

O-419-20

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3419968
BY PHAT LASH
TO REGISTER

PHAT LASH

AS A TRADE MARK IN CLASS 44

AND

OPPOSITION THERETO
UNDER NO. 600001341
BY FATLASH LTD

Background and pleadings

1. On 08 August 2019, Phat Lash (“the applicant”) applied to register the trade mark shown below under number 3419968:

PHAT LASH

2. The application was published for opposition purposes on 22 November 2019 for the following services in Class 44:

Beauty care.

3. Fatlash Ltd (“the opponent”) filed a notice of opposition under the fast-track opposition procedure on 24 February 2020. The opposition, which is based upon sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the services in the application. The opponent relies upon some of the goods and services for which the following UK trade mark is registered:

Mark: FATLASH

UK registration no. 3116532

Filing date: 06 July 2015

Registration date: 09 October 2015

Goods and services relied upon:

- Class 3 Adhesives for cosmetic purposes; Adhesives for false eyelashes, hair and nails.
- Class 8 Tweezers
- Class 44 Beautician services; Beauticians (services of-);Beauty care; Beauty care for human beings; Beauty consultation; Beauty salon services; Beauty salons; Beauty therapy services; Beauty therapy treatments; Beauty treatment; Beauty treatment services; Beauty-salon services.

4. The applicant filed a counterstatement denying the grounds of opposition, they are reproduced below in full:

“I would like to disagree with the opposing person. Firstly both names are spelt differently our name is ‘PHATLASH’¹ and the other name being spelt “FATLASH” although both names are pronounced the same the spelling is different meaning visually it’s hard to be mixed up. Secondly the two companies in question are both operating differently, our company “PHATLASH” is an eyelash and beauty brand selling beauty products and offering online training courses which are fully accredited through CPD, and “FATLASH” is someone who is an eyelash technician who puts the products on someone’s eyes so we don’t cross paths in the fields. We sell the product and they apply the product. If anything, I would be inviting the opposing person to try our products. Thirdly we are a growing company with links to America and the rest of the world. With our name ever growing it’s the heart of our business and it’s our identity hence for the application of trade mark. Lastly I would just like to say if you view both logos our logo is has the PHAT in bold and lash normal in black with a pink background and the opposing persons logo is completely different which makes it unique to us.”

5. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be

¹ The applied-for mark is PHAT LASH (two words).

taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions.

8. Both parties are litigants in person.

DECISION

Sections 5(1) and 5(2)(b)

9. The opposition is based upon sections 5(1) and 5(2)(b) of the Act, which read as follows:

“5. (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

10. An earlier trade mark is defined in s. 6 of the Act, the relevant parts of which state:

“6. - (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade

mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

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

Sections 5(1)

12. In order to get an objection under the above section off the ground, the competing trade marks must be identical. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held, that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

13. Further, I take into account the ruling in *Reed Executive plc v Reed Business Information Ltd*, Court of Appeal [2004] RPC 767, where Jacob L.J. found that ‘Reed’ was not identical to ‘Reed Business Information’ even for information services. He stated that:

“40. It was over “Reed Business Information” that battle was joined. The composite is not the same as, for example, use of the word “Reed” in the sentence: “Get business information from Reed”. In the latter case the only “trade-marky” bit would be “Reed”. In the former, the name as a whole is “Reed

Business Information”. The use of capital letters is of some visual significance – it conveys to the average user that “Business Information” is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg “Palmolive Soap” compared to “Palmolive”) the position might have been different. But “Business Information” is not so descriptive – it is too general for that.”

14. The applicant’s mark consists of two words “PHAT” and “LASH”. Even though the opponent’s mark consists only of a single word “FATLASH”, the mark appears to be a play on words created by the combination of “FAT” and “LASH” which the average consumer will perceive within the mark. The differences between the first word/part of the marks and the presentation of the respective marks as a single word and two words are unlikely to go unnoticed by the average consumer. As there is no identity between the competing marks, the opposition under section 5(1) is dismissed accordingly.

Section 5(2)(b) – case law

15. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect

picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of services

16. The applicant contends:

“The two companies in question are both operating differently, our company “PHATLASH” is an eyelash and beauty brand selling beauty products and offering online training courses which are fully accredited through CPD, and “FATLASH” is someone who is an eyelash technician who puts the products on someone’s eyes so we don’t cross paths in the fields we sell the product and they apply the product.”²

17. The applicant’s contention that the respective parties offer distinct services is irrelevant for the issue of comparison. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, the CJEU stated, at paragraph 66 of its judgment, that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for **might be used** if it were registered. The way in which the applicant, or the opponent, currently uses the mark in the market place may change over time. Registered trade marks are also items of property which may be sold to third parties in the future who may wish to use them in a different way to the current proprietor. This means that I am required to make the assessment of the likelihood of confusion notionally and objectively based on the applicant’s services, as applied for, and the opponent’s services, as registered.³ Differences between the actual services offered by the parties, are therefore not relevant unless such differences are apparent from the specifications before me.

18. The applicant further argues:

“Miss Edbrooke has stated that both companies come under class 44 beauty care for human beings. This is incorrect after discussing with my accountant and a confirmation email I will attach to this letter our SIC code for PHAT

² See the applicant’s counterstatement.

³ See *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84.

BEAUTY LTD is 47910 which is “Retail sale via mail order houses or via internet’.”⁴

19. “Beauty care” in class 44 (contained twice in the specification) is the only service covered by the trade mark application. As this term is identically contained in the opponent’s specification, the competing services are, notionally and objectively, identical.

The average consumer and the nature of the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which these services are likely to be selected by the average consumer.

21. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

22. I consider that the average consumer of the competing services is a member of the general public. The service providers are most likely to be selected after perusal of the internet, catalogues, or visiting traditional outlets. Visual considerations are, therefore, likely to dominate the selection process. These services may also be selected further to word-of-mouth recommendations. In such circumstances, I do not discount an aural element to the selection process. When making a choice, the average consumer will give attention to factors such as customer reviews or the

⁴ See the applicant’s written submissions dated 20 August 2020.

experience of staff. The frequency with which the services may be used varies depending on the type of services, for example, beauty care services such as cosmetic fillers for the skin/lips may not be used as regularly as eyelash extension or facial services. The costs will also vary according to the type of services. These factors suggest that the average consumer will pay a medium degree of attention when making their selection.

Comparison of marks

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

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

24. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

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

Opponent's trade mark	Applicants' trade mark
FATLASH	PHAT LASH

26. The opponent's mark is presented as a single word "FATLASH" in capital letters without any stylisation. The mark appears to be created by the combination of the words "FAT" and "LASH" which the average consumer will perceive within the mark. The overall impression and the distinctiveness of the mark lie in the single word "FATLASH".

27. The opponent's mark consists of two words "PHAT" and "LASH" both presented in capital letters without any stylisation. The average consumer is likely to perceive the word "PHAT" as qualifying the word "LASH" such that the words combine together to form a phrase. Therefore, in my view, neither word dominates the overall impression of the mark.

28. The applicant submits:

"I would just like to say if you view both logos our logo is has the PHAT in bold and lash normal in black with a pink background and the opposing persons logo is completely different which makes it unique to us."⁵

It may be the case that the applicant uses the mark in the market place in colour with some stylization as indicated. However, the mark applied-for is a word mark without any stylization.⁶ I must, therefore, assess any potential conflict of the applicant's mark as it appears on the register with the opponent's mark.

29. Visually, six out of seven letters in the opponent's mark are contained in the applicant's mark in the same order. In terms of differences between the marks, the opponent's mark is presented as a single word while the applicant's mark is presented as two words. The marks begin with the letter "F" and the letters "PH", respectively. Weighing up the similarities and differences, I consider that the marks are visually similar to a reasonably high degree.

⁵ See the applicant's counter statement.

⁶ Please see the certificate of filing trade mark dated 8 August 2019.

30. In an aural comparison, the opponent's mark will be pronounced entirely conventionally. Given that "PHAT" in the applicant's mark is the phonetic equivalent of the word "FAT" and the word "LASH" is pronounced identically in both marks, the competing marks are aurally identical.

31. As regards the conceptual comparison, I consider that the average consumer will see the words "FAT" and "LASH" in the applicant's mark and construe it accordingly. While the word "FAT" can have more than one meaning, bearing in mind the services at issue, the average consumer is likely to construe the word as "thick".⁷ "LASH" is the shortened word for eyelash. The opponent's mark, therefore, conveys the concept of "thick lash". The position in relation to the applicant's mark is less clear cut. According to *Collins English Dictionary*, "PHAT" is a slang word which means "terrific; superb".⁸ "LASH" will be given the same meaning in both marks. The concept of the applicant's mark, according to the dictionary definition, is, therefore, of "superb/excellent lash". However, I am mindful that, just because a word has a dictionary definition, it does not automatically follow that the average consumer will be aware of it.⁹ It seems to me that there may be some consumers who are aware of the aforementioned meaning of the slang word 'PHAT' and will therefore perceive the mark as 'superb/excellent lash'. However, there are likely to be a significant number of others who are not aware of the dictionary meaning of 'PHAT' and may perceive it as an invented word with no meaning, with the overall concept of PHAT LASH also having no clear meaning. In both of those scenarios, the concept of the opponent's mark would not be shared with the applicant's mark. There may also be a third group of consumers who perceive the word 'PHAT' as meaning the same as the well-known word 'FAT' (given the aural identity between those words). For the latter group of consumers, the respective marks would be conceptually identical.

⁷ <https://www.collinsdictionary.com/dictionary/english/fat> [accessed on 19 June 2020]

⁸ <https://www.collinsdictionary.com/dictionary/english/phat> [accessed on 19 June 2020].

⁹ See, for example, the comments of Ms Anna Carboni, sitting as the Appointed Person, in *CHORKEE*, decision BL O/048/08, [36] – [38].

Distinctiveness of the earlier mark

32. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

33. As the opponent filed no evidence, I have only the inherent position to consider. As I mentioned earlier, the average consumer will readily identify the words “FAT” and “LASH” in the earlier mark and construe it accordingly. The mark is, therefore, highly allusive of and possesses a low degree of inherent distinctive character in relation to beauty services related to eyelashes. It is not allusive in relation to services not related to eyelashes and, therefore, possesses a normal degree of distinctiveness in relation to such services.

Likelihood of confusion

34. A likelihood of confusion is made on a global assessment of all factors relevant to the circumstances of the case (*Sabel* at [22]). It is necessary for me to factor in the distinctive character of the earlier trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion (*Sabel* at [24]). I must also 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 services and vice versa (*Canon* at [17]). I must also keep in mind the average consumer for the services, the nature of the purchasing process and that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

35. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

36. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

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

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

37. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

38. Earlier in this decision, I concluded:

- That the contested services are identical to the services covered under the opponent’s mark;
- That the services will be selected primarily by visual means, with a medium degree of attention. There is also an aural element to the selection process;
- That the marks are visually similar to a reasonably high degree and aurally identical. Conceptually, the marks either share no concept or are identical, depending on how the average consumer construes the word “PHAT/FAT” in the respective marks;
- That the opponent’s mark, as a whole, is distinctive to a low or normal degree, depending upon the kind of beauty service at issue.

39. I also bear in mind the CJEU decision in *Lloyd Schuhfabrik Meyer*¹⁰ in which it stated:

“28. ...the answer to the questions referred to the Court must be that it is possible that mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) of the Directive. The more similar the goods or services covered and the more distinctive the earlier mark, the greater will be the likelihood of confusion.”

¹⁰ [1999] ECR I-3819

40. For some services at issue I have found that the earlier mark possesses only a low degree of distinctive character. In this regard, I bear in mind that the low degree of distinctive character of the earlier trademark does not in itself preclude a finding of likelihood of confusion. I have already concluded that the services are not selected wholly visually. In my view, a proportion of average consumers are likely to use the services further to word-of-mouth recommendations. In those circumstances, the aural identity between the marks is likely to lead those average consumers to think that it is the same undertaking that offers identical services. Accordingly, I find that, from the aural perspective, there is a likelihood of direct confusion. I find this to be the case in relation to services where the earlier mark has a low degree of distinctiveness and in relation to those for which it has a normal degree of distinctiveness.

41. Where visual considerations are likely to dominate the selection process, I find that there is also a likelihood of confusion, regardless of whether the mark possesses a normal or low degree of distinctiveness. For those consumers who perceive no conceptual similarity, I consider that the identical services in play, together with the reasonably high visual similarity and the aural identity between the marks, in particular, outweighs any conceptual differences. The average consumer who pays a medium degree of attention to the selection process is likely, in my view, to misremember the marks, bearing in mind imperfect recollection, and therefore mistake one mark for the other (i.e. there will be direct confusion). Alternatively, they are likely to think that the marks are variant marks used by the same undertaking or economically linked undertakings (i.e. there will be indirect confusion). Turning to those consumers who perceive the marks to be conceptually identical, the likelihood of confusion is even greater, both directly and indirectly.

Conclusion

42. The opposition has succeeded in full. The application will be refused.

Costs

43. The opponent has been successful and is entitled to an award of costs. As the opponent is without legal representation, and is therefore 'a litigant in person', the

Tribunal invited the opponent to submit a breakdown of the actual costs it has incurred in the proceedings, including accurate estimates of the number of hours spent. The opponent was advised that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. The opponent claims that it has spent the following amount of time on the proceedings:

Notice of Opposition: 2 hours

Considering the Form TM8 filed by the applicant: 30 mins

Preparing and filing written submissions: 1 hour

Total time: 3.5 hours

This seems to me to be a reasonable amount of time. I therefore award the opponent the sum of $(£19 \times 3.5) + £100$ for the cost of the opposition fee = £166.50.

44. I order Phat Lash to pay Fatlash Ltd. the sum of **£166.50**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4 September 2020

Karol Thomas
For the Registrar
The Comptroller-General