

O-766-22

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3588458
BY BRILLER INTERNATIONAL LTD
TO REGISTER**



LIP MUD

**AS A TRADE MARK IN CLASS 03
AND
OPPOSITION THERETO (UNDER NO. 425189)
BY
MAKE-UP DESIGNORY**

BACKGROUND

1) On 02 February 2021, Briller International Ltd ('the applicant') applied to register the following trade mark in respect of the goods shown below:



Class 03: Cleansing milk for toilet purposes; cleaning preparations; leather preservatives [polishes]; grinding preparations; essential oils; make-up powder; lip glosses; cosmetics; beauty masks; lipsticks; dentifrices; incense; cosmetics for animals; make-up removing preparations; cotton swabs for cosmetic purposes; cotton wool for cosmetic purposes; lipsticks.

2) The application was published in the Trade Marks Journal on 26 March 2021 and notice of opposition was later filed by Make-Up Designory ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act'). Those grounds are directed against all of the goods of the application except 'leather preservatives [polishes]; grinding preparations; incense'¹.

3) In support of its grounds under section 5(2)(b) of the Act, the opponent relies upon the following three trade mark registrations:

- **UKTM 00800974232 ('mark 1')**

¹ See Ms Wickenden's skeleton argument, dated 13 June 2022, at paragraph 6.



Make-up designory

Class 03: Cosmetics and make-up.

Class 21: Cosmetic and make-up brushes and sponges.

Filing date: 01 August 2008

Date of entry in register: 27 July 2009

- **UKTM 00910724854 ('mark 2')**

MUDSHOP

Class 35: Retail store and on-line retail store services featuring cosmetics and make-up, namely, foundations, concealers, highlights, shadows, cheek colors, lipstick, lip pencils, lip gloss, eye colors, eye pencils, eye liner, mascara, loose powder, and blush, liquid cosmetics and make-up, namely foundations, concealers, highlights, shadows, cheek colors, lipstick, eye colors, eye liner, and blush, all purpose carrying bags, cosmetic bags, cosmetic cases, beauty supplies and equipment, books and textbooks in the field of make-up artistry and cosmetology.

Filing date: 14 March 2012

Date of entry in register: 30 August 2012

- **UKTM 00911629409 ('mark 3')**

MUD STUDIO

Class 41: Educational services, namely, conducting classes and workshops in the field of make-up artistry and cosmetology and distribution of course material and student kits in connection therewith.

Filing date: 06 March 2013

Date of entry in register: 10 July 2013

4) It is claimed that the respective goods and services are identical or similar and the respective marks are similar such that there exists a likelihood of confusion under section 5(2)(b) of the Act.

5) Marks 1 and 3 are also relied upon under section 5(3) of the Act in respect of the same goods and services as relied upon under section 5(2)(b). It is claimed that the earlier marks enjoy the requisite reputation in respect of all those goods and services and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier marks.

6) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. As both completed their registration procedure more than five years prior to the application date of the contested mark, they are, in principle, subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods and services relied upon.

7) The applicant filed a counterstatement where it states the following:

- It does not put the opponent to proof of use of any of the earlier marks.
- It does not admit that mark 1 would be perceived by the average consumer as containing the word MUD.
- It denies that any of the respective marks are similar. However, later, in its submissions in lieu, it concedes that there is a low degree of similarity between each of the earlier marks and the contested mark².

² See Applicant's submissions in lieu, dated 13 June 2022, paragraph 12

- It does not admit that the goods covered by mark 1 are similar to its goods. However, later, in its submissions in lieu it does concede that certain of its goods are identical or similar to the goods covered by that earlier mark³.
- It denies that the services relied upon for marks 2 and 3 are similar to its goods⁴.
- It submits that the term MUD is widely used in trade as a descriptive indication in relation to cosmetics and skin treatments such as soaps, scrubs, face and body masks, cleansers, moisturisers and serums and therefore MUD has little or no distinctiveness in relation to cosmetics and skincare products generally.
- It submits that marks 2 and 3 each consist of a combination of words which are descriptive and/or non-distinctive such that those marks are very low in distinctiveness.
- It makes no admission in respect of the opponent's claims to reputation and denies that there would, if reputation is found, be the requisite link made between the marks.

8) The opponent is represented by J A Kemp LLP. The applicant is represented by Haseltine Lake Kempner LLP. The opponent's evidence in chief consists of a witness statement dated 30 November 2021 and nine exhibits and comes from its founder and president, Mr Tate Holland. The applicant's evidence consists of a witness statement from its trade mark attorney, Mr Martin Krause, and one exhibit thereto. A hearing took place before me on 15 June 2022 where the opponent was represented by Ms Stephanie Wickenden of Counsel. The applicant was not represented at the hearing but filed written submissions in lieu⁵.

Comparable marks – relevance of evidence pertaining to the EU

9) All of the marks relied upon by the opponent are 'comparable' marks and the evidence before me purporting to show enhanced distinctiveness and reputation includes use in the EU. In this regard, I note that Tribunal Practice Notice 2/2020 states:

³ See Applicant's submissions in lieu, paragraphs 6 - 7

⁴ This denial is maintained in its submissions in lieu at paragraph 9

⁵ Dated 13 June 2022

‘Comparable marks – use and reputation

4. Where, to the extent set out above, comparable marks are relied on in opposition/invalidation proceedings, there will be circumstances when the use provisions apply, or where a reputation is claimed under section 5(3) of the Act. Comparable marks may also be the subject of revocation claims based on non-use. In such circumstances, it may still be possible to rely on evidence of use in the EU, as set out below:

- where all or part of the relevant five-year period for genuine use under sections 6A, 46(1)(a) or (b), or 47 falls before IP Completion Day, evidence of use of the corresponding EUTM in the EU in that part of the relevant period before IP Completion day will be taken into account in determining whether there has been genuine use of the comparable trade mark. For that part of the relevant period, for the purposes of the genuine use assessment, the UK will be taken to include the EU.
- where it is asserted that a comparable mark has a reputation under section 5(3), and that reputation falls to be considered at any time before IP Completion Day, use of the corresponding EUTM in the EU will be taken into account in determining whether the comparable mark had a reputation at the relevant date.’

I will bear this in mind in the instant case.

Section 5(2)(b)

10) This section of the Act states:

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

(a)....

(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.

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.”

11) The leading authorities which guide me are from the CJEU: *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 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 and services

12) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

13) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

14) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

In *Sanco SA v OHIM* Case T-249/11, the General Court (‘GC’) found that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

15) In relation to the comparison between retail services connected with certain goods and the goods themselves, I note that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

16) Further, in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*⁶, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁷, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁸, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

⁶ Case C-411/13P

⁷ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁸ Case C-398/07P

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

17) I also bear in mind that in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05), the GC held that:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by 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 (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

18) I will take each of the earlier marks in turn, dealing first with the similarity between the goods covered by mark 1 and the goods covered by the contested mark.

Mark 1

Opponent's goods	Applicant's goods
Class 03: Cosmetics and make-up.	Class 03: <u>Cleansing milk for toilet purposes; cleaning preparations;</u>

<p>Class 21: Cosmetic and make-up brushes and sponges.</p>	<p>essential oils; <u>make-up powder</u>; <u>lip glosses</u>; <u>cosmetics</u>; <u>beauty masks</u>; <u>lipsticks</u>; dentifrices; <u>cosmetics for animals</u>; make-up removing preparations; cotton swabs for cosmetic purposes; cotton wool for cosmetic purposes; <u>lipsticks</u>. (my emphasis)</p>
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19) The applicant concedes that the underlined goods are **identical** to the opponent's goods.

20) The applicant also concedes that its 'make-up removing preparations; cotton swabs for cosmetic purposes; cotton wool for cosmetic purposes' are similar to the opponent's goods but does not comment on the degree of similarity. To my mind, 'make-up removing preparations' falls within the opponent's 'cosmetics'. I therefore find those goods to be **identical**. As for 'cotton swabs for cosmetic purposes; cotton wool for cosmetic purposes', I find the degree of similarity between those goods and the opponent's 'Cosmetic... brushes and sponges' to be **high** given that they may share users, intended purpose, be in competition, share trade channels and be stocked in close proximity in a retail store.

21) That leaves 'dentifrices' and 'essential oils'. The applicant does not accept that those goods are identical or similar to any of the opponent's goods. Dentifrices are substances, including pastes or powders, which are used to clean teeth. It follows that dentifrices may be used, not only for dental health and hygiene purposes, but also, occasionally, for beautifying/cosmetic purposes to improve the appearance of teeth by, for example, making them look whiter. In this connection, I note that the applicant's own evidence shows 'Tooth Whitening Mud' which appears to be intended primarily for cosmetic purposes⁹. There is therefore some overlap in intended purpose with the opponent's 'cosmetics' (i.e. beautification of the person). However, there is nothing before me to show that dentifrices and cosmetics

⁹ See page 49 of exhibit MK 1

commonly share trade channels or are often sold in close proximity. Further, their method of use differs to the opponent's cosmetics and there is unlikely to be any real competitive relationship in play. I find 'cosmetics' and 'dentifrices' to be similar to a **low** degree. As for 'essential oils' these would include 'essential oils for cosmetic purposes'. As such, I find that the applicant's 'essential oils' fall within the opponent's 'cosmetics' and are therefore **identical**. If I am wrong about that, they would nevertheless be **highly similar** because of the shared nature, purpose, methods of use, trade channels and because they may be in competition and/or complementary.

Mark 2

Opponent's services	Applicant's goods
<p>Class 35: Retail store and on-line retail store services featuring cosmetics and make-up, namely, foundations, concealers, highlights, shadows, cheek colors, lipstick, lip pencils, lip gloss, eye colors, eye pencils, eye liner, mascara, loose powder, and blush, liquid cosmetics and make-up, namely foundations, concealers, highlights, shadows, cheek colors, lipstick, eye colors, eye liner, and blush, all purpose carrying bags, cosmetic bags, cosmetic cases, beauty supplies and equipment, books and textbooks in the field of make-up artistry and cosmetology.</p>	<p>Class 03: Cleansing milk for toilet purposes; cleaning preparations; essential oils; make-up powder; lip glosses; cosmetics; beauty masks; lipsticks; dentifrices; cosmetics for animals; make-up removing preparations; cotton swabs for cosmetic purposes; cotton wool for cosmetic purposes; lipsticks.</p>

22) The term 'beauty supplies' in the opponent's specification covers all kinds of beauty products including cosmetics, essential oils (which includes those used for

cosmetic/beautification purposes) and products for applying cosmetics. All of the applicant's goods, with the exception of 'dentifrices', are specific kinds of beauty supplies. On the same basis as in *Oakley*, I therefore find that the opponent's 'Retail store... services featuring beauty supplies...' are complementary to such goods. However, the respective nature, method of use and purpose differs and there is no competitive relationship in play. I find a **medium** degree of similarity between the aforementioned goods and services.

23) Turning to 'dentifrices', I do not consider that these goods can naturally be described as a beauty supply per se. However, as the case law above indicates, the fact that those goods are not identical to the goods which are the subject of the opponent's retail services does not preclude a finding of similarity between them. As I noted earlier, dentifrices may, in addition to their health/hygienic function, also sometimes be used for beautifying/cosmetic purposes. However, there is nothing before me to indicate that dentifrices are commonly sold alongside beauty supplies such that both kinds of goods are typically subject to the same retail service. The opponent's 'Retail store... services featuring beauty supplies...' is therefore unlikely to be important for the sale of the applicant's 'dentifrices'. The average consumer is unlikely to believe that an undertaking selling 'dentifrices' is the same, or connected to, an undertaking that provides 'Retail store... services featuring beauty supplies...'. There is therefore no complementarity in play between those goods and services. The respective nature, purpose and method of use also differs and there is no obvious competitive relationship. I find **no similarity** between the opponent's 'Retail store... services featuring beauty supplies...' and the applicant's 'dentifrices'.

Mark 3

Opponent's services	Applicant's goods
<p>Class 41: Educational services, namely, conducting classes and workshops in the field of make-up artistry and cosmetology</p>	<p>Class 03: Cleansing milk for toilet purposes; cleaning preparations; essential oils; <u>make-up powder</u>; <u>lip glosses</u>; cosmetics; beauty masks;</p>

and distribution of course material and student kits in connection therewith.	<u>lipsticks</u> ; dentifrices; <u>cosmetics for animals</u> ; make-up removing preparations; cotton swabs for cosmetic purposes; cotton wool for cosmetic purposes; <u>lipsticks</u> . (my emphasis)
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24) At the hearing, Ms Wickenden submitted that the opponent's services are similar to the underlined goods in the applicant's specification, in particular, because students using the opponent's services will be provided with kits containing those underlined goods. Accordingly, the users are the same and there is a complementary relationship in play because the applicant's underlined goods are important for the use of the opponent's services. I agree. However, the nature, method of use and intended purpose is not the same and they are not in competition. I find the opponent's services to be similar to the underlined goods of the contested mark to a **medium** degree.

25) Turning to the goods of the applicant which are not underlined in the table above, it is not obvious to me that any of those goods would be contained in the kits provided as part of the opponent's services or that they are likely to be important for the use of, or indispensable to, the opponent's services in such a way that the average consumer would believe they are provided by the same undertaking. I find **no similarity** between the opponent's services and the applicant's goods which are not underlined.

Average consumer and the purchasing process

26) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. 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.”

27) The average consumer for the goods and services at issue is the general public and, in relation to the services covered by mark 3, make-up artistry and cosmetology students.

28) The cost of the parties' goods and the opponent's retail type services is likely to vary but is unlikely to ever be particularly high. That said, my own experience tells me that the consumer of the relevant goods is likely to take into account various factors such as colour, texture, desired finish (e.g. matte or glossy), suitability for skin-type (e.g. oily skin/dry/combination/sensitive) or scent, for example. Insofar as the opponent's retail-type services are concerned, factors such as the variety of cosmetics on offer are likely to be taken into account. Generally speaking, I find that a **medium** degree of attention is likely to be paid during the purchase. Both the goods and the retail-type services are likely to be sought out by eye, whether on-line or on the high street. Visual considerations are therefore more important than aural. That said, I do not discount the latter given the possibility of word-of-mouth recommendations and/or discussions with sales representatives.

29) As regards the opponent's class 41 services covered by mark 3, the cost of these services may also vary but even where the cost is at the lower end of the spectrum, these are not services which are a casual or impulse purchase. They are likely to be the subject of some consideration with the consumer taking into account factors such as course content, length, location, types of qualification on offer etc. I would expect a **medium to high** degree of attention to be paid during the purchase of those services. The services are likely to be sought out primarily by eye on websites or brochures and so I would expect the purchase to be mainly visual.

However, I bear in mind that the services may sometimes be the subject of word-of-mouth recommendations and so aural considerations are also borne in mind.

Distinctive character of the earlier marks

30) The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of confusion between each of them and the contested mark (*Sabel BV v Puma AG*). 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).”

Distinctiveness of the word 'MUD'

31) The distinctiveness of 'MUD' is relevant to my assessment of the inherent distinctiveness of the opponent's earlier marks and to the ultimate assessment of the likelihood of confusion given that it is the distinctiveness of the common element that is important¹⁰. The applicant submits that the word 'MUD' is descriptive and therefore non-distinctive for a wide range of cosmetic products. In support of this contention, it relies upon the evidence from Mr Krause. Mr Krause states that he has carried out research on the Internet to find use of the word MUD in relation to various body products. Some examples of the extracts from the websites that he has found are set out below¹¹:

- An article entitled 'COSMETICS BUSINESS' entitled 'Clay and mud cosmetics emerge as next big beauty trend', dated 4 June 2015. This appears to relate primarily to the United States but there is some mention of the growth in the UK market for mud and clay beauty products.
- An article from www.independent.co.uk, dated 6 August 2020, entitled '10 best clay face masks that clear pores, prevent breakouts and brighten skin'. It shows a number of face masks from different undertakings which contain clay.
- An advertisement on www.mirror.co.uk, dated 25 July 2018, from Aldi for face masks containing clay or mud.
- An article from www.glamourmagazine.co.uk, dated 7 January 2021, listing '15 of the best face masks to try now...' such as one from the brand 'Origins' which contains rose clay.
- An article from www.elle.com/uk, dated 7 June 2017, entitled '4 reasons to invest in a dead sea mask for all your skincare woes'. A number of different branded face masks are listed which all contain dead sea mud.
- An article from www.cosmopolitan.com/uk, dated 19 September 2018, about a product called 'GlamGlow Instamud' and its skin benefits. It contains a number of ingredients, including 'kaolin clays'.

¹⁰ See the comments of Mr Iain Purvis in *Shoe Boudoir London*, BL O-075-13, [39]

¹¹ Exhibit MK 1

- Products from the brand 'Wild Ferns' described as Rotorua Mud Body lotion and Rotorua Mud Hand Creme, advertised on www.blossomandroot.co.uk.
- A product from the brand 'OmMade Organic skincare' described as 'Tooth Whitening Mud' containing clays and activated charcoal.
- Advertises for various branded soaps containing mud or thermal mud such as the 'Drunk Elephant Juju bar' and shampoo such as 'Omorovicza Revitalising Scalp Mask' said to contain Hungarian moor mud.

32) The evidence of Mr Krause shows that the term 'mud' is used in trade in a descriptive manner primarily in relation to face masks, but also products such as shampoo, soap and tooth whitening goods and face and hand cream, which all contain mud or clay. There is, however, no evidence before me that the word 'mud' is used descriptively in relation to make-up products or that make-up products may contain mud or clay. I will bear these conclusions in mind when assessing the inherent distinctiveness of the opponent's earlier marks.

Mark 1

33) Dealing first with inherent distinctiveness, the words 'Make-up designory' in the earlier mark are not particularly distinctive in relation to the earlier goods for obvious reasons. The device element consists of the stylised representation of the letters/word 'MUD'. Some average consumers may be led to perceive that element as the three separate letters 'M-U-D' because of the underlying strapline. Others may simply perceive the word 'mud'. I have already concluded that 'mud' is descriptive for certain cosmetics, as shown in Mr Krause's evidence. For such goods, the distinctiveness of the 'MUD' element lies in its stylisation rather than the word itself and the stylisation gives that element a **low** degree of inherent distinctiveness. The applicant highlights, in its submissions, that MUD may also be meaningful in relation to certain cosmetics which have a mud-like texture i.e. those which come in the form of a moist paste resembling the consistency of mud. I accept that, where the goods have such a texture, the word 'mud' may be perceived as being suggestive of a mud-like texture. However, such a message is allusive, not descriptive and, together with the stylisation, the 'MUD' element is still of a **normal**

level of distinctiveness for those type of goods. For other goods, which do not contain mud or have a mud-like texture, the word 'MUD' is neither descriptive nor allusive and, taking into account the stylisation, that element has a **normal** degree of distinctiveness.

34) Turning to the question of whether the inherent distinctiveness of mark 1 has been enhanced through use, at the hearing Ms Wickenden took me to exhibits TH7 – TH9, in particular, and to specific examples therein showing use of mark 1 in relation to various cosmetics in the EU prior to the relevant date. She also drew my attention to the numerous advertisements present in exhibit TH9 which have been published in various EU magazines prior to the relevant date and to the 'Ad values' shown at the top of each page which gives, in her submission, an indication of the substantial advertising and promotional spend in relation to mark 1. There are a large number of adverts showing use of mark 1 for various items of make-up, including lipsticks, mascara and eye-shadow. All of them are from the year 2016, some five years before the filing date of the contested mark. The vast majority of the use on social media in Exhibit TH8, showing mark 1 being used at various exhibition stands in relation to make-up, is dated 2014 -2016. However, there is use of mark 1 on the magazines 'Mud Art' shown in 2018 and 2019¹². Mr Holland states that those magazines were distributed widely at conferences and trade shows, including the International Make-up Artistry Show. However, no further information is provided to ascertain the exact scale of that distribution or the geographical spread of it.

35) Mr Holland states that, since 2007, the opponent has expended in excess of USD 10,000 per month in the EU by way of central allocation but that each of the opponent's studios located in the EU will have their own marketing spend on top of this. No indication is given of the likely amount of that expenditure. Examples of such marketing activities are shown in exhibit TH7 which consists of posts on social media and all of it appears to emanate from four years before the relevant date in 2017.

¹² Exhibit TH8, pages 184 and 187, for example

36) Mr Holland provides a list of URLs, including www.makeupdesignory.eu, which he states are used by the opponent¹³. Figures are provided relating to UK user traffic for the years 2016 -2020 which appear to be very low. Examples of the kinds of goods offered at that URL are shown at exhibit TH5. The web pages are dated 2021 and show use of mark 1 at the top of the web pages, together with use on various cosmetics including eye-shadow, foundation, lipsticks, blusher, mascara, make-up brushes, facial primers, cleansers and make-up remover.

37) Mr Holland states that, for the period 1 Jan 2016 – 31 October 2021, direct to consumer sales in the UK amounted to USD 115,219.96. Additionally, sales made by the opponent's EU distributor in the UK from 2017 – 2020 were (in EUROS):

2017	2018	2019	2020
13, 413	2, 160	53, 731	1, 026

38) At the hearing, Ms Wickenden pointed out that the sales figures and web traffic figures provided above relate only to the UK. The opponent has not provided figures relating to the whole of the EU and therefore, she submitted, it can be assumed that the opponent's overall sales and web traffic for the whole of the EU is much larger.

39) Taking the evidence in the round, the opponent has not satisfied me that mark 1 had an enhanced degree of distinctiveness at the relevant date bearing in mind, in particular, the very low web traffic and sales figures for the UK, and the complete absence of any such figures for the EU at large, in the period leading up to the relevant date. I am not prepared to infer that the absent EU figures are likely to have been substantial in the absence of other evidence before me that clearly indicates that that is likely. There is, for example, little use shown in the evidence of mark 1 which post-dates 2016-2017. Although I accept that the opponent does appear to have used the mark on various cosmetics on its websites such as www.makeupdesignory.eu during that period, there is little else showing use of mark 1 in the four years leading up to the relevant date. It is not clear that mark 1 has

¹³ Witness Statement of Mr Holland, paragraph 14

been extensively promoted during that period or that the advertising which took place up to 2016, such as that shown in Exhibit TH9 for example, is likely to have had a lasting effect up to the relevant date, some four-five years later. On the contrary, the low sales figures and web traffic in the years leading up to the relevant date would indicate that any such promotion is likely to have been small in that period and have had little effect on the distinctiveness of the earlier mark, whether in the UK or the EU at large.

Mark 2

40) MUDSHOP will be perceived as a conjoining of the two well-known words MUD and SHOP. The word SHOP is entirely descriptive in relation to the earlier services. As for the word MUD, I note that the earlier mark includes retail services connected with the sale of specific items of make-up but also 'beauty supplies' at large which, to my mind, includes all kinds of cosmetics and beauty products. In relation to the retail services connected with goods which contain mud, the mark MUDSHOP must be attributed with a **very low** degree of distinctiveness. In relation to all other retail services relating to goods which do not contain mud, the mark has a **normal** degree of distinctiveness. This includes retail services which relate to goods which may have a mud-like texture because I consider it unlikely that MUD would send any allusive message in relation to those services. In my view, the services are a step removed from the goods themselves such that any allusive message is unlikely to be immediately apparent.

41) There is little use of this mark in the opponent's evidence. I find no enhanced distinctiveness of MUDSHOP.

Mark 3

42) In MUD STUDIO, the word STUDIO is entirely descriptive in relation to the earlier services. As for MUD, I find that, where the opponent's 'classes and workshops in the field of make-up artistry and cosmetology' relate to education about cosmetics which contain mud (such as mud masks for the face), the mark MUD STUDIO has a **low** degree of distinctiveness. In relation to all other services covered

by the opponent's mark (i.e. that do not relate to cosmetics containing mud), the mark has a **normal** degree of distinctiveness. This includes such services which relate to goods which may have a mud-like texture because I consider it unlikely that MUD would send any allusive message in relation to those services. The services are a step removed from the goods themselves such that any allusive message is unlikely to be immediately apparent.

43) I will now consider whether the evidence supports the opponent's contention that the distinctiveness of MUD STUDIO has been enhanced through use. Mr Holland states that the opponent's schools have been referred to as the 'Harvard of make-up schools. However, two of the publications¹⁴ referred to in that regard are not from the EU or the UK. As for the one which does relate to the UK,¹⁵ I note that nowhere in this article is there any mention of the mark MUD STUDIO.

44) Mr Holland states that the opponent's schools can be found throughout the EU offering make-up courses under the mark MUD STUDIO. Those locations are in Vienna (Austria), Gent and Antwerp (Belgium), Berlin (Germany), Milano and Roma (Italy), and Ljubljana (Slovenia).¹⁶ He further states that the opponent does not have a physical school in the UK but has been a regular attendee at numerous industry events, including the International Make-up Artistry Show which is held annually in London. He states that the opponent has attended many of these events since 2002 promoting its schools and studio courses¹⁷. No further information is provided about those events and neither are there any examples of the kind of promotion that took place at them.

45) Mr Holland states that the mark MUD STUDIO has been extensively and continuously promoted in the UK and EU, primarily through a major online presence in which considerable sums have been invested prior to the relevant date. None of the URLs he lists include the mark MUD STUDIO.¹⁸ It is also not clear if any of the

¹⁴ Witness Statement of Mr Holland, paragraph 9

¹⁵ Shown at Exhibit TH3, page 16

¹⁶ Witness Statement of Mr Holland, paragraph 10

¹⁷ Ibid, paragraph 11

¹⁸ Ibid, paragraph 14

figures given in paragraphs 18 and 19 of Mr Holland's statement relate to sales under the mark MUD STUDIO.

46) A further problem for the opponent is that it is not clear how much of the 10,000 USD referred to in paragraph 21 of Mr Holland's statement, which he states has been expended 'by way of central allocation', relates to marketing activities and expenditure under the MUD STUDIO mark (as opposed to the other marks referred to in that paragraph). Further, although he stresses that each of the MUD STUDIO locations in the EU also have their own marketing spend on top of the aforementioned figure, no further information is provided about the amount of that expenditure. However, he does provide some prints from social media websites and various EU websites owned by the opponent showing some use of MUD STUDIO¹⁹ in relation to a make-up school. There is also some use of MUD STUDIO in Exhibit TH8 on various social media posts about various events attended by the opponent in the EU. Much of this use is not prominent use but rather the use is of #MUDSTUDIO at the end of the post. A number of the posts also appear to show use in relation to cosmetics per se or retail services connected with the sale of cosmetics rather than the services in class 41 covered by the opponent's mark. As regards the 'MUD ART' magazine shown in the same exhibit, it is not clear where, or to what extent, that magazine was circulated in the EU.

47) None of the press clippings in exhibit TH9 show use of the mark MUD STUDIO, aside from a single article dated 25 Jan 2016 which mentions MUD STUDIO within the body of the article. As it is not in English, it is not clear what goods or services this article is promoting.

48) Bearing in mind all the above, I am not persuaded that the evidence before me is sufficient to show that the mark MUD STUDIO had any enhanced distinctiveness at the relevant date.

¹⁹ Exhibit TH7


Comparison of marks

49) 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.”

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

50) The marks to be compared are:

Opponent's marks	Applicant's mark
<p data-bbox="204 1644 316 1680"><u>Mark 1:</u></p> 	

Mark 2:

MUDSHOP

Mark 3:

MUD STUDIO



Overall impressions

51) The applicant's mark consists of the words LIP MUD and the stylised device element of a pair of lips. The device element has little, if any, distinctiveness in relation to goods for use on the lips but it does have significant visual impact such that it has only slightly less weight in the overall impression of the mark than the words LIP MUD. Further, within the LIP MUD element, it is the word MUD that will likely have greater impact upon the average consumer than the word LIP, at least in circumstances where the contested goods do not contain mud, given that LIP will be perceived as entirely descriptive of the intended purpose of the goods (i.e. goods to be used on the lips) and it will therefore be the word MUD which is of greater distinctiveness.

52) Mark 1 consists of the words 'Make-up designory' below a stylised device element which, as I stated earlier, may either be perceived as the letters M-U-D or the single word 'MUD'. Regardless of how the device is perceived, it is larger and more prominently positioned than the words 'Make-up designory'. The device is also more distinctive than the words in the context of the relevant goods, whether or not it

is perceived as separate letters or a single word, bearing in mind, in particular its stylisation. I therefore find that it is the device which is likely to have the greater impact upon the average consumer than the words 'Make-up designory'. That is not to say that the latter element is negligible but it does play a lesser role than the device.

53) Mark 2 consists of the plain word MUDSHOP, which will likely be perceived as consisting of the two separate, and well-known words, MUD and SHOP. SHOP, although not negligible, is entirely descriptive of all the opponent's services. It is likely that MUD will have more of an impact than SHOP upon the average consumer owing to the relatively greater degree of distinctiveness of the former than the latter, at least insofar as the retailing of products which do not contain mud, are concerned, and its more prominent position at the beginning of the mark.

54) Mark 3 consists of the words MUD STUDIO. STUDIO is entirely descriptive of the opponent's services covered by that mark. Although its relative size and positioning to the word MUD means that it is not negligible, it is the word MUD, prominently positioned at the beginning of the mark, that will likely have the greater impact upon the average consumer.

Similarity between mark 1 and the applicant's mark

55) The applicant submits that the stylisation of the device in the opponent's mark is such that it may not be perceived as 'MUD' by the average consumer.²⁰

In my view, the stylisation of that element is not so heavy that it disguises or completely obscures the presence of 'MUD' within it. I find that the consumer will, despite the stylisation, immediately recognise that it consists of the letters/word 'MUD'.

56) Visually, each mark contains elements which have no counterpart in the other mark i.e. the words 'Make-up designory' in the opponent's mark is entirely absent from the applicant's mark and the device of stylised lips and the word LIP are absent

²⁰ Applicant's submissions in lieu, paragraph 11

from the opponent's mark. The sole point of similarity is that both contain 'MUD'. However, that element, in the opponent's mark, bears stylisation which is absent from the word MUD in the applicant's mark. That creates yet another point of visual difference between the marks. I find that there is a **very low** degree of visual similarity overall.

57) Aurally, it is possible that, when faced with the opponent's mark, the average consumer may be led to perceive 'MUD' as an abbreviation of the underlying strap-line, 'Make-up designory', such that the former may be pronounced as the three separate letters, M-U-D. However, other average consumers may simply pronounce it as the word 'MUD'. For average consumers who pronounce the earlier mark as 'M-U-D Make-up designory', there is clearly **no aural similarity** with LIP MUD (and the device in the applicant's mark will not be spoken). For average consumers who pronounce the opponent's mark as 'MUD Make-up designory', there is a **low** degree of aural similarity with LIP MUD owing to the sole point of similarity being the common MUD pronunciation but taking into account the presence/absence of 'Make-up designory'/'lip' from the respective marks.

58) Turning to the conceptual comparison, the applicant's mark will be perceived as meaning mud for lips and the device element merely reinforces that message. The words 'Make-up designory' in the opponent's mark are self-explanatory and have no counterpart in the contested mark. That is therefore a point of conceptual difference, albeit not a particularly distinctive one. As I have already touched upon, the stylised 'MUD' element in the opponent's mark, may either be perceived as an abbreviation for the underlying strapline or as the word 'MUD'. If perceived in the former way, there is **no conceptual similarity** overall between the marks. If perceived in the latter way, the marks share a common 'mud' concept, albeit that the concept in the opponent's mark is mud per se and in the applicant's mark it is mud for lips. There is also the conceptual difference created by the words 'Make-up designory' in the opponent's mark which are absent from the contested mark. I find a **medium** degree of conceptual similarity in those circumstances.

Similarity between mark 2 and the applicant's mark

59) Visually, the point in common between the marks is the word MUD. SHOP, in the opponent's mark has no counterpart in the applicant's mark and the word LIP and the device of the stylised lips are absent from the opponent's mark. Overall, there is a **low** degree of visual similarity.

60) Aurally, the comparison is between LIP MUD on the one hand and MUDSHOP. There is no reason to suppose that the average consumer is likely to perceive, and therefore pronounce, MUD in the opponent's mark as the three separate letters M-U-D because there is nothing in the mark to lead the consumer to that perception. Rather, they are likely to immediately perceive and vocalise that part of the mark simply as the everyday word 'mud'. Both marks therefore contain the word MUD but that word will be preceded by LIP in the applicant's mark and followed by SHOP in the opponent's mark. In my view, this results in a **medium** degree of aural similarity overall.

61) Conceptually, the marks share the main concept of mud, albeit that the opponent's mark is specifically of a shop which sells mud and the applicant's mark is of mud for use on the lips. It is, of course, distinctive concepts which are of the greatest importance. Bearing in mind the descriptive nature of the respective words SHOP and LIP, and that for goods and services which do not contain mud or relate to goods containing mud, the word 'mud' is distinctive, I find this results in a **fairly high** degree of conceptual similarity overall for such goods and services. For other goods, containing mud, and services relating thereto, although the marks would still share a fairly high degree of conceptual similarity, this would not be a distinctive similarity.

Similarity between mark 3 and the applicant's mark

62) Visually, again, the only point in common between the marks is the word MUD. STUDIO, in the opponent's mark has no counterpart in the applicant's mark and the word LIP and the device of the stylised lips are absent from the opponent's mark. Overall, there is a **low** degree of visual similarity.

63) Aurally, the comparison is between LIP MUD and MUD STUDIO. Again, there is no reason to suppose that the average consumer is likely to perceive, and therefore pronounce, MUD in opponent's mark as the three separate letters M-U-D as opposed to the word 'mud'. Both marks therefore contain the word MUD but that word will be preceded by LIP in the applicant's mark and followed by STUDIO in the opponent's mark. In my view, this results in a **medium** degree of aural similarity overall.

64) Conceptually, the marks share the main concept of mud, albeit that the opponent's mark is specifically of a studio which specialises in, or is mainly concerned with, mud and the applicant's mark is of mud for use on the lips. Again, I remind myself that it is distinctive concepts which are of the greatest importance. Bearing in mind the descriptive nature of the respective words STUDIO and LIP, and that for goods and services which do not contain mud, or relate to goods containing mud, the word 'mud' is distinctive, I find this results in a **fairly high** degree of conceptual similarity overall for such goods and services. For other goods containing mud, and services relating thereto, although the marks would still share a fairly high degree of conceptual similarity, this would not be a distinctive similarity.

Likelihood of confusion

65) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier marks are, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

66) At the hearing, Ms Wickenden conceded that there is no likelihood of direct confusion between any of the marks at issue²¹. She also conceded that there is no likelihood of confusion in respect of any of the contested goods which may contain mud or clay (I will return to this issue later). However, in respect of all other goods, Ms Wickenden submitted that there is a likelihood of indirect confusion because the average consumer is likely to perceive the contested mark as a brand extension of the earlier marks, as per the decision of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Mr Iain Purvis Q.C., as the Appointed Person, where he explained that:

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

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

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

²¹ Ms Wickenden’s skeleton argument, paragraph 26

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

67) I bear in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

68) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

Mark 1

69) I do not consider that there would be a likelihood of indirect confusion between the contested mark and mark 1 where the stylised 'MUD' element is perceived as the three separate letters M-U-D given the lack of any conceptual similarity that would exist in those circumstances together with the very low degree of visual similarity and lack of any aural similarity. The strongest case for the opponent is where the average consumer perceives the 'MUD' element as a single word which has the same meaning as the word 'MUD' in the contested mark. I bear in mind that some of the respective goods are identical, others are highly similar and others similar to a low degree and the earlier mark has a normal level of distinctiveness in relation to goods which do not contain mud/clay. However, although there is a medium degree of conceptual similarity between the marks, there is a low degree of aural similarity. Furthermore, there is only a very low degree of visual similarity between the marks such that I do

not consider that the average consumer, paying a medium level of attention, during a mainly visual purchase, is likely to perceive the contested mark as being entirely logical and consistent with a brand extension of the earlier mark. The contested mark does not, in my view, have the 'look' of a natural brand extension of the earlier mark. I can also see no other reason why the average consumer would put the similarities between the marks, when considered as wholes, down to the respective goods coming from the same or inked undertaking(s). **The ground under section 5(2)(b) of the Act fails based upon mark 1.**

Mark 2

70) Turning to mark 2, MUDSHOP has a normal level of distinctiveness for retail services which do not relate to goods containing mud. The respective goods and services are also similar to a medium degree (with the exception of the applicant's 'dentifrices' which are not similar to the earlier services and for which there can be no likelihood of confusion). Although, again, the purchase is likely to be mainly visual and the marks are visually similar only to a low degree, there is nevertheless a medium degree of aural similarity and a fairly high degree of conceptual similarity. In relation to the respective goods and services which do not contain mud, it is the shared word 'MUD' in the marks that will have the greatest impact upon the consumer. This is so, despite the possibility of the contested mark sending an allusive message (not a descriptive one) of a mud-like texture for some goods. Furthermore, the other words in the marks, LIP and SHOP, are entirely descriptive (I see no reason why all of the applicant's goods could not be used on the lips) and the device of lips is of very little, if any, distinctiveness for goods intended for use on the lips. Bearing in mind all of the aforesaid, it seems to me that there will be a significant proportion of average consumers, paying a medium degree of attention, who are likely to put the similarities that exist between MUDSHOP and the contested mark down to the respective goods and services coming from the same undertaking, at least insofar as goods which do not contain mud/clay, and services relating to the same, are concerned. **The ground under section 5(2)(b) of the Act therefore succeeds based upon mark 2 against the contested goods which do not contain mud/clay and fails against 'dentifrices'.**

Mark 3

71) MUD STUDIO has a normal level of distinctiveness for the earlier services which do not relate to goods containing mud. The contested 'make-up powder; lip glosses; cosmetics; beauty masks; lipsticks' and 'cosmetics for animals' are also similar to a medium degree to the opponent's services (the rest of the applicant's goods are not similar to the opponent's services such that there can be no likelihood of confusion for those goods). The purchase is likely to be mainly visual and the marks are visually similar to only a low degree. However, there is a medium degree of aural similarity and a fairly high degree of conceptual similarity. In relation to the respective goods and services which do not contain mud, it is the shared word 'MUD' in the marks that will have the greatest impact upon the consumer. The other words, LIP and STUDIO are also entirely descriptive and the device of lips is of very little, if any, distinctiveness for goods intended for use on the lips. I find that the average consumer is likely to put the similarities that exist between MUD STUDIO and the contested mark down to the respective goods and services coming from the same undertaking despite the medium to high degree of attention that is likely to be paid. **The ground under section 5(2)(b) of the Act succeeds based upon mark 3 against 'make-up powder; lip glosses; cosmetics; beauty masks; lipsticks' and 'cosmetics for animals' in so far as they do not contain mud/clay and fails against the rest of the contested goods.**

Section 5(3)

72) Section 5(3) of the Act provides:

“(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.”

Reputation

73) Ms Wickenden submitted that the opponent's evidence going to the issue of enhanced distinctiveness was also relied upon to show that marks 1 and 3 had the requisite reputation. Bearing in mind my earlier comments regarding the evidence filed by Mr Holland, I am not satisfied that those marks had a qualifying reputation at the relevant date, as per Case C-375/97, *General Motors* [1999] ETMR 950. Without the requisite reputation, there can be no link or damage. **The grounds under section 5(3) of the Act fail.**

The opponent's proposed limitation to the specification to goods containing mud/clay

74) The opponent has partially succeeded under section 5(2)(b) against the contested goods in so far as they do not contain mud or clay. Ms Wickenden stated that the opponent would have no objection to an appropriately limited specification including 'beauty masks all containing mud or clay' and 'cosmetics all containing mud or clay' for example. The applicant, however, has put forward no revised specification for my consideration or commented upon that proposed by the opponent. Tribunal Practice Notice 1/2012 entitled "Partial Refusal" states:

"3.2.2. Defended Proceedings

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of

the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not

be reflected in changes to the specification via either the “blue pencilling” approach or the “save for” type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal. “(my emphasis)

75) In the case before me, I have no evidence from the applicant about the nature of its business or the kinds of goods it sells/intends to sell. That said, I note that, when filing its evidence in support of its contention that ‘mud’ is descriptive for various cosmetics, it did not put in any evidence to suggest that it sells/intends to sell goods containing mud which would have been easy to provide and which would have lent even more support to its contention that ‘mud’ is descriptive. It therefore seems likely to me that the applicant does not provide/intend to provide goods containing mud or clay. Bearing this in mind, together with i) the absence of any form of revised specification having been submitted by the applicant, ii) that the words ‘LIP MUD’, would be entirely non-distinctive for goods containing mud or clay and iii) the device of lips would also have little, if any, distinctiveness for such goods, it is difficult to see how adding the limitation proposed by the opponent would leave the applicant with a registration of any real substance. I therefore do not consider it would be appropriate to limit the specification in the manner proposed by the opponent. The contested mark will therefore be refused for all of the broad terms within its specification which fall foul of section 5(2)(b) of the Act.

OVERALL OUTCOME

76) The application is to be refused for the following goods:

‘Class 03: Cleansing milk for toilet purposes; cleaning preparations; essential oils; make-up powder; lip glosses; cosmetics; beauty masks; lipsticks; cosmetics for animals; make-up removing preparations; cotton swabs for cosmetic purposes; cotton wool for cosmetic purposes; lipsticks.’

77) The application is to proceed to registration for the following goods:

‘Class 03: leather preservatives [polishes]; grinding preparations; dentifrices; incense.’

COSTS

78) As the opponent has been largely successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side’s statement	£400
Official fee (Form TM7)	£200
Preparing and filing evidence and considering the applicant’s evidence	£800
Preparing for, and attending, the hearing	£600
Total:	£2000

79) I order Make-Up Designory to pay Briller International Ltd the sum of **£2000**. This sum is to be paid within twenty-one of the expiry of the appeal period or within

twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of September 2022

**Beverley Hedley
For the Registrar,
the Comptroller-General**