

**O-624-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3443662**

**BY OMER FARUK ASLAN**

**FOR THE TRADE MARK:**

**The Bio Shop**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 420136**

**BY THE BODY SHOP INTERNATIONAL LIMITED**

## **Background and pleadings**

1. On 13 November 2019 (“the relevant date”), Omer Faruk Aslan applied to register the words “The Bio Shop” as a trade mark, under number 3443662. Registration is sought for “Retail and wholesale services connected with the sale of food, cosmetics, textiles, chemicals, furniture, drinks and pharmaceuticals” in class 35.

2. The application is opposed by The Body Shop International Limited (“the opponent”). The opposition is based upon ss. 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under each of these grounds, the opposition is directed against only part of the application, namely “retail and wholesale services connected with the sale of cosmetics, chemicals and pharmaceuticals”.<sup>1</sup> The opponent relies upon the following earlier trade marks, the full specifications for which are set out in the annexe to this decision:<sup>2</sup>

- (i) European Union trade mark (“EU”) 1980416 “THE BODY SHOP”

Filing date: 23 December 1999; registration date: 16 April 2003

Registered in classes 3, 21 and 42.

- (ii) EU2305175 “THE BODY SHOP”

Filing date: 11 July 2001; registration date 12 June 2003

Registered in classes 35, 36 and 42.

3. Under s. 5(2)(b), the opponent relies upon EU1980416 and all of the goods for which it is registered in class 3, and upon EU2305175 for all of the services for which it is registered in class 35. The opponent claims that the similarity between the marks and the identity or similarity between the goods and services give rise to a likelihood of confusion, including the likelihood of association.

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<sup>1</sup> Opponent’s skeleton argument, §8, confirmed at the hearing.

<sup>2</sup> Under the transitional provisions at paragraph 7(1), Schedule 5 of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, EU trade marks constitute relevant earlier rights, notwithstanding the UK’s exit from the EU.

4. Under s. 5(3), the opponent relies upon all of the goods and services for which its trade marks are registered. It says that the average consumer will believe that there is an economic connection between the users of the marks where no such connection exists. Further, it claims that Mr Aslan would gain an unfair advantage by benefiting from the power and attraction of the earlier marks, without having to pay financial compensation to the opponent or investing in marketing to create and maintain the image of the contested mark. The opponent says that the image and characteristics of its marks will be transferred, allowing the provision of services under the contested mark which would not otherwise have been possible.

5. The opponent also claims that there would be damage to the reputation of the earlier marks if the services provided under the contested mark are inferior. The public, it says, may no longer perceive the goods offered under the earlier marks as being of particular quality and may associate the opponent with services of a different, potentially inferior quality. Use of the contested mark may also lead to damage as consumers would no longer associate the opponent with its long-established and highly ethical values and ideologies.

6. In addition, the opponent claims that there is a serious likelihood that the use of the contested sign would lead to a dispersion of the identity associated with the opponent's marks. Detriment and dilution would occur because consumers may no longer rely on the earlier marks as a guarantee of origin and value.

7. Mr Aslan filed a counterstatement denying the grounds of opposition. I will return to the details of his comments later in this decision.

8. A hearing was requested and held before me, by videoconference, on 14 July 2021. The opponent was represented at the hearing by Rachel Wilkinson-Duffy of Baker & McKenzie LLP, with some assistance, which I permitted, from Rebecca Davey, also of Baker & McKenzie. Mr Aslan chose not to attend the hearing, nor did he file written submissions in lieu but he did file written submissions during the evidence rounds, which I have read and will keep in mind.

## **Relevance of EU law**

9. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Witnesses**

10. Only the opponent filed evidence. Its witness is Peter O'Byrne, General Counsel for the opponent since September 2018. Among other things, Mr O'Byrne is responsible for the clearance, registration, maintenance and enforcement of the opponent's trade marks. Mr O'Byrne gives background information concerning the opponent and provides evidence going to the use which has been made of the marks.

## **Proof of use**

11. Given their registration dates, the opponent's marks are subject to the use provisions at s. 6A of the Act. The opponent indicated in its notice of opposition that it has used the marks in respect of all the goods and services upon which it relies. Mr Aslan asked the opponent to demonstrate its use in relation to the goods in class 3 and the services in class 35. The opponent may rely upon the other goods and services without showing that it has used the marks.

12. The relevant legislation reads:

“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 relevant period.

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

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

(5) In relation to a European Union 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”.

13. Section 100 is also relevant. It 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”.

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J 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 Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

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

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

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

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

15. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C., sitting as the Appointed Person summed up the law regarding a fair specification as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of



the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned”.

16. I also bear in mind the guidance provided by the late Mr Justice Carr in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) (at [47]).

17. The relevant period for assessing genuine use is 14 November 2014 to 13 November 2019.

18. The opponent filed a good deal of evidence. Much of it is of little or no assistance as it is either dated outside the relevant period or does not clearly relate to the EU or UK. It has been said before but it bears repeating that parties should think carefully before filing large amounts of evidence concerning their global standing without any indication of how that translates to the market relevant to proceedings before this tribunal, i.e. the UK or the EU.

19. The evidence is that the opponent began trading in the UK in 1976 and began to expand internationally from 1978.<sup>3</sup> It produces and retails its goods under the “THE BODY SHOP” brand, both in stores (its own and franchises) and through its website, [www.thebodyshop.co.uk](http://www.thebodyshop.co.uk). As at 7 December 2020 there were 232 shops in the UK.<sup>4</sup> All of the goods produced by the opponent are branded “THE BODY SHOP”.<sup>5</sup> UK retail sales over the period 2016 to 2019 exceeded €225 million annually.<sup>6</sup>

20. There are prints showing the opponent’s products featured in magazines in the UK and EU, and information about press events.<sup>7</sup> The vast majority of this evidence is not dated or is dated after the relevant date. A handful of magazine features, along with some press events, are dated 2013, which is before the relevant date.<sup>8</sup> Goods such as

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<sup>3</sup> O’Byrne, §9; exhibit POB1.

<sup>4</sup> O’Byrne, §§11-12, 28.

<sup>5</sup> O’Byrne, §10.

<sup>6</sup> O’Byrne, §22. POB6 contains the group financial reports but these are not UK- or EU-specific.

<sup>7</sup> POB11.

<sup>8</sup> Pp. 255, 261, 263, 265. p. 254 also appears to be from 2013, as the cover story seems to be about the birth of Prince George.

moisturisers, soap and bath melts are shown, mainly from the “HoneyMania” range. It appears that this was launched in 2013.<sup>9</sup> Shower gel and body polish, blemish oil and gel, toner and “body yogurt” from various ranges, are mentioned in an article about awards won by the opponent in the “*Glamour* Beauty Power List 2019”, which include “Best Responsible/Sustainable Initiative” and “Best Cruelty-Free Brand”.<sup>10</sup> There are also articles from *Glamour* about the opponent’s “Fenty Body Lava dupe” (May 2018).<sup>11</sup> Articles in both *Glamour* (December 2019) and *Good Housekeeping UK* (January 2019) refer to a serum which sells at least once every 26 seconds worldwide.<sup>12</sup> The former refers to the hundreds of five-star reviews afforded the product, the latter calls the opponent a high street beauty brand. There is also a hand cream featured on an unspecified website.<sup>13</sup> The print is not dated but profits are said to go to the Bio-Bridges initiative, which was launched in 2016.<sup>14</sup> An article posted “1 year ago” (the witness statement is dated January 2021) refers to various of the opponent’s products, such as fragrance, a facial moisturiser, lip balm and body butter; although the article is about products used by the contributors in their youth, some of the products are said still to be available.<sup>15</sup> An article dated 14 November 2019 reports that the opponent is currently the UK’s favourite beauty brand.<sup>16</sup> It reports that the same is true of Norway. Gift sets for bathing are mentioned.

21. The opponent does not rely on external advertising.<sup>17</sup> However, it reports over 9 million followers in the UK of its Facebook page, over 153,000 UK followers of its Twitter page and 35,100 UK subscribers to its YouTube channel.<sup>18</sup> Marketing material (not location specific) dated between 2017 and 2019 shows the words “THE BODY SHOP” used in relation to toiletries such as smoothing concentrate, moisturiser, scent and

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<sup>9</sup> The Dublin launch was 21 August 2013: p. 269.

<sup>10</sup> Pp. 273-279.

<sup>11</sup> P. 285.

<sup>12</sup> Pp. 283, 291.

<sup>13</sup> P. 287.

<sup>14</sup> POB7.

<sup>15</sup> Pp. 289-290.

<sup>16</sup> P. 294.

<sup>17</sup> O’Byrne, §29. See also, e.g. POB3, p. 31.

<sup>18</sup> O’Byrne, §33.

blemish products.<sup>19</sup> Website prints from [www.thebodyshop.com](http://www.thebodyshop.com) are dated within the relevant period but this appears to be either a global site or the US version: there are links to “The Body Shop UK” and prices, where visible, are in dollars.<sup>20</sup> Goods range from eye gel to shower cream and body butter. There is a page from [uk.thebodyshop.com](http://uk.thebodyshop.com) dated 1 September 2004, obtained from [archive.org](http://archive.org).<sup>21</sup> It does not show any products.

22. The opponent has won or topped rankings for various accolades, including “Best Sustainable Brand” (Marie Claire Skin Awards 2020), “Best Ethical Brand” (unspecified UK award 2019) and “Act of Kindness Award” (Fabulous Magazine (UK) 2018).<sup>22</sup> The opponent also won various awards between 2006 and 2015 for, for example, its commitment to avoiding animal testing and responsible business practices.<sup>23</sup>

23. Although the evidence leaves a lot to be desired, I accept that the opponent has had a substantial presence on the UK high street since 1976. Whilst December 2020 postdates the relevant period, it is highly improbable that all or most of the 232 UK shops opened after the end of the relevant period, particularly given that the country was in the teeth of a pandemic for much of 2020. There is also unchallenged evidence that all of the goods sold by the opponent are branded “THE BODY SHOP”, very significant UK sales throughout the relevant period and a smattering of press coverage which refers to the long-standing and significant presence of the “THE BODY SHOP” in the UK beauty market. Social media figures show significant UK follower numbers which are unlikely all to have been garnered after the relevant period. The evidence as to the specific goods and services in relation to which the mark has been used is very limited. The thrust of the evidence as a whole is that the opponent manufactures and sells toiletries, with some evidence that various fragrance, face and body care goods were on the UK market in the relevant period, resulting in awards. Although the evidence from the opponent’s website appears to be from the US, the range of goods lends support to the assertion that the opponent traded in toiletry goods: the specific goods may have varied in the different

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<sup>19</sup> O’Byrne, §30 and POB9.

<sup>20</sup> POB10.

<sup>21</sup> P. 204.

<sup>22</sup> O’Byrne, §26.

<sup>23</sup> O’Byrne, §35.

continents but the fact that the opponent manufactures and sells only own-brand goods makes it unlikely that entire categories were sold in one region but not another.

24. As far as cosmetics are concerned, it may be that the term includes toiletries but my view is that the average UK consumer would construe it as at least including make-up, which is a different category of goods. There is a BBC article from the relevant period which refers to the opponent as a UK cosmetics chain but it is not clear whether the term is used to mean make-up or toiletries.<sup>24</sup> An article from *Stylist* magazine, which appears to date from January 2020 and concerns the UK (prices are in sterling), describes the opponent as a cosmetics and toiletries retailer.<sup>25</sup> The US web pages include categories for make-up throughout. Whilst there is no evidence of any make-up goods which might be contained under such headings, there is one advertisement which highlights a discount offer in Spain in November 2013 and appears to show THE BODY SHOP lipstick and bronzing or possibly highlighter pearls.<sup>26</sup> The November 2019 article which describes the Body Shop as the UK's favourite beauty brand appears to be categorised as a "makeup" piece.<sup>27</sup> Given the evidence that the opponent has been a longstanding presence on the UK high street and that third parties appear to regard it as a provider of make-up, I am prepared to accept that there has been genuine use in relation to "fragrance; cosmetics; toiletries" in class 3. The evidence does not show any use on other goods and I am not prepared to find on the evidence before me that the use extends further.

25. It is not entirely clear how many of the 232 UK shops are owned by the opponent itself. The 2019 annual report puts the figure for opponent-owned shops against franchises at around 35% over 2 years.<sup>28</sup> That would equate to around 81 shops in the UK under the opponent's control, far more than one in each major city. There is also some, albeit limited, evidence that the opponent is perceived as a retailer.<sup>29</sup> Ms Wilkinson-Duffy relied upon the website as evidence that the opponent offers retail services but, as I have indicated, that evidence appears to be US-based and is problematic. However, it

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<sup>24</sup> POB4.

<sup>25</sup> POB11, p. 289.

<sup>26</sup> POB11, p. 245.

<sup>27</sup> POB11, p. 293.

<sup>28</sup> POB6, p. 57.

<sup>29</sup> Pp. 289-290.

seems to me that, given the number of shops run by the opponent, the range of goods sold under its brand and the turnover figures, there has been genuine use in relation to “retail of fragrance, cosmetics and toiletries” in class 35.

26. I note that there is some evidence of the opponent’s role in franchises.<sup>30</sup> It is, however, dated outside the relevant period and is limited in nature. I am not prepared make any inferences about the nature or extent of the opponent’s activities in relation to services for the establishment of business and retail stores, not least because there is no evidence of how many, if any, franchises were set up in the EU with the opponent’s assistance during the relevant period. There is also no evidence that the opponent has provided to third parties any of the remaining services in class 35 of EU2305175.

27. A fair specification upon which the opponent may rely is:

EU1980416:

Class 3: Fragrance; cosmetics; toiletries.

EU2305175:

Class 35: Retail of fragrance, cosmetics and toiletries.

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

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

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

[...]

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

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<sup>30</sup> POB3, pp. 22, 34.

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

29. Section 5A is also relevant and reads:

“5A. [...] Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only”.

30. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **The average consumer and the nature of the purchasing act**

31. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik*.

32. I have no submissions concerning the identity of the average consumer from either party. In my view, the average consumer of the goods and services upon which the opponent may rely, and of retail services in relation to cosmetics, will be a member of the general public. The goods and services will be selected through mainly visual means. The goods may be chosen from the shelves of retail premises or from websites. The services will be selected after inspection of premises, websites or, for example, online searches. There may, however, be an oral element to the purchase, for example if advice is sought from sales assistants or because of word of mouth recommendations. These goods will be selected with some care to factors such as the skin concern it is intended to address or colour of the product. The choice of services will be influenced by factors such as the range of goods on offer, knowledge of staff and potentially factors such as ethical practices towards employees. There will be a medium level of attention to the selection of both goods and services.

33. Wholesale services relating to cosmetics will mainly be directed at professional users, such as retailers, or businesses providing, for example, wedding make-up services. The consumer is likely to be exposed to the mark through shop frontages, advertising, catalogues and websites. The selection process will be mainly visual though I do not discount an oral component. The user of such services will pay an above average degree of attention, as they will have heightened regard to range of stock, delivery lead times and are likely to be paying out greater sums than a retail purchaser.

34. In respect of the retail and wholesale of chemicals, my view is that the most likely average consumer is a professional user, for example a procurement officer in a manufacturing company or a trader who uses chemicals as part of their business. These users are likely to be purchasing reasonable quantities at some cost and there may be considerations such as safe storage/transport of the goods to be borne in mind. The services will be chosen from websites and advertising and there will likely be some exposure to catalogues and brochures. The selection will be mainly visual, though I acknowledge that there may be an oral component, and the consumer will pay a reasonably high degree of attention.



35. Retailers of pharmaceuticals will cater to the general public. The general public will purchase these goods off the shelves, over the counter or they may be available on prescription. Visual considerations will dominate but there is some scope for oral exposure to the mark, for example, in the course of discussion with doctors about suitable/nearby pharmacies, which I will bear in mind. The choice of retailer will include considerations such as whether there is a pharmacist available and will be made with a medium degree of attention. Wholesalers of pharmaceuticals will cater to the business or professional user. The services will be selected using predominantly visual means but there is more likelihood here of an important aural component, such as where the services are engaged through the use of sales representatives. Given the likely large quantities, cost and considerations such as stock levels and delivery times, this consumer will pay at least a reasonably high degree of attention.

**Comparison of goods and services**

36. The goods and services to be compared are:

<b>Earlier specifications</b>	<b>Contested specification</b>
<p><u>EU1980416</u></p> <p>Class 3: Fragrance; cosmetics; toiletries.</p> <p><u>EU2305175</u></p> <p>Class 35: Retail of fragrance, cosmetics and toiletries.</p>	<p>Class 35: Retail and wholesale services connected with the sale of cosmetics, chemicals and pharmaceuticals</p>

37. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

38. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

39. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“12. [...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent*

*Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

40. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

41. A further relevant factor is whether there is a complementary relationship between the respective goods and/or services. It was explained by the CJEU in *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. The same applies by analogy to services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the General Court stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

42. Mr Aslan submits that the similarity between the goods and services is “severely low and unimportant”. The opponent submits that the goods and services are identical or

highly similar. It relies in particular upon proximity of trade channels and submits that “a medicated skin cream (being a type of pharmaceutical product), talc (being a type of chemical) and a cosmetic skin cream are all likely to be sold together in the same aisle within a supermarket. Pharmaceutical products, chemicals for cosmetic purposes and cosmetics are also customarily all sold within pharmacies”.

43. “Retail services connected with the sale of cosmetics”, although expressed slightly differently, are contained in both the contested specification and that of EU2305175. These services are self-evidently identical.

44. The contested mark’s “wholesale services connected with the sale of cosmetics” is similar in purpose to the earlier “retail of cosmetics” as both are designed to enable the transfer of cosmetics goods to buyers. However, there is a difference because wholesale is a business-to-business service whilst retail concerns the provision of goods to the end consumer. That will also entail a difference in nature and method of use of the services: for example, though both may be purchased via websites, there will be some difference in how the goods are offered and obtained through these different channels, with wholesalers less likely to be reliant on attractive store/shopfront displays than comprehensive price lists. The users are unlikely to overlap to a significant degree. Although some individual consumers may choose to buy from a wholesaler rather than a retailer, my view is that this is at the fringes and that, for the most part, there is no meaningful competitive relationship. The services are not complementary: one services a business need, the other an end consumer. They are similar to a medium degree.

45. Turning to “retail services connected with the sale of pharmaceuticals”, the opponent’s best case is its own retail services. I accept that cosmetics and toiletries, on the one hand, and pharmaceuticals, on the other, are commonly sold to end users through the same channels, such as chemists. The nature of the service coincides because both include the presentation of goods on shelves for customers in a similar way. The purpose of both at a general level is providing goods to retail consumers and the goods themselves are not poles apart: medicated shampoos, for example, do not differ greatly from ordinary shampoo. That said, “pharmaceuticals” covers a much wider range of goods than

medicated toiletries. Whilst I accept that some pharmaceuticals such as aspirin and paracetamol are available through a wide variety of retailers, the retail of pharmaceuticals frequently involves the provision of a qualified professional, i.e. a pharmacist, to advise customers, to supply drugs which are not on open shelves and, increasingly, to prescribe medicines. Shop assistants in cosmetics retailers may offer some assistance but it does not equate to the provision of an independent and professionally trained advisor. Users will be the same. These services are similar to a medium degree.

46. “Wholesale services in connection with pharmaceuticals” are a step further removed from the earlier retail services. That is because a wholesale service is directed at a business purchaser. In the case of controlled substances, supply is likely to be limited so that it is simply not open to individuals to make bulk purchases, though I accept that some goods which come under the umbrella term are unlikely to be subject to such restrictions. As with the wholesale services considered above, whilst there are overlaps in the purpose, nature and method of use of the services, there will also be differences because of the different concerns of a business purchaser compared with an end consumer. There may also be additional consumer controls and checks for providers of wholesale services connected with pharmaceuticals, to ensure compliance with any legislation or restrictions on sales. There is no competition and no complementarity. These services are similar to a fairly low degree.

47. Concerning “retail and wholesale services connected with the sale of chemicals”, the opponent argues that chemicals for cosmetic purposes are sold in pharmacies. As an example, Ms Wilkinson-Duffy submitted that talc is a chemical and a pharmaceutical but that it drifts into cosmetics.

48. The opponent’s position appears to be that “retail of chemicals” means that the contested services cover chemicals for cosmetic purposes. I do not agree. Absent any indication of the purpose of “chemicals”, my view is that the contested term relates to the retail of chemicals proper to class 1. Although goods in other classes may technically be chemical compounds, and I accept that this includes toiletries/cosmetics, to interpret “retail of chemicals” as covering retail of any type of chemical compound would give

coverage for the retail of goods as diverse as window sealants and flavourings for electronic cigarettes. That seems to me to be straining the language and I do not consider that the average consumer would construe the term “chemicals” so widely. More likely, in my view, it would be perceived as a reference to chemicals for use in science and industry which are proper to class 1 of the Nice classification system.

49. The goods subject to the earlier retail services and the chemicals subject to the contested retail services are, therefore, not identical. At the least, while the purpose of goods in classes 1 and 3 may coincide, it will not be the same: bleach for hair in class 3, for example, has a specific purpose which is not shared by bleaching chemicals in class 1; talc (magnesium silicate) in class 1 differs in purpose from talcum powder in class 3, as well as in channels of trade, users and nature, since talcum powder for cosmetic purposes is usually mixed with other compounds such as perfume. Whilst I acknowledge the similarities, particularly in nature, between the goods which are the subject of the retail services, it seems to me that a retailer or wholesaler of chemicals per se will not be catering to the same market as a retailer of goods for personal care. First, the purchasers of chemicals will be business users/professionals rather than the general public. Second, chemicals other than for personal care or pharmaceutical use are unlikely to be sold through pharmacies or near to one another in large stores. There is no competition or complementarity. I accept that retail services all involve encouraging the purchase of goods and the placing of those goods before the consumer, and that there is some similarity in nature, purpose and method of use as a result. However, it seems to me that that is insufficient, without more, to result in an overall finding of similarity, because it would lead to findings of similarity in respect of radically different goods where the nature of the retail services themselves bears little resemblance to one another. The opponent itself accepts that not all retail services are automatically similar.<sup>31</sup> Overall, these services are not similar.

50. “Wholesale services connected with the sale of chemicals” are, in my view, not similar to any of the earlier services. The service provided by a chemicals wholesaler is unlikely

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<sup>31</sup> Opponent’ skeleton, §19.

to entail the physical inspection of products by the consumer and will be tailored towards providing important technical information about the goods for sale in written form or through staff with specialist knowledge. There is likely to be a heavier emphasis on distance selling, e.g. via the internet or telephone orders. A wholesaler of chemicals is likely to cater exclusively to professional purchasers. There will also be considerations about the safe storage and transport of chemicals which are alien to a retailer of cosmetics and toiletries. The high-level similarity occasioned by the fact that both services provide goods to consumers is not enough to result in a meaningful degree of similarity overall.

51. I do not see that the opponent's position would be improved if I were to conduct the assessment based on the goods in class 3. These goods are wholly different in nature, purpose and method of use from retail and wholesale services and are, therefore, even less similar overall.

### **Distinctive character of the earlier trade marks**

52. In *Lloyd Schuhfabrik*, 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)".

53. Ms Wilkinson-Duffy accepted at the hearing that the earlier marks are inherently "relatively low" indistinctiveness but submitted that the opponent has acquired a very strong reputation. Mr Aslan has made various submissions regarding what he considers the limited distinctiveness of the earlier marks, principal among which is that "THE" and "SHOP" are very common words and that "BODY" is, therefore, the dominant element of the earlier marks.

54. There is no dispute that "THE BODY SHOP" has little inherent distinctiveness. That is an inescapable conclusion, given that the mark conveys the clear message that the company is a manufacturer/purveyor of goods for use on the body.

55. I accept, however, that the opponent's use of the marks has resulted in acquired distinctive character. Notwithstanding my earlier criticisms of its evidence, the opponent has demonstrated significant UK sales and there is evidence both of shops on the UK high street for many years and of a certain level of customer recognition from the various awards which it has won, not least that it was by the end of 2019 (the relevant date is 13 November 2019) the UK's favourite beauty brand. I am satisfied that THE BODY SHOP was factually highly distinctive for cosmetics, toiletries, fragrance and retail services associated with those goods.

### **Comparison of trade marks**

56. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:



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

57. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

<b>Earlier marks</b>	<b>Contested mark</b>
THE BODY SHOP	The Bio Shop

58. Ms Wilkinson-Duffy submitted that the marks have a very strong similarity, though she accepted that there is slightly less aural than visual similarity between the two. Mr Aslan accepts that the marks are similar because they share the words “The” and “Shop” and have the same structure but points to differences between the words “Bio” and “BODY”.

59. Considering first the overall impression of the earlier marks, neither “THE” nor “SHOP” is inherently distinctive but nor is “BODY” for the goods or services upon which the opponent may rely. The average consumer will read the mark as a phrase meaning a provider of/shop for body care goods and the overall impression is contained in the phrase “THE BODY SHOP” as a whole.

60. Much the same applies to the contested mark. “Bio” may be interpreted in a range of ways but, in connection with the contested services, it is likely to be perceived as

indicative of products of natural or organic origin. The average consumer will perceive “The Bio Shop” as a complete phrase indicating a business which sells such goods.

61. The marks have an identical structure and share the words “The” and “Shop”. The central word of the respective marks differs but both begin with the letter “B”. There is a reasonably high level of visual similarity.

62. The marks are both four syllables long, the first and last of which are identical. Whilst the second syllable shares the consonant, the vowel sound is different. The third syllable is entirely different. There is a medium degree of aural similarity.

63. Plainly, both marks convey the notion of a shop. As wholes, they indicate a shop which trades in body care products and one which trades in natural goods, respectively. Any conceptual similarity which arises from the fact that they both indicate a shop is not a distinctive conceptual similarity.

### **Likelihood of confusion**

64. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*), from the perspective of the average consumer. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

65. Where there is no similarity between the goods and services, there can be no confusion.<sup>32</sup> The opposition against “retail and wholesale services connected with the sale of chemicals” is dismissed.

66. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10, where Iain Purvis Q.C., sitting as the Appointed Person, explained that:

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

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

68. I remind myself that conceptual differences are not always sufficient to avoid a likelihood of confusion but that there are occasions when conceptual differences may counteract the visual and aural similarities between trade marks.<sup>33</sup> I must also bear in

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<sup>32</sup> *Waterford Wedgewood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07P, EU:C:2009:288.

<sup>33</sup> *Nokia Oyj v OHIM*, Case T-460/07, EU:T:2010:18; *The Picasso Estate v OHIM*, Case C-361/04 P, EU:C:2006:25.

mind the distinctiveness of the common element. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

69. I acknowledge that "THE BODY SHOP" as a whole is factually highly distinctive. However, it is the mark as a whole which has acquired distinctiveness, not merely the words "THE" and "SHOP", or even the construction "THE ... SHOP". The elements common to both marks remain inherently descriptive. Even where the services are identical, and notwithstanding the visual and aural similarities, including the structure, between the marks, I see no reason why a consumer would misremember the marks, given the difference in their meanings. There is no likelihood of direct confusion.

70. As for indirect confusion, Ms Wilkinson-Duffy submitted that "bio" evokes a connection to nature which "THE BODY SHOP" is known for and that indirect confusion will result. My view is that even if I were to assume, without deciding, that the average consumer would bring to mind "THE BODY SHOP" when encountering the contested mark, there would be no assumption of a connection. I am doubtful that the evolution of a brand from "THE BODY SHOP" to "The Bio Shop" would be a natural one suggesting to the average consumer a commercial relationship; it is certainly not an obvious fit for any of the

categories identified by Mr Purvis in *LA Sugar* (at [17]). Given that the distinctiveness of the earlier marks is in the totality of the elements, and that the alteration of the word “BODY” for the word “Bio” would make a fundamental change to the concept of the trade mark, I do not think that the average consumer would think that the contested mark was an example of co-branding or that there was any other economic connection between the parties. There is no likelihood of indirect confusion.

71. The opposition based upon s. 5(2)(b) is dismissed.

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

72. Section 5(3) states:

“(3) A trade mark which-

(a) 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 the repute of the earlier trade mark”.

73. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*. The law appears to be as follows:

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

- b) The trade mark for which protection is sought must be known by a significant part of that relevant public: *General Motors*, paragraph 26;
- c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63;
- d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: *Intel*, paragraph 42;
- e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel*, paragraph 79;
- f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: *Intel*, paragraphs 76 and 77;
- g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel*, paragraph 74;
- h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a

characteristic or quality which is liable to have a negative impact 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 proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

## **Reputation**

74. In *General Motors*, 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”.

75. In addition to the evidence detailed above, there is evidence of the opponent's certification as a B Corp company in September 2019.<sup>34</sup> This certification is said to measure a company's entire social and environmental performance, with scores for categories such as "workers" and "environment". A *Guardian* article in 2016 reports the opponent's campaign for "bio-bridges" (regenerating forest and connecting habitats) and an article from *Elite Daily* concerns the opponent's 2018 campaign to end animal testing worldwide.<sup>35</sup> Mr O'Byrne says that 8 million signatures were collected for the latter petition, which was taken to the UN, but it is not clear whether those signatures were all or mostly from UK/EU customers (animal testing for cosmetics had been banned by the EU in 2013: p. 187).<sup>36</sup> It is said that the opponent launched its Community Fair Trade programme in 1987, which targets small-scale, traditional farmers and offers good trading practices and "independence-building" prices. It had 18 such suppliers at the date of Mr O'Byrne's statement (January 2021).<sup>37</sup>

76. The evidence also includes a press release about a child protection campaign and extracts from various books, with titles such as *Companies That Changed The World* and *Superbrands*.<sup>38</sup> The books detail the opponent's ethos, such as its "profits with principle" philosophy, use of natural ingredients and its activism regarding, for example, animal testing and deforestation. The company is referred to as, for example, an "iconic 'natural' firm", an "undisputed revolutionary and brand leader" and "ethical".<sup>39</sup> None of this material is more recent than 2012. An article which appears to be dated early 2020 mentions the 1976 beginnings of the opponent and introduces the company as not only "the first cosmetics and toiletries retailer to introduce RPSO-certified palm oil to the masses, but it's also a brand that has continually led by example in terms of its recycling initiatives, the commitment to fair trade and sustainability".<sup>40</sup>

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<sup>34</sup> O'Byrne, §19; POB5.

<sup>35</sup> POB7, POB8.

<sup>36</sup> O'Byrne, §27.

<sup>37</sup> O'Byrne, §16.

<sup>38</sup> POB3.

<sup>39</sup> POB3, pp. 27, 30, 43.

<sup>40</sup> Pp. 289-290.



77. For the reasons given at paragraph 55, above, I am satisfied that the opponent's marks had a strong reputation for cosmetics, fragrance, toiletries and related retail services at the relevant date. Taking all of the evidence into account, which includes references to the opponent's "green" credentials and awards in the relevant period for its ethical and sustainable practices, I consider that the reputation at the relevant date was one of a company producing toiletries with natural ingredients, that has ethical trading practices, is against animal testing and is concerned with sustainability. Although campaigns on other social issues are mentioned, they do not appear with sufficient frequency to persuade me that the opponent's reputation includes, for example, an image as a business with a particular interest in child protection.

78. The claim to a reputation extends to the full specifications of the earlier marks. I accept that the opponent has been involved in various campaigns and charitable endeavours. However, there is a difference, it seems to me, between promoting good causes as part of a brand ethos or corporate social responsibility and offering, for example, charitable services or administrative services connected with humanitarian awards as services themselves. The evidence does not, in my view, go any further than establishing the former proposition. There is no evidence of any turnover in respect of such services and nothing to suggest that the opponent has itself provided such services. There is no evidence of use in relation to any other goods and services. The opponent's claim to a reputation in all of the remaining goods and services is rejected.

## **Link**

79. Whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are

### The degree of similarity between the conflicting marks

80. I adopt the findings made at paragraphs 58 to 63, above. There is a reasonably high degree of visual and a medium degree of aural similarity. There is some conceptual similarity between the marks but this arises from descriptive elements.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

81. I adopt my reasoning at paragraphs 43 to 51. The similarity between the respective goods and services varies from no similarity to identity. For the reasons given at paragraphs 32 to 35, the average consumers of the goods and services are professionals and/or member of the general public who will pay between a medium and a high degree of attention, depending on the particular goods and services.

The strength of the earlier mark's reputation

82. The earlier mark has a strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

83. For the reasons given at paragraph 55, above, the earlier mark is factually distinctive to a high degree. However, the evidence does not come close to establishing that the words "THE ... SHOP" on their own or that mark structure are distinctive of the opponent.

Whether there is a likelihood of confusion

84. There is no likelihood of confusion. In respect of those services which are not similar and where the opposition was dismissed on that basis, I see no prospect of a likelihood of confusion. The greater distance between the services, when taken alongside the conceptual distinctions between the marks and the non-distinctive common element will not induce the consumer either to mistake the marks or to assume that there is an economic connection.

85. Bearing in mind all of the above, my view is that the earlier mark will not be brought to mind. Whilst I am mindful of the acquired highly distinctive nature of the opponent's mark, the conceptual distance between the marks is unlikely to bring the earlier mark to mind, even for identical services. I acknowledge that the marks have an identical structure

but it is an ordinary grammatical description of a type of shop. I do not think that the fact that the marks are in the format “the ... shop”, or that the second word in both starts with a “B”, is enough for the required link. Nor do I think that the words “Bio” and “Body”, even taking into account the marks’ identical construction, convey a sufficiently close meaning that the contested mark would bring the earlier mark to mind. The opposition based upon s. 5(3) is dismissed.

### **Conclusion**

86. The opposition has failed. The application will proceed to registration for all of the services in its specification.

### **Costs**

87. Mr Aslan has been successful and would ordinarily be entitled to an award of costs. However, the tribunal wrote to Mr Aslan on 17 May 2021 asking him to complete and return a costs pro forma if he sought costs, otherwise no costs other than official fees would be awarded. The pro forma was not returned and Mr Aslan has incurred no costs from official fees. Accordingly, I order that the parties bear their own costs.

**Dated this 24<sup>th</sup> day of August 2021**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**

## **ANNEXE**

### **EU 1980416**

Class 3: Perfumes, soaps, shampoos, cosmetics, non-medicated toilet preparations; hair colourants; hair conditioners, hair dyes, hair lotions or hair styling preparations; deodorants; depilatories; anti-perspirant preparations; non-medicated talcum powder for toilet purposes; sun-tanning preparations (cosmetics) sun care skin preparations, sun block preparations; non-medicated massage preparations; bath additives, bath oils or bath salts, not for medical purposes; shaving preparations; dentifrices; essential oils; beauty masks, facial packs, nail care preparations, nail varnish; pumice stone, cotton sticks; cotton wool for non-medical purposes; scented articles all for perfumery purposes, pot pourri, powder-impregnated paper for cosmetic use, abrasives for personal use; all included in class 3.

Class 21: Bowls, basins, boxes of glass and metal, containers for household or kitchen use, flasks, pitchers, vases; vanity cases, picnic baskets, porcelain ware, pots and flower pots; soap dishes, boxes and dispensers, tableware including coasters and candlesticks; brushes including toilet brushes; loofahs and sponges; tea services, plates, drinking vessels including cups and mugs; glassware including glass receptacles, jars, jugs and indoor terrariums; kitchen utensils including cutting boards, moulds, hand-operated mills and spice sets; cosmetic utensils including comb and comb cases, eyebrow brushes, appliances for removing make-up, nail brushes, powder compacts, powder puffs, shaving brushes and their stands, tooth brushes, tooth picks, toilet cases and utensils; perfume burners and sprays, vapourisers and deodorising apparatus, not included in other classes; works of art of porcelain, terracotta or glassware, shoe-horns; watering cans; all included in class 21.

Class 42: Research, development and the provision of information and advice concerning cosmetics, skin and hair care preparations.

## **EU 2305175**

Class 35: Retail services in respect of beauty products, toiletries, cosmetics, make-up, hair care preparations, perfumes, skin care preparations, deodorants and anti-perspirants; services relating to the establishment of business and retail stores; services relating to advertising and the preparation and distribution of promotional materials; services relating to business management.

Class 36: Charitable fund raising.

Class 42: Administration of cultural and educational award programmes, and humanitarian grants and award programmes; financial services including providing educational scholarships, fellowships, and humanitarian grants through cultural and educational programmes; educational and training services including conducting training seminars, conferences, and workshops in the field of philanthropic, humanitarian and services activities; promoting public awareness of the need for cultural, humanitarian and educational programmes that address issues such as injustice, poverty and universal human rights.