

O/0445/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003709205
IN THE NAME OF AMALGAMATED EURO PRODUCTS UK LTD
FOR THE TRADE MARK**

LOLA

IN CLASS 3

AND

**THE OPPOSITION THERETO UNDER NO. 432118
BY LOLA'S COSMETICS LTD**

Background and pleadings

1. On 12 October 2021, Amalgamated Euro Products UK Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK.

2. The application was accepted and published in the Trade Marks Journal on 24 December 2021 in respect of goods in class 3. The contested goods will be set out later in this decision.

3. On 23 March 2022, Lola's Cosmetics LTD (“the opponent”) opposed the application under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. Under Sections 5(2)(b) and 5(3), the opponent relies on the trade mark set out below:

UK00003434183

Lola's Lashes

Filing date: 06 October 2019

Date of entry in register: 03 April 2020

5. The opponent relies upon the goods for which the mark is registered as set out later in this decision.

6. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the earlier trade mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act.

7. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the applicant’s mark is similar to its own mark, and the respective goods are identical or similar.

8. Under Section 5(3), the opponent claims a reputation in relation to the goods for which the mark is registered and states that use of the applicant’s mark would, without

due cause, take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

9. Under Section 5(4)(a), the opponent relies on the sign 'Lola's Lashes' and claims to have used it throughout the UK since July 2019 for *Artificial eyelashes; False eyelashes; Magnetic false eyelashes; Cosmetic preparations for eye lashes; Eyeliners; Magnetic eyeliners; Cosmetic preparations for eyelashes.*

10. The applicant filed a defence and counterstatement, in which:

- It admits that there is identity and similarity in respect of the respective goods;
- It admits that the element 'LOLA' is both distinctive and dominant when used in respect of the goods covered by the opponent's mark;
- It neither admits nor denies the opponent's claims that there is a likelihood of confusion, and that the application should be rejected under Section 5(2)(b) and puts the opponent to strict proof of those claims;
- It neither admits nor denies the opponent's claims that it has a reputation, and that the application should be rejected under Section 5(3) and puts the opponent to strict proof of those claims;
- It neither admits nor denies the opponent's claim that use of the mark 'LOLA' by the applicant is without due cause and puts the opponent to strict proof of that claim;
- It neither admits nor denies the opponent's claims that it has developed both reputation and goodwill in their 'LOLA'S LASHES' mark in the UK and that the application should be rejected under Section 5(4)(a) and puts the opponent to strict proof of those claims;
- It claims that the applicant is the proprietor of UK trade mark no. 3420333 for the mark 'LOLA MAKE UP BY PERSE', in respect of goods in Class 3 which has a filing date of 9 August 2019 (which is earlier than the filing date of the opponent's mark) and is an earlier right that invalidates the opponent's right to oppose the application;
- It claims that the applicant has made use of its 'LOLA' mark in the UK, since 2014 and is the owner of unregistered rights in the 'LOLA' mark.

11. Only the opponent filed evidence and submissions during the evidence rounds. I shall refer to the evidence and submissions to the extent that I consider necessary.

12. The opponent is represented by Dolleymores and the applicant by Douglas C Thomson Trade Marks and Brands Limited. Neither party asked to be heard nor did they file submissions in lieu.

EU Law

13. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

14. The opponent's evidence consists of a witness statement by Fraser Ian Angus, the joint managing director of the opponent's company. Mr Angus' witness statement is dated 27 September 2022 and is accompanied by 10 exhibits (FIA1 – FIA10).

DECISION

Section 5(2)(b)

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

“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”.

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

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

17. 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.

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods

18. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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 für 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. The goods to be compared are as follows:

The applicant's goods	The opponent's goods
<p>Class 3: <i>Artificial eyelashes; False eyelashes; Magnetic false eyelashes; Cosmetic preparations for eye lashes; Eyeliners; Magnetic eyeliners; Cosmetic preparations for eyelashes.</i></p>	<p>Class 3: <i>Non-medicated cosmetics and toiletry preparations; perfumery; essential oils; cosmetics; make-up; make-up kits; eye-make up; make-up foundations; body make-up; eyebrow cosmetics; false eyebrows; eyelashes; cosmetics for eyelashes; false eyelashes; adhesives for affixing artificial eyelashes; lipstick; lip creams; lip balm; lip make up; lip glosses; skin care lotions; skin care cosmetics; skin care preparations; cleansing milks for skin care; exfoliants for the care of the skin; facial toner; skin toner; toners for cosmetic use; face masks; body masks; cleansing masks for the face; nail care preparations; nail varnish; body lotion; scented body lotions; hair care preparations; hair care lotions; hair care masks; hair care serums; shampoos; shampoo conditioner; hair conditioner; shower and bath preparations; non-</i></p>

	<i>medicated toiletry preparations; non-medicated dentifrices; teeth whitening products.</i>
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20. Whilst the applicant has conceded that the goods are identical or similar, it did not specify which goods it considers to be identical and which goods it considers to be similar. I will therefore briefly say that the applicant's goods are all encompassed by the broad term *cosmetics* in the opponent's specification. These goods are clearly identical on the principle outlined in *Meric*.

Average consumer

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

22. The average consumer of the parties' goods is a member of the general public, however, I do not discount that it could also include a professional user such as a make-up artist or a beautician. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into

consideration such as the cost, quality, aesthetic and suitability of the product for their specific needs. Therefore, the level of attention paid during the purchasing process will be medium.

23. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, or online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.

Comparison of marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

25. It would be wrong, therefore, to artificially 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. The respective marks are shown below:

The applicant's mark	The opponent's marks
LOLA	Lola's Lashes

26. The applicant's mark consists of the word 'LOLA' presented in capital letters. There are no other elements to contribute to the overall impression, which lies in the word itself.

27. The opponent's mark consists of the words 'Lola's Lashes' presented in title case. The applicant conceded that the word 'Lola' is both distinctive and dominant when used in respect of the goods covered by the opponent's mark. This is a reasonable concession since the element "s Lashes" of the opponent's mark is descriptive of the registered goods (which are cosmetic lashes, eyelashes and eyeliners) and has a reduced impact in the overall impression of the mark.

28. Visually, as both marks are word marks, they may be used in upper- or lower-case letters. Consequently, no weight can be attached to the use of title case letters in the opponent's mark and upper-case letters in the applicant's mark. The first element of the opponent's mark appears as the only element of the applicant's mark. The element "s Lashes" of the opponent's mark which is absent from the applicant's mark act as a point of visual difference, however, its descriptive nature reduces its impact. I consider the marks to be visually similar to a high degree. The same goes for the aural aspect of the marks.

29. Conceptually, the word 'LOLA' will be perceived in both marks as a female name. Whilst I note the presence of the element "s' Lashes" in the opponent's mark, which differs from the applicant's mark, it is insufficient to differentiate the marks conceptually. In particular, the possessive form "s" and word "Lashes" in the opponent's will be understood as a reference to the goods in relation to which the mark is used and do not introduce any distinctive concept. The marks are conceptually identical or, alternatively, similar to a very high degree.

Distinctive character of earlier mark

30. 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).”

31. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

32. The earlier mark consists of the words ‘Lola's Lashes’. The word ‘Lola’ being perceived as a female name is not descriptive or laudatory in relation to the goods for

which the mark has been registered, but nor is it an invented word. Rather it derives from a personal name that is not especially out of the ordinary or unfamiliar. The apostrophe which is deployed before the final letter “s” will be construed as signifying the possessive use of the name, i.e. lashes that belong to Lola. I find that the earlier mark has a medium degree of inherent distinctiveness.

33. The opponent’s evidence is that the earlier mark has been used by the opponent since 17 June 2019, the date on which the opponent was incorporated. Since the date of incorporation, the opponent’s turnover in goods has been as follows (rounded): £2.4 million (2019/2020); £5.5million (2020/2021) and £4.5million (2021/2022) for a total of £12.4million. The opponent’s goods are available for purchase in physical retail stores and from online stockists, with most sales being made online. The opponent’s products are currently stocked in prestigious outlets such as Harrods and House of Fraser and can be purchased online from the opponent’s website (www.lolalashes.co.uk) and from third-party websites.

34. The opponent acts primarily as an online business and has a strong social media presence with more than 100,000 followers on Instagram, 20,000 followers on Tik Tok and more than 50,000 followers on Facebook. Since 2019, the Opponent’s approximate expenditure on advertising and promotion on Facebook, Instagram, Google and TikTok has been as follows:

Year	Meta	Google	TikTok	Total
2019	£114,710	£25,300	n/a	£140,010
2020	£993,880	£195,000	£7,680	£1,196,560
2021	£1,116,860	£235,000	£14,620	£1,366,480
Total	£2,225,450	£455,300	£22,300	

35. Marketing expenditures for retaining the services of influencers and celebrities and "paid for" press articles have been as follows: £4,000 in 2019, £99,100 in 2020 and £84,600 in 2021.

36. The opponent has also been mentioned in various magazines including Grazia (in February 2021), Stylist magazine, Woman and Home magazine, and Platinum magazine. All these magazines are published, or widely circulated, in the UK.

37. In 2021, the opponent's directors were named Fashion & Beauty Entrepreneur of the Year for Scotland and Northern Ireland for their work at the opponent. In the same year the opponent was awarded the Silver Award for Best New Eye Product, for its Magnetic Eyelash & Eyeliner Kit at the Pure Beauty Awards, an annual competition recognising achievement in the beauty industry.

38. Although the turnover and marketing figures which have been produced are significant, there is little evidence of marketing activity and press coverage, the use is far from being long-standing - the opponent's products having been available on the market for just over two years before the relevant date – and there is no indication of market share. Overall, I am not satisfied that the evidence filed supports the conclusion that the distinctiveness of the mark has been enhanced through use.

Likelihood of confusion

39. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

40. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

41. Earlier in this decision I found that:

- the competing goods in class 3 are identical;

- the relevant consumers of the goods at issue include members of the general public and professional users, such as beauticians;
- the purchasing process will be predominantly visual although I do not discount aural considerations. The goods will be selected with an average degree of attention;
- the earlier marks and the contested marks are visually and aurally similar to a high degree. Conceptually, they are either identical or similar to a very high degree;
- the earlier mark is inherently distinctive to a medium degree and although there has been some use of the mark, it has not materially increased its distinctiveness.

42. Taking all of the above factors into account, I consider that the differences between the marks are insufficient to avoid confusion, when the principle of imperfect recollection is considered. This is especially so, given the descriptive nature of the element “s Lashes”, which is the only differentiating element between the marks. I consider it likely that the marks will be misremembered or mistakenly recalled as each other. Alternatively, if the differences between the marks are noted, I consider that the presence in both marks of the identical word “Lola” will create an expectation on the part of the average consumer that the goods originate from the same or economically linked undertakings. There is a likelihood of confusion.

43. The opposition under section 5(2)(b) succeeds.

Section 5(3)

44. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair

advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

45. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

46. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas 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* and *Environmental Manufacturing, paragraph 34*.

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

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

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

47. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 12 October 2021.

Reputation

48. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

49. Bearing in mind my earlier assessment of the evidence before me, I am not satisfied that the opponent had a qualifying reputation at the relevant date for the goods claimed. Given that the conditions for establishing a claim under Section 5(3) are cumulative, without being able to establish a reputation the opposition under Section 5(3) fails at the first hurdle.

Section 5(4)(a)

50. Section 5(4)(a) states:

“(4) 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, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

(c)

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.”

51. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

52. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“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)."

Goodwill

53. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

54. The relevant date for the assessment under Section 5(4)(a) is normally the filing date of the application at issue, being 12 October 2021. Although the applicant argued that they have prior use of their alleged unregistered sign (which could have affected the relevant date calculation)¹ – they filed no evidence, so I say no more about it.

55. The opponent relies upon the use of the sign 'Lola's Lashes' under this ground, which is identical to that which I have already considered under Section 5(2)(b). I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires "a substantial number of members of the public are deceived" rather than considering whether the "average consumer is confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here. I accept that the opponent had the requisite goodwill in the UK at the relevant date in relation

¹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

to a business selling artificial eyelashes and that 'Lola's Lashes' was distinctive of that goodwill. Given my finding that there is a likelihood of confusion between the opponent's mark 'Lola's Lashes' and the contested mark 'LOLA', I also find that a substantial number of the opponent's customers will be misled into purchasing the applicant's goods in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion under Section 5(2)(b). The opposition under Section 5(4)(a) succeeds.

Final remarks

56. I have not overlooked the fact that the applicant has claimed that it is the owner of earlier rights. These issues have no bearing upon the instant proceedings because as far as I am aware, at no time did the applicant have sought to invalidate the opponent's earlier mark, thus, the existence of prior rights (registered and unregistered) is irrelevant to the issue I have decided.²

OUTCOME

57. The opposition is successful, and the applied-for mark is refused registration.

COSTS

58. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the opponent the sum of £1,300 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's statement:	£200
Filing evidence:	£700

² See Tribunal Practice Notice 4/2009

Preparing submissions	£200
Official fees:	£200
Total	£1,300

59. I therefore order Amalgamated Euro Products UK Ltd to pay Lola's Cosmetics LTD the sum of £1,300. 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 the proceedings if any appeal against this decision is unsuccessful.

Dated this 12th day of May 2023

Teresa Perks
For the Registrar