

**O-386-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3104342  
BY THE EYELASH DESIGN COMPANY LIMITED  
TO REGISTER THE TRADE MARK:**

**Hi Brow**  
**EYEBROWS BY DESIGN**

The logo features the text "Hi Brow" in a thin, black, sans-serif font. The letter "i" has a vertical line with a dot above it. The word "Brow" is written in a similar font, but the "o" is stylized with a decorative flourish that loops under the "w" and extends to the right. Below the text "Hi Brow" is a solid red horizontal bar. Inside this bar, the words "EYEBROWS BY DESIGN" are written in a white, uppercase, sans-serif font. The decorative flourish from the "Hi Brow" text continues to curve over the right side of the red bar.

**IN CLASSES 3, 35 AND 41  
AND  
IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 404863 BY HIBROW PRODUCTIONS LTD**

## BACKGROUND AND PLEADINGS

1. On 16 April 2015, The Eyelash Design Company Limited (“the applicant”) applied to



register the trade mark  for the following goods and services:

Class 3      Cleansing products for eyebrows; cosmetic preparations for use on eyebrows; cosmetic products for eyebrows; non-medicated cosmetic preparations; creams, gels and lotions; eyebrow cosmetics; eyebrow pencils; eyebrows [false].

Class 35      Retail, wholesale and on-line retail services connected with the sale of cosmetics, beauty products, eyebrow products, hand implements for use in relation to eyebrows.

Class 41      Supply of training for eyebrows; practical training [demonstration]; arranging and conducting of training workshops; arranging of demonstrations for training purposes; arranging of exhibitions for training purposes; arranging of presentations for training purposes; conducting workshops [training]; education, teaching and training services; professional training services; providing courses of training; provision of training services for business; training courses; vocational training services; adult training.

2. The application was published for opposition purposes on 15 May 2015.

3. The application is opposed by Hibrow Productions Ltd (“the opponent”). The Notice of Opposition was originally filed on 13 August 2015 but required amendment. The amended Notice of Opposition was admitted into proceedings and served on the applicant on 8 September 2015.

4. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods and services in the application. The opponent relies upon its UK trade mark registration no. 2595125 for the trade mark **HIBROW**, which has a filing date of 21 September 2011 and for which the registration procedure was completed on 23 December 2011. The opponent relies upon all of the goods and services for which the earlier mark is registered, namely:

Class 9       Downloadable audio, visual and audio-visual recordings; computer software; computer software supplied from the Internet; electronic publications provided on-line from databases or the Internet; computer software and telecommunications apparatus to enable connection to databases and the Internet.

Class 16       Paper, cardboard and goods made from these materials, not included in other classes; articles of paper or cardboard; printed matter; printed publications; newspapers; magazines and periodicals; books; catalogues; stationery; photographs; posters; calendars; greeting cards.

Class 35       Advertising; business management; business administration; office functions; promotion and information services relating thereto; bringing together for the benefit of others, of a variety of audio-visual recordings downloadable from the Internet, and allowing customers to conveniently view and purchase such goods.

Class 38       Telecommunications; data streaming; broadcasting services; radio and television broadcasting; broadcasting on the Internet; telecommunication of information, computer programs and any other data; electronic communication services; chat room services; portal services; e-mail services; texting services; SMS services; mobile Internet services; providing user access to the Internet; information and advisory services relating to the aforesaid.

Class 41 Education; providing of training; entertainment; sporting and cultural activities; the production, presentation and distribution of audio, visual and audio visual works including television programmes, radio programmes and films; distribution of cinema, television films, video tapes, cassettes and disks; rental of cine films; library services; educational services relating to films.

5. In its Notice of Opposition, the opponent claims that there is a likelihood of confusion, including a likelihood of association. As these are the only comments I have from the opponent, they are reproduced, in full, below:

“The name and image for HIBROW is identical in almost every respect. Confusion exists intrinsically. An online search immediately makes ambiguity clear. Position on Search Engines like Google are crucial to attracting traffic to the company’s website. Brands that might become sponsors or advertisers for [www.hibrow.tv](http://www.hibrow.tv) would find the ambiguity a commercial hindrance. Cosmetics and glamour have powerful connections with the broadranging [sic] media content that Hibrow Productions Ltd produces and distributes both online and in all other media. The words EYBROWS [sic] and DESIGN are also search engine friendly when connected with HI BROW and internet users, notoriously impatient, might be deterred from continuing to search for [www.hibrow.tv](http://www.hibrow.tv) if navigated to a cosmetics company’s website”.

6. The applicant filed a counterstatement, in which it denies that the trade marks are similar and that the goods and services at issue are identical or similar (paragraph 9).

7. The applicant has been represented throughout by Boulton Wade Tennant; the opponent is not professionally represented. The opponent did not file evidence. During the evidence rounds, the applicant filed both evidence and submissions. I have read all of the papers carefully but I will only summarise the evidence to the extent that I consider necessary. Whilst neither party asked to be heard, the applicant filed written

submissions in lieu of attendance at a hearing. I will bear both parties' comments in mind and refer to them, as necessary, below. References are to the applicant's submissions dated 9 June 2016, unless otherwise stated,

### **The applicant's evidence**

8. This consists of the witness statement of Beverly Alison Piper, with eight exhibits. Ms Piper is a Director of the applicant company, a position which she states she has held since 2006. The salient points of Ms Piper's evidence are:

- Ms Piper states that the applicant has been using the trade mark since 2012, though she indicates that there was "a small modification to the logo", which has been used in its current format (presumably, the mark applied for) since 2013 (paragraph 5).
- The applicant offers training courses about shaping, colouring and styling eyebrows.<sup>1</sup> Ms Piper states that 334 of these courses have been held since 2012 and that the courses are offered directly, such as through the applicant's website, or through wholesalers (paragraph 9).
- The applicant sells a range of products which complement its courses in eyebrow grooming. These include serums, tints and waxes.<sup>2</sup> Ms Piper states that the applicant has sold over 150,000 of these products to retail customers since 2012 (paragraph 11). It appears that the applicant's products are sold by beauticians through their own salons (paragraph 12) and through a retail outlet at Stansted airport.<sup>3</sup>
- Advertising and promotional activities for the applicant's products and training services have included posters in salons,<sup>4</sup> advertisements in magazines for professional beauty therapists<sup>5</sup> and stands at beauty exhibitions.<sup>6</sup> Ms Piper

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<sup>1</sup> Exhibit BAP-1

<sup>2</sup> Exhibit BAP-2

<sup>3</sup> Paragraph 17 and Exhibit BAP-8

<sup>4</sup> Exhibit BAP-3

<sup>5</sup> Exhibit BAP-4

<sup>6</sup> Exhibits BAP-5 – BAP-7. Although exhibit BAP-6 is said to show the applicant's stand at Olympia Beauty Show, the applied-for mark is not visible.

states that the applicant has attended these beauty exhibitions each year since 2012 (paragraph 16).

## **DECISION**

9. The opposition is based upon section 5(2)(b) of the Act which reads 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”.

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

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

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

### **Section 5(2)(b) – case law**

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

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

13. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the Court of Justice of the European Union (“CJEU”) 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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

15. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. 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".

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) said:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context".

17. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

18. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. I also 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. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C., sitting 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".

20. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*,<sup>7</sup> and *Assembled Investments (Proprietary) Ltd v. OHIM*,<sup>8</sup> upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*,<sup>9</sup> 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;
- (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 GC'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

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<sup>7</sup> Case C-411/13P

<sup>8</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

goods as those for which the other party's trade mark was registered (or proposed to be registered).

21. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

22. I have no submissions from the opponent to explain which of the goods and services of the earlier mark it considers similar to the applied-for goods and services, or to what degree. As I mentioned above, the applicant submits that the goods and services at issue are not similar.

Class 3: Cleansing products for eyebrows; cosmetic preparations for use on eyebrows; cosmetic products for eyebrows; non-medicated cosmetic preparations; creams, gels and lotions; eyebrow cosmetics; eyebrow pencils; eyebrows [false].

23. In the absence of submissions, I can see no meaningful similarity between the applicant's goods in class 3 and the opponent's goods and services in classes 9, 16, 38 or 41, or to "business management; business administration; office functions; promotion and information services relating thereto" in class 35. The nature and intended purpose of the goods and services at issue are different. The users and channels of trade may overlap at a very superficial level, in that the users may be members of the public or distribution channels may be online or via shops on the high street. However, this in itself is insufficient to give rise to similarity and the goods and services are not likely to be sold in the same retail outlets, nor are they likely to arrive on the market through the same channels. They are neither in competition nor complementary.

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<sup>9</sup> Case C-398/07P

24. Regarding “advertising; promotion and information services relating thereto” in class 35 of the earlier mark, I acknowledge that the goods in the applied-for specification may be the subject of advertising services. However, advertising is a service offered by a third party to promote a business’s goods and/or services: the intended purpose of such services has no similarity to the purpose of the applied-for goods. The nature is different and there is no evidence that the channels of trade coincide. The respective goods and services are neither in competition nor complementary as defined in the case law. I consider that the applicant’s goods and the services identified above are dissimilar.

25. That leaves the “bringing together for the benefit of others, of a variety of audio-visual recordings downloadable from the Internet, and allowing customers to conveniently view and purchase such goods” in class 35 of the opponent’s specification. I bear in mind the case law cited above, which allows for a degree of similarity between retail services and goods on the basis of complementarity, even though the nature, purpose and method of use of goods and retail services are different. However, rather than retail services at large, the opponent’s specification covers retail services for particular goods, namely downloadable audio-visual recordings. I have already found that those goods are not similar to the applicant’s goods. The goods which are the subject of the opponent’s retail services are not likely to be sold alongside the applicant’s goods and, as a result, they are unlikely to benefit from the same retail services. In the absence of any similarity between the goods subject to the services, and in circumstances where there is no complementarity and no overlap in channels of trade, save for at a very high level of generality because both may be available online, the consumer is unlikely to assume that the undertaking providing the retail service is the same as or connected to that providing the goods. I find that the applicant’s goods in class 3 are not similar to the “bringing together for the benefit of others, of a variety of audio-visual recordings downloadable from the Internet, and allowing customers to conveniently view and purchase such goods” in class 35 of the earlier specification.

Class 35: Retail, wholesale and on-line retail services connected with the sale of cosmetics, beauty products, eyebrow products, hand implements for use in relation to eyebrows.

26. As far as the services in class 35 of the application are concerned, the opponent's best case rests in its own services in class 35 for the "bringing together for the benefit of others, of a variety of audio-visual recordings downloadable from the Internet, and allowing customers to conveniently view and purchase such goods. The opponent would not be in any better a position were I to consider its other goods and services and I will therefore restrict my assessment to the services I have specified.

27. At the most general level, retail or wholesale of any product might be said to have broadly the same nature and purpose as the retail or wholesale of any other product. However, this is too high a level of generality to give rise to similarity and could result in any retail/wholesale service being regarded as similar, even if the goods are poles apart and, as importantly, the inherent nature and characteristics of the retail service are completely different. While I bear in mind that the case law allows for similarity between retail services for different goods, I also keep in mind the CJEU's ruling in *Praktiker* that in registering a trade mark for retail services the goods or types of goods to which those services relate must be specified.<sup>10</sup> The reason given (at [51]) is that this will make it easier to apply the legal provisions relating to similarity of goods and services and genuine use.

28. The users of the parties' retail services for, on the one hand, downloadable audio-visual recordings and, on the other, beauty products and tools, are the general public, while the users of wholesalers will also include retailers. However, this is a fairly superficial point of similarity. The purpose of the services at issue is to provide the facility for the consumer to select the relevant goods and to encourage the consumer to purchase those goods from the trader in question rather than a competitor. The provider of the services will also offer information about the goods, such as product descriptions

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<sup>10</sup> *Praktiker Bau- und Heimwerkermärkte*, Case C-418/02

and price comparisons, to enable the consumer to ascertain the suitability of the product for his requirements. However, the parties' services here are aimed at goods which are markedly different. Accordingly, the precise nature of the service (such as the information provided and the particular inducement to purchase) is likely to be very different. Although the method of use for both parties' services may involve use of a website or the Internet, this is a fairly tenuous link since the respective services are unlikely to be offered on the same Internet sites— and the opponent's goods will be downloaded directly, while the applicant's may only be *ordered* online. Even in a wholesale situation, the goods belong to discrete categories and it is unlikely that the services will be offered by the same provider. In circumstances where the goods which are the subject of the services are strikingly different and where the services offered are unlikely to share more than a trivial similarity, I do not consider that the average consumer would imagine that the services are offered by the same service provider. I find that the parties' services in class 35 are not similar.

**29. In view of my findings, above, in relation to the similarity between the applied-for goods and services in classes 3 and 35 and the goods and services of the earlier specification, the opposition against classes 3 and 35 of the application is hereby dismissed.<sup>11</sup>**

Class 41: Supply of training for eyebrows; practical training [demonstration]; arranging and conducting of training workshops; arranging of demonstrations for training purposes; arranging of exhibitions for training purposes; arranging of presentations for training purposes; conducting workshops [training]; education, teaching and training services; professional training services; providing courses of training; provision of training services for business; training courses; vocational training services; adult training.

30. The applicant submits that the services at issue in class 41 are not similar because:

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<sup>11</sup> If the goods/services are not similar, there can be no likelihood of confusion. See, for example, *Waterford Wedgwood plc v OHIM*, C-398/07 P (CJEU).



“In Class 41 of the Application, again, the terms are related clearly to beauty services. The terms relating to “the arranging of training and exhibitions” clearly relate to beauty services, in particular, teaching customers to implement the eyebrow related beauty techniques they learn at the training in their own beauty salons” (paragraph 18).

31. The applicant’s comments are noted. However, the applied-for specification is, for the most part, unlimited and I must consider all the circumstances in which the mark applied for might be used if it were registered.<sup>12</sup> The specification of the earlier mark contains the broad terms “education; providing of training”. These include all of the terms in the specification of the applicant’s mark. The services are, on the principle outlined in *Meric*, identical. If that is not right in relation to “arranging and conducting of training workshops; arranging of demonstrations for training purposes; arranging of exhibitions for training purposes; arranging of presentations for training purposes”, those services are highly similar to the services of the earlier mark: the respective services all relate to training, share users and channels of trade and potentially have both a competitive and a complementary relationship.

### **The average consumer and the nature of the purchasing act**

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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:

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<sup>12</sup> See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) at [66]

“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”.

33. Given my findings, above, regarding the similarity of the goods and services, it is only necessary for me to consider the average consumer of the parties’ class 41 services. I have no submissions from the opponent on this point. The applicant submits that:

“The average consumers of the goods and services offered under the Applicant’s goods are professional beauticians and consumers of the beauty market. The average consumer is different to that of, what appears to be, a film production company, and the average consumer is likely to be either film makers, or those that watch films. In both cases the average consumer’s attention is likely to be at a low to medium level” (paragraph 20).

34. There is, however, nothing in the specification of either mark which would support the restrictive view of the average consumer proposed by the applicant. For the services at issue, the average consumer may be a member of the general public or a business user. The member of the public is likely to be attentive to, for example, the length of the training course, fees and the qualifications on offer. The purchase of the services is likely to be relatively infrequent. Although the level of attention will vary depending on the exact nature of the services sought, I consider that the member of the public will pay a reasonably high degree of attention to the selection of the services at issue. For the business consumer, while the purchase of training services may be more frequent, the purchase may involve contracts of significant value or duration. The business user will also be keen to ensure that the nature of the training offered and any qualifications are

suitable for his/her purpose. I consider that the business user will also pay a reasonably high degree of attention in selecting the parties' services in class 41.

35. The parties' services in class 41 are, for both groups of average consumer, likely to be selected through primarily visual means, with the parties' marks being encountered through websites, advertisements in magazines and trade publications, prospectuses and course syllabi. However, given the potential for oral recommendations and use over the telephone, there may also be an important aural component.

### **Comparison of trade marks**


36. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

38. 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”.

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

38. The trade marks to be compared are as follows:

| Opponent's trade mark | Applicant's trade mark   |
|-----------------------|--|
| HIBROW                |  |

39. The opponent claims that “the name and image for HIBROW is identical in almost every respect”; the applicant denies that the marks are similar.

40. The opponent's mark consists of the word “HIBROW”, presented all in capital letters. There are no other elements to contribute to the overall impression, which is contained in the word itself.

41. The applicant's figurative mark contains a number of elements. The words “Hi” and “Brow” are presented in title case. Two curved lines, looped at the end, trail from the letter “o”. Underneath are the words “EYEBROWS BY DESIGN”, presented, in capital letters, in a smaller white font on a rectangular red background. I consider that the words “Hi Brow” have the greatest impact in the overall impression, given their size and position, with neither word dominating the other. A lesser role is played by the phrase “EYEBROWS BY DESIGN” which, positioned beneath the words “Hi Brow” and in a smaller typeface, has a lesser impact, particularly in relation to those services for which the words have little or no distinctive character, i.e. those services relating to eyebrows. The red background and the lines emanating from the letter “o” are likely to be seen as decorative and play a weaker role.

42. Visually, both marks share the letters “H-i-B-r-o-w” / “H-I-B-R-O-W”. There are, however, presentational differences between the marks, including the additional words “EYEBROWS BY DESIGN” in the application. Having regard to all the similarities and

differences, and bearing in mind my assessment of the overall impression of the respective marks, I consider there to be a reasonably high degree of visual similarity between the marks at issue.

43. Aurally, the words “Hi Brow” in the application will be pronounced entirely conventionally. I consider it unlikely that the words “EYEBROWS BY DESIGN” will be articulated, as the words are underneath the words “Hi Brow” and in a much smaller typeface. Insofar as the services offered by the applicant relate to eyebrows, the words have little or no distinctiveness as they allude strongly to the nature of the services. I also consider that the average consumer is most likely to articulate the opponent’s mark as “HI-BROW”. As a consequence, I am of the view that the marks are aurally identical. However, though I consider it less likely, I acknowledge that some average consumers may pronounce the earlier mark as “HIB-ROW” and that the marks would then share only a low degree of aural similarity.

44. Neither party has provided submissions on the concept likely to be associated with either mark, although the applicant asserts that:

“As “Hi” and “Brow” are shown as separate words, and because the phrase “EYEBROWS BY DESIGN” is included in The Application, the conceptual meaning of this mark is entirely different to that of The Earlier Registration” (paragraph 12).

45. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer.<sup>13</sup> Conceptually, both marks evoke a concept of exclusivity associated with the term “highbrow”, albeit with an unusual spelling in the earlier mark and as a play on words in the later mark. The applicant’s mark is also likely to be perceived as relating to eyebrows, a concept which is all the more likely to be elicited because of the presence of the words “EYEBROWS BY DESIGN”. However, the average consumer may also identify the word “BROW” in the earlier mark and thus

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<sup>13</sup> See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

perceive the mark as being in relation to eyebrows. As the average consumer might attribute the same meaning to either mark, it makes no difference that there is more than one possible conceptual meaning. While I acknowledge that some average consumers may perceive the earlier mark as an invented word, and thus attribute no particular meaning to it, I consider this the less likely scenario. Insofar as both marks create the same concept, they are conceptually identical; for those average consumers who attribute no meaning to the earlier mark, there is a conceptual difference, albeit a non-distinctive difference, as only one mark has a clear conceptual meaning.

### **Distinctive character of the earlier trade mark**

46. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. 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-2779, 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)".

47. I have no submissions from either party regarding the distinctiveness of the earlier trade mark and the opponent has filed no evidence in support of a claim of enhanced distinctiveness.

48. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the goods and services relied upon normally have the lowest. The earlier mark references the dictionary word "highbrow" but with an unusual spelling. For those average consumers who recognise the dictionary word, I consider that the earlier mark has an average degree of inherent distinctive character. For those average consumers who perceive the mark as an invented word, it is inherently highly distinctive.

### **Likelihood of confusion**

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

as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Confusion can be direct (the average consumer mistaking one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

50. The applicant relies on a lack of actual confusion (at paragraph 22 of its written submissions and at paragraph 20 of Ms Piper's witness statement) which, it says, should lead me to find that there is no likelihood of confusion.

51. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

"80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur".



52. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark".

53. There is no evidence before me relating to the use of the earlier mark and only limited evidence regarding the use of the mark applied for. The absence of actual confusion does not assist the applicant, there being no way for me to determine whether there has been a real opportunity for confusion to occur or whether any absence of actual confusion is due to differences extraneous to the marks themselves.

54. My primary finding was that the marks are visually similar to a reasonably high degree and aurally and conceptually identical. Moreover, the earlier mark enjoys an average degree of distinctive character and the services are identical: these are all factors which point towards a likelihood of confusion. Although the average consumer will pay a reasonably high degree of attention in selecting the services at issue (thus making the average consumer less prone to the effects of imperfect recollection), my view is that there is a likelihood of direct confusion. Whilst there are visual differences between the marks, they could be easily lost, particularly bearing in mind the effects of imperfect recollection.

55. In the course of my assessment of the similarity of the marks, I recognised that to some consumers the marks may only share a low degree of aural similarity and that they may perceive a conceptual difference, albeit non-distinctive. However, even had I proceeded on the basis of the position most favourable to the applicant, I consider that there would still be a likelihood of confusion: the low level of aural similarity and the conceptual difference are not sufficient to neutralise the reasonably high degree of

visual similarity, especially when considered alongside the identity between the services and the distinctiveness of the marks.<sup>14</sup>

## Conclusion

56. The opposition succeeds in relation to:

Class 41 Supply of training for eyebrows; practical training [demonstration]; arranging and conducting of training workshops; arranging of demonstrations for training purposes; arranging of exhibitions for training purposes; arranging of presentations for training purposes; conducting workshops [training]; education, teaching and training services; professional training services; providing courses of training; provision of training services for business; training courses; vocational training services; adult training.

The application will proceed to registration for:

Class 3 Cleansing products for eyebrows; cosmetic preparations for use on eyebrows; cosmetic products for eyebrows; non-medicated cosmetic preparations; creams, gels and lotions; eyebrow cosmetics; eyebrow pencils; eyebrows [false].

Class 35 Retail, wholesale and on-line retail services connected with the sale of cosmetics, beauty products, eyebrow products, hand implements for use in relation to eyebrows.

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<sup>14</sup> On the potential for conceptual differences to counteract visual and aural similarities, see *Nokia Oyj v OHIM*, Case T-460/07 at [98] and *The Picasso Estate v OHIM*, Case C-361/04 P at [20].

## Costs

57. Both sides have achieved a measure of success, with the split being roughly two thirds in the applicant's favour. It seems to me that the fairest way to award costs is to relate the award to the decision I have made. Accordingly, the award is two thirds what it would have been had the applicant been completely successful. The applicant filed evidence but this did not assist me in making my decision and I make no award in respect of it; its two sets of submissions were in large part duplicated. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using that TPN as a guide but bearing in mind my comments, above, I award costs to the applicant on the following basis:

|  |      |
|--|------|
| Considering the Notice of Opposition<br>and filing a counterstatement: | £120 |
| Written submissions:   | £180 |
| Total:   | £300 |

58. I order Hibrow Productions Ltd to pay The Eyelash Design Company Limited the sum of **£300**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11th day of August 2016**

**Heather Harrison  
For the Registrar  
The Comptroller-General**