

O-191-20

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3387537
BY YNR INSTRUMENTS LTD
TO REGISTER

ROYAL LASHES

AS A TRADE MARK IN CLASS 3, 8 AND 44

AND

OPPOSITION THERETO
UNDER NO. 416495
BY BORA CREATIONS S.L.

Background and pleadings

1. On 28 March 2019, YNR Instruments Ltd (“the applicant”) applied to register the trade mark shown below under number 3387537:

ROYAL LASHES

2. The application was published for opposition purposes on 05 April 2019 for the following goods and services:

Class 3	Eyelashes; Eyelashes (Adhesives for affixing false -); Eyelashes (Cosmetic preparations for -); Eyelashes (False -); Adhesives for affixing artificial eyelashes; Adhesives for affixing false eyelashes; Adhesives for false eyelashes, hair and nails; Artificial eyelashes; Cosmetic preparations for eyelashes; False eyelashes.
Class 8	Tongs [hand tools]; Tool aprons; Tool bags [filled]; Tool belts; Tweezers; Manicure and pedicure tools; Manicure implements; Manicure sets; Manicure sets, electric; Embroidery scissors; Extensions for hand tools; Eyelash curlers; Eyelash separators; Scissor holders; Scissors.
Class 44	Beauty treatment services especially for eyelashes.

3. Bora Creations S.L. (“the opponent”) filed a notice of opposition on 4 June 2019. 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 the following European Union Trade Mark (“EUTM”):

Mark:

ROYALASH

EU registration no. 014951412

Filing date: 22 December 2015

Date of entry in register: 15 April 2016

Goods relied upon: Class 3 - *Decorative cosmetics; Mascara; Eyeliner; kohl; Eyebrow pencils.*

4. The opponent argues that there is a likelihood of confusion, including the likelihood of association, because the respective marks are highly similar, and the goods and services are identical, or at the very least highly similar. The applicant filed a counterstatement denying the grounds of opposition.

5. The opponent is represented by Squire Patton Boggs (UK) LLP and the applicant is a litigant in person. The applicant filed evidence which I will mention to the extent I consider appropriate. Both parties filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

DECISION

Section 5(2)(b)

6. Section 5(2)(b) of the Act 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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

7. An earlier trade mark is defined in s. 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”.

8. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than five years before the application date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

9. The following principles are gleaned from the judgments 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 C3/03, *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 the 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

10. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, 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”.

11. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

12. 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”.

13. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

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

14. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated 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 are 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., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/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 *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

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

Class 3 of the contested application

Eyelashes; Eyelashes (Cosmetic preparations for -); Eyelashes (False -); Artificial eyelashes; Cosmetic preparations for eyelashes; False eyelashes

16. The applicant’s terms cover products for the beautification of eyelashes and false/artificial lashes. The *Collins English Dictionary* defines “cosmetics” as “beauty preparations; make-up”.¹ I think that the word cosmetics would also extend to products such as false eyelashes used to modify or enhance one’s appearance.² Accordingly, I consider that “decorative cosmetics” in the opponent’s specification is wide enough to cover the above goods. The competing goods are identical based on the *Merici* principle.

¹ <https://www.collinsdictionary.com/dictionary/english/cosmetics> [accessed 16 March 2019].

² As per Collins English Dictionary “make-up consists of things such as lipstick, eye shadow, and powder which some women put on their faces to make themselves look more attractive or which actors use to change or improve their appearance”
[<https://www.collinsdictionary.com/dictionary/english/makeup>] [accessed 16 March 2019].

Adhesives for affixing artificial eyelashes; Adhesives for affixing false eyelashes; Adhesives for false eyelashes, hair and nails

17. While the nature, method of use and intended purpose of these goods may differ from those of decorative cosmetics in the opponent's specification, they may share the same users. In retail premises, they may be sold alongside cosmetic products. As the applicant's goods are paraphernalia used with false eyelashes/hair/nails, I find that the competing goods are complementary in a sense described by the case law. Considered overall, I think the applicant's goods are similar to the opponent's goods to a medium degree.

Class 8 of the contested application

Tongs [hand tools] and Eyelash curlers

18. "Tongs" are defined in the *Collins English Dictionary* as "a tool for grasping or lifting, consisting of a hinged, sprung, or pivoted pair of arms or levers, joined at one end".³ It is commonplace for hair curling implements to be called curling tongs, and I see no reason why implements for curling eyelashes would not be considered tongs. These goods are used to give eyelashes an enhanced appearance. The competing goods do not share nature, intended purpose or method of use with decorative cosmetics in the opponent's specification. The users may overlap. They may be sold through the same distribution channels. There could be a degree of competitiveness as a person may choose to purchase either cosmetics such as false eyelashes or use eyelash curlers/tongs to emphasise the lashes. The average consumer may consider it important to curl their lashes before applying decorative cosmetics such as mascara. In those circumstances, I find that the competing goods are complementary in a sense described by the case law. Considering these factors, I find that the competing goods share a medium degree of similarity.

Eyelash separators

³ <https://www.collinsdictionary.com/dictionary/english/tongs> [accessed 24 March 2020].

19. The applicant's goods are eyelash combs used to give lashes an enhanced appearance. Their nature and method of use are different from decorative cosmetics. The respective goods may compete. Given that the average consumer may consider it important to comb their lashes before and/or after applying decorative cosmetics such as mascara, I find that the goods are complementary in a sense described by the case law. Accordingly, I find that the respective goods share a medium degree of similarity.

Tweezers

20. The applicant's goods include tweezers used to pluck and shape eyebrows. Their nature and method of use are different from decorative cosmetics. The respective goods are aimed at the same users and are likely to be sold through the same distribution channels. There could also be a degree of competitiveness as a person may choose either to purchase goods to beautify their brows or to shape them with tweezers instead. They form part of a person's eyebrow paraphernalia. Considering these factors, I find that competing goods are similar to a medium degree.

Manicure and pedicure tools; Manicure implements; Manicure sets; Manicure sets, electric

21. These are tools used for manicure treatment intended for the care of nails. Their nature, purpose and method of use are different from decorative cosmetics. They may be aimed at the same consumers and are likely to pass through the same distribution channels. The goods may include buffing tools which compete with cosmetics such as nail polish. Given that the average consumer may apply nail polish after or as part of a manicure, I find that the respective goods are complementary in a sense described by the case law. Considering these factors, I conclude that the respective goods share a medium degree of similarity.

Scissors

22. The term scissors include eyebrow scissors or nail scissors used for cosmetic purposes. Therefore, despite the difference in nature and method of use with

decorative cosmetics, they may share the same users, may reach the market through the same trade channels and share a complementary relationship. Considered overall, I find that the goods at issue share a medium degree of similarity.

Tool aprons; Tool belts

23. The purpose of the applicant's goods is different from decorative cosmetics as they are used to store, organise or carry tools. Whilst the applicant's goods are worn or tied around the waist, the decorative cosmetics are applied to the body. Their nature and method of use differ. There is no competition. Even if tool aprons or tool belts were used to organise cosmetic tools such as brushes when applying make-up, they are not considered important for the use of cosmetics: the respective goods are not complementary. The users may overlap. However, the mere fact that the potential customers coincide does not, in itself, mean that there is an overall similarity between the goods and services. In the absence of any other factors that support a finding of similarity, I conclude that the respective goods are dissimilar.

Tool bags [filled]

24. I cannot see where the similarity can reside with decorative cosmetics in the opponent's specification. Given that make-up/cosmetic bags are covered under Classes 18 or 21, the applicant's goods, which are in Class 8, strike me as bags used to store or organise tools for industrial or household purposes. Their nature, method of use and intended purpose are different. The goods are not in competition, nor are they complementary. The competing goods are dissimilar.

Extensions for hand tools

25. To my knowledge, these are products such as extension bars fitted to hand tools in order to extend their length. Their nature, purpose and method of use are different from decorative cosmetics. They do not share users; neither are they in competition nor complementary. Applying these conclusions, I find that the respective goods are dissimilar.

Scissor holders

26. These goods are used to organise scissors; accordingly, the purpose of these goods differs from that of cosmetics. Their nature and method of use are also different from decorative cosmetics. They are neither in competition nor are complementary with decorative cosmetics. Considered overall, I find that the goods are dissimilar.

Embroidery scissors

27. To my mind, these scissors are used to cut sewing thread and therefore, I struggle to see any similarity with decorative cosmetics. The nature and method of use are clearly different. Neither are they in competition with each other, nor are they complementary. They may be aimed at the same users; however, that factor in itself will not lead to a finding that there is an overall similarity between the contested goods. Considering all these factors, I find that the competing goods are dissimilar.

Class 44 of the contested application

Beauty treatment services especially for eyelashes

28. There is an intrinsic difference between the nature of the applicant's services and the opponent's goods, as is the case with any goods and services. The applicant's services are aimed at enhancing eyelash appearance, and as far as I understand, it will include procedures such as eyelash extensions, eyelash lift or eyelash tint. To my knowledge, procedures such as eyelash extensions use false/artificial eyelashes which are covered under the opponent's specification. In that regard, I consider that the competing goods and services are complementary as the opponent's goods are important in order to provide the applicant's services. The goods and services at issue may compete as the average consumer may, for example, elect to purchase false eyelashes to use at home instead of obtaining the applicant's services. Considering these factors, I find the competing goods and services are similar to a medium degree.

Comparison of marks

29. 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 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 in 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.”

30. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

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

Opponent's trade mark	Applicant's trade mark
ROYALASH	ROYAL LASHES

32. The opponent's mark is comprised of the word "ROYALASH" presented in capital letters. The mark has no additional stylisation. Although presented as a single word, the mark appears to be created by the combination of the everyday words "ROYAL" and "LASH" which the average consumer is likely to perceive within the mark. The overall impression and the distinctiveness of the mark lie in the word "ROYALASH".

33. The applicant's mark is comprised of the words "ROYAL" and "LASHES", both presented in capital letters without any stylisation. The average consumer is likely to perceive the word "ROYAL" as qualifying the word "LASHES" such that the words combine together to form a phrase. Therefore, in my view, neither word dominates the overall impression of the mark.

34. Visually all the letters in the opponent's mark are contained in the applicant's mark. In terms of differences between the marks, the earlier mark is a single word with one "L", whilst the contested mark consists of the separate words "ROYAL" and "LASHES". The applicant's mark ends with the letters "E" and "S" which do not have a counterpart in the opponent's mark. Weighing up the similarities and differences, and my assessment of the overall impression of the marks, I find that the marks are visually similar to a high degree.

35. The applicant's mark will be pronounced entirely conventionally and contains four syllables. The average consumer may try to articulate the earlier mark as a single, three-syllable word. The marks will coincide in the first and third syllables. If a consumer does try to articulate the earlier mark as one word, there is potential for an aural difference because there will be only one "L" clearly pronounced, though the likely elision in ordinary speech of the two "L" sounds of the contested mark means I do not consider this to be a very striking aural difference. Even though the applicant's mark ends in "ES", this difference in sound is only in the last syllable and therefore has less impact on the average consumer. Considering these factors, I find that the marks are similar to a reasonably high degree. Given that the opponent's mark is a play on the words created by conjoining two words that are readily identifiable, I do not discount the possibility that some average consumer may instinctively read the mark as "ROYAL LASH". In this situation, I find that the marks are aurally similar to a high degree.

36. As regards the conceptual comparison, I consider that the two words in the applicant's mark hang together to form a unitary phrase. The word "lashes" appears to be the shortened word for eyelashes while the word "royal" can be construed in more than one way; the most relevant definitions are *"of, relating to, or befitting a king,*

queen, or other monarch; regal” or “*unusually good or impressive; first-rate*”.⁴ Bearing in mind the goods and services at issue, it is unlikely that the average consumer will construe the word “ROYAL” as indicative of Royal patronage. Accordingly, I agree with the opponent that the marks will be seen as referring to an elevated status of eyelashes or that of impressive lashes, though whichever meaning is attributed to the word “ROYAL” is likely to be the same in both marks. For a conceptual message to be relevant, it must be one capable of immediate grasp.⁵ Notwithstanding the possibility that the average consumer may attempt to articulate the opponent’s mark as one word, I think that they will see the words “ROYAL” and “LASH” in it and construe it accordingly. The word “lashes” in the applicant’s mark refers to the whole of someone’s eyelashes whilst “lash” in the opponent’s mark refers to an eyelash. With that in mind, I find that the marks are conceptually similar to a very high degree.

The average consumer and the nature of the purchasing act

37. 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.

38. 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”.

⁴ <https://www.collinsdictionary.com/dictionary/english/royal> [accessed on 3 March 2019].

⁵ See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.

39. I agree with the opponent that the average consumer of the competing goods and services is a member of the general public. The average consumer is likely to obtain the goods through self-selection from a shelf, catalogue or online equivalent. The service providers are most likely to be selected after perusal of the internet or visiting traditional outlets. Visual considerations are, therefore, likely to dominate the selection process for both goods and services. I do not discount that there may be an aural aspect to the selection process, such as word-of-mouth recommendation. When selecting the goods, the average consumer will pay some attention to factors such as compatibility of the cosmetic products with their skin or the quality of cosmetic tools. These factors suggest that the average consumer is likely to pay a medium degree of attention when selecting these products. When choosing the service provider, the average consumer will give attention to customer reviews, the qualifications and experience of the staff, costs etc. They may also book a consultation with the service provider before making the final decision. However, the services do not strike me as either especially costly or as infrequently purchased. These factors suggest that the average consumer will pay a medium degree of attention when making their selection.

Distinctiveness of the earlier mark

40. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*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).”

41. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods/services have the lowest. Distinctiveness can be enhanced through the use of the mark. The opponent filed evidence; however, none of that evidence is relevant to my assessment of enhanced distinctiveness. The prints of the webpages are undated, and the remaining exhibits contain details of trade mark registrations in various territories which, in any event, are irrelevant to the issues under consideration. Based on the evidence provided, I am not in a position to determine that the earlier mark had an enhanced distinctive character in relation to goods in Class 3.

42. Turning to the inherent position, I have already concluded that the trade mark is a play on the words created by conjoining the words “ROYAL” and “LASH”. In my view, those words are joined together in a slightly unusual manner; however, the average consumer would readily identify those words in the earlier mark and construe it accordingly. When considered as a whole, the mark is highly allusive of and possesses a low degree of inherent distinctive character in relation to products applied on eyelashes. It is less clearly allusive in relation to the remainder of the products and has a fairly low degree of distinctiveness.

Likelihood of confusion

43. In *Waterford Wedgwood plc v OHIM – C-398/07 P* (CJEU), it was held that some similarity of goods is essential to establish a likelihood of confusion.

44. Having concluded that there is no degree of similarity between the opponent's goods and *tool aprons; tool bags [filled]; tool belts; extensions for hand tools; scissor holders; embroidery scissors* in Class 8 in the application, there can be no likelihood of confusion. Accordingly, the opposition against these goods fails.

45. I must now consider the matter in relation to those goods and services in the application where I have found similarity with the opponent's decorative cosmetics in Class 3.

46. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa (*Canon* at [17]). As I mentioned above, it is also necessary for me to bear in mind the distinctive character of the opponent's trade marks, as the more distinctive those trade marks are, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods and 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, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

47. Confusion can be direct (which occurs when the average consumer mistakes 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 undertaking being the same or related).

48. The marks are visually similar to a high degree, aurally similar to a reasonably high or high degree depending on how the mark is articulated, and conceptually at least highly similar. The purchasing process will be dominated by visual considerations, and the consumer will pay a medium degree of attention to the selection of goods and services at issue. The goods and services vary from identical to having a medium degree of similarity.

49. Considering first the position where the earlier mark has a fairly low level of distinctive character, the high degree of visual, aural and conceptual similarity between the competing marks is sufficient to lead to a likelihood of direct confusion. The average consumer who pays a medium degree of attention to the selection process is likely to misremember the differences between the marks, particularly when the effects of imperfect recollection are borne in mind. Even where the marks are aurally similar only to a reasonably high degree or where the goods and services are similar to a medium degree, when factoring in the high level of similarity between the marks and the interdependency principle, I am satisfied that the consumer will mistake one mark for the other. I also find that where the earlier mark is distinctive to a low degree, the similarity between the marks, when considered alongside imperfect recollection and the at least medium degree of similarity between the goods and services, is likely to lead to direct confusion.

Conclusion

50. The application will be refused in relation to:

Class 3: Eyelashes; Eyelashes (Adhesives for affixing false -); Eyelashes (Cosmetic preparations for -); Eyelashes (False -); Adhesives for affixing artificial eyelashes; Adhesives for affixing false eyelashes; Adhesives for false eyelashes, hair and nails; Artificial eyelashes; Cosmetic preparations for eyelashes; False eyelashes.

Class 8: Tongs [hand tools]; Tweezers; Manicure and pedicure tools; Manicure implements; Manicure sets; Manicure sets, electric; Eyelash curlers; Eyelash separators; Scissors.

Class 44: Beauty treatment services especially for eyelashes.

51. The application will proceed to registration for the following goods:

Class 8: Tool aprons; Tool bags [filled]; Tool belts; Extensions for hand tools; Scissor holders; Embroidery scissors.

Costs

52. Both parties have achieved a measure of success. However, the opponent has been more successful than the applicant and is entitled to an award of costs. Award of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. In making my assessment, I bear in mind that the evidence filed by the opponent was not relevant to the issues under consideration and make no award in respect of it. I also consider it appropriate to reduce the costs to reflect the partial success of the opponent. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Filing written submissions:	£200
Total:	£500

53. I order **YNR Instruments Ltd** to pay **Bora Creations S.L.** the sum of £500. This sum is to be paid within twenty-one days 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 26th day of March 2020

Karol Thomas
For the Registrar
The Comptroller-General