

**O-0017-23**

**CONSOLIDATED PROCEEDINGS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NOS. 3558493, 3562279 & 3620622**

**BY PAT MCGRATH COSMETICS LLC**

**TO REGISTER**

**DIVINE SKIN**

**DIVINE BLUSH**

**DIVINE ROSE**

**AS TRADE MARKS**

**IN CLASSES 3 & 18**

**AND OPPOSITION THERETO (UNDER NOS. 424217, 424218 & 427206)**

**BY**

**THE BOOTS COMPANY PLC**

## BACKGROUND & PLEADINGS

1. Pat McGrath Cosmetics LLC (“the applicant”) applied to register the following trade marks:

UK TM No.3558493	UK TM No.3562279	UK TM No.3620622
<b>DIVINE SKIN</b>	<b>Divine Blush</b>	<b>DIVINE ROSE</b>
<i>Class 3: cosmetics; makeup.</i>	<i>Class 3: cosmetics; makeup.</i>	<i>Class 3: cosmetics; makeup.</i>
		<i>Class 18: Bags; Makeup bags; Carrying bags; Tote bags; All-purpose carrying bags.</i>
Filing date: 20 November 2020 Publication date: 29 January 2021	Filing date: 30 November 2020 Publication date: 29 January 2021	Filing date: 2 April 2021 Priority date: 5 October 2020 Publication date: 25 June 2021

2. The Boots Company PLC (“the opponent”) opposes the three applications in full under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Mark Act 1994 (“the Act”). For sections 5(2)(b) and 5(3), the opponent relies on some goods in class 3 in its UK registration no. 3086839, the details of which are set out below. Under section 5(4)(a) the opponent relies on the sign **i DIVINE** for which it claims use in the UK since 2014 for *cosmetics; cosmetics preparations; eyeshadows; eyeshadow palettes; eyeshadow preparations; blushers; cosmetic bronzers.*

UK TM No. 3086839	Goods relied on
<b>i Divine</b>  Filing date: 19 December 2014 Registration date: 27 March 2015	<i>Class 3: Cosmetics; Cosmetics preparations; Eyeshadows; Eyeshadow palettes; Eyeshadow preparations; blushers; cosmetic bronzers.</i>

3. The opponent's trade mark has a registration date that is earlier than the filing date of the application and, therefore, it is an earlier mark, in accordance with Section 6 of the Act. As the registration procedure was completed more than 5 years prior to the earliest filing date of the contested applications, it is subject to proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

4. The applicant filed counterstatements denying all of the opposition grounds and putting the opponent to proof of use of its earlier mark.

5. The proceedings were consolidated by the Tribunal and confirmed in an official letter dated 15 December 2021.

6. Both parties have been represented throughout proceedings. The applicant has been represented by Basck Limited, whilst the opponent has been represented by Barker Brettell LLP. Both parties filed evidence and submissions in lieu of a hearing.

7. Section 6(3)(a) of the European (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.

8. I make this decision following a consideration of all the material before me.

## **Opponent's evidence**

9. The opponent filed three witness statements and associated exhibits. The first witness statement dated 16 September 2021 is filed in the name of Stephen Lowry, a Chartered Trade Mark Attorney employed by Barker Brettell LLP who are the opponent's legal representatives. Mr Lowry appends 7 exhibits.


10. The second witness statement also dated 16 September 2021 is made in the name of Gabriele Enders who is responsible for global brand and products strategy. Ms Enders is employed by Walgreens Boots Alliance Services Limited, which is stated to be a sister company to the opponent and that both entities belong to the Walgreens Boots Alliance Inc as the parent company. Ms Enders states she is responsible for Sleek Makeup, which is a brand owned by the opponent and for which the registered earlier mark is a sub brand. Ms Enders appends 3 exhibits.

11. The third witness statement dated 25 March 2022 was again filed in the name of Stephen Lowry with two appended exhibits.

12. Starting with Mr Lowry's evidence from his two witness statements and exhibits, he also confirms the relationship between Sleek Makeup and the earlier mark. Mr Lowry states that the earlier mark is used for an eyeshadow palette range and appends a range of images from the Amazon retail site showing products for sale in pounds sterling<sup>1</sup>. Although the images are dated 16 September 2021 a number of customer reviews dated between 2013-2021 are apparent on the screenshots. The products featured do not appear to have the earlier mark on the palette box itself but it is featured in the advertising rubric as per this illustrative example,

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<sup>1</sup> Exhibit SL03



**Genuine Sleek i-Divine Eyeshadow Palettes - (Original)**  
Visit the Sleek MakeUp Store  
17 ratings


Price: ~~£7.54~~ (£7.54 / count)  
New (2) from ~~£7.54~~ & FREE Delivery

Brand: Sleek MakeUp  
Ingredients: Mica, Talc, Kaolin, Magnesium Stearate, Dimethylsiloxane, Paraffinum  
[See more](#)

Finish type: Matte  
Item weight: 0.24 Pounds  
Colour: Multicolour

**About this item**

- These Are Genuine Sleek Products
- Sleek's New Packaging Looks Great
- Perfect For Every Skin Tone
- Very High Quality Eyeshadow
- Makes For A Wonderful Present



**Sleek MakeUP i-Divine Eyeshadow Palette A New Day 9g**  
Visit the Sleek MakeUp Store  
2,307 ratings  
13 answered questions

RRP: ~~£8.99~~  
Price: **£8.03** (£8.03 / count)  
You Save: **£0.96** (11%)

**Note:** This item is eligible for **FREE Click and Collect** without a minimum order subject to availability. [Details](#)

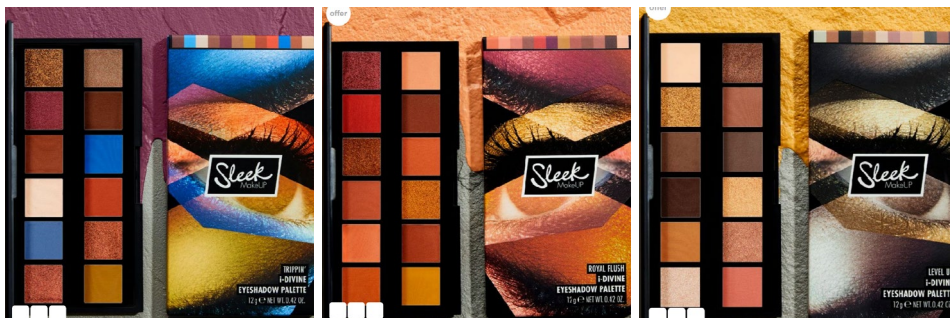
New (14) from ~~£7.54~~ & FREE Delivery

Style Name: **A New Day**

**£8.03**  
(£8.03 / count)

13. Mr Lowry further appends a press release dated April 2021 relaunching the earlier mark **i Divine** in a media campaign entitled “I am Divine”<sup>2</sup> which includes a still from a YouTube video<sup>3</sup> dated 3 November 2020 and an article posted on 9 November 2020 from [www.diarydirectory.com](http://www.diarydirectory.com)<sup>4</sup> as part of this media campaign. The relaunch featured contributions from prominent Black British changemakers on using makeup as a form of self-expression and identity.

14. Mr Lowry appends a series of screenshots from the boots.com website<sup>5</sup> demonstrating several eyeshadow palettes appearing to bear the earlier mark on the products themselves, viz



15. These are offered at pounds sterling prices but also as free gifts with other purchases. There are a number of customer reviews dated from 10 months before the screen shot was taken on 16 September 2021 and nearly all the reviews identify that the customer received the product as a free sample.

<sup>2</sup> Exhibit SL04  
<sup>3</sup> Exhibit SL05  
<sup>4</sup> Exhibit SL06  
<sup>5</sup> Exhibit SL07

16. From his second witness statement, Mr Lowry refers to an online article on [harpersbazaar.com](http://harpersbazaar.com) dated 3 November 2020<sup>6</sup> concerning Yomi Adegoke, one of the Black British changemakers who fronted the relaunch campaign “I am Divine”, referred to at exhibit SL04 in his previous witness statement. The article refers primarily to the Sleek makeup range and one mention is made of **i Divine** in conjunction with the relaunch. The mark **i-Divine** also appears in what I presume to be pop-up ads breaking up the article’s text. Mr Lowry also includes two images related to the article, the first is the Facebook page for Harper’s Bazaar which indicates 854k followers and the second is from its Instagram page with 1.5m followers. The other exhibit<sup>7</sup> relating to this second witness statement is from the Guardian Newspaper Weekend magazine dated 16 March 2019 entitled “30 best bargain makeup, nail and hair products under £15” and features an image of the Sleek Makeup i-Divine Palette. The image is similar to those featured above namely

**Sleek MakeUp i-Divine Palettes, £8.99, CF**



Mr Lowry also includes images of the Guardian’s FaceBook and Instagram pages showing 8.6m and 5.1m followers respectively for those platforms.

17. With regard to the evidence provided by Ms Enders, she also states that the earlier mark **i Divine** is used on eyeshadow palettes and goods bearing the mark are available in the UK in opponent’s retail stores, from websites owned and operated by the opponent and other third-party retailers. By means of the Wayback Machine internet archive service, Ms Enders appends various screenshots from the

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<sup>6</sup> Exhibit SL01

<sup>7</sup> Exhibit SL02

sleekmakeup.com website dated between June 2018 to January 2021<sup>8</sup> which demonstrates use of **i Divine** on eyeshadow palettes and a sale price in pounds sterling.

18. Ms Enders also references a turnover of more than £1m from 2018 to the date of the declaration for **i-Divine** branded goods of which more than £280k was from third-party retailers. Ms Enders also references a combined marketing expenditure of £475k between September 2019 and August 2021 and a PR spend of £170k between September 2017 and August 2020.

### **Applicant's evidence**

19. The applicant filed a witness statement dated 25 May 2022 in the name of Christian Bunke, the director of Basck Limited who are the applicant's legal representatives. Mr Bunke appends 5 exhibits which include

- the applicant's Chinese trade mark registration<sup>9</sup>
- a rebuttal that website prices shown in pound sterling do not constitute proof of sales in the UK but are merely shown as a payment option<sup>10</sup>
- a screenshot from Statista showing the value of the UK cosmetics market between 2009 and 2020 and market value of cosmetic products by type including palettes in 2020<sup>11</sup>
- an examination letter and registration certificate from the UK IPO for the mark DIVINE BRONZE which does not form part of these proceedings.<sup>12</sup>

20. That concludes my summary of the evidence.

### **Proof of use provisions**

21. The relevant statutory provisions for proof of use are as follows:

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<sup>8</sup> Exhibit GE03

<sup>9</sup> Exhibit CB01

<sup>10</sup> Exhibit CB02

<sup>11</sup> Exhibit CB03

<sup>12</sup> Exhibits CB04 & 05

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and



(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

22. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

23. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use

in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

## Relevant period

24. My first task is to establish whether, or to what extent, the opponent has shown genuine use of the earlier UK mark within the 'relevant period'. The relevant period is defined as being a period of five years ending with the filing date of the contested application. In this case there are three different filing dates so the earliest relevant period is 5 October 2015 to 4 October 2020, then the next is 20 November 2015 to 19 November 2020 and finally the third is 30 November 2015 to 29 November 2020.

## Variant use

25. The opponent's evidence indicates that the earlier mark, **i Divine**, is a sub brand of Sleek and there are a number of examples of where the marks are used together, for instance in the Amazon listings and on the Boots.com website. In *Colloseum Holdings AG v Levi Strauss & Co.*<sup>13</sup>, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue

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<sup>13</sup> Case C-12/12

to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

26. I find there is sufficient evidence to show that whilst **i Divine** is used in conjunction with Sleek, it is acting as a brand identifier for a specific product range.

### **Use in a differing form**

27. The earlier mark, as registered, is **i Divine**. There are instances within the evidence where the mark used is variously **I-Divine**, **I Divine** and **i-DIVINE**. The issue of use in a differing form was considered in *Lactalis McLelland Limited v Arla Foods AMBA*<sup>14</sup>, where Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

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<sup>14</sup> BL O/265/22

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

28. In my view the mixed use of capitals and lower case letters is acceptable as use in a differing form, as it does not alter the distinctive character of the mark. Neither do I find that the addition of a hyphen alters the mark's distinctive character. Most average consumers will overlook punctuation marks and do not give them significance but will instead focus on what the text elements are. Overall then I find use of all the differing forms of the earlier mark are acceptable.

### **Sufficiency of use**

29. Ms Enders' evidence indicates that the **i Divine** branded goods have generated a reasonable turnover from 2018 and there has been considerable advertising expenditure spent on the promotion and marketing of the goods bearing the trade mark (for the purposes of this assessment I have taken the marketing spend and PR spend together under the umbrella of advertising expenditure). However I accept that some of this turnover and advertising expenditure occurred outside of the relevant periods. There is also evidence that the goods have been on sale from the opponent's own website and other third-party websites during the relevant period according to the product review dates. The evidence regarding the relaunch of the product in 2020, suggests that the product was at that point 13 years old but was being relaunched with more emphasis on appealing to Black communities. Taking all this into account I find that the evidence supports the opponent's position that there has been sufficient genuine use of the earlier mark on the goods during the relevant period.

### **Framing a fair specification**

30. The next stage is to decide whether the opponent's use entitles it to rely on all of the goods for which it is make a statement of use. In framing a fair specification, I rely on guidance given in the following judgments. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*<sup>15</sup>, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there

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<sup>15</sup> BL O/345/10

has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

31. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*<sup>16</sup>, Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of

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<sup>16</sup> [2016] EWHC 3103 (Ch)



the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

32. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*<sup>17</sup>, a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

33. The evidence demonstrates that the opponent has used its mark on a range of eyeshadow palettes. As such I find that a fair specification which reflects use made of the mark demonstrated by the evidence provided would be *Eyeshadows; Eyeshadow palettes; Eyeshadow preparations*.

### **Section 5(2)(b)**

34. Section 5(2)(b) of the Act is 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

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<sup>17</sup> [2017] EWCA Civ 1834 (Court of Appeal)

protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

35. 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.”

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

#### *The principles*

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

### **Comparison of the goods**

37. In *Canon*<sup>18</sup>, the CJEU stated at paragraph 23 that:

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<sup>18</sup> Case C-39/97

“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”.

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>19</sup>, for assessing similarity were:

- (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.

39. I also find that the following case law is useful in these proceedings where in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”)*<sup>20</sup>, the General Court (“GC”) stated that:

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<sup>19</sup> [1996] R.P.C. 281

<sup>20</sup> Case T- 133/05

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”.

40. With regards to the issue of complementarity I also find that the following case law to be relevant where in *Kurt Hesse v OHIM*,<sup>21</sup> 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 OHIM*<sup>22</sup>, the General Court 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”.

41. In *Sanco SA v OHIM*<sup>23</sup>, 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. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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<sup>21</sup> Case C-50/15 P

<sup>22</sup> Case T-325/06

<sup>23</sup> Case T-249/11

“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.

42. The goods to be compared are set out below. The three applications have identical goods in class 3 so that specification is only reproduced once below for convenience and with class 18 from the applicant’s mark ending ‘622.

Opponent’s goods	Applicant’s goods
<i>Cl 3: Eyeshadows; Eyeshadow palettes; Eyeshadow preparations.</i>	<i>Class 3: cosmetics; makeup.</i>
	<i>Class 18: Bags; Makeup bags; Carrying bags; Tote bags; All-purpose carrying bags</i>

Class 3

43. I find the applicant’s goods namely *cosmetics; makeup* are sufficiently broad to cover the opponent’s goods and they are therefore considered identical on the *Meric* principle.

## Class 18

44. The opponent does not have a directly comparable class 18. In its written submissions of 14 October 2022<sup>24</sup>, it contends that

In addition, insofar as the 217 mark only, the Opponent submits that the Contested Class 18 Goods are complementary to the Earlier Goods. By way of example, the Opponent's "cosmetics" could be sold with "makeup bags" or the average consumer could think on seeing a branded "Divine Rose" make-up bag that the same is connected to the Earlier Trade Mark, as it is a natural extension and reasonable expectation for one to extend its commercial activities into makeup bags when it already provides the make-up. Therefore, the Contested Class 18 Goods can only be concluded as being similar to the Earlier Goods.

45. I agree that *make up bags* are specifically designed to hold make up and cosmetic products and can often be sold alongside such products. I further agree that a consumer would make a reasonable connection between the two products and assume that a single undertaking was responsible for both. As such I find the goods are complementary and therefore similar to a low degree. However I do not find this complementarity extends to the other goods in the applicant's class 18 specification, namely *Bags; Carrying bags; Tote bags; All-purpose carrying bags* as their nature and purpose will be different so I consider them to be dissimilar.

### **Average Consumer**

46. I next consider who the average consumer is for the contested goods and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect<sup>25</sup>. 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<sup>26</sup>.

47. The average consumer for the contested goods is the general public. The contested goods are a reasonably frequent and a relatively inexpensive purchase. I find the purchasing public will pay at least a medium degree of attention when purchasing as class 3 goods will be applied to the skin, so care will be taken in consideration of constituent ingredients, allergens and method of production (e.g.

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<sup>24</sup> Paragraph 74

<sup>25</sup> *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)

<sup>26</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97.

cruelty free products) as well as the aesthetic considerations of colour and style for both the class 3 and 18 goods. Purchasing will be primarily visual as consumers will examine the goods in either a bricks and mortar retail environment or an online equivalent website. I do not discount any aural considerations such as word of mouth recommendations.

### **Mark comparisons**

48. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>27</sup>, 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.”

49. 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.

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<sup>27</sup> Case C-591/12P



50. The respective trade marks to be compared are:

Opponent's mark	Applicant's marks
<b>i Divine</b>	<b>DIVINE SKIN</b> <b>Divine Blush</b> <b>DIVINE ROSE</b>

51. The opponent's mark is a word only and consists of a single letter **i** in lower-case followed by the word **Divine** in title case. The word **Divine** has laudatory connotations and in my view is low in distinctiveness. The mark has no other aspect to it and the overall impression is derived from this presentation.

52. The applicant's marks are also word only and all share the same format namely the first word being **DIVINE** followed by a different second word. In the mark ending '493 the second word is **SKIN**, in mark ending '279 it is **Blush** and in mark ending '622 it is **ROSE**. I find the marks **DIVINE SKIN**, **Divine Blush** and **DIVINE ROSE** to be low in distinctiveness because of their laudatory qualities in relation to cosmetic and makeup goods. As such neither element dominates and the overall impression is derived from the whole.

53. In a visual comparison the respective marks share the common word **DIVINE**. The point of difference is that the opponent has an element placed before **DIVINE** and the applicant has elements which follow it. The opponent's preceding element is a single letter and the applicant's succeeding element are full words. This makes a visual impact so overall I find there is a medium level of visual similarity.

54. In an aural comparison, I find the common element in the respective marks will be pronounced identically in each case. The preceding element in the opponent's mark will most likely be pronounced as EYE-DIVINE and the applicant's succeeding

elements pronounced in full. Taking this into account I find there is a medium level of aural similarity.

55. In a conceptual comparison, consumers will likely bring the usual dictionary definitions of the word **DIVINE**, namely being god-like or beautiful, to mind. Given that the opponent's goods are eyeshadow products, some consumers may see **i Divine** as play on words for "eye divine" whereas others will simply see the **i** as being the first-person singular pronoun and therefore connect it to a personal divine quality although the mark is not quite grammatically correct. The way the applicant's marks are constructed, it is more straightforward to see **DIVINE** acting in an adjectival capacity and describing the quality of **SKIN, BLUSH** and **ROSE** respectively. As previously set out, I find the applicant's marks to be low in distinctiveness and the concept brought to mind will be something considered divine or beautiful in relation to the word which follows it. I find that the construction of the marks makes some conceptual differences, however the word **DIVINE** has a shared concept so I conclude that the marks are conceptually similar overall to a low degree.

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

56. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*<sup>28</sup> 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).

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<sup>28</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

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).”

57. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

58. The mark **i Divine** consists of a single letter and an ordinary dictionary word and is not descriptive of the goods for which it is registered, although **Divine** has laudatory connotations so is low in distinctiveness. Therefore I find that the earlier mark is inherently distinctive to somewhere between a low and medium degree.

59. As evidence has been provided for the earlier mark, I must consider whether use made of this mark has enhanced its distinctiveness and I remind myself of the *Windsurfing Chiemsee* factors set out above as to what I should consider.

60. As I set out in paragraph 29 above, the evidence demonstrated that there has been use of the mark during the relevant period which included the relaunch campaign material on YouTube and the Guardian and Harper’s Bazaar articles. However I take into account that some of the turnover and advertising expenditure is outside of the relevant period. Moreover whilst I accept that Harper’s Bazaar and The Guardian have large social media presences and possibly millions of readers, it does not follow that the articles featuring the earlier mark were ever seen or read by those numbers. No evidence has been provided showing how many followers actually read the articles. Furthermore no information was provided by the opponent

regarding market share in what by any reckoning must be a high value retail sector. Indeed the applicant provided evidence to indicate that the value of the UK cosmetics market in 2020 was £351m for eye products and £11m for palette products.<sup>29</sup> Finally whilst the evidence showed the goods are for sale in the UK, there was no indication of the geographical customer base in the UK. All of these issues fall short of the factors set out for consideration in the *Windsurfing Chiemsee* guidance. Taking this into account I find that the earlier mark's distinctive character has not been enhanced through use to any higher degree.

### **Likelihood of confusion**

61. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>30</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

63. In *L.A. Sugar Limited*<sup>31</sup>, Mr Iain Purvis Q.C. sitting 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

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<sup>29</sup> Exhibit CB03

<sup>30</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>31</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

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.””

64. Whereas in *Liverpool Gin Distillery*<sup>32</sup>, Arnold LJ referred to the comments of James Mellor QC sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Moreover, it is not sufficient that a mark merely calls to mind another mark as set out in *Duebros*<sup>33</sup>. This is mere association not indirect confusion.

65. So far in this decision I have found that,

- some goods are identical and similar although some goods were dissimilar
- the average consumer will pay a medium level of attention during a primarily visual purchasing process
- the respective marks are visually and aurally similar to a medium degree but are conceptually similar to a low degree
- the earlier mark is inherently distinctive to between a low and medium degree

66. The respective marks clearly share the same word, namely **DIVINE**. Although the construction of the marks means it is the second element of the opponent’s mark and the first element of the applicant’s mark, I find it is still the element most likely to be recalled taking into account the case law relating to the notion of imperfect

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<sup>32</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

<sup>33</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

recollection, and the interdependency principle. The preceding single letter **i** in the opponent's marks could be overlooked and the three succeeding words in the applicant's mark are in and of themselves descriptive of the goods so **DIVINE** becomes the fulcrum on which the marks turn. Therefore I find there is a likelihood of direct confusion.

67. The opposition brought under section 5(2)(b) has succeeded in full against the contested class 3 and in part against class 18.

68. Having considered the opposition under section 5(2)(b), I now go on to consider the other grounds.

### **Section 5(3)**

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

“(3) A trade mark which-

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”.

70. 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.”

71. The relevant case law in relation to section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 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 on 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*).

72. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark is similar to the applicant's mark. Secondly, that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. 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.

73. Having found that the marks are similar, I will now consider reputation. As outlined above, for an opposition under section 5(3) to get off the ground it is first necessary



for the opponent to show that it has the necessary reputation. I must be satisfied that **i Divine** is known by a significant part of the relevant public, in this case consumers of goods in class 3. The high point of the evidence provided is that the goods were available for purchase from the opponent's own and third party websites and that there were several UK customer reviews during the relevant period. However whilst this demonstrates use, it does not demonstrate reputation. There is no indication of the level of custom for the applicant's goods or the volume of goods sold. In its written submissions dated 14 October 2022<sup>34</sup> the opponent sought to amplify the points made in Stephen Lowry's second witness statement which included the exhibits<sup>35</sup> from Harper's Bazaar and The Guardian, viz

In addition, the Opponent submits that based on the evidence furnished in these Consolidated Proceedings, one only has to look at the sheer length of time the Earlier Trade Mark has been used in the UK in relation to the Earlier Goods. This product would have been discontinued if it was not successful, but instead, it was re-launched. It has been described as "iconic" by third parties, has been advertised in Harper's Bazaar UK and the relaunch of i-Divine is discussed in the same, dated 3 November. Harper's Bazaar UK Facebook page has 800,000 followers, and its UK Instagram page has 1.5 million followers. As such, it is clear how many people would have seen the article in question and not only been aware of the Earlier Trade Mark, but also the re-launch, all before two of the Relevant Dates and within two of the Relevant Periods. In addition, the Opponent's Earlier Goods bearing the Earlier Trade Mark were also included in an article in 2019 in the Guardian titled "the 30 best bargain makeup, nail and hair products under £15" and the "Sleek Makeup i-Divine Palettes" are listed at £8.99. The Guardian has a large readership with over 5.1 million follows on its Instagram page. As such, one can only imagine how many UK readers came across this article prior to the Relevant Dates.

74. I note the opponent's point about the use of the word "iconic", but in my view that does not necessarily equate to a tangible reputation. As previously stated I acknowledge the large readership and social media following of Harper's Bazaar and The Guardian but no evidence was provided showing how many followers actually read the articles. More pertinently, Yomi Adegoke, in the Harper's Bazaar article, talks about the impact of the Sleek makeup brand on her sense of identity as a black woman, rather than with specific reference to the **i Divine** product. In the Guardian article, the writer Sali Hughes describes Sleek in the following terms "I think Sleek may be the best budget brand on the high street". Although the product she is reviewing is the eyeshadow palette, **i Divine** is not mentioned by name in the article but only appears in the title above the image of the goods. In my view it is the Sleek makeup brand which has the reputation based on the evidence provided rather than the **i**

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<sup>34</sup> Paragraph 86

<sup>35</sup> SL01 & 2 – second witness statement of Stephen Lowry

**Divine** eyeshadow palette. Overall I do not find that a case for reputation has been made out and therefore the ground of opposition under section 5(3) fails.

### **Section 5(4)(a)**

75. 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) [...]

(a) [...]

(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.”

76. 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).”

77. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumers are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*<sup>36</sup>, it is doubtful whether the difference between the legal tests will produce different outcomes. In my view, this is the case here. Whilst I accept that the opponent has demonstrated sufficient use for *Eyeshadows; Eyeshadow palettes; Eyeshadow preparation* and I would likely find goodwill in those goods, its claim under Section 5(4)(a) does not provide any better an outcome for the goods which I found to be dissimilar. Therefore I do not need to consider this ground further.

### **Conclusion**

78. The opposition has been successful in full against UK TM No.3558493 and UK TM No.3562279 and subject to any appeal against this decision, these trade marks should be refused.

79. The opposition has been partially successful against UK TM No.3620622. Subject to any appeal against this decision, this trade mark should be refused for all goods in class 3 and for *Makeup bags* in Class 18. However it can proceed to registration for the remaining goods in class 18, namely *Bags; Carrying bags; Tote bags; All-purpose carrying bags*.

### **Costs**

80. The opponent has been partially successful, so it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016 but factoring in the partial nature of its success, I award costs as follows:

£600	Official fees for Notices of Opposition (x3)
£600	Preparation of statements & consideration of counterstatements (x3)

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<sup>36</sup> [2012] EWCA (Civ) 1501

£500	Preparation of evidence
£300	Preparation of written submissions
<b>£2000</b>	<b>Total</b>

81. I order Pat McGrath Cosmetics LLC to pay The Boots Company PLC the sum of £2000. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11<sup>th</sup> day of January 2023**

**June Ralph**  
**For the Registrar**  
**The Comptroller-General**