

O-678-18

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3114196
IN THE NAME OF BAREFACE COSMETICS LTD
OF THE TRADE MARK

BareFace minerals

IN CLASS 3

AND

THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 501890
BY BAREFACED BEAUTY LTD

Background and pleadings

1. On 20 June 2015, Bareface Cosmetics Ltd (“the registered proprietor”) filed trade mark application number UK00003114196 for the mark ‘BareFace minerals’ for ‘*Cosmetics for personal use; Facial makeup*’ in Class 3.

2. The application was published in the Trade Marks Journal on 25 September 2015. No opposition was received and the mark became protected in the UK on 04 December 2015.

3. On 01 December 2017, Barefaced Beauty Ltd (“the applicant”) filed an application to have the protection of the registered proprietor’s mark declared invalid, relying upon sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. For section 5(3), the applicant is relying upon its earlier registered trade mark ‘BareFaced Beauty’ (application number UK00002570027), which has a filing date of 24 January 2011 and a registration date of 29 April 2011, and is registered for the following goods:

Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; face creams, eye creams, hand creams, body moisturisers; non-medicated toilet preparations; powders, creams and lotions, all for the face, hands and body; makeup; mineral makeup and mineral cosmetics; lip gloss, lip stick, lip liner, eye makeup, mascara, blusher, face powder, foundation, cover-up; makeup removing preparations; cleansers, toners, eye makeup removers, masks, scrubs; shower and bath preparations; aromatherapy products; dentifrices; deodorants and antiperspirants for personal use; air perfuming preparations.

Class 21: Brushes; makeup brushes, foundation brushes, powder brushes, eye brow brushes, eye shadow brushes, eye liner brushes, blusher brushes, face powder brushes, mascara wands and mascara brushes, cosmetics bags.

5. As the applicant’s earlier mark completed its registration process more than five years prior to the date of the application for invalidation, it is subject to the proof of use conditions, as per section 47 of the Act. The registered proprietor, in its counterstatement, did not request that the applicant provide proof of use of the mark upon which it relies. The consequence of this is that the applicant is entitled to rely upon all of the goods for which its earlier mark is registered.

6. The applicant, in its application, claims that, at the time the later trade mark was applied for, its earlier mark had a reputation for all the goods it is registered for. It further claims that use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of all the goods covered by its earlier mark.

7. The applicant ticked 'yes' to question 3 of the application in the section 5(3) part of the form, which reads as follows:

“Is it claimed that the similarity between the reputed earlier trade mark and the later mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade mark?”

8. The applicant also submitted the following:

“The infringing Sign is very similar to our Trade Mark and is being applied to goods that are identical with, or very similar to, the goods covered by our Trade Mark. As a result, there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the Trade Mark, contrary to section 10(2) of the Trade Marks Act 1994 (TMA).”

9. I will deal with these submissions in due course.

10. Questions 4, 5 and 6 of the application relate to claims of unfair advantage, detriment to the reputation of the earlier mark and detriment to the distinctive character of the earlier mark, respectively. These sections have not been completed by the applicant. As such, I cannot consider these grounds as they are not pleaded.

11. The applicant made a statement of use in its application, stating that its earlier mark has been used for all the goods for which it is registered.

12. The applicant provides further information in support of its claim under section 5(3) of the Act as follows:

“I have worked long and hard marketing my brand, I have spent a fortune in advertising over the years and feel that it is unfair for a brand selling basically the same type of product to have such a similar name.”

13. For section 5(4)(a), the applicant relies upon the earlier unregistered mark ‘BareFaced Beauty’, which it states has been used throughout the UK since 30 December 2005 for ‘*Cosmetics (in particular Mineral Cosmetics)*’.

14. Under section 5(4)(a), the applicant claims that use of the registered proprietor’s mark would amount to passing off for all of the goods for which it is registered. The applicant’s reasoning for this is as follows:

“By virtue of our substantial goodwill and reputation the above actions amount to a misrepresentation which is likely to lead the public to believe that the goods that they are offering are either being offered by us or by an entity with commercial links with us.

As a result of this misrepresentation, we will suffer damage to our goodwill and reputation, as well as suffering from loss of sales, diversion of trade, and dilution of our right to exclusivity in the Trade Mark. This is likely to have occurred already, and is probable in the future in the event that they continue to use the Infringing Sign.”

15. The registered proprietor denies the grounds set out by the applicant and, in its counterstatement, submitted the following:

“When applying for the BareFace minerals trademark, there was no intention of replicating or piggy-backing off an existing company brand/reputation, or even trying to mislead the public, we are very proud of our unique identity and like Barefaced Beauty, wouldn’t want it confused with another brand.

Our brand has a very unique logo, completely different to Barefaced beauty. We promote completely different packaging and colouring [...].”

16. Aside from the statement of grounds and counterstatement, neither party filed written submissions and only the applicant filed evidence. Neither party requested a hearing, nor did they file written submission in lieu of a hearing. Neither party is represented.

Preliminary issues

17. The applicant, in its application, has pleaded sections 5(3) and 5(4)(a) of the Act only. Under its section 5(3) and 5(4)(a) grounds, the applicant refers to section 10 of the Act. Firstly, section 10 of the Act concerns infringement and is dealt with by the courts. As such, the tribunal does not have jurisdiction to deal with matters relating thereto. Secondly, the application form TM26(I) sets out the grounds that may be pleaded. It is section 5 of the Act that deals with objections to applications to register trade marks and (by virtue of section 47(2) of the Act) objections to registered trade marks on the basis of earlier rights.

18. Furthermore, under the section 5(3) pleading (as I have quoted at paragraph 8, above), the applicant refers to section 10(2) of the Act, which corresponds to section 5(2). However, section 5(2) has not been pleaded.

19. The registered proprietor, in its counterstatement, has attached and makes comparisons between stylised forms of both parties' marks, both by themselves and as used on packaging. I am required to consider (as far as is necessary for the grounds pleaded), the marks in question exactly as they are registered. Consequently, the comparisons made by the registered proprietor do not assist me in making a decision.

Evidence summary

20. The applicant's evidence takes the form of a witness statement and two corresponding exhibits from Nadine Anderson, Company Director for the applicant.

Witness statement

21. Ms Anderson's witness statement is dated 29 April 2018, in which she gives the following evidence:

- The applicant did not receive a letter regarding the application for the trade mark BareFace minerals;
- If the applicant had received such a letter, it would have objected due to the very similar name and products being sold;
- The applicant was first made aware of the BareFace minerals trade mark on 30 September 2016, by way of an email from a customer.

22. The examination report produced in relation to the registered proprietor's trade mark application did list the applicant's trade mark registration as an earlier right that would be notified for opposition purposes. I cannot comment further on what happened subsequently.

Exhibits

23. Exhibit 1 contains the email as mentioned in Ms Anderson's witness statement. It shows a date of 30 September 2016. Within the email, the sender refers to 'BareFace minerals' and 'Barefaced Beauty' and the possible confusion between the two marks.

24. Exhibit 2 contains a comparison between stylised forms of its earlier mark and the later mark, in response to the registered proprietor's comparisons in its counterstatement. Ms Anderson disagrees that the marks are not similar and points out similarities between the two.

25. As I have mentioned previously, I am required to consider the marks in question exactly as they are registered. Consequently, the comparisons made by Ms Anderson do not assist me in making a decision.

26. This is the sum total of the evidence filed by the applicant.

Decision

Section 5(3)

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

“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 mark.”

28. Section 47 states:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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

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

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

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

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

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a

change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

30. The conditions of section 5(3) are cumulative. Firstly, the application must show that Barefaced Beauty has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of Barefaced Beauty being brought to mind by BareFace minerals. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage (unfair advantage,

detriment to distinctive character and detriment to reputation) will occur; alternatively, as set out in the form TM26(l) that the similarity between the reputed earlier trade mark and the later mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade mark. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

31. The first condition is reputation. In *General Motors*¹, the CJEU held that:

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

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

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

32. In accordance with *General Motors*, the applicant must file evidence of reputation of the earlier mark; for example, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made in promoting it. None of this has been provided by the applicant and no evidence of use of the mark has been provided at all, so I cannot make an assessment as to whether the earlier mark it relies upon has a reputation or not. The application under section 5(3) fails at the first hurdle.

Section 5(4)(a)

¹ Case C-375/97

33. Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

34. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and, iii) damage. In *Discount Outlet v Feel Good UK*², Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

² [2017] EWHC 1400 EPEC

35. The first condition is goodwill. It is impossible for me to assess whether there is goodwill and to what extent as no relevant evidence has been filed by the applicant. Consequently, the application under section 5(4)(a) fails at the first hurdle.

Outcome

36. The application for invalidation fails. The application for the mark BareFace minerals remains on the register.

Costs

37. As the registered proprietor has been successful, it would, ordinarily, be entitled to an award of costs in its favour. As it represents itself, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs. It was made clear that if the pro-forma was not completed “no costs, other than the official fees arising from the action and paid by the successful party...will be awarded”. Since it did not respond to that invitation, and as no official fee has been paid by the registered proprietor, I make no award of costs in its favour.

Dated this 26th day of October 2018

Emily Venables

For the Registrar,

The Comptroller-General