brian Whitehead raised that the Hearing Officer did not take into account the coexistence of the marks up until the point at which the decision was issued, stating as follows:

“35. It is certainly arguable, in my view, that there could be a likelihood of confusion given the above factors. However, I believe it is appropriate also to take into account a further factor which was not taken into account by the Hearing Officer, but was raised by BCL both in the invalidity action and on appeal. BCL’s mark was filed in June 2015 and registered in December 2015. Accordingly, by the date of the Decision, BCL’s mark had been on the register for over 5 years. Furthermore, BCL’s mark was already in use when its registration was filed, and by the date of the Decision had been in use in the UK for around 9 years.

37. On the one hand, therefore, there is an arguable but not compelling case of inherent likelihood of confusion. On the other hand, there is clear evidence that the two marks have co-existed on the UK market for around 9 years, without giving rise to a single instance of actual confusion that has come to the attention of either party. It is important to bear in mind the observation of Iain Purvis QC in the ROCHESTER Trade Mark case cited at paragraph 12 above: “The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence”.

38. Applying the “healthy degree of self-doubt to [my] own opinion” urged by Iain Purvis QC in ROCHESTER Trade Mark, I am forced to conclude that in reality there is no likelihood of direct confusion between the marks. My overall conclusion, therefore, is the same as the Hearing Officer’s, albeit for different reasons.”

73. It is clear there are some similarities between the current matter and the case above, although the period of use claimed is shorter, at five years rather than the nine years stated. However, I must of course treat this case on its own merits. In this case, I have no evidence that the contested mark has been in use for the period of time claimed, whereas Dr Whitehead as the Appointed Person confirmed in the case above that he had clear evidence of the co-

existence on the market. The contested marks existence on the register is not evidence of its use. The proprietor has also confirmed its mark is no longer in use, and I am unaware when the claimed use stopped. As I have no evidence of the use made, it follows that I am unable to determine if any use made has been minimal or extensive. Whilst I note that it weighs in favour of the proprietor that the cancellation applicant has been unable to provide any evidence of actual confusion, this is not determinative that there will be none should the use of the proprietor's mark intensify or resume in the UK. Further, it is my view that the case for likelihood of indirect confusion based on the "inherent" factors alone is fairly convincing in this particular case. Whilst I have therefore considered that the marks may have coexisted in the UK market for a period without confusion, I find in this instance that this does not prevent me from reaching the conclusion that should the use of the contested mark become widespread within the UK, there would be a likelihood that the consumer would believe the products derive from the same economic undertaking. Therefore, taking into account all of the relevant factors, including the claimed previous coexistence of the marks on the UK market, I find a likelihood of indirect confusion between both of the earlier marks and the contested mark in respect of all of the goods registered.

Section 5(3)

74. Although the cancellation applicant has been successful under section 5(2)(b), for completeness I will also consider its case under section 5(3) of the Act.

Legislation

75. Section 5(3) states:

“(3) A trade mark which-

(a) 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 the repute of the earlier trade mark.

Case Law

76. 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* and Case C-323/09, *Marks and Spencer v Interflora* and 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 proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks*

and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

77. To be successful on this ground, firstly the cancellation applicant must establish that the marks are similar. Should this be shown, the cancellation applicant must go on to prove that they hold a reputation for the earlier marks relied upon in respect of a significant part of the public. If it is found both that the marks are similar, and that the earlier mark holds a qualifying reputation, it must then be shown that the result of this reputation, combined with the similarity between the earlier marks and the contested mark will result in the public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the result of the link made by the public will manifest in one of the pleaded types of damage.

78. In this instance, the cancellation applicant has pleaded that the earlier marks have a reputation, and that the consumer will be confused as to the origin of the later mark. Further, the cancellation applicant claims that there will be an association with its earlier marks, which will result in the erosion and damage of its distinctive character.

79. The relevant date for establishing if the cancellation applicant held a reputation in the marks relied upon for the purpose of this decision is the filing date of the contested registration, namely 11 July 2015.¹⁰

Similarity of the marks

80. I have found under section 5(2)(b) that the marks are visually similar to a low degree, that the marks are aurally similar to a medium degree where they are pronounced in full and aurally dissimilar where the later mark is pronounced as SHADES only. I have found that the marks are conceptually similar to a medium degree.

¹⁰ See sections 47(2H) and (2G) of the Act

Reputation

81. The courts have provided guidance on the factors to consider when assessing if a reputation has been established for a trade mark. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

82. The cancellation applicant has filed evidence of use of its mark ‘bareMinerals’.¹¹ The focus of the majority of the evidence is the territory of the UK, although Mr Boursier explains that products are sold in the UK and Ireland, Poland, Germany, France, the Netherlands, Italy and Spain. Sales figures and advertising spend is given in respect of the UK, and whilst this is not broken

¹¹ As previously stated, I find this to be use of the mark as registered.

down by product, the figures are substantial, and a total of over 45 million GBP is given for the year of 2014, predating the filing of the contested mark, and a figure of over 50 million GBP is given for the year of 2015, of which I find it reasonable to assume that at least a portion of which fell prior to the contested marks filing on 11 July 2015. Figures given in relation to advertising spend are also given for this period, with 1.5 million GBP being spent on advertisement in 2014, and over 2 million GBP being spent in 2015, and again I find it reasonable to assume at least a portion of this was spent within the relevant timeframe. Much of the promotional material provided post dates the filing of the contested registration, but there are two 'Cosmo' awards from 2013 and 2014, both of which predate the filing of the contested registration. These were given for the products including under-eye and skin creams. In addition, the images provided of the UK Instagram page between 2013 and 2015 helps to identify the types of products sold under the mark prior to the relevant date, those being foundations, including powder foundations, skin moisturisers, cleansers and lotions, eye pencils, eye shadows, lipsticks and mascaras. In the UK, the marketing material identifies the opponent's boutiques being spread across England and in Glasgow just prior to the relevant date.

83. The evidence filed only gives a clear picture of the extent of the use made for the 18 months prior to the relevant date, with sales and advertising figures dating back to 2014 only. The social media posts begin in 2013, but the posts do not appear to have a huge reach during the relevant time, with the 'likes' shown as ranging between 10 – 389 for posts between 2013 and the relevant date. I do not have any evidence relating to the size of the cosmetics market in either the UK or the EU, but it is my view this will undoubtedly be very large. However, whilst I do not have figures on the market share owned by the cancellation applicant either in the EU as a whole or the UK only, the figures given for sales and advertising spend are high in the 18 months prior to the relevant date, and I note the items' retail value is shown in the evidence as falling between £15-£40. This retail value means there will have been a considerable number of sales to reach the sales figures provided. Whilst I therefore note that the evidence filed could certainly be improved, particularly in light of the level of sales made, it is my view that from the sum of the evidence

provided I am able to establish that earlier marks will have been known by a significant number of consumers in the UK at the relevant date.

84. Based on the evidence provided, I find the earlier mark EU mark will have held a reasonable reputation for *cosmetics and non-medicate skin care preparations* as relied upon at the relevant date in the territory of the UK, which I find constitutes a substantial part of the territory of the EU for the purpose of this decision. I also find from the sum of the evidence the cancellation applicant held a reasonable reputation under the earlier UK mark for the goods *Cosmetic skin creams and lotions* and *cosmetic powders for the skin and eyes* as relied upon, at the relevant date under the UK mark.

Link

85. In order to determine if a link will be established between the marks, I must consider the position globally, taking into account all the factors as set out in the case law, including the degree of similarity between the marks and the goods, the extent of the overlap between the relevant consumers, the strength of the reputation and distinctiveness of the earlier marks, and whether there is a likelihood of confusion.

86. In this instance, I firstly consider my findings in respect of the similarity of the marks and similarity and identity of the goods, as set out under section 5(2)(b). I remind myself that I found a likelihood of indirect confusion between both earlier marks and the contested registration under this ground. I also consider that I found the earlier marks to be inherently distinctive to only a low degree, but that this had been enhanced through use to a medium level at the relevant date in respect of the identical and similar goods. I consider that the similarity and identity of the goods in this instance means there will be shared users, comprising mostly of members of the general public but also some professionals, and I consider that I found the marks to hold a reasonable reputation in respect of *cosmetics and non-medicate skin care preparations* and *cosmetic skin creams and lotions* and *cosmetic powders for the skin and eyes* under the earlier marks at the relevant date. Considering all of these factors, it

is my view that there will be a link made between the both earlier marks relied upon and the contested registration, in respect of all of the contested goods.

Damage

87. The cancellation applicant has pleaded under section 5(3) that the use of the contested mark will cause the consumer to be confused as to the origin of the mark in respect of both the earlier EU and UK registrations. It is well established that confusion as to the origin of a contested mark, namely confusion that the contested mark derives from the same undertaking as an earlier mark for which a reputation has been shown, will result in an unfair advantage for the proprietor. I find in this instance there will be an unfair advantage for the proprietor in respect of the contested registration, as it will inevitably benefit from the cancellation applicant's reasonable reputation in respect of its goods where there is confusion as to the origin of the marks.

88. The cancellation applicant goes on to plead that as the contested mark has an association with the cancellation applicant's mark it is "at the very least eroding the distinctiveness of the applicant for cancellation's earlier mark and thus damaging the distinctive character of the mark". It is well established that a claim of detriment to the distinctive character of a mark must be clearly made out, and although evidence of actual detriment is not necessarily required, I should not find for the cancellation applicant on this ground based on suppositions alone.¹² I consider that in order for detriment of distinctive character to be found, I must establish either that there has been a change in the consumers economic behaviour in respect of the earlier marks, or that there will very likely be one in future. It is my view that on the basis of the evidence filed and the submission made, there is no reason for me to find that the use of the applicant's mark will result in the consumer changing their economic behaviour towards the opponent's marks based on the supposed eroding of its distinctive character. I do not find that detriment to distinctive character has been established in this instance.

¹² See paragraph 43 of CJEU decision *Environmental Manufacturing LLP v OHIM*, Case C-383/12P

89. As I have found the earlier mark to hold a reasonable reputation for some of the goods relied upon under both earlier marks, that there will be a link made between the earlier UK and EU marks in respect of all of the goods registered under the contested registration, and that this will result in an unfair advantage for the proprietor in respect of all of the goods registered, the invalidation under section 5(3) of the Act succeeds in its entirety.

Final Remarks

90. The application for invalidation has been successful under section 47(2)(a) relying on both section 5(2)(b) and section 5(3). Subject to a successful appeal, the earlier registration will be invalidated in its entirety.

COSTS

91. The cancellation applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the cancellation applicant the sum of £1700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£200
Preparing and filing the TM26(I)	£400
Preparing and filing the evidence	£800
Preparing and filing written submissions in lieu	£300
Total	£1700

92. I therefore order Yasmin Majid to pay SHISEIDO AMERICAS CORPORATION the sum of £1700. The above sum should be paid within twenty-one days of the

expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of August 2021

Rosie Le Breton

For the Registrar