

**O-602-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3037243  
BY TIANA FAIR TRADE ORGANICS LTD  
TO REGISTER THE TRADE MARK**

**TIANA**

**IN CLASSES 3, 29, 30 & 32  
AND OPPOSITION THERETO UNDER NO 402620 BY  
BARONY UNIVERSAL PRODUCTS PLC**

**AND**

**IN THE MATTER OF TRADE MARK REGISTRATION IN THE NAME  
OF BARONY UNIVERSAL PRODUCTS PLC NO. 2388167 FOR THE  
MARK**

**TIAMA**

**IN CLASS 3  
AND REVOCATION FOR NON-USE THERETO UNDER NO 500489  
BY TIANA FAIR TRADE ORGANICS LTD**

## Background

1) These consolidated proceedings involve opposition against a trade mark application for TIANA, and a non-use revocation action against the earlier registration (TIAMA) which the opposition is based.

2) The opponent in these proceedings is Barony Universal Products Plc (“Barony”) and the applicant is TIANA Fair Trade Organics Ltd (“TFTOL”). In the revocation action TFTOL is the applicant and Barony is the registered proprietor.

### **OPPOSITION proceedings (no. 402620)**

#### **Background & pleadings**

3) On 9 January 2014, TFTOL applied to register the trade mark TIANA (“the application”) in the UK. It was appointed trade mark application no. 3037243 then subsequently accepted and published in the Trade Marks Journal on 2 May 2014 in respect of the following goods:

**Class 3:** Skin and Hair products

**Class 29:** Coconut Oil, Coconut Butter, Desiccated Coconut, Coconut Water, Coconut Products, Coconut Oil Derivatives, Palm Oil, Palm Oil Derivatives

**Class 30:** Coconut Flour, Coconut Sugar, Honey

**Class 32:** Coconut Water

4) On 4 August 2014, Barony opposed class 3 of the application on the basis of Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Pertinent details of the earlier mark relied upon for the section 5(2)(b) and 5(3) claims are below:

<b>Mark:</b>	TIAMA (“the earlier mark”)
<b>Filing date:</b>	30 March 2005
<b>Filing number:</b>	2388167
<b>Publication date:</b>	22 July 2005
<b>Date of entry on register:</b>	4 November 2005
<b>Goods relied upon:</b>	Class 3: Perfumery; cosmetics; deodorants for personal use

5) The section 5(2)(b) claim Barony claim that the respective goods are similar and the marks are identical or highly similar. Under section 5(3) of the Act Barony claims that due to its significant reputation for personal care products, body care products, toiletries, perfumery, cosmetics, deodorants, body sprays and skin products use of the application would take unfair advantage of or cause detriment to the distinctive character or repute of its TIAMA mark. It claims that this is likely to result in a loss of sales and customers.

6) Under section 5(4)(a) of the Act Barony claims to have acquired goodwill under the sign TIAMA, since 1 January 1999, for personal and body care products, toiletries, perfumery, cosmetics, deodorants, body sprays and skin products. Due to

the goodwill, Barony claims use of the mark TIANA by TFTOL for any or all of the applied for goods is contrary to the law of passing off under section 5(4)(a) of the Act.

7) TFTOL filed a counterstatement denying the claims made, and requested that Barony prove the claims made. The counterstatement also states that TFTOL relies upon section 7 of the Act because:

“...the Applicant will also place reliance on the provisions of Section 7 of the Trade Marks Act 1994 (as amended) (“the Act”) namely “honest concurrent use” (“HCU”) arising out of the Applicant’s HCU of its mark in relation to haircare and skincare products, without instances of confusion, especially given the Opponent’s claims to the use of its mark relied upon. The said HCU will be adduced in evidence”

8) Section 7 of the Act states:

“7. - (1) This section applies where on an application for the registration of a trade mark it appears to the registrar-

- (a) that there is an earlier trade mark in relation to which the conditions set out in Section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section “honest concurrent use” means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938.

(4) Nothing in this section affects-

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds, where no consent to registration).

(5) This section does not apply when there is an order in force under section 8 below.”

9) Mr Stacey, TFTOL's trade mark attorney, claims that the opposition should be refused since there has been honest concurrent use of the marks. The significance of Section 7 of the Act was outlined by Ms Anna Carboni, sitting as the Appointed Person in the case of *Ion Associates Limited v Philip Stainton and Jeffrey Stainton* O-211-09 (MUDDIES), whereby she stated at paragraphs 12 and 13:

"I pause to mention at this point that section 7(2) was of more significance at the time the Application was being examined by the United Kingdom Registry than it is today. At that time, the Registry had the practice of blocking the registration of any trade mark whose use was thought likely (inter alia) to give rise to a likelihood of confusion with an earlier UK trade mark or CTM, unless either the owner of the earlier mark consented to its registration or the applicant could establish honest concurrent use of the trade mark concerned in accordance with section 7 of the Act.

Pursuant to an Order made under section 8 of the Act, the Registrar's role in raising such "relative grounds" of objection to the registration of new trade marks was stopped as of 1 October 2007. Since then, the Registrar's examiners have instead conducted searches for earlier conflicting marks in respect of each new application and given the results of these searches to applicants and to the owners of relevant earlier UK marks as well as of certain CTMs. If the earlier trade mark owners choose not to oppose a new application, then it may proceed to registration. Section 7(2) still applies at this point, effectively avoiding a strict application of section 5(2)(b) and the other "relative grounds".

10) Ms Carboni went on to state at paragraphs 51 and 52 that:

"Finally, I should mention that the Applicant did not pursue an argument on appeal that section 7 of the Act supported the case for registration based on honest concurrent use. As is clear from the section, honest concurrent use only assists an applicant until the point at which the owner of the conflicting right that had been provisionally overcome in the examination process (as it stood prior to the changes referred to above) opposes the application. At that point, section 7 is of no further assistance and the question of relative rights has to be assessed by reference to the relevant part of section 5. Mr Groom accepted this position, but made a general submission that the fact of honest concurrent use was something that could be taken into account in applying the global appreciation test to determine the likelihood of confusion.

As the hearing officer said (at paragraph 39), for honest concurrent use to be of assistance to an applicant, it must be possible for the tribunal to be satisfied that the effect of concurrent trading is such as to suggest that the relevant public has shown itself able to distinguish between goods bearing the marks

in question without any confusion as to trade origin. That sort of evidence was not presented and the argument therefore did not assist.”

11) Mr Stacey did not claim that honest concurrent use should be taken into consideration in the global assessment, though his reliance on this section of the Act 7 is dismissed since 1) section 7(2) of the Act states that honest concurrent use may not be relied upon in opposition proceedings, and 2) no evidence was been presented which demonstrates that the relevant public has shown itself able to distinguish between the respective marks.

12) If it is the case that Mr Stacey indeed meant that there are no instances of confusion, then this argument is also dismissed. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. it is stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

13) In view of the above, the claim to honest concurrent use under section 7 of the Act and absence of confusion in the marketplace does not assist TFTOL and this claim is dismissed.

14) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. A Hearing took place on 13 October 2015, with Barony represented by Ms Joanne Lecky of Murgitroyd & Company, and TFTOL represented by Mr Max Stacey of Baron Warren Redfern.

### **Barony's evidence (opponent and registered proprietor)**

*Witness Statement of Louise McCullagh and exhibits LM1 – LM6*

15) Ms McCullagh is director of marketing at Barony. This is a position she has held since 2014. Prior to this, and from January 2011, Ms McCullagh was marketing manager.

16) Ms McCullagh states that Barony was founded in 1994 to produce personal care products, toiletries, perfumery, cosmetics, deodorants and skin products in the form of body sprays. She states that Barony adopted use of the TIAMA brand in 1999 for personal care products, body care products, toiletries, perfumery, cosmetics, deodorants and skin products in the form of body sprays. The TIAMA mark was first produced exclusively at the company's manufacturing facility in Scotland. Following high demand Ms McCullagh states that they "recently" opened a factory on an 18 acre site in Irvine, Ayrshire which contained "in excess of 65 million units, of which a high percentage were TIAMA products"<sup>1</sup>. No specific figures have been provided. The witness statement contains the following exhibits:

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<sup>1</sup> Paragraph 7 of the witness statement

- Exhibit LM1 consists of photographs of various TIAMA body spray/fragrance canisters bearing the TIAMA trade mark. Each of them has the year hand written in the top right hand corner, these being 2001, 2003, 2005, 2012.
- Exhibit LM2 are undated photographs of other products that Barony produce. Since none of them bear the TIAMA mark they have no bearing on these proceedings.
- Exhibit LM3 is a list of outlets whereby Ms McCullagh claims that the TIAMA products are available. The exhibit also includes web prints from Amazon which show a Tiama product for sale. The print outs are dated 16 December 2014. Further, under the additional information heading it states that the "Date first available" was 26 October 2013.
- Exhibit LM4 consists of sample invoices dated between October 2005 and October 2014. The invoices include references to TIAMA with a separate sub-brand name. They are addressed to various retailers including Wilkinsons, Netto Foodstores, B&M Bargains, etc.
- Ms McCullagh states that Barony advertises their TIAMA products in printed publications including bespoke brochures. Exhibit LM5 is an order for their inclusion in the catalogue for the Cosmoprof Bologna. It is not clear what the 1 – 4 April 2005 date refers to. Ms McCullagh states that Cosmoprof Worldwide Bologna is the leading worldwide event for the beauty profession. She states that the catalogue is distributed worldwide, but the circulation figures specific to the UK are not provided. The catalogue makes reference to "Tiama 75ml Female Body Sprays".
- Exhibit LM6 consists of a selection of examples of packaging for the "TIAMA Passion Body Sprays". They are all dated 15 September 2008.

17) Ms McCullagh states that Barony began keeping full TIAMA sales volume records in January 2011. From that period to October 2014 it is claimed that the total volume of TIAMA products made and sold in the UK were 10,339,320 units. A breakdown on what specific products these relate to has not been provided.

#### *Turnover*

18) It is claimed that the annual turnover for personal care products, body care products, toiletries, perfumery cosmetics deodorants and skin products in the form of body sprays in the UK under the mark TIAMA are (these figures were not broken down into categories of goods):

2011 - £1,767,768  
 2012 - £3,210,696  
 2013 - £2,691,876

19) Ms McCullagh states that Barony's annual marketing spend is in the region of £120,000 per annum.

## TFTOL's EVIDENCE (Applicant in opposition and for the revocation)

### *Witness Statement of Tatiana Harris and exhibits TH01 – TH015*

20) Ms Harris is the founder of the TIANA brand and a director since 25 January 2013. She has been actively involved with both the TIANA brand and the Tiana Company since its launch around 2002.

21) The company originally started marketing organically sourced coconut based food products; then in April 2010, to test the market, TFTOL launched their first coconut oil based beauty products under the TIANA brand. Full commercial production took place in June 2010. By late 2012, Ms Harris states that they launched a full beauty range under the name TIANA Fair Trade Organics "Beauty Sensations". These included 'hair hydration treatment' for damaged hair as well as skincare products for dry and problem skin.

- Exhibit TH01 is an extract from Companies House website and DUE DIL. They confirm that Ms Harris is a director, along with a Mr John Harris and Mr Vadim Harris.

22) Ms Harris also makes reference to UK trade mark registration no. 2302363 for the mark TIANA. The mark was applied for on 7 June 2002 in the name of BBS Oils-Vegetable Limited, but was subsequently assigned to TFTOL on 1 October 2006. The registration was then "inadvertently lapsed" when it was due for renewal on 7 June 2012. Details of the registration were attached to the witness statement at exhibit TH02.

23) Exhibit TH03 consists of copies of press releases issued by TIANA in 2010, 2011 and 2012. They relate to the beauty range sold under the TIANA brand and its support of fair trade products, particularly from the Philippines.

### *Turnover*

24) Ms Harris provides turnover figures for all of its products in the food and beauty range.

<b>Year</b>	<b>Turnover</b>
2014	1,744,701
2013	1,091,493
2012	712,945
2011	128,594
2010	101,493
2009	74,605

The turnover in relation to the beauty range is as follows:

<b>Year</b>	<b>Turnover (ex. VAT)</b>
2014	£62,964.51
2013	£12,350.43
2012	£3,707.70
2011	£3,507.54

25) With regard to the marketing and advertising spend, Ms Harris states that the “annual PR and marketing budget is now £200,000”<sup>2</sup>.

26) Exhibit TH04 consists of various examples of advertising in relation to the TIANA beauty products dating from 2010 to date. These include features in various magazines dated between 2010 and 2014.

27) Ms Harris’ evidence sets out the extent of use of the mark throughout the UK, stating that their product is sold in 2000 stockists nationwide including Holland and Barrett (who have 620 stores nationwide).

28) Exhibits TH06 and TH07 consist of a large selection of invoices dated between 2010 and 2014. They are addressed to various retailers throughout the UK and for various marketing and advertising activities in the same period. Ms Harris highlights that many of the invoices pre-date and post-date the filing date of the application.

29) Exhibit TH08 outlines the various awards received by TIANA between 2010 and 2014.

30) Ms Harris states that TFTOL’s website was acquired on 13 July 2005 and exhibits TH09, TH10 and TH11 comprise various prints outs from its website showing the beauty products on offer. They are dated from 2006 to early 2010 and extracts from when the witness statement was produced in March 2015. On 12 November 2012 it created its Facebook page<sup>3</sup> and in August 2012 launched its Twitter account<sup>4</sup>.

31) TFTOL’s success led to positive media comments from “high profile supporters”<sup>5</sup> such as Jamie Lee Grace (blogger, broadcaster and author on healthy foods and beauty products), Hollie Wakeham (blogger on beauty products) and articles in the Sunday Times and Daily Mail which Ms Harris states have circulation figures of around 800,000 and 2 million respectively. Ms Harris states that TFTOL’s products have numerous testimonials from customers<sup>6</sup>

32) Ms Harris states that the evidence demonstrates that there have not been any instances of confusion prior to the date that the application was filed nor has it received any complaints from Barony with regard to their use stating that “I would like to make the observation that it is difficult to distinguish the profile of our TIANA brand between our food products and our beauty range”<sup>7</sup>. It is claimed that the evidence supports a claim that there has been honest concurrent use, which I have already addressed.

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<sup>2</sup> Paragraph 8 of the witness statement

<sup>3</sup> Exhibit TH12

<sup>4</sup> Exhibit TH13

<sup>5</sup> Paragraph 16 of the witness statement and examples as exhibit TH14

<sup>6</sup> A selection of these are produced at exhibit TH15

<sup>7</sup> Paragraph 18 of the witness statement



*Witness statement of James Maxwell Stacey and exhibits JMS01 – JMS04*

33) Mr Stacey is a trade mark attorney and partner at Baron Warren Redfern, TFTOL's professional representatives. The witness statement is mainly commentary on Ms McCulloch's witness statement. It also includes dictionary references for cosmetics, dentifrices, essential oils, lotions, perfumery and soap. If necessary, these shall be referred to later in this decision. Further, Mr Stacey has conducted various internet investigations into the use of the TIAMA and concluded that he was unable to find any media use, reviews, etc.

*Witness statement of James Maxwell Stacey and exhibits JMS05 – JMS07*

34) Mr Stacey's second witness statement again consists mainly of commentary and submissions on the other party's evidence. These shall be referred to where necessary.

35) Exhibit JMS05 consists of photographs taken at a Tesco supermarket in Wembley on 13 June 2015. "The photographs include aisle signage which references BODY SPARYS and shelving signage which references BODY SPRAYS and shelving signage, positioned below the aisle signage which references DEODORANTS. A further photograph of shelving in that section shows **body sprays** on the shelving below the shelving signage of DEODORANTS".

36) Exhibit JMS06 consists of photographs taken at an Asda store on 12 June 2015. The photographs show that the same as JMS05, i.e. that in the "deodorants" area they also sell body sprays. Exhibit JMS07 is the same, but in a Boots store. Mr Stacey states at paragraph 17 that:

"It will be noted that each retailer grouped deodorants and body sprays together, which I believe provides clear indication that the retail trade considers the body sprays appearing on the shelves of the stores in question, which are clearly the same in nature and with similar price points to the BUP body sprays deodorants, to be a deodorant product, to be sold as such rather than as a cosmetic or perfumery as argued by BUP"

**Barony's evidence in reply**

*Witness Statement of Jacqueline McKay and exhibit JM1*

37) Ms McKay is a trade mark attorney and director of Murgitroyd & Company, Barony's legal representatives. As their trade mark attorney, as one would expect, most of her statements are composed of legal arguments and references to cases which discuss various comparisons of goods. I will come to these later.

**PROOF OF USE**

**Relevant statutory provision: Section 6A:**

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.”

38) 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.”

## The relevant periods

39) Barony is required to provide genuine use of its TIAMA mark not just to overcome the revocation claim under section 46(1)(a) of the Act but also to rely upon the registration for its opposition claim<sup>8</sup>. To summarise, the relevant five year periods and for what goods Barony are required to prove genuine use of its TIAMA mark are as follows:

Action	Relevant period	Goods
Revocation	5 November 2005 – 4 November 2010 <sup>9</sup>	Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices
Opposition <sup>10</sup>	3 May 2009 – 2 May 2014	Perfumery; cosmetics; deodorants for personal use

40) Section 46(3) of the Act states:

“46(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”

41) These proceedings involve a non-use revocation action, and opposition proceedings whereby the same party is required to provide proof of use. The guidance in assessing the revocation and the proof of use provisions are the same so it is prudent to assess whether there has been genuine use of the registration for both sets of actions.

42) The relevant section 6A period is later than the relevant section 46(1)(a) period. Therefore, if Barony can demonstrate genuine use of its TIAMA registration for the opposition period then it follows under the provision of section 46(3) that the registration shall not be revoked for the earlier revocation period. The only caveat to this is that the revocation action was not against “deodorants for personal use”, so it will not be revoked. However, in the applicant’s counterstatement in the opposition action, they requested proof of use for all of the relied upon goods. Therefore, whilst “deodorants for personal use” are not subject to the revocation action and shall remain on the register, unless the opponent has demonstrated genuine use for these goods, then they may not rely upon them for the opposition proceedings.

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<sup>8</sup> As required under Section 6A of the Act (as amended)

<sup>9</sup> Effective date of registration sought is 5 November 2010

<sup>10</sup> Trade mark application no. 3037243 was published on 2 May 2014

## Case law

43) In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeo SRL v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Ms Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

44) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

45) It is clear from the evidence that the only product being used is body sprays. There is no evidence to show use of the mark on any other product. Mr Stacey argues that “deodorants” are the same goods as “body sprays”. He has filed evidence which shows that the goods are sold in very close proximity to one another and even examples of products which make reference to “deodorising body sprays”. I accept that deodorants may be fragranced to give a pleasant spray. However, I do not accept that deodorants and body sprays are the same. The evidence shows<sup>11</sup> that the definition of deodorants is “1. a substance applied to the body to suppress or mask the odour of perspiration or other body odours”. The purpose of a body spray is to enhance the smell of one’s body. It may be either applied directly to the body or over one’s clothes. Whilst there is a fine distinction between the goods, they are not the same products and are not described in the same manner.

### **Proof of use outcome**

46) In view of the above, I find that Barony has sufficiently proven genuine use of the mark TIAMA for class 3 “perfumery in the form of body fragrance sprays”. These are the goods which Barony may rely upon for the opposition proceedings.

## **OPPOSITION**

### **SECTION 5(2)(b)**

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

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<sup>11</sup> Exhibit JMS02 of the witness statement of Mr James Maxwell Stacey

## The principles

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

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

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

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

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

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

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

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

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

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

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

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

### **Average consumer**

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

50) 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 at paragraph 60 the average consumer in these terms:

“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.”

51) The goods in question are perfumery in the form of body sprays. They are goods which would be bought by the general public. They will be purchased following a visual perusal of the goods on a shelf or website, though I do not discount some aural recommendations. Generally the goods will not be expensive though consumers will want to ensure that they like the smell of the product so are likely to pay more attention. Accordingly, I consider the level of care and attention paid when purchasing the goods to be above low but not as high as medium.

### **Comparison of goods**

52) In the judgment of the Court of Justice of the European Union in *Canon, Case C-39/97*, the court stated at paragraph 23 of its judgment that:

“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”.

53) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

<b>Applicant's goods</b>	<b>Opponent's goods</b>
Skin and hair products	Perfumery in the form of body fragrance sprays

54) The applicant's skin and hair products are goods which are intended to enhance, clean and/or preserve a person's skin or hair. They would be applied to the relevant part of the body either as a shampoo, conditioner, cream, liquid or spray. The opponent's goods are also applied to the body, as a spray. However they are intended to impart a pleasant smell rather than enhance, clean or preserve. Therefore, the nature and intended purpose of the goods do differ. Notwithstanding this they do form part of a person's beautification process. Whilst the goods are not in direct competition with one another, they would be sold in the same shops. They are not likely to be sold next to one another or in the same aisle, but are likely to be in the same area. Nevertheless, the channels of trade are likely to be the same.

55) Taking all of the relevant factors into consideration, I find that the respective goods are similar to a low degree.

### **Comparison of marks**

56) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”



57) 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.

58) The respective trade marks are shown below:

<b>Earlier mark</b>	<b>Application</b>
TIAMA	TIANA

59) Each of the respective marks comprise of one single invented word. Therefore, the initial impression of each is that of an invented word which has no meaning for the goods nor does it allude to a characteristic thereof. During the hearing Mr Stacey did concede that the respective marks are similar but not “identical or substantially similar” as argued by Ms Lecky.

60) Visually, both marks consist of five letters with the only difference being the fourth letter of the application being N and the opponent’s being M. Since this is only one letters difference and it is at the end of the mark, it does not materially alter the level of visual similarity which I consider to be high.

61) Conceptually neither mark has no meaning nor do they allude to any meaning. Therefore, there is no conceptual comparison. The position is neutral.

62) Aurally, both marks will be pronounced as 3 syllables. The first syllable will sound like either “tie” or “tee”. The second syllable differs slightly given the “M” in the earlier mark and the “N” in the application. The final syllable will be pronounced as “A” and is the same for each mark. In view of the aforementioned, I find that the marks are aurally similar to a high degree.

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

63) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”

64) Barony has filed evidence of use of the mark but has not claimed enhanced distinctive character due to the use made of the mark. Nevertheless, I do not consider its use to have been sufficient to warrant an enhanced level of distinctive character. The turnover figures provided have not been broken down into how much they relate to TIAMA. Therefore, I cannot be satisfied that Barony has sufficiently demonstrated an enhanced degree of distinctive character through its use.

65) The earlier mark is not descriptive of the subject goods, nor does it allude to a characteristic thereof. It is an invented single word which has no meaning. Accordingly, I find that the inherent distinctive character of the mark is high.

### **Likelihood of confusion**

66) Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I must also keep in mind the distinctive character of the opponent’s mark as the more distinctive these marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture retained in their mind.

67) To summarise, I have found that:

- The inherent distinctive character of the earlier mark is high.
- The respective marks are invented words which do not allude to any characteristic of the goods.
- The goods are similar to a low degree.
- The respective marks are visually and aurally highly similar. There is no conceptual comparison so the position is neutral.
- The goods will be purchased following a visual perusal of the goods on a shelf. The level of attention paid when purchasing the goods are above low but not as high as medium

68) Having considered each of my findings, I conclude that there is a likelihood of direct confusion between the marks. The respective marks are very similar, which does offset any lesser degree of similarity between the goods and imperfect recollection.

### **Outcome**

69) The opposition under section 5(2)(b) succeeds in its entirety.

### **Section 5(3) and 5(4)(a)**

70) Since the opponent has already been successful, there is no need to consider the remaining grounds of opposition. Although the grounds were not dropped, Ms Lecky's submissions were brief and the grounds were not pursued with vigour. On the other hand, Mr Stacey had taken the time to prepare his submissions.

### **REVOCAION (no. 500489)**

#### **Pleadings**

71) With regard to the revocation action, Barony is the registered proprietor of trade mark registration no 2388167 consisting of the trade mark TIAMA. Pertinent details of the registration are as follows:

<b>Mark:</b>	TIAMA
<b>Filing date:</b>	30 March 2005
<b>Date of entry in register:</b>	4 November 2005
<b>Goods:</b>	Class 3 "Bleaching preparations and other substances for laundry use; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use."

72) TFTOL seeks partial revocation of the TIAMA registration on the grounds of non-use based upon Section 46(1)(a) of the Act. The revocation is against:

"Bleaching preparations and other substances for laundry use; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices" but not "deodorants for personal use"

73) Barony filed a counterstatement denying the claim. In their counterstatement they only claim to have used their registration on the following goods:

"Soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices"

#### **The position so far**

74) I have already found that during the later opposition period (under section 6A), Barony sufficiently demonstrated use of its TIAMA mark for class 3 "perfumery in the form of body fragrance sprays". Therefore, under the provisions of section 46(3) it follows that these goods cannot be revoked. Further, the revocation was not

directed against class 3 “deodorants for personal use”. Therefore, the registration shall remain registered for the following goods:

“perfumery in the form of body fragrance sprays; deodorants for personal use”

75) The class 3 “bleaching preparations and other substances for laundry use” were not defended so these goods shall be revoked. Therefore, the only issue to address is whether there was genuine use of TIAMA during the revocation period<sup>12</sup> (5 November 2005 to 4 November 2010) for the following goods:

Class 3: soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;

## **Legislation**

76) Section 46(1)(a) of the Act states

“46. –(1) The registration of a trade mark may be revoked on any of the following grounds –

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

### **Is the position any different for the section 46(1)(a) revocation period?**

77) It is clear from the evidence that other than use on “perfumery in the form of body sprays”, Barony did not use the registration on any other goods. Other than the aforementioned goods there were no photographs, references in invoices or marketing materials. Therefore, I am satisfied that the only use made of the TIAMA mark for the revocation period is for “perfumery in the form of body sprays”. Therefore, it shall be revoked for all of the class 3 goods, except for “Perfumery in the form of body sprays; Deodorants for personal use”.

## **OVERALL OUTCOME**

78) The opposition against class 3 of trade mark application no. 3037243 succeeds and it shall be refused, subject to appeal, for “Skin and Hair products”. The opposition was not directed against classes 29, 30 and 32 and so it shall proceed to registration for the following goods:

Class 29: Coconut Oil, Coconut Butter, Desiccated Coconut, Coconut Water, Coconut Products, Coconut Oil Derivatives, Palm Oil, Palm Oil Derivatives

Class 30: Coconut Flour, Coconut Sugar, Honey

Class 32: Coconut Water

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<sup>12</sup> Section 46(1)(a) of the Act

79) The revocation against trade mark registration no. 2388167 was not defended in relation to class 3 “Bleaching preparations and other substances for laundry use”. It was not directed against “deodorants for personal use”. Accordingly, trade mark registration no. 2388167 shall, with effect from 5 November 2010, be revoked for the following goods:

“Bleaching preparations and other substances for laundry use; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices”

80) Subject to appeal, it shall remain registered for:

“Perfumery in the form of body sprays; Deodorants for personal use”

### **COSTS**

81) Barony has been successful in the opposition and TFTOL has been largely successful in the revocation claim. On this basis, and in view of Mr Stacey having to unnecessarily prepare for the section 5(3) and 5(4)(a) claims, it appears appropriate for each party to bear its own costs.

**Dated this 30<sup>th</sup> day of December 2015**

**MARK KING**  
**For the Registrar,**  
**The Comptroller-General**