

O-346-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2626713
BY ORIGINAL ADDITIONS (BEAUTY PRODUCTS) LIMITED
TO REGISTER:**

TRIPLELASH

&

TRIPLE LASH

AS A SERIES OF TWO TRADE MARKS IN CLASS 3

AND:

**OPPOSITION THERETO UNDER NO. 103971
BY BROOKS- HILL LIMITED**

BACKGROUND

1. On 27 June 2012, Original Additions (Beauty Products) Limited (“the applicant”) applied to register the series of two trade marks shown on the cover page of this decision. The application was accepted and published for opposition purposes on 20 July 2012 for the following goods in class 3:

False eyelashes and adhesives for fixing such eyelashes; lash extensions; lash perming preparations; eyelash coating preparations; cosmetics; preparations for shaping, depilation, colour tinting and lightening of the eyebrows; non-medicated toilet preparations; bathcare products; body scrub; facial scrub; preparations for the care and treatment of the skin, nails, body and hair; soaps; shampoos; creams, lotions and butters, all for the skin, nails, body and hair; beauty masks; perfumes; essential oils; preparations for covering and reducing skin imperfections, wrinkles and blemishes; preparations for removing cosmetics; anti-perspirants; deodorants for personal use; depilatory preparations and wax; false nails and adhesives for fixing such nails; abrasive paper and boards for the nails; emery boards; kits and gift sets consisting wholly or principally of the aforementioned goods.

2. On 17 October 2012, Brooks-Hill Limited (“the opponent”) filed a notice of opposition directed against the goods shown above in bold. Insofar as the objection to cosmetics is concerned, the opponent indicates that its opposition is directed at mascara. The opposition is based upon grounds under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”). In relation to its ground under section 3(1)(b) of the Act, the opponent states:

“triple lashes is not an indication of origin for products which are or relate to eyelashes.”

In relation to the opposition based upon section 3(1)(c) of the Act, the opponent states:

“triple lashes describes three layers of eyelashes or three times the usual length of eyelashes and so is directly descriptive for these and related goods.”

3. On 31 October 2012, the applicant filed a counterstatement in which the opponent’s claims are denied.

4. Both parties filed evidence. Whilst neither party asked to be heard, both filed submissions in lieu of attendance at a hearing. I will refer to these submissions as necessary below.

The opponent’s evidence

5. This consists of a witness statement from Janice Trebble, a trade mark attorney at Saunders & Dolleymore LLP, the opponent’s professional representatives. Exhibit JMT1

consists of extracts taken from the 2001 edition of the *Collins Concise Dictionary* which Ms Trebble notes contains the following definitions:

“TRIPLE three times as great or as much
 to increase threefold

LASH see eyelash

EYELASH any one of the short curved hairs that grow from the edge of the
 eyelids; a row or fringe of these hairs.”

Based on these definitions, Ms Trebble concludes:

“The mark TRIPLE LASH (or TRIPLELASH) therefore describes lashes which are three times as thick as normal or three times as long, or products which give this effect.”

The applicant’s evidence

6. This consists of a witness statement from Jeffrey Parker, a trade mark attorney and the applicant’s professional representative. Mr Parker states:

“3. The trade mark was coined by the applicant to describe one of their products in their EYLURE range of false eyelashes and associated products...”

And:

“4. The applicant invented [the trade marks the subject of the application] to describe the product which had been specifically designed to provide the wearer with extremely full and outstanding length lashes...”

7. Although Mr Parker states that the trade mark has been used extensively in the UK by the applicant and products sold under the trade mark can be found in major high street retailers such as Boots and Superdrug, no evidence to this effect has been provided. Exhibit JP1 to Mr Parker’s statement consists of 4 pages, all of which were obtained from the Internet on 12 March 2013. Pages 6 and 7 have been obtained from the opponent’s website www.girlswithattitude.co.uk. The pages are headed “TRIPLE LASH 1 [or 2] FALSE EYELASHES” and contain the following text:

“Triple the amount of Lash! These specifically designed lashes have three layers of lashes for the most voluptuous volume you could hope for!

Girls with Attitude know how to make the most of their assets and are not afraid to show them off to their best advantage. Super – natural and so much better than the real thing. Girls with Attitude false eyelashes exaggerate and amplify when nature can’t quite make the grade. Long and full with extra sweep at the

sides, they widen and open the eyes in a way mascara never can. These super sweepers won't break the bank either!

Fabulously light, easy to apply, comfy to wear and adhesive is included."

Further down both pages there are references to:

"Other details on Girls With Attitude Triple Lash 1 [or 2]..."

In addition, both pages contain, inter alia, a photograph of the packaging in which the goods are supplied. Better quality copies of this packaging have been supplied by the opponent in their evidence in reply and are shown later in this decision.

8. Of these pages Mr Parker states:

"6...It appears that the opponent is itself using TRIPLE LASH as a trade mark, despite claiming that the mark is not a trade mark at all..."

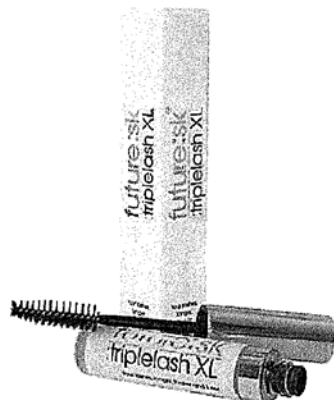
9. Page 8 comes from www.cosmpolitan.co.uk, the website of the well known woman's magazine. The article, dated 13 September 2012, is entitled: "False lashes; single, double or triple?" Mr Parker notes that the page contains a reference to "Girls With Attitude Triple Lash". I note that the article contains the following text:

"There was once a time when die-hard falsie fans had to layer single strip lashes to get that dramatic lash look...God bless the beauty brands that decided to save their consumers the extra gluing time by attaching the additional layers themselves.

...I decided to try out the different layers of lash layering.

...this is because the three layer lashes were a little too much for me..."

Page 9 comes from www.dailymail.co.uk and contains the following image:



10. Of this page Mr Parker states:

“9...However, it demonstrates use of TRIPLELASH as a trade mark for goods in class 3, albeit by another proprietor. This is indicative of our view that the trade mark is one which is novel, possesses sufficient distinctiveness and makes a desirable trade mark.”

11. Having noted that the application is for the trade marks TRIPLELASH and TRIPLE LASH and not “triple lashes”, Mr Parker states:

“10...the trade mark is not “triple lashes” but [as mentioned above]. The marks are clearly different. One would not expect the use of a singular form of “lash” preceded (sic) a given multiple amount, which adds greatly to the distinctiveness of the trade mark. The opponent has filed the opposition using arguments against “triple lashes” which is not the mark applied for.

12. Finally, Mr Parker notes the acceptance in 2002 (without evidence of acquired distinctiveness) of trade mark no. 2294375 DOUBLE LASH also in class 3 for a range of goods including, for example, mascara, eyeliner and eye shadow standing in the name of Revlon (Suisse) S.A. As the opponent points out in its submissions, it is well established that when considering an application for registration the “state-of-the-register” is, in principle, irrelevant; I agree. As a consequence, I need say no more about this earlier registration.

The opponent’s evidence-in-reply

13. This consists of a witness statement from Timothy Hill, the opponent’s director. Mr Hill states that he has:

“1. ...a good knowledge of the market for the goods which are the subject of this opposition.”

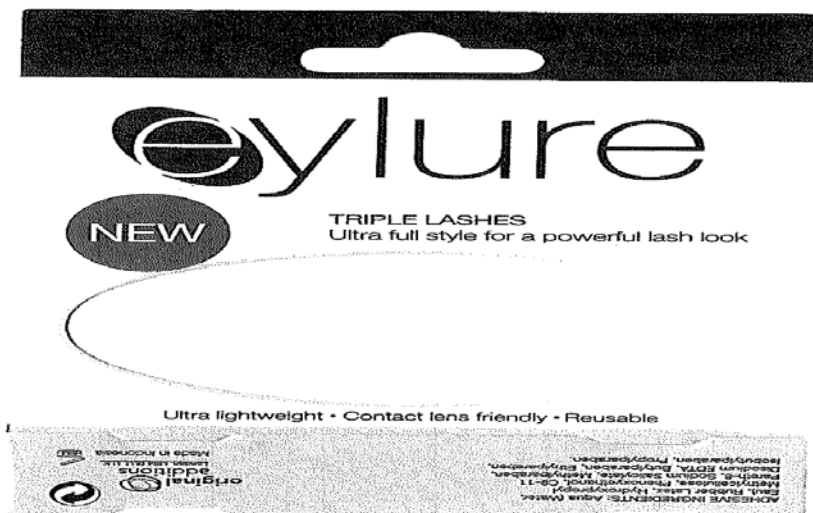
14. Pages 5 and 6 of exhibit TH1 consist of photographs of the opponent’s packaging as referred to by Mr Parker, which carries a copyright date of 2011. Pages 7 and 8 contain photographs of the adhesive which accompanies the eyelashes and page 9 is a photograph of the eyelashes themselves and the tray in which they are supplied. The front and back of the packaging looks like this:



15. Mr Hill explains that the opponent has another product in its false eyelashes range which it refers to as double lash. Photographs of the packaging carrying a copyright date of 2013 is provided as pages 11 and 12, and differ from that shown above only to the extent that the packaging contains the numeral “2” and the words “DOUBLE LASHES” in the eye device which appears at the top right of the packaging and the words “double lash” at the bottom left of the packaging. Pages 13 to 15 consist of photographs of the adhesive and the eyelashes themselves and the tray in which they are supplied. Exhibit TH2 consists of 2 pages obtained on 21 April 2013 from the opponent’s website www.girlswithattitude.co.uk. The pages refer to: “BODY ART PAINT STICKS” (page 17) and “DAZZLING CRYSTALS BODY ART” (page 18). Mr Hill states:

“4...These show that (sic) name of the product at the top of the page is not necessarily the trade mark for the product. For some products it is simply a description. This holds for the TRIPLE LASH products too.”

16. Exhibit TH3 consists of what appears to undated examples of the applicant’s packaging (pages 21 to 35) together with photographs of adhesive and false eyelashes. The front of the Eylure Naturalites packaging (page 21) looks like this:



The text on the rear of the packaging (page 22) reads:

“Eylure Naturalites Triple Effect Lashes have been specifically designed to give ultra-fullness and outstanding length to lashes. A real statement lash it gives the effect of wearing multiple pairs of lashes...”

17. This exhibit also contains pages obtained from the applicant's website www.eylure.co.uk on 7 May 2013. Page 36 contains the heading "TRIPLE LASH 301" and is accompanied by, inter alia, the following text:

"A fabulously full and fluttery new addition to the revered Naturalites range – Triple lash 301 are three times more than a standard pair of lashes – big, beautiful and still completely wearable! This is too-too Triple!"

The same page also contains a reference to "Double Lash 208", whilst page 37 contains a reference to "SUPER FULL 075 BROWN" and "Eylure have created concise range (sic) of lashes in dark brown..." Pages 39 to 43 were obtained on 21 April 2013 from www.superdrug.com and show a number of the applicant's other products sold by reference to the eyelure and/or eyelure and Naturalites trade marks. These are: "Individual Lashes", "NATURAL VOLUME" and "DOUBLE LASHES", which also contains the following text:

"Layered style for a full and textured effect. When our customers told us they loved wearing 2-3 pairs of our eyelashes at once we thought there must be something we can create for these lash lovers!

The result was Eylure Double Lashes – an extraordinary innovation which gives a double wear look in one lash...",

there are also references to "Eyebrow Shapers" and "Lash Extend" all of which Mr Hill states are:

"...descriptive words used in the same way as triple lashes is used."

18. Mr Hill concludes his statement in the following terms:

"6. From my experience and knowledge of the market, the words TRIPLE LASH and/or TRIPLELASH are commonly used to denote false eyelashes which are, or give the impression that they are three times thicker than usual. This is supported also by the evidence referred to in Mr Parker's statement...the extract from Cosmopolitan. The mark applied for is an ordinary description of a characteristic of the goods which are the subject of this opposition – shortening "lashes" to "lash" does not change the perception of consumers as to the nature of the goods."

19. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

20. The opposition is based upon sections 3(1)(b) and (c) of the Act which state:

“3. - (1) The following shall not be registered –

(a).....

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

21. It is well established that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union (“CJEU”), paragraphs 67 to 70. In *Starbucks (HK) Limited, PCCW Media Limited, UK Broadband Limited v British Sky Broadcasting Group plc, British Sky Broadcasting Limited, Sky IP International Limited* [2012] EWHC 3074, Arnold J referred to summaries of the law in two decision from the CJEU in relation to Articles 7(1)(b) and (c) of the Community Trade Mark Regulation, which correspond to sections 3(1)(b) and (c) of the Act:

“90. The principles to be applied under Article 7(1)(b) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

“29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the

product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v. OHIM* [2004] ECR I-10107, paragraph 78; *Storck v. OHIM*, paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & Gamble v. OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v. OHIM*, paragraphs 36 and 38; and *Audi v. OHIM*, paragraph 37).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

...

37. ... it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely prima facie to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...

45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45). “

91. The principles to be applied under Article 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I-0000, [2011] ETMR 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 30, and the order in Case C-150/02 P *Streamserve v OHIM* [2004] ECR I-1461, paragraph 24).

...

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 45, and Case C-48/09 P *Lego Juris v OHIM* [2010] ECR I-0000, paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to

register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in Case C-80/09 P *Mergel and Others v OHIM*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 58). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

...

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56). "

92. In addition, a sign is caught by the exclusion from registration in Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see Case C-191/01 P *OHIM v Wm Wrigley Jr Co* [2003] ECR I-12447 at [32] and Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 at [97].

93. Counsel for PCCW relied upon two other authorities. First, Case C-273/05 P *OHIM v Celltech R&D Ltd* [2007] ECR I-1912, in which the CJEU stated at [81]:

"In this case, it must be held that the Court of First Instance properly assessed the descriptive character of the mark CELLTECH considered as a whole and concluded that it was not established that the mark, even understood as meaning 'cell technology', was descriptive of the goods and services referred to

in the application for registration. Therefore, it did not infringe Article 7(1)(c) of Regulation No 40/94. "

94. Secondly, Case T-207/06 *Europig SA v OHIM* [2007] ECR II-1961, in which the Court of First Instance (now General Court) said at [27]:

"It follows that, for a sign to be caught by the prohibition set out in [Article 7(1)(c)], there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see *PAPERLAB*, paragraph 25, and the case-law cited there). "

22. In its submissions the opponent states:

"5...On this basis, the mark TRIPLE LASH means a single hair or row of hairs on the edge of eyelids, that is three times as thick as usual, or is three times longer than usual or products which give or result in this effect.

6. The mark TRIPLELASH is identical to the mark TRIPLE LASH but the space between the words is removed. This has no effect on the meaning either of the individual elements of the mark TRIPLELASH or the mark as a whole."

23. As the above case law indicates, the distinctive character of the trade marks applied for must be assessed, first, by reference to the goods the subject of the opposition and, secondly, by reference to the perception of those goods by the relevant public. The relevant public for the opposed goods i.e. "false eyelashes and adhesives for fixing such eyelashes, lash extensions, lash perming preparations, eyelash coating preparations and cosmetics", is the general public, albeit, most likely, females.

24. The date at which the distinctiveness of the applicant's trade marks must be assessed is the date of the application for registration i.e. 27 June 2012. I must first make an assessment on the basis of the trade marks' inherent characteristics, and, if I find the trade marks are open to objection on that basis, I must then determine, whether before the date of the application for registration, the trade marks have, in fact, acquired a distinctive character as a result of the use made of them. In his evidence, Mr Parker states that the applicant has used the trade mark the subject of the application and goods have been sold through a number of retailers such as Boots and Superdrug, however, as no evidence has been filed by the applicant to explain, for example, when this use began, the actual trade marks used, what goods were sold under the trade marks, turnover achieved under the trade marks, amounts spent on promoting the trade marks etc, I have only the inherent characteristics of the trade marks to consider. Although the applicant has not raised this point in its submissions, I should perhaps mention here that although the opponent has, as exhibit TH3, filed some examples of the applicant's trade mark in use, as this evidence is either undated or after the material

date in these proceedings and lacks any of the necessary detail mentioned above, it does not assist the applicant.

25. In its submissions the applicant states:

“4...We accept that the expression “triple lashes” may have a descriptive nature. However, “triple lashes” is not the mark the subject of the application.

5. The first mark in the series has been formed by conjoining TRIPLE and LASH to produce a trade mark which possesses sufficient distinctiveness to be registrable. The fact that the trade mark may be made up of words which separately have a dictionary definition does not suffice to preclude registration of the mark.

6. The second mark in the series is the combination of TRIPLE with a shortened form of the word lashes, which is unexpected and thereby imbues distinctiveness. This is a clever trade mark as one would not expect the plural form to be used in conjunction with a singular object. Such use is contrary to the rules of English grammar. It adds novelty and is therefore distinctive...”

26. The applicant appears to accept that the expression “triple lashes” has a descriptive nature. It then argues that the distinctiveness in its trade marks lay in the conjoining of the words TRIPLE and LASH (in the first trade mark in the series) and that both trade marks in the series (the second of which is presented as two separate words) use the word LASH (singular) instead of lashes (plural). In its submissions, the opponent states:

“15...Mr Parker argues that “triple lashes” and “triple lash” are not the same, “lash” being singular and “lashes” being plural. However, the evidence shows that “lash” can refer to either a single hair or a row of hairs that grow on the edge of the eyelid...The exhibits provided by Mr Parker and Mr Hill are littered with examples of “lash” and “lashes” being used synonymously...”Lash” can mean a single hair or a row of hairs; “lashes” can mean a single row of hairs or can refer to a pair of rows of hairs which form a set (one lash for each eye). Making LASH singular does not affect the fact that it is descriptive in this context.”

27. As the relevant public would be familiar with the words TRIPLE and LASH and their meanings, and would identify these words as separate elements of the first trade mark in the series, if I find the words TRIPLE LASH presented as separate words are open to objection, the conjoining of the two words would not, in my view, assist the applicant.

28. Although a good deal of both parties’ evidence appears to be either undated or to originate from after the material date, as the words TRIPLE and LASH are words with well established meanings, and as neither party has raised any objections to the other side’s evidence on the basis of its date, and keeping in mind that the material date of June 2012 is sufficiently close to the date the evidence was provided to suggest that the

position would not have been significantly different at or before the material date, I intend to take this evidence into account when reaching a decision.

29. The applicant has provided examples of what it considers to be use (including use by the opponent) of the words TRIPLELASH/TRIPLE LASH as trade marks. In the packaging shown above, the words "triple lash" (which appears at the bottom left of the front of the opponent's packaging) would, in my view, be seen by the relevant public not as a trade mark but as a description. This, in my view, is supported by the use of the numeral "3" and the words "NEW TRIPLE LASHES" at the top right of the front of the packaging, and in the references on the opponent's website to:

"Triple the amount of Lash! These specifically designed lashes have three layers of lashes for the most voluptuous volume you could hope for!"(my emphasis)

Rather, the indication of origin on the opponent's packaging is, in my view, the words Girls WITH ATTITUDE. The evidence from www.cosmpolitian.co.uk refers to: "False lashes: single, double or triple" and "...the three layer lashes..."(my emphasis), which again, in my view, is descriptive rather than trade mark use; insofar as this page refers to the opponent, it does so by reference to the words "Girls With Attitude Triple Lash". Finally, in the page obtained from www.dailymail.co.uk, the words triplelash are, once again, in my view, being used as a description, the indication of origin being the words and letters future:sk. As to the applicant's use provided by the opponent, I note that the applicant uses the words "TRIPLE LASHES" on its packaging accompanied by a reference to: "Eylure Naturalites Triple Effect Lashes...", and that, in relation to its TRIPLE LASH 301 product, the accompanying text reads: "...Triple lash 301 are three times more than a standard pair of lashes..."; and in relation to its DOUBLE LASHES product the accompanying text reads: "...When our customers told us they loved wearing 2-3 pairs of our eyelashes at once..."

30. On the basis of the evidence provided and the applicant's apparent concession, there can be little argument that the words "triple lashes" are apt to describe the intended purpose of goods which have the effect the opponent suggests. The only question that remains is whether the use of the singular version of the word LASH bestows sufficient distinctiveness on the resulting combinations to render them prima facie registrable (I have already concluded that the conjoining of the two words does not assist the applicant). In my view it does not. I reach this conclusion because, as the opponent points out, the word LASH can refer to either a single hair or a row of hairs that grow on the eyelid. Were there any doubts that this is the case, one need only look to Appendix 1 of the opponent's submissions, which highlights the interchangeable use of the words LASH and LASHES in the evidence filed by both parties to these proceedings. In my view, the applicant's trade marks consist exclusively of indications which may serve in trade to designate the intended purpose of "false eyelashes and adhesives for fixing such eyelashes; lash extensions; lash perming preparations; eyelash coating preparations; cosmetics (mascara)" which, as the opponent argues, have the effect of making one's eyelashes look three times as thick as usual, or three times longer than usual or products which assist in achieving this effect. As a

consequence of that conclusion, the opposition based upon section 3(1)(c) of the Act succeeds. As I have concluded that the trade marks are descriptive, it follows that the trade marks are also open to objection under section 3(1)(b) of the Act on the basis that they are devoid of any distinctive character.

Conclusion

31. The opposition to the opposed goods succeeds in full. Insofar as the opposition is directed at “mascara” which falls within the broad phrase “cosmetics”, I have, as per the guidance in TPN 1/12 – “Partial Refusal”, considered whether it is appropriate to give the applicant an opportunity to offer a limited specification in relation to the phrase “cosmetics” which might avoid the above conclusion in relation to that broad term. Paragraph 3.2.2(d) of that notice reads in part:

“...Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal”,

32. Given what I consider to be the descriptive nature of the words the subject of the application, and keeping in mind the evidence provided by Mr Parker which indicates the goods of interest to the applicant i.e. those relating to false eyelashes, I have concluded that it is not appropriate to offer the applicant this opportunity. In summary, subject to a successful appeal, the application will be refused in respect of:

False eyelashes and adhesives for fixing such eyelashes; lash extensions; lash perming preparations; eyelash coating preparations; cosmetics.

The application will, in due course, proceed to registration for those goods which were not opposed i.e.

Preparations for shaping, depilation, colour tinting and lightening of the eyebrows; non-medicated toilet preparations; bathcare products; body scrub; facial scrub; preparations for the care and treatment of the skin, nails, body and hair; soaps; shampoos; creams, lotions and butters, all for the skin, nails, body and hair; beauty masks; perfumes; essential oils; preparations for covering and reducing skin imperfections, wrinkles and blemishes; preparations for removing cosmetics; anti-perspirants; deodorants for personal use; depilatory preparations and wax; false nails and adhesives for fixing such nails; abrasive paper and

boards for the nails; emery boards; kits and gift sets consisting wholly or principally of the aforementioned goods.

Costs

33. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Preparing evidence and considering the applicant's evidence:	£500
Opposition fee:	£200
Written submissions:	£300
Total:	£1200

34. I order Original Additions (Beauty Products) Limited to pay Brooks-Hill Limited the sum of **£1200**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of August 2013

C J BOWEN
For the Registrar
The Comptroller-General