

O/571/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003474958

BY MUNDARE LIMITED

TO REGISTER:

pura.
mypura.com

AS A TRADE MARK IN CLASSES 3, 5 AND 35

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 421447 BY

OPTIMA CONSUMER HEALTH LIMITED

BACKGROUND AND PLEADINGS

1. On 13 March 2020, Mundare Limited (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 3: Baby care products (non-medicated); baby wipes; baby powders; baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion; baby suncream.

Class 5: Baby foods; milk powder for babies; dietetic substances for babies; baby diapers; babies’ napkins; babies’ creams (medicated); dietetic preparations for children.

Class 35: Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; online retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; advisory and consultancy services relating to all of the aforesaid.

2. The applicant’s mark was published for opposition purposes on 12 June 2020 and, on 14 September 2020, it was opposed by Optima Consumer Health Limited (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the sections 5(2)(b) and 5(3) grounds, the opponent relies on the following trade marks:



UK registration no. 2167642

Filing date 23 May 1998; registration date 8 January 1999

Relying on some goods, namely:

Class 3: Hair lotions

Class 5: Pharmaceutical preparations; dietetic substances, all incorporating aloe vera

("the opponent's first mark");



UK registration no. 2405436

Filing date 2 November 2005; registration date 28 April 2006

Relying on some goods, namely:

Class 3: Hair lotions; non-medicated toilet preparations; non-medicated skin care preparations; non-medicated balms, ointments, creams, gels, lotions.

Class 5: Dermatological products; medicated skin care preparations; dietetic substances adapted for medical use; food supplements; herbal preparations.

("the opponent's second mark"); and



EUTM: 831818¹

Filing date 22 May 1998; registration date 6 October 1999

Relying on some goods, namely:

Class 3: Hair lotions.

Class 5: Pharmaceutical preparations; dietetic substances, all incorporating aloe vera

("the opponent's third mark").

3. In respect of the opponent's third mark, the limitation relied on, being "all incorporating aloe vera" is not included within the mark as registered. Further, while the term "dietetic substances" is included, it is expressed as "dietetic substances adapted for medical use". Given that both "dietetic substances, all incorporating aloe vera" and "dietetic substances adapted for medical use" are present in the opponent's first and second marks, respectively, I do not consider this issue will affect the decision. I will, therefore, proceed on the basis that the opponent's third mark relies on "hair lotions" in class 3 and "pharmaceutical preparations" in class 5, only.
4. Under its section 5(2) ground the opponent claims that in view of the similarity of the applicant's mark and the opponent's marks and the identity/similarity of the goods and services, there is a likelihood of confusion which includes a likelihood of association. Further, under its section 5(3) ground the opponent claims that its marks enjoy a considerable reputation and that use of the applicant's mark would obtain a competitive advantage, would benefit from its prestige and reputation, whilst simultaneously causing dilution and tarnishment to the opponent's marks.
5. In respect of its opposition under section 5(4)(a), the opponent alleges that it has been using the following sign:

¹ Although the UK has left the EU and the EUTM relied upon by the opponent now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application



throughout the UK since July 1997 in respect of the following goods:

Class 3: Aloe vera gel for cosmetics purposes; skin lotion; hair conditioner; sunscreen; after sun lotions; shampoo.

Class 5: Aloe vera gel for therapeutic purposes; food supplements

6. The opponent claims that it has acquired a considerable amount of goodwill in its mark as a result of the use made of it in the UK. Further, the opponent claims that use of the applicant's mark will result in a misrepresentation that will cause damage to the opponent, including damage to goodwill, damage to reputation, lost sales, dilution and tarnishment.
7. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use of its marks.
8. The relevant period in respect of the proof of use that the opponent must show for its goods is 14 March 2015 to 13 March 2020. As for the relevant date at which point the opponent must be shown to have acquired a reputation under its section 5(3) ground and goodwill under its section 5(4)(a) ground is 13 March 2020, being the date of the application at issue.
9. The opponent is represented by Wynne-Jones IP Limited. The applicant was initially represented in these proceedings by HGF Limited but is now unrepresented. The opponent has filed evidence in the form of the witness statement of Mr Matthew James Richard Harvey dated 18 February 2021. The applicant did not file any evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

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

EVIDENCE

The Witness Statement of Mr Matthew James Richard Harvey dated 18 February 2021

11. Mr Harvey is the Managing Director of the opponent, a position that he had held for five months prior to the statement being given. Overall, as at the date of the statement, Mr Harvey had been employed by the opponent for five years and seven months.

12. The background of the marks is then discussed and Mr Harvey states that use of the 'ALOE PURA' mark began in 1997 for aloe vera gels and food supplements. Since then, Mr Harvey explains that the opponent has continued to use its marks and developed a wider range of products. The various ranges of products launched is then discussed. Of these, I note that in 2001 the opponent introduced a sun care range which included sun lotion and after sun lotions. Also in 2001, the opponent launched a hair care range that included shampoo and conditioner. According to Mr Harvey, these products are still sold today. A number of screenshots obtained from the internet archive facility 'The Wayback Machine' between the dates of 15 May 2006 and 27 November 2018 show images of these products together with a wide range of other types of products.² Given the website address on the screenshots, it appears that they are taken from the opponent's own website. Despite some of the earlier screenshots showing the prices of the products in pounds, it doesn't seem to have these products listed for sale but is, instead, a list of products. While I do not intend to list each item shown, I note that it includes various products in the opponent's juice, skin care, hair care, sun care and capsules and tablets ranges. Due to the size of the products shown, it is not entirely

² Exhibit MH-02

clear what trade mark is shown on them. While it is possible to make out a green trade mark consisting of the words 'Aloe Pura', it is not clear whether it is the opponent's marks as registered or the following mark, that also features prominently throughout this evidence:



13. I also note that some products, namely Aloe Vera Herbal Conditioner, Aloe Vera Herbal Shampoo Dry Hair and Aloe Vera Shampoo bear the following mark:



14. Mr Harvey sets out that since 1997, the opponent's approximate total monetary value of sales under its trade marks in the UK is over £30 million. No breakdown of this figure is provided in relation to the particular goods relied on.

15. In 2001, the opponent began selling its products through Holland & Barrett and Boots. In 2003, it began selling its products through Superdrug. Screenshots of these retailers' websites are included within the evidence that show a range of the opponent's goods, bearing the same trade mark shown at paragraph 12 above (albeit in different shades of green).³ While this evidence is noted, the screenshots are all dated outside the relevant period for proof of use and after the relevant date in respect of the section 5(3) and 5(4)(a) grounds.

16. The opponent began listing after sun lotion, hair conditioner, gel and shampoo on Amazon in 2008. This was followed by the addition of food supplements in 2011 and lotions and sun lotions in 2016. Screenshots showing the listings on

³ Exhibits MH-03 to MH-05

Amazon.co.uk are included within the evidence.⁴ I note that some products are listed as 'Amazon Choice' products, although I have no further evidence as to what this means or how it is determined what products qualify for this listing. I also note that the products listed all show the opponent's marks on their packaging. The screenshots are all dated outside the relevant period for proof of use and after the relevant date in respect of the section 5(3) and 5(4)(a) grounds. Despite this, the screenshots do contain evidence of use by way of reviews from verified purchases from within the relevant period/prior to the relevant date. Further, of the 10 products shown for sale, five of them are sold by a number of third-party sellers whereas the remaining five are sold directly by Amazon. Of this evidence, I note the following:

- a. A product called 'Aloe Vera Gel' was made available for sale on 12 April 2014 and has 1,866 'global ratings' with two verified purchases from within the relevant period/prior to the relevant date;
- b. A product called 'After Sun Lotion' was made available for sale on 2 February 2008 and has 354 'global ratings' with four verified purchases from within the relevant period/prior to the relevant date;
- c. A product called 'Aloe Vera Herbal Conditioner' was made available for sale on 2 February 2008 and has 30 'global ratings' with seven verified purchases from prior to the relevant date, with six of those also falling within the relevant period for proof of use;
- d. A product called 'Aloe Vera Lotion Shea Butter' was made available for sale on 5 January 2016 and has 106 'global ratings' with one verified purchase from within the relevant period/prior to the relevant date;
- e. A product called 'Aloe Vera Food Supplement Capsules' was made available for sale on 17 May 2012 and have 397 'global ratings' but no verified purchases from within the relevant period/prior to the relevant date;
- f. A separate listing for 'Aloe Vera Food Supplement Capsules' is shown as being available for sale on 1 December 2012 and has 318 'global ratings' but no verified purchases from within the relevant period/prior to the relevant date;

⁴ Exhibit MH-06

- g. A separate listing for 'Aloe Vera Gel' is shown as being available for sale on 2 February 2008 and has 4,557 'global ratings' but no verified purchases from within the relevant period/prior to the relevant date;
- h. A product called 'Aloe Vera Juice (Food Supplement)' was made available for sale on 2 February 2008 and 4,223 'global ratings' but no verified purchases from within the relevant period/prior to the relevant date;
- i. A product called 'Aloe Vera Herbal Shampoo' was made available for sale on 2 February 2008 and has 44 'global ratings' but no verified purchases from within the relevant period/prior to the relevant date; and
- j. A product called 'Aloe Vera Sun Lotion' was made available for sale on 23 May 2014 and has 176 'global ratings' but no verified purchases from within the relevant period/prior to the relevant date.

17. An article from the Daily Mail titled "As the heatwave strikes Britain which sun screen works best at stopping sunburn?" dated 11 July 2010 is provided.⁵ I note that the opponent's 'Aloe Pura organic aloe vera sun lotion' was listed as number 9 on a list of "the latest sunscreens available". The article is dated outside the relevant period for proof of use so will not assist the opponent on that front. However, it is still relevant in respect of the claims under section 5(3) and 5(4)(a).

18. Mr Harvey then discusses a number of awards that the opponent's products have obtained.⁶ A number of screenshots from the website yourhealthyliving.co.uk that show 'Aloe Vera Lotion' as a nominee for 'Best Toiletries Products' 2017, 'Aloe Vera Gel' as a nominee for 'Best Toiletries or Beauty Product' in 2019 and 'Aloe Pura Aloe Vera Juice' as an 'Editor's Choice' for 'Best Gut Health'. While the first two nominations are noted, the latter screenshot is undated and it is, therefore, not clear whether this award was received during the relevant period/prior to the relevant date or not. I am, therefore, unable to consider the undated screenshots.

19. Mr Harvey states that the opponent's products are sold by other retailers including, but not limited to, Big Green Smile, HealthStuff and pharmacies. A number of invoices are provided in support of this; however, I note that save for one invoice

⁵ Exhibit MH-07

⁶ Exhibit MH-08

addressed to Holland & Barrett, the recipient of the products has been redacted. The only information provided in relation to the recipients of the orders is the town/county the products are being shipped to. Mr Harvey also states that the reference to 'AP' in the description column of the invoices is a reference to the 'ALOE PURA' brand. I have no evidence or submissions as to what the other initials in the invoices (such as DO, RG, OP, IG and AL, amongst others). I have only considered products that bear the initials AP in assessing these invoices. Of the invoices, I note the following:

- a. There are 11 invoices, two of which being dated after the relevant date, which is also outside the relevant period. The remaining invoices are dated between 3 January 2013 and 2 July 2019. The earliest four invoices, being those dated 3 January 2013, 8 February 2013, 20 March 2014 and 9 March 2015 are outside the relevant period for proof of use but remain relevant in respect of the section 5(3) and 5(4)(a) grounds of this opposition;
- b. The recipients of the goods sold are located in Staffordshire, London, Ruislip, Somerset, Cornwall and Powys; and
- c. The invoices show a total sale of 1,962 products for a sum of £9,269.42 over a period of six and a half years.

20. The invoices show a wide range of products being sold. I have broken these down into separate categories, being 'sun lotions', 'lotions', 'gels', 'shampoo', 'juice' and 'food supplements'. The invoices show the following level of sales for each category of goods:

- a. 24 total sales of 'After Sun' for a sum of £78.56;
- b. 1,581 total sales of 'Sun Lotion' for a sum of £8,009.60. However, I note that the bulk of these sales (1,500) stem from one transaction to Holland & Barratt in 2017;
- c. 36 total sales of 'Aloe Vera lotion' for a sum of £98.64.
- d. 147 total sales various types of 'Aloe Vera' gel for a sum of £342.32;
- e. 18 total sales of shampoo (including 'dry shampoo') for a sum of £48.78;
- f. 51 total sales of 'Aloe Vera Juice – Max Strength' for a sum of £260.52; and

g. 105 total sales of various different types of food supplements for the sum of £388.40. For completion, each different type of food supplement is broken down as follows:

- (i) 30 sales of 'Advance Colax Tabs' for the sum of £112.35;
- (ii) 25 sales of 'Gentle Action Colax Tabs' for the sum of £105.00;
- (iii) 18 sales of "Super Strength Aloe Vera Tablets" for a total of £67.24;
- (iv) 5 sales of 'Aloe Peppermint and Chamomile' for a total of £20.80;
- (v) 2 sales of 'Joint Complex' for a total of £15.40;
- (vi) 10 sales of 'Gentle Action' for a total of £42.50;
- (vii) 3 sales of a 'Aloe Vera Liquid Fibre' for a total of £13.89;
- (viii) 6 sales of 'Advanced Colon Cleanse Tabs' for a total of £27.60; and
- (ix) 6 sales of 'Joint Complex Gel' for a total of £26.22.

21. Further to the breakdown above, some of these sales fall outside the relevant period for assessing proof of use. I will not address the separate level of sales here but will instead reflect it in my assessment on proof of use below.

22. Mr Harvey states that the opponent's marks have been used for lip balm, gel, liquid food supplements, food supplements, sun screen, sun lotion, after sun lotion, shampoo and hair conditioner.

23. Mr Harvey then goes on to set out the approximate annual monetary turnover in the UK, being £1.9 million for 2014, £2 million for 2015, £2 million for 2016, £2 million for 2017, £2.2 million for 2018, £2 million for 2019 and £2.6 million for 2020. While the figures are noted, the figures for 2020 will, for the most part, fall outside the relevant period/after the relevant date. Further, the figures from 2014 and a proportion of those from 2015 fall outside the relevant period in respect of the proof of use issue only but remain relevant for the section 5(3) and 5(4)(a) grounds. No specific breakdown of these figures is provided.

24. Marketing expenditure is also discussed and Mr Harvey states that the approximate amount spent annually on advertising the goods sold under the opponent's marks in the UK is £20,000 for 2014, £25,000 for 2015, £30,000 for

2016, £35,000 for 2017, £40,000 for 2018, £40,000 for 2019 and £45,000 for 2020. The same comments made regarding the relevance of these figures in respect of the relevant period/relevant date at paragraph 23 above also apply here. No breakdown of the expenditure is provided. In support of the advertising spend, Mr Harvey has included three pages of advertising materials from 2012 and 2013 that advertise Aloe Vera Gel, Aloe Vera Sun Lotion and Aloe Vera After Sun Lotion, all of which bear the marks shown at paragraphs 12 and 13 above.

25. As for geographical spread, Mr Harvey sets out where the opponent operates within the UK. While I do not intend to set out every UK town or city that Mr Harvey states that the opponent sells goods under its marks in, I note that it is widespread and covers every area of the UK.

26. Finally, Mr Harvey discusses use of its mark in the EU and that the annual revenue in countries such as (but not limited to) Italy, Spain, the Netherlands, Portugal and Ireland is over half a million pounds per country. No specific breakdown of these figures is provided. Mr Harvey also states that the opponent sells products in over 30 countries worldwide and that it is now a leader in the natural products industry.

DECISION

Section 5(2)(b): legislation

27. Section 5(2) of the Act reads as follows:

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

(a) [...]

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

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

28. Section 5A of the Act states as follows:

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

29. An earlier trade mark is defined in section 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.”

30. Given their filing dates, the opponent’s marks qualify as an earlier trade marks under the above provisions.

Proof of use

31. As I have set out above, the applicant sought to put the opponent to proof of use of its marks because its marks completed their registration process more than 5

years before the date of the application in issue. Therefore, all of the opponent's marks are subject to proof of use pursuant to section 6A of the Act.

32. The relevant statutory provisions are as follows:

“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.

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

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5) 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.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

33. Section 100 of the Act is also relevant, which reads:

“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.”

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

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

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from

others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

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

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

35. Two of the opponent’s marks are UK trade marks meaning that the opponent must show use of these marks in the UK. However, the opponent’s third mark is an EUTM, meaning that the opponent must show use of this mark in the EU. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”⁷

36. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

⁷ Paragraph 36.

Form of the Mark

37. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

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

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

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

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

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

38. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

39. Although this case was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

40. I have set out above that the opponent has used its marks in the following ways in its evidence:



41. Firstly, the opponent's marks are registered in black and white meaning that the use of the colour green in mark a) above is in line with the notional fair use of the marks as registered. Secondly, I am of the view that the addition of the word 'LABORATORIES' in the mark will be seen as a non-distinctive addition that indicates that the products being sold were created or researched in a laboratory, especially given their nature as cosmetic, skin care, hair care and food supplement goods. I, therefore, consider the use shown in mark a) and used throughout the evidence of the opponent is an example of use of the marks as registered in accordance with *Colloseum*.

42. As for mark b), this is not use of the mark as registered. The distinctive character of the opponent's marks as registered is dominated by the words 'Aloe Pura' with the border/background elements and the device element playing much lesser roles. Firstly, the words 'aloe pura' in mark b) are displayed in light green and in a standard lower-case typeface. Secondly, mark b) has no border/background element and its device element, that appears to be a droplet of liquid, is placed between the word 'aloe' and 'pura'. It is my view that the distinctive and dominant component of mark b) is the words 'aloe pura'. While the average consumer will notice the differences between the marks as registered and mark b), I am of the view that those differences do not alter the distinctive character of the opponent's marks as registered. Therefore, I consider the use of mark b) as acceptable use of the opponent's mark in a different form in accordance with the case of *Nirvana*.

Sufficient Use

43. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁸
44. I have no evidence or submissions from either party as to the size of the relevant markets for the goods at issue in the UK or the EU. However, I am of the view that the markets in the UK and the EU for the varying ranges of goods are significant, totalling tens of millions, if not hundreds of millions, of pounds or euros per annum each.
45. The opponent has provided a number of screenshots of goods for sale via Boots', Holland & Barratt's and Superdrug's websites. While the screenshots are dated outside of the relevant period, the opponent's evidence confirms that it began selling its range of goods through Holland & Barrett and Boots in 2001 followed by Superdrug in 2003. I have no reason to doubt that the opponent's goods have not been sold via these retailers since that time.
46. The opponent's evidence also sets out that its annual turnover in the UK alone between 2014 and 2020 is 14.7 million pounds. I acknowledge that some of these figures fall outside the relevant period, being 14 March 2015 to 13 March 2020. There is no forensic way I can accurately attribute these figures to the relevant period as a whole. However, on balance I consider it reasonable to take into account the total figures of 2015 to 2019. This means that the approximate turnover of the opponent during the relevant period is in the region of £10.2 million (whilst taking into account it may be slightly lower or higher due to the inclusion of the figures from 1 January to 13 March 2015 and the absence of figures from 1 January to 13 March 2020). While there is no detailed breakdown of these figures, I have no reason to doubt that they cover all of the goods upon which the opponent relies in these proceedings.

⁸ *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

47. Use of the marks in the EU is also discussed in that the opponent generates an approximate total of over £500,000 per annum in various countries, including Italy, Spain, Netherlands, Portugal and Ireland (amongst others). I consider that each of these countries' markets for the types of goods the opponent sells are significant in the sum of tens of millions, if not hundreds of millions of euros per annum. Against these markets, the turnover figures provided are low. However, they are not insignificant.

48. The opponent has also provided evidence of Amazon.co.uk sales and the invoices that I have discussed above. The breakdown of the invoices above sets out that the opponent, between 2013 and 2019 has shown sales of 1,953 products for a sum of £9,269.42. However, this figure will not apply fully to the issue of proof of use as some of the invoices fall outside the relevant period. Taking this into account, I have prepared the following breakdown of the invoices in respect of the relevant period only:

- a. 12 total sales of 'After Sun' for a sum of £38.96;
- b. 1,577 total sales of 'Sun Lotion' for a sum of £7,987.26. However, I note that the bulk of these sales (1,500) stem from one transaction to Holland & Barratt in 2017;
- c. 36 total sales of 'Aloe Vera lotion' for a sum of £98.64;
- d. 131 total sales various types of 'Aloe Vera' gel for a sum of £302.81;
- e. 18 total sales of shampoo (including 'dry shampoo') for a sum of £48.78;
- f. 48 total sales of 'Aloe Vera Juice – Max Strength' for a sum of £248.16; and
- g. 86 total sales of various different types of food supplements for the sum of £347.01. For completion, each different type of food supplement is broken down as follows:
 - (i) 30 sales of 'Advance Colax Tabs' for the sum of £112.35;
 - (ii) 15 sales of 'Gentle Action Colax Tabs' for the sum of £62.50;
 - (iii) 18 sales of "Super Strength Aloe Vera Tablets" for a total of £67.24;
 - (iv) 5 sales of 'Aloe Peppermint and Chamomile' for a total of £20.80;
 - (v) 2 sales of 'Joint Complex' for a total of £15.40;
 - (vi) 10 sales of 'Gentle Action' for a total of £42.50; and
 - (vii) 6 sales of 'Joint Complex Gel' for a total of £26.22.

49. In total, the invoices show sales of 1,908 products for a sum of £9,071.61 during the relevant period. I accept Mr Harvey's explanation in the evidence⁹ that the reference to 'AP' on the products in the invoices is a reference to the Aloe Pura range and in cross-referencing the goods listed in the invoices with the goods contained in the screenshots of the opponent's website from within the relevant period, I am satisfied that the goods show the opponent's marks or an acceptable variant of the same.

50. As for the Amazon evidence, I am unable to determine the actual level of monetary value from these sales. This is because there is no confirmation that the price shown on the screenshots is the price at which the products were sold, especially considering the fact that the screenshots are dated some 11 months after the end of the relevant period. Therefore, I can only consider the number of sales made, being 2 sales of Aloe Vera Gel, 4 sales of After Sun Lotion, 6 sales of Aloe Vera Herbal Conditioner and 1 sale of Aloe Vera Food Supplement Capsules. While I acknowledge that the Amazon evidence contains a significant number of 'global ratings', I do not consider this to be evidence of sales in the UK or the EU. This is because 'global ratings' are undated meaning that they could relate to sales that were made outside the relevant period. Further, even taking into account that the products are listed on Amazon.co.uk, I am conscious that international users are able to purchase goods from Amazon.co.uk meaning that a proportion of these ratings may include those given by customers outside the UK or EU. It is, therefore, impossible for me to assess the actual level of global ratings issued by UK or EU customers within the relevant period.

51. I also note that the opponent's advertising expenditure for the relevant period (being on the same basis of the calculation made at paragraph 46 i.e. 2015 to 2019) stands at £170,000. While I note screenshots of advertising materials are included within the evidence, these are outside the relevant period and cover a limited range of goods. There is no breakdown of these figures and, in comparison to the size of the relevant markets, they are low. However, the expenditure is not

⁹ Paragraph 18 of the Witness Statement of Matthew James Richard Harvey dated 18 February 2021

insignificant and, in my view, it does indicate a genuine attempt by the opponent to generate a presence in the marketplace for its goods.

52. Further, the opponent has included a list of 30 areas across the breadth of Scotland, England and Wales where it claims to have sold its goods. Further, the invoice evidence also points to widespread use across the UK. As for use within the EU, the opponent's evidence sets out that it has used its marks in Italy, Spain, Netherlands, Portugal and Ireland (amongst others). This indicates widespread use of the marks in the EU.

53. Of the use shown by the opponent, I note the following:

- a. As set out above, I am of the view that the relevant markets in the UK and the EU for the varying ranges of goods are significant, totalling tens of millions, if not hundreds of millions, of pounds or euros per annum each. The total turnover of approximately £10.2 million over five years against the relevant markets is, in my view, not quantitatively significant. However, the case law set out above states that use does not need to be quantitatively significant for it to be deemed genuine and that minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the goods;
- b. The nature of the goods at issue are that they will be purchased frequently. Given that the opponent's goods are relatively inexpensive goods, the total turnover of £10.2 million over five years suggests a reasonably frequent level of sales;
- c. The use shown relates to a number of goods that can be said to fall within the broader categories of the goods for which the opponent relies on in these proceedings;
- d. The evidence points towards sales to customers across the entirety of the UK and also to countries within the EU. I am of the view that this is evidence of widespread geographical use of the marks; and

- e. While the advertising expenditure is relatively low in comparison to the size of the relevant markets, the figure of £170,000 over five years is not insignificant.

54. When assessing the evidence as a whole, I am satisfied that the evidence points to genuine use of the opponent's marks and indicates a justified attempt in the economic sector concerned for the purpose of creating or preserving market share for shampoo, skin lotion, skin gels, sun lotion, after sun lotion, food supplement and dietetic substances, all incorporating aloe vera.

Fair Specification

55. I must now consider whether, or the extent to which, the evidence shows use of the opponent's marks in relation to the all of the goods relied upon.

56. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

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

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

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

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

57. I remind myself that the goods relied upon by the opponent are as follows:

The opponent's first mark:

Class 3: Hair lotions.

Class 5: Pharmaceutical preparations; dietetic substances, all incorporating aloe vera.

The opponent's second mark

Class 3: Hair lotions; non-medicated toilet preparations; non-medicated skin care preparations; non-medicated balms, ointments, creams, gels, lotions.

Class 5: Dermatological products; medicated skin care preparations; dietetic substances adapted for medical use; food supplements; herbal preparations.

The opponent's third mark:

Class 3: Hair lotions.

Class 5: Pharmaceutical preparations.

58. The opponent claims that its marks have been used for lip balms, gels, liquid food supplements, food supplements, sun screen, sun lotion, after sun lotion, shampoo and hair conditioner.

59. Firstly, I note from the evidence that lip balms fall under the 'Aloe Dent' range of goods. Therefore, I do not consider the evidence shows genuine use of lip balms under the opponent's marks. Secondly, I note that there is a lot of overlap in the opponent's specification. For example, "non-medicated balms, ointments, creams, gels, lotions" is included as its own term but goods within that term will also fall within the broader term of "non-medicated skin care preparations". Additionally, "food supplements" may include food supplements that consist of various herbs, meaning that they may also fall within "herbal preparations".

60. The turnover evidence provided by the opponent is not broken down into the types of goods sold. However, there is additional evidence that assists in painting a picture of what goods have been sold by the opponent, being the invoice evidence, Amazon sales and the Boots, Superdrug and Holland & Barrett screenshots. While the latter evidence of screenshots are from outside the relevant period, I am content to conclude that those goods shown on those screenshots attracted a reasonable level of sales during the relevant period on the basis that the opponent's evidence confirms those goods were sold via those retailers since either 2001 or 2003.

61. Based on the evidence, I make the following findings in respect of fair specification:

Non-medicated toilet preparations; non-medicated skin care preparations; non-medicated balms, ointments, creams, gels, lotions.

62. In my view, toilet preparations are goods that are used to cleanse, improve or alter the complexion of skin, hair or teeth. In respect of all of the above terms, I am of the view that the opponent has shown use of shampoo, skin gels, skin lotions, sun lotion and after sun lotion. The evidence points to the fact that all of these goods are non-medicated. All of these goods can fall within each of the broader terms shown above. In my view, all of these goods are capable of being in their own sub-categories of goods and I do not consider that the use of five types of goods over a number of different broad categories of goods is sufficient to grant fair specification for those terms. No use has been shown for any balms or ointments. As a result, for the purpose of fair specification, I limit the opponent to “non-medicated shampoo”, “non-medicated skin gels and lotions”, “non-medicated sun lotion” and “non-medicated after sun lotion” in its second mark’s specification.

Hair lotion.

63. The opponent has shown use of shampoo. However, I do not consider that shampoo falls within this category. While conditioner is, in my view, a type of hair lotion, the opponent has not shown any sales of hair conditioner during the relevant period. Therefore, I do not consider there has been any use of these goods.

Dermatological products; medicated skin care preparations.

64. I consider these goods to be medicinal. I have no evidence to suggest that the goods for which the opponent has proven use are for medicinal purposes or goods that are prescribed by doctors. Therefore, I do not consider that the opponent’s evidence shows use of these goods.

Food supplements; pharmaceutical preparations.

65. The opponent's evidence contains a wide range of different types of food supplements. The term "food supplements" is included in the opponent's second mark's specification. I also note that "dietetic substances, all incorporating aloe vera" is present in the opponent's first mark's specification. I consider food supplements are dietetic substances. The evidence shows a wide range of different types of tablets, capsules and juices that are categorised on their packaging as 'food supplements'. Given the wide range of the different type of food supplements that the opponent's has demonstrated use for (ten different types), I consider it appropriate to allow the opponent to proceed with "food supplements" in the opponent's second mark's specification and "dietetic substances, all incorporating aloe vera" in the opponent's first mark's specification (on the basis that all products shown contain aloe vera as an ingredient). However, I do not consider that the food supplements for which the opponent has shown use for fall within the category of "pharmaceutical preparations" in the opponent's third marks' specification. This is because pharmaceuticals are categorised as drugs whereas the evidence shows only food supplements which are not types of drugs. Even if that is incorrect, I consider food supplements to be an independent sub-category and that use in relation to this sub-category would not justify retaining the broader term.

Herbal preparations.

66. While the opponent's goods all incorporate aloe vera, which is a herb, I consider that my findings above provide a fair specification to the opponent without having to consider this term in detail. However, even if I were to consider "herbal preparations", it is such a broad term that covers such a wide range of goods that can be made of herbs that I would only find fair specification in respect of those specific sub-categories of goods that I have already accounted for above.

67. In summary, for the purpose of fair specification, I limit the opponent's specifications to the following goods:

The opponent's first mark:

Class 5: Dietetic substances, all incorporating aloe vera

The opponent's second mark:

Class 3: Non-medicated shampoo; non-medicated skin gels and lotions;
non-medicated sun lotion; non-medicated after sun lotion.

Class 5: Food supplements.

68. I do not consider that the opponent has proven use of any of the goods contained within its third mark's specification. As a result, the opposition reliant upon the opponent's third mark in respect of the section 5(2)(b) grounds fails.

Section 5(2)(b): case law

69. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods and services

70. In light of my finding above, the competing goods and services are as follows:

The opponent's goods	The applicant's goods and services
<p><i>The opponent's first mark:</i></p> <p><u>Class 5</u> Dietetic substances, all incorporating aloe vera</p> <p><i>The opponent's second mark:</i></p> <p><u>Class 3</u> Non-medicated shampoo; non-medicated skin gels and lotions; non-medicated sun lotion; non-medicated after sun lotion.</p> <p><u>Class 5</u> Food supplements.</p>	<p><u>Class 3</u> Baby care products (non-medicated); baby wipes; baby powders; baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion; baby suncream.</p> <p><u>Class 5</u> Baby foods; milk powder for babies; dietetic substances for babies; baby diapers; babies' napkins; babies' creams (medicated); dietetic preparations for children.</p> <p><u>Class 35</u> Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; online retail services in relation</p>

	to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; advisory and consultancy services relating to all of the aforesaid.
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71. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

72. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

73. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

74. I have detailed submissions from the opponent regarding the similarity of the goods and services. While I do not intend to reproduce them here, I have taken them into account in making my following assessment.

Class 3 goods

75. “Baby care products (non-medicated)” in the applicant’s specification can cover a wide range of different types of goods, including (but not limited to) skin lotions and gels, shampoo and suncream, all for babies. The opponent’s second marks’ specification contains “non-medicated shampoo”, “non-medicated skin gels and lotions”, “non-medicated sun lotion” and “non-medicated after sun lotion”. All of the opponent’s goods can cover goods used for babies. Therefore, I am of the view

that the opponent's goods all fall within the broader term of the applicant meaning that these goods are identical under the principle outlined in *Meric*.

76. "Baby shampoo" in the applicant's specification falls within the broader category of "non-medicated shampoo" in the opponent's second mark's specification. These goods are, therefore, identical under the principle outlined in *Meric*.

77. "Baby conditioner" in the applicant's specification shares a level of similarity with "non-medicated shampoo" in the opponent's second mark's specification, which can include baby shampoo. I consider there to be an overlap in user in that both goods will be purchased by parents who may purchase both shampoo and conditioner for their babies. One is a conditioner and the other is a shampoo meaning that there is no overlap in nature. There is also an overlap in purpose due to the fact that both goods are used to for the benefit of the user's hair. Method of use will also overlap on the basis that both goods will be massaged into the hair and then washed out. Finally, there is an overlap in trade channels on the basis that producers of shampoos also tend to produce hair conditioner. Overall, I consider these goods to be similar to a high degree.

78. "Baby lotion" in the applicant's specification falls within the broader category of "non-medicated skin gels and lotions" in the opponent's second mark's specification. These goods are, therefore, identical under the principle outlined in *Meric*.

79. "Baby suncream" in the applicant's specification falls within the broader category of "non-medicated sun lotion" in the opponent's second mark's specification. These goods are, therefore, identical under the principle outlined in *Meric*.

80. "Baby oil" in the applicant's specification is a good that can be used for the same purpose as "non-medicated skin gels and lotions". For example, both are products that can be rubbed onto the skin in order to moisturise. While the natures are different in that one is an oil and one is a gel or lotion, the method of use is the same in that both are applied to the skin. There is likely to be an overlap in user in that it will be someone looking for skin treatments. Alternatively, the goods may be competitive as a user may wish to buy oil over gel or lotion, and vice versa. Finally,

there is an overlap in trade channels as producers of oils are also likely to produce gels and lotions and both are likely to be sold in the same aisle of general retailers. Overall, I consider these goods to be similar to a high degree.

81. “Baby bubble bath” in the applicant’s specification is a type of product that is added to a bath to introduce an element of fun into a baby’s cleaning routine. While its primary purpose is not to clean, it is my view that bubble bath products do have cleaning qualities. They are commonly scented and have ingredients that may assist in cleaning and conditioning the skin. In my view, “baby bubble bath” shares a level of similarity with “non-medicated skin gels and lotions” in the opponent’s second mark’s specification. This is on the basis that there is a general overlap in end purposes in that both aim to cleanse and condition the skin. Further, there is an overlap in user in that both goods are likely to be purchased by parents in order to help cleanse and condition their child’s skin, either during bath time or generally. Alternatively, these goods may be competitive in nature as a parent may choose to buy bubble bath or a non-medicated skin gel for their child (such as a body wash), or vice versa. Overall, I consider these goods to be similar to a medium degree.

82. I do not consider there to be any level of similarity between “baby wipes” and “baby powders” in the applicant’s specification and any of the opponent’s goods. While there may be an overlap in trade channels, I consider such overlap to be superficial. This is on the basis that, while there are exceptions for larger undertakings, I do not consider it common for undertakings that produce shampoos, skin lotions, skin gels, sun lotions and after-sun lotions to also produce baby wipes and baby powders. I consider the userbase for the applicant’s goods and the opponent’s goods to be so broad that any overlap in user is also superficial. Finally, I do not consider there to be any overlap in nature or method of use between these goods. However, if I am wrong in my finding of these goods being dissimilar then I consider the goods to be similar to a very low degree.

Class 5 goods

83. “Dietetic substances for babies” and “dietetic preparations for children” in the applicant’s mark’s specification are goods that can include dietetic substances/preparations that incorporate aloe vera. Further, I consider dietetic substances/preparations to be the same as food supplements. As a result, I consider that these goods fall within the broader categories of “dietetic substances, all incorporating aloe vera” and “food supplements” in the opponent’s first and second marks’ specifications, respectively. This is on the basis that the opponent’s goods can include supplements/substances aimed at babies and children. These goods are, therefore, identical under the principle outlined in *Meric*.

84. I do not consider that “milk powder for babies” in the applicant’s specification shares any level of similarity with “dietetic substances, all incorporating aloe vera” or “food supplements” in the opponent’s first and third marks’ specifications, respectively. In the absence of any evidence or submissions to the contrary, I consider milk powder for babies to be an alternative food to breast milk. In my view, this is used by parents in the event that they choose not to breast feed or are unable to breast feed. I do not consider that it is a food supplement nor a dietetic substance that incorporates aloe vera. As a result, I consider these goods to be dissimilar.

85. “Baby foods” in the applicant’s specification is, in my view, a type of food that is a soft and easily consumed. It is used in the early years of a baby’s life to assist the transition from breast or powdered milk to solid foods later in life. I do not consider it to be a food supplement or a dietetic substance that incorporates aloe vera. As a result, I do not consider there to be any level of similarity between these goods, which are dissimilar.

86. I do not consider there to be any obvious level of similarity between “baby diapers” and “babies’ napkins” in the applicant’s marks’ specification and any of the goods in the opponent’s marks’ specifications. Therefore, these goods are dissimilar.

87. “Babies’ creams (medicated)” in the applicant’s marks’ specification shares a level of similarity with “non-medicated skin gels and lotions” in the opponent’s second

mark's specification. This is on the basis that the goods overlap in nature and method of use in that they are both types of substances that are applied to the skin. While it is possible for a user of non-medicated skin lotions or gels to also require medicated creams for their babies, such an overlap is very broad meaning that any overlap in user is superficial. Further, I do not consider that the purposes will be the same on the basis that one is used for cosmetic purposes whereas the other is for medicinal purposes. There may be a slight competitive relationship between these goods as a user may try non-medicated skin lotions or gels on their babies before seeking to use medicated creams if the skin condition does not improve. Finally, I do not consider there to be any overlap in trade channels on the basis that the producers of non-medicated skin lotions and gels tend not to also produce medicated creams. Overall, I consider these goods to be similar to a medium degree.

Class 35 services

88. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

89. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b),

it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

90. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*¹⁰, and *Assembled Investments (Proprietary) Ltd v. OHIM*¹¹, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*¹², Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

91. The applicant's specification contains the following services:

¹⁰ Case C-411/13P

¹¹ Case T-105/05, at paragraphs [30] to [35] of the judgment

¹² Case C-398/07P

“Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children” and “online retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children”.

92. As set out above, the GC has explained that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore, similar to a degree. It is common for producers of various types of skin care, hair care and food supplement products to also retail in those goods. For example, a producer may operate its own retail stores that exclusively sell that producer's goods. In addition, those goods may be listed for sale on the producer's website directly rather than via third party retailers. In my view, the average consumer will be aware of the complementary relationship between the producer of these types of goods and the retailing of the same. For the goods that I have found identical and highly similar in my class 3 and 5 goods comparison above, it follows that a medium degree of similarity exists between the opponent's goods and the services within the applicant's class 35 specifications which relate to identical goods. I, therefore, find that the following services in the applicant's specifications are similar to a medium degree with various goods contained in the opponent's mark's specification:

“Retail services in relation to baby care products [...] baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, [...] dietetic substances for babies [...] babies creams [and] dietetic preparations for children” and “online retail services in relation to baby care products [...] baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, [...] dietetic substances for babies [...] babies creams [and] dietetic preparations for children.”

93. As for the goods I have found similar to a medium degree, being “babies’ creams (medicated)”, I note that it is not directly included within the applicant’s retail services and is instead listed as “retail services in relation to [...] babies creams” and “online retail services in relation to [...] babies creams”. In my view, babies’ creams does not cover medicated creams but, instead, non-medicated creams. As a result, the retail of these goods is closer to the opponent’s “non-medicated skin gels and lotions” than the retail of medicated baby creams would be. I consider there to be an overlap in trade channels between the production of skin gels and lotions and the retail of baby creams. Firstly, the term “non-medicated skin gels and lotions” can include skin gels and lotions for babies. Secondly, the average consumer would consider the production of non-medicated skin gels and lotions for babies to be so closely related with babies’ creams meaning that they would consider there to be an overlap in trade channels. Further, the average consumer would be aware of the complementary relationship between the producer of these types of goods and the retailing of the same. Additionally, I also make this finding on the basis that the terms lotions and creams are often used interchangeably. Overall, I consider there to be a medium degree of similarity between these goods and services.

94. As for the remaining services in the applicant’s specification, being “retail services in relation to [...] baby wipes, baby powders, [...] baby foods, milk powder for babies, [...] baby diapers [and] babies napkins” and “online retail services in relation to [...] baby wipes, baby powders, [...] baby foods, milk powder for babies, [...] baby diapers [and] babies napkins”, I do not see any obvious level of similarity between these services and any of the opponent’s goods. As a result, I consider these services to be dissimilar.

95. At the end of the applicant’s class 35 services, it has the term “advisory and consultancy services relating to all of the aforesaid”. Where I have found the applicant’s services to be dissimilar, it follows that these additional services relating to them are also dissimilar. However, where I have found the applicant’s services to be similar to a medium degree with the opponent’s goods, the applicant’s advisory and consultancy services relating to those services are also similar to the opponent’s goods. This is on the basis that there is an overlap in trade channels.

There is also, in my view, an overlap in user in that a user buying the goods in the opponent's marks' specifications may also seek advice and consultancy in relation to the retail of those specific goods. In addition, I consider that there may also be a complementary relationship between these goods and services. For example, I consider that the goods being sold are important and indispensable to advisory and consultancy services relating to the retail of those specific goods. In my view, the average consumer would consider the undertaking responsible for the goods to also be responsible for the services, and vice versa.¹³ Overall, I consider these services to be similar to a medium degree.

96. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition under section 5(2)(b) aimed against those goods and services I have found to be dissimilar will fail.¹⁴ For ease of reference, these goods and services are as follows:

Class 5: Baby foods; milk powder for babies; baby diapers; babies' napkins.

Class 35: Retail services in relation to baby wipes, baby powders, baby foods, milk powder for babies, baby diapers, babies napkins; online retail services in relation baby wipes, baby powders, baby foods, milk powder for babies, baby diapers, babies napkins; advisory and consultancy services relating to all of the aforesaid.

The average consumer and the nature of the purchasing act

97. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited*,

¹³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

¹⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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.”

98. In my view, the average consumer of the goods and services at issue will be members of the general public at large. While the applicant’s goods and services are more likely to be bought/selected by parents, it is possible that those some of those goods and services may also be bought by people without children. For example, baby oil is commonly used by adults for skincare and massages.

99. The goods are likely to be sold through a range of retail shops such as supermarkets or beauty and health stores and their online equivalents. The goods at issue are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply online where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods is, therefore, primarily visual, although I do not discount that aural considerations may play a part by way of word of mouth recommendations and advice from sales assistants.

100. The goods will range in price but are likely to be fairly inexpensive. As for the frequency at which the goods will be purchased, I am of the view that they will be purchased on a regular basis. Some goods will be purchased less frequently than others, for example sun lotion is likely to be a more seasonal purchase that is made during the summer or when the consumer is going on a holiday whereas shampoo is likely to be purchased frequently. For these goods, the average consumer is likely to consider such things as ingredients, whether the products have been tested on animals or, for sun care products, the sun protection factor. I am of the

view that the average consumer is likely to pay a medium degree of attention during the selection process for the goods.

101. As for the services at issue, I consider these are mostly likely to be selected having considered, for example, promotional material (in hard copy and online) and signage appearing on the high street. For online retail services, these are likely to be selected after viewing online advertising or search engine links. Visual considerations will be an important part of the selection process. Such services are also likely to be the subject of word-of-mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process. When selecting these services, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method (for online retail only) and expertise/knowledge of staff. I am of the view that the average consumer is likely to pay a medium degree of attention during the selection process for the services.

Distinctive character of the opponent's marks

102. 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).”

103. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, evidence of use of the marks has been provided. I note that the opponent has failed to provide evidence of the market share held by its mark in the UK. Further, while the evidence provided shows sales of the opponent’s goods within the UK, I have no evidence as to the size of the relevant market for the opponent’s goods in the UK. However, given that the opponent’s goods are a range of skin care, hair care and food supplements, I am of the view that the markets would be significant with an annual turnover of tens, if not hundreds of millions of pounds each. In comparison to the relevant markets, the evidence of turnover provided is low and would, in my view, represent a low market share. Finally, while evidence of advertising expenditure has been provided, I consider this to be low in relation to the size of the markets at issue. I, therefore, do not consider that the evidence filed is sufficient to show that the opponent’s marks have acquired an enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

104. The opponent has submitted that the word ‘Aloe’ in its marks is descriptive of the main ingredient of the opponent’s class 3 and 5 goods and, therefore, ‘Pura’ is the dominant element. I agree with these submissions. The word ‘Aloe’ is descriptive of goods that incorporate aloe vera (being a plant that contains a gel in its leaves that is commonly used in skin care, hair care and food supplement goods) and I consider that the average consumer of the opponent’s goods will be aware of this connection. As a result, it is unlikely to be attributed any trade mark

significance. As for the word 'Pura', I consider this to be laudatory on the basis that it will be seen by average consumers as a play on the word 'pure' or an obvious misspelling of 'purer'. On the basis that the opponent's goods are skin care, hair care and food supplement products, the connection with the word 'pure' will be seen as an indicator of their quality in that they are clean and free from harmful substances.¹⁵ This is a desirable quality of these types of goods. Given the fact that 'Pura' will be seen as laudatory, it will be low in inherent distinctiveness.

105. As for the remaining elements, being the device and the background/border element, I consider that these have very little effect on the distinctiveness of the marks, regardless of whether the device element is seen, as submitted by the opponent, as an aloe vera leaf or not. As a result, I consider that 'Pura' is the distinctive element of the opponent's marks. On the basis of my findings above, I consider that the opponent's marks enjoy a low degree of inherent distinctive character.

Comparison of the marks

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

107. 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

¹⁵ <https://www.collinsdictionary.com/dictionary/english/pure>

light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

108. 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.

109. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
 <p data-bbox="347 999 743 1032">("the opponent's first mark")</p>  <p data-bbox="323 1294 767 1328">("the opponent's second mark")</p>	

110. The opponent's marks are identical meaning that the following comparison will apply to both marks. I have detailed submissions from the opponent in respect of the comparison of the marks. However, I do not intend to reproduce these here but have taken them into account in making my following comparison.

Overall Impression

The applicant's mark

111. The applicant's mark consists of two separate word elements, the first being 'pura' displayed above the words 'mypura.com'. There is also a small device

element, being a light green full-stop after the word 'pura'. I am of the view that this will be overlooked. In my view, the applicant's mark will be dominated by the word 'pura' with the words 'mypura.com' playing a much lesser role as they will be seen as a reference to the applicant's website and are much smaller in size.

The opponent's marks

112. The opponent's marks consist of word and device elements. The word element is 'Aloe Pura' that sits within a black background device. Above this is a small device of a shape placed inside a black and white grid device. I am of the view that the eye will be drawn to the parts of the mark that can be read. I have already found 'Aloe' to be descriptive and, therefore, unlikely to be of any trade mark significance. This means that while I have found 'Pura' to be laudatory, it plays the greater role in the overall impression of the opponent's marks with 'Aloe' and the device/backgrounds elements playing lesser roles.

Visual Comparison

113. Visually, the marks share the word 'Pura'. The marks differ in the presence of the word 'Aloe' and the background/device elements in the opponent's marks and the words 'mypura.com' in the applicant's mark. While I have found that the word 'Aloe' and the device/background elements in the opponent's marks and the words 'mypura.com' in the applicant's mark all play lesser roles in their respective marks, they still constitute a visual difference. Given the dominant role that 'Pura' plays in both marks, I consider that the marks are visually similar to a medium degree.

Aural Comparison

114. The opponent's marks consist of four syllables that will be pronounced 'AL-OH-PYEW-RUH'. As for the applicant's mark, I do not consider that the words 'mypura.com' will be pronounced. This is on the basis that it is simply a reference to the applicant's website. The applicant's mark consists of two syllables that will be pronounced 'PYEW-RUH'. The entire aural element of the applicant's mark sits

within the opponent's marks, albeit at the end. Overall, I consider the marks are aurally similar to a medium degree.

Conceptual Comparison

115. In both parties' marks, I consider that the word 'Pura' will be seen by average consumers as a play on the word 'PURE' or an obvious misspelling of 'PURER'. Therefore, the concept of 'Pura' in both marks is identical. However, the additional word 'Aloe' in the opponent's marks is not present in the applicant's mark meaning that this will be a point of conceptual difference between them. However, given its descriptive nature, I do not consider 'Aloe' to be a distinctive point of difference. Overall, I consider the marks are conceptually similar to a high degree.

Likelihood of confusion

116. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

117. I have found the applicant's goods and services to be either identical or similar to varying degrees to the opponent's goods. I have found the average consumer for the goods and services to be members of the general public at large who will

select them through primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods and services. I have found that the opponent's marks enjoy a low degree of inherent distinctive character. I have found the applicant's mark to be visually and aurally similar to a medium degree and conceptually similar to a high degree with the opponent's marks.

118. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the visual and aural differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks. I make this finding even on goods or services that are identical.

119. It now falls to me to consider whether there is a likelihood of indirect confusion. I am reminded that just because a mark has a low degree of distinctive character, it does not preclude a likelihood of confusion.¹⁶ In the present case, I consider that it is plausible that as a result of the common misspelling 'Pura', the average consumer will believe that the applicant's mark is another brand of the owner of the opponent's marks.¹⁷ This is on the basis that the different element, being 'Aloe' will be seen as a reference to goods made with aloe vera and, therefore, a 'Aloe Pura' will be seen as a sub-brand of 'pura' that focuses on producing and selling goods containing aloe vera. Further, the differences in stylisation and presentation of the marks (such as the typeface, colour and device element used) will be seen as an alternative mark being used by the same or economically linked undertakings and consistent with a re-branding. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even on those goods and services that I have found to be similar to a medium degree. However, where I have found goods and services to be similar to only a very low degree, I consider that the differences between the goods and services will offset the similarities between the marks. I therefore find that there is no likelihood of indirect confusion between the marks in respect of the goods and services that are similar to a very low degree.

¹⁶ *L'Oréal SA v OHIM*, Case C-235/05 P

¹⁷ Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

120. As a result of my findings above, the opposition under section 5(2)(b) is partially successful in respect of the following goods and services:

Class 3: Baby care products (non-medicated); baby oil; baby shampoo; baby conditioner; baby lotion; baby suncream; baby bubble bath.

Class 5: Dietetic substances for babies; babies' creams (medicated); dietetic preparations for children.

Class 35: Retail services in relation to baby care products, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, dietetic substances for babies, babies creams, dietetic preparations for children; online retail services in relation to baby care products, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, dietetic substances for babies, babies creams, dietetic preparations for children; advisory and consultancy services relating to all of the aforesaid.

121. The section 5(2)(b) grounds, however, have failed against the following goods and services:

Class 3: Baby wipes; baby powders.

Class 5: Baby foods; milk powder for babies; baby diapers; babies' napkins.

Class 35: Retail services in relation to baby wipes, baby powders, baby foods, milk powder for babies, baby diapers, babies napkins; online retail services in relation baby wipes, baby powders, baby foods, milk powder for babies, baby diapers, babies napkins; advisory and consultancy services relating to all of the aforesaid.

122. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

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

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

124. Given my findings in relation to proof of use above, the opponent’s specifications for the purposes of this ground are limited in accordance with my findings at paragraph 67 above. As a result of these findings, the section 5(3) grounds reliant upon the opponent’s third mark must fail on the basis that the opponent has not demonstrated any use in respect of its third mark.

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

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

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

126. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

127. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 13 March 2020.

Reputation

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

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

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

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

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

129. In its notice of opposition, the opponent claimed that its marks have a reputation in respect of the goods listed at paragraph two above. The opponent's first and second marks are UK registrations meaning that the opponent is required to show its marks had established a reputation amongst a significant part of the relevant UK public at the relevant date. As set out above, the opposition reliant upon the opponent's third mark fails on the basis that the opponent has failed to demonstrate any use of goods for which it is registered.

130. The opponent submits that:

"We know of no way to evaluate the market in toiletry, medicated skin care preparations and dietetic supplements in the UK. However, the Opponent has shown constant use of the mark throughout the past twenty four years, constant advertising throughout this period, and repeated nomination for beauty awards, important turnover, excellent rating on various website and constant contracts with major high street retailers."

131. I note that the opponent has been unable to comment on the size of the relevant markets. I am of the view that they are very large markets and I would expect them to be significant, amounting to tens of millions, if not hundreds of millions of pounds per annum per market. The opponent has not provided any evidence as to the market share achieved by its marks. The remaining claims by the opponent in the above submissions will be addressed separately below.

132. The same evidence discussed in respect of the proof of use and enhanced distinctiveness issues above will also apply to the matter of reputation that I must now consider. However, on this point I note that the evidence that fell outside the relevant period for proof of use will now be relevant insofar as it falls prior to the relevant date. I note that this additional evidence is the turnover figures and advertising expenditure outside the relevant period together with the additional invoices from 2013 to 2015. Further, there is some evidence that I did not consider at all on the basis that it fell outside the relevant period for proof of use but is relevant to the issue of reputation. This additional evidence is the Daily Mail article from 2010 and the marketing materials from 2012 and 2013.

133. In respect of the turnover figures, the opponent states that since 1997, it has generated a turnover of over £30 million in its marks and this has been broken down to include a total of £12.1 million between 2014 and 2019. Taking into account the turnover figures provided, the Amazon sales discussed at paragraph 16 and the invoice evidence discussed at paragraph 20, I consider that the total UK sales against the size of the relevant markets are low.

134. I note the submissions reproduced above state that the opponent has advertised throughout the entire twenty-four-year period, however, evidence has only been provided in respect of 2012, 2013 and 2014 to 2019, being the limited advertising materials provided and the advertising expenditure of £190,000 between 2014 and 2019. Of this evidence I note the following:

- a. When considering the advertising materials, these appear to be materials issued by the opponent itself seemingly aimed at customers in the trade, being retailers. The evidence shows two adverts from 2012 and 2013 advertising sun lotion and after sun with an offer for free aloe vera gel to the end consumer.

While the evidence of these adverts is noted, it is far from extensive, being just two adverts between 2012 and 2013 and nothing before or since. Further, the opponent has not provided any explanation as to how many people are likely to have seen these adverts, neither has the opponent explained who the recipients of these adverts were; and

- b. As for the advertising expenditure, I am of the view that this only covers six years and, in comparison to the size of the relevant markets at issue, a total expenditure of £190,000 is low. Further, I have no evidence as to what markets and consumers were targeted by this advertising expenditure, neither is there any breakdown provided in respect of what goods were advertised or where they were advertised.

135. I turn now to the Daily Mail article from 2010 that shows the opponent's 'Aloe Pura organic Aloe Vera sun lotion' being listed at number nine on a guide of recommended sunscreen. While the evidence is from a national UK news publication, it is one article from 10 years prior to the relevant date that shows one of the opponent's product amongst a range of at least 11 other manufacturers' products. In addition, there is further evidence regarding press coverage that I have discussed above at paragraph 18, being the two awards given to the opponent's products in 2017 and 2019 by yourhealthyliving.co.uk. While I note the submissions reproduced above of repeated nominations for awards, this is the only evidence of awards provided. In terms of press coverage, I note that there are a total of three articles spread across almost 10 years that only show three products, one of which being on a list of recommended sunscreens and the other two being awards from a healthy living website. While these articles are noted, there is no evidence or explanation regarding the level of exposure generated from featuring in this article or from being awarded these awards.

136. Finally, the submissions reproduced above state that the opponent has obtained excellent ratings on various websites and has constantly entered into contracts with major high street retailers. I note the screenshots from Holland & Barret show individual reviews and average star ratings. I also note that the Superdrug screenshots also show average star ratings. Firstly, I note that the

individual reviews are all from after the relevant date and, therefore, do not assist the opponent. Secondly, as for the average star ratings, I have the same issues with this evidence as I have set out in respect of the Amazon global ratings at paragraph 50 above. As for the Amazon verified reviews, these are very limited in number. As for the submissions regarding the constant contractual agreements with major high street retailers, I note the opponent sells its goods via Boots, Holland & Barrett and Superdrug, which are major high street retailers.

137. While the evidence points to longevity of use and geographical spread of the marks since 1997, I do not consider that the opponent has demonstrated that its marks have generated a reputation amongst a significant part of the relevant public in the UK. This is on the basis that the turnover figures are low in relation to the size of the relevant markets at issue. Further, the expenditure in promoting the marks is low and it is not clear what markets or consumers were targeted or how extensive or intensive this advertising was. Taking the evidence as a whole, I am not satisfied that the opponent's mark had established a reputation amongst a significant part of the relevant public in the UK at the relevant date. The section 5(3) grounds of opposition fail accordingly.

Section 5(4)(a)

138. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

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

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

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

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

141. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

142. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the Registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

143. As the applicant's mark does not have a priority date and there is no evidence that the applicant's mark was used prior to the application date, the relevant date for assessment of the opponent's claim under section 5(4)(a) of the Act is the date of the application for registration, being 13 March 2020.

Goodwill

144. The first hurdle for the opponent is that they need to show that they had the necessary goodwill in the below sign at the relevant date.



145. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

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

146. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

147. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

148. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

149. Goodwill arises as a result of trading activities. Clearly, the opponent was trading prior to the relevant date. This is clear from the turnover, invoice and advertising expenditure evidence. I consider that the evidence of sales of £30

million since 1997 with a turnover of £12.1 million sales between 2014 and 2019 to be sufficient to demonstrate a level of goodwill. This is particularly the case given that the opponent has been selling its goods through nationwide retailers since 2001. On balance, I am prepared to accept that the opponent has a modest, though not trivial, degree of goodwill in the UK in relation to “aloe vera gel for cosmetics purposes”, “skin lotion”, “sunscreen”, “after sun lotions”, “shampoo” and “food supplements”. I am satisfied that the sign relied upon was distinctive of that goodwill at the relevant date.

150. I note that the opponent has also claimed goodwill in “hair conditioner” and “aloe vera gel for therapeutic purposes”. However, I do not consider that the opponent has demonstrated any trading activities in respect of these goods.

Misrepresentation and damage

151. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

152. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here. I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's goods or seeking the applicant's services in the mistaken belief that they are the goods or services of the opponent.

153. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). However, the closeness of the parties' respective fields, together with the moderate amount of goodwill in the opponent's sign are factors which must be taken into account. In my view, the distance between the goods and services of the applicant that I have not found to be subject to a likelihood of confusion (being those goods and services listed at paragraph 121) and the goods for which the opponent has demonstrated goodwill is sufficient to avoid misrepresentation occurring, particularly taking into account the moderate level of goodwill in the opponent's sign.

154. In relation to those goods and services for which I have found a misrepresentation, I consider that damage through diversion of sales is easily foreseeable. The opposition based upon section 5(4)(a) is, therefore, successful

against those goods and services. It does, however, fail in respect of those goods and services for which I consider misrepresentation is avoided.

CONCLUSION

155. The opponent has enjoyed partial success in respect of its 5(2)(b) and 5(4)(a) grounds but failed in respect of its 5(3) ground. The application is, therefore, refused in respect of the following goods and services in relation to which the opposition has been successful:

Class 3: Baby care products (non-medicated); baby oil; baby shampoo; baby conditioner; baby lotion; baby suncream; baby bubble bath.

Class 5: Dietetic substances for babies; babies' creams (medicated); dietetic preparations for children.

Class 35: Retail services in relation to baby care products, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, dietetic substances for babies, babies creams, dietetic preparations for children; online retail services in relation to baby care products, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, dietetic substances for babies, babies creams, dietetic preparations for children; advisory and consultancy services relating to all of the aforesaid.

156. The application can proceed to registration for the following goods and services in relation to which the opponent has been unsuccessful:

Class 3: Baby wipes; baby powders.

Class 5: Baby foods; milk powder for babies; baby diapers; babies' napkins.

Class 35: Retail services in relation to baby wipes, baby powders, baby foods, milk powder for babies, baby diapers, babies napkins;

online retail services in relation baby wipes, baby powders, baby foods, milk powder for babies, baby diapers, babies napkins; advisory and consultancy services relating to all of the aforesaid.

COSTS

157. I consider that the opponent has enjoyed a greater degree of success in this opposition. As a result, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. However, as the opposition failed against some of the goods and services against which it was aimed, I consider it appropriate to reduce the award of costs relative to the degree of success. In the circumstances, I award the opponent the sum of **£950** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the applicant's counter statement:	£150
Preparing evidence:	£400
Preparing submissions in lieu of a hearing:	£200
Official Fees:	£200
Total	£950

158. I therefore order Mundare Limited to pay Optima Consumer Health Limited the sum of £950. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of July 2021

A COOPER
For the Registrar