

O/674/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003492300
BY THE STOCKROOM (KENT) LIMITED
TO REGISTER THE TRADE MARK:

Purity

IN CLASSES 3 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 421484
BY SWIRL CONSUMER PRODUCTS LIMITED T/A FMCG

AND

IN THE MATTER OF UK TRADE MARK
REGISTRATION NO. UK00002594131
IN THE NAME OF SWIRL CONSUMER PRODUCTS LIMITED T/A FMCG
FOR THE TRADE MARK:

Purity Plus

IN CLASS 3

AND

THE APPLICATION FOR REVOCATION THEREOF UNDER NO. 503481
BY THE STOCKROOM (KENT) LIMITED

BACKGROUND AND PLEADINGS

1. On 21 May 2020, The Stockroom (Kent) Limited (“Stockroom”) applied to register the trade mark **Purity** shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 19 June 2020. Stockroom seeks registration for the following goods and services:

Class 3 Cosmetic nail care preparations; nail strengtheners; cosmetic nail care preparations for artificial and natural nails; gel polish; cosmetic and beauty care products; artificial nail preparations; nail care preparations; nail gel; nail cosmetics.

Class 35 Online retail store services relating to cosmetic and beauty products, cosmetic nail care preparations, nail strengtheners, cosmetic nail care preparations for artificial and natural nails, gel polish, cosmetic and beauty care products, artificial nail preparations, nail care preparations, nail gel, hand operated hygienic and beauty implements, nail buffers, nail files, nail clippers, nail scissors, manicure and pedicure tools, nail brushes, electrical dryers for the hands and nails, led lights.

2. The application was opposed by Swirl Consumer Products Limited T/A FMCG (“Swirl”) on 18 September 2020. The opposition is based upon sections 5(2)(b) and 5(3) of Trade Marks Act 1994 (“the Act”). Swirl relies on the following trade mark:

Purity Plus

UK registration no. UK00002594131

Filing date 12 September 2011; registration date 3 February 2012

Relying upon all goods for which the earlier mark is registered, namely:

Class 3 Soaps, perfumery, essential oils, cosmetics, hair lotions, deodorants for personal use, preparations for cleaning hair and body, preparations for care of the skin.

3. Under section 5(2)(b), Swirl claims that there is a likelihood of confusion because the goods and the marks are similar.

4. Under section 5(3), Swirl claims to have developed a reputation for all of the class 3 goods for which the mark is registered. Swirl claims that use of Stockroom's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark and result in economic loss and damage to Swirl's business.

5. Stockroom filed a counterstatement denying the claims made.

6. On 1 December 2020, Stockroom sought revocation of Swirl's mark on the grounds of non-use. Under section 46(1)(b) Stockroom claims non-use in respect of Swirl's mark for the period between 20 May 2015 and 19 May 2020, claiming an effective date of revocation of 20 May 2020.

7. Swirl filed a counterstatement defending its registration for all the goods for which it is registered, on the basis that it has been used throughout the relevant period.

8. On the 18 March 2021, the Tribunal wrote to the parties informing them of the consolidation of the revocation action no. 503481 and the opposition no. 421484.

9. Swirl is represented by Hilton Law and Stockroom is represented by J P Mitchell Solicitors. Only Swirl filed evidence in chief and neither party filed evidence in reply. Neither party requested a hearing, but both parties 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

11. Swirl filed evidence in the form of the witness statement of Mark Hilton dated 30 March 2021. Mr Hilton is the Partner and Solicitor of Hilton Law who is acting on behalf of Swirl. Mr Hilton's statement was accompanied by 1 exhibit (MJH1).

12. Both parties submitted written submissions in lieu on the 13 July 2021.

13. Whilst I do not propose to summarise the evidence and submissions here, I have taken them into consideration and will refer to them below where necessary.

PRELIMINARY ISSUE

14. In its written submissions, Stockroom made a point that I intend to address as a preliminary issue.

15. I note that Stockroom emailed the tribunal on 27 May 2021 stating that they had decided not to file evidence during the evidence rounds. However, in their submissions in lieu, Stockroom submitted the following:

“10. The Applicant submits that the Proprietor's final piece of evidence, namely certain internal 'customer sales' figures, are in sufficient to prove use of the Proprietor's mark. The figures provided by the Proprietor are internal and entirely self-generated. As such, they do not provide a means of establishing trade.

11. When one looks at these 'customer sales' figures in more detail, it is also clear that they fail to provide any indication of where any alleged sales took place. There is certainly nothing to link the alleged sales to the UK. There are various companies listed in these internal records which are clearly foreign, for example (i) "Feminia Family s.r.o." appears to be a Slovak company, (ii) "Dentex Trading SRL" appears to be an Italian company, and (iii) 'McGloins-Supertex Pty' could be either an Australian or South African company. [...]

12. [...] Mr Hilton’s statement fails to provide any context or any explanation for the alleged ‘customer sales’ figures and the IPO has no basis for making any assumptions or drawing any inferences in favour of the Proprietor. It must also be noted that even if one accepts that the ‘customer sales’ figures are genuine (which the Applicant does not accept), they fail to refer to any products other than cleaning products.”

16. Firstly, I note Stockroom’s submission that the sales figures provided are self-generated by Swirl and cannot, therefore, be relied upon to show genuine use. In this regard, I refer to the comments of Mr Richard Arnold QC (as he was then), sitting as the Appointed Person in *Extreme Trade Mark*, Case BL O/161/07, at paragraph 36 in which he states the following:

“Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.”

17. I bear in mind that Stockroom did not raise these criticisms during the evidence rounds so that Swirl could respond to them, nor did they request cross-examination. In any event, I see no reason to disbelieve these figures provided by Swirl on the basis that they are ‘self-generated’. Consequently, I do not consider that these submissions assist Stockroom.

DECISION

The Revocation

18. Section 46 of the Act states:

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

(a) [...]

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

19. Section 100 is also relevant, which reads:

“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.”

20. 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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, 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].”

21. The relevant period within which use of the mark has been challenged is the five year period of 20 May 2015 to 19 May 2020.

Form of the mark

22. Under exhibit MJH1, in the “Inventory- Customer Sales” evidence provided for the period of 1 January 2015 to 30 November 2020, use of the mark as registered is clearly demonstrated. This is, therefore, use upon which Swirl can rely.

Sufficient/genuine use

23. Under exhibit MJH1, Mr Hilton provided screenshots dated 6 January 2021 of Google internet search results for ‘purity plus’. These fall after the relevant period and therefore will not be taken into consideration. However, they would not have strengthened Swirl’s case because there is nothing within the screenshots to demonstrate that all the results were Swirl’s products.

24. Mr Hilton in his witness statement gave evidence that the sales figures for goods sold to retailers and wholesalers throughout the UK is contained within the Inventory-Customer Sales evidence in MJH1. These sales confirm that Swirl has been trading under the Purity Plus mark during the period of 1 January 2015 to 30 November 2020. I accept that some of the company names on the invoices do indicate that the recipients are located outside of the UK. For example, some of the company names end in alternatives to LTD (which is used for UK-incorporated companies) such as “s.r.o.” or “SRL”. I recognise that these companies will, therefore, have been registered outside of the UK. In any event, even if we do not take into account the sales made to companies with alternative endings to LTD, there is still a significant amount of sales made to UK LTD companies. This combined with the narrative evidence from Mr Hilton’s amended witness statement dated 30 March 2021, that from the sales information provided it was clear that the products were supplied under Swirl’s mark to stores, retailers and wholesalers throughout the United Kingdom, is sufficient enough to demonstrate that sales were made throughout the UK.

25. Mr Hilton also submits in his witness statement that the total sales for this period amounted to £351,446.03. I acknowledge that part of these costs will relate to the period before and after the relevant period. These costs are broken down into the following products:

- Purity Plus Charcoal Facial Wash

- Purity Plus Charcoal Facial Scrub
- Purity Plus Charcoal Face Mask
- Purity Plus Charcoal Facial Wipes
- Purity Plus Charcoal Pore Strips
- Purity Plus Charcoal Micellar Water
- Purity Plus Activated Charcoal
- Bamboo Charcoal and Sea Salt Face
- Purity Plus Charcoal Infused Konjac

26. The costs for each product are broken down into invoiced quantity, amount, discount amount and profit, albeit the profit column is redacted. As submitted by Stockroom, the figures provided under the Inventory- Customer Sales are only in relation to the above products. No other evidence is provided for their remaining registered goods.

27. It is clear that the majority of the above goods are all in relation to skincare which are recognisable from their descriptors such as 'facial wash' and 'micellar water'. However, Swirl does not provide any information as to what "Activated Charcoal", "Bamboo Charcoal and Sea Salt Face" and "Charcoal Infused Konjac" are. Consequently, as it is unclear what these goods are, I do not consider that they show genuine use of the mark in relation to the goods relied upon.

28. Taking the above into account, I am satisfied that Swirl has demonstrated genuine use of the earlier mark in the UK during the relevant period only in relation to Purity Plus Charcoal Facial Wash, Purity Plus Charcoal Facial Scrub, Purity Plus Charcoal Face Mask, Purity Plus Charcoal Facial Wipes, Purity Plus Charcoal Pore Strips and Purity Plus Charcoal Micellar Water.

Fair Specification

29. I must now consider whether, or the extent to which, the evidence shows use of the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,

BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law 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.”

30. 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."

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

32. Clearly, Swirl has demonstrated use for their products Charcoal Facial Wash, Charcoal Facial Scrub, Charcoal Facial Wipes, Charcoal Pore Strips and Charcoal Micellar Water. I consider that the breadth of these goods will enable Swirl to rely upon the broader category of "preparations for care of the skin" in their class 3 specification. However, it is important to note that all the above goods include the key ingredient charcoal. Therefore, I consider the term should be limited to preparations for care of the skin including charcoal. There is nothing before me to suggest that Swirl sells a broader range of goods in the UK than this.

33. For the sake of completeness, I recognise that it could be argued that the above goods fall within the broader term "cosmetics" in Swirl's class 3 specification. Cosmetics are defined as "any preparation applied to the body, especially the face,

with the intention of beautifying it”.¹ However, cosmetics is such a broad term which would encompass a whole range of products, from make-up to skincare. Consequently, I consider “preparations for care of the skin including charcoal” to be the appropriate sub-category of cosmetics which all of Swirl’s above goods fall under.

34. Taking all of this into consideration, I consider a fair specification for the registration UK00002594131 to be:

Class 3 Preparations for care of the skin including charcoal.

35. The revocation based upon section 46(1)(b) has been partially successful resulting in revocation of the following goods:

Class 3 Soaps, perfumery, essential oils, cosmetics, hair lotions, deodorants for personal use, preparations for cleaning hair and body.

The Opposition

Section 5(2)(b)

36. Section 5(2)(b) reads as follows:

“5(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 of association with the earlier trade mark.”

¹ <https://www.collinsdictionary.com/dictionary/english/cosmetic>

37. 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 IR 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

38. The trade mark upon which the Swirl relies qualifies as an earlier trade mark because it was applied for at an earlier date than Stockroom’s mark pursuant to section 6 of the Act. As the earlier trade mark had completed its registration process more than five years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act. I have already considered the extent to which Swirl has used its mark in relation to the revocation above and as the effective date of revocation was 20 May 2020 (before the filing date of the application in issue), Swirl will only be entitled to rely upon the narrower specification that I have set out above. In any event, as the same principles apply to both proof of use under section 6A and revocation for non-use, I would have reached the same conclusions as set out above.

Section 5(2)(b) case law

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

40. As a result of my findings above, the competing goods and services are as follows:

Swirl's goods (the opponent)	Stockroom's goods and services (the applicant)
<p><u>Class 3</u> Preparations for care of the skin including charcoal.</p>	<p><u>Class 3</u> Cosmetic nail care preparations; nail strengtheners; cosmetic nail care preparations for artificial and natural nails; gel polish; cosmetic and beauty care products; artificial nail preparations; nail care preparations; nail gel; nail cosmetics.</p> <p><u>Class 35</u> Online retail store services relating to cosmetic and beauty products, cosmetic nail care preparations, nail strengtheners, cosmetic nail care preparations for artificial and natural nails, gel polish, cosmetic and beauty</p>

	<p>care products, artificial nail preparations, nail care preparations, nail gel, hand operated hygienic and beauty implements, nail buffers, nail files, nail clippers, nail scissors, manicure and pedicure tools, nail brushes, electrical dryers for the hands and nails, led lights.</p>
--	---

41. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 for 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.”

42. Guidance on this issue has come from Jacob J. (as he then was) in 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

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

“... 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.”

44. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

45. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated 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.”

46. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC 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 the responsibility for those goods lies with the same undertaking.”

47. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Class 3

Cosmetic and beauty care products

48. Cosmetics are defined as “any preparation applied to the body, especially the face, with the intention of beautifying it”.² I also consider that ‘beauty care’ products would cover a range of goods such as hair care, nail care, body care and skincare items. Consequently, I consider that Swirl’s “preparations for care of the skin including charcoal” fall within the broader category of *cosmetic and beauty care products*. I consider them identical on the principle outlined in *Meric*.

Cosmetic nail care preparations; nail strengtheners; cosmetic nail care preparations for artificial and natural nails; gel polish; artificial nail preparations; nail care preparations; nail gel; nail cosmetics.

49. I consider that the above goods overlap with Swirl’s “preparations for care of the skin including charcoal”. I consider that there is an overlap in user. I also consider that there is some limited overlap in purpose to the extent that they are all types of beauty care products used to improve, protect and enhance the appearance of the body. However, the purpose differs to the extent that they are intended for use on different parts of the body. The method of use and nature will not overlap. There may be some limited overlap in trade channels, such as pharmacies. They are neither in competition nor complementary. Taking the above into account, I consider the goods to be similar to a between a low and medium degree.

Class 35

50. *In Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods,

² <https://www.collinsdictionary.com/dictionary/english/cosmetic>

retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

51. 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 stated (at paragraph 9 of his judgment):

“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.

52. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*³, and *Assembled Investments (Proprietary) Ltd v. OHIM* Case T-105/05⁴, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded:

(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;

³ Case C-411/13P

⁴ paragraphs [30] to [35] of the judgment

- 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).

Online retail store services relating to cosmetic and beauty products [...] cosmetic and beauty care products

53. "Preparations for care of the skin including charcoal" in Swirl's specification may overlap with Stockroom's above services. As set out in the case law 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. I consider that the same applies to Stockroom's above services. Therefore, I consider there to be a medium degree of similarity between Swirl's goods and Stockroom's services.

Online retail store services relating to cosmetic nail care preparations, nail strengtheners, cosmetic nail care preparations for artificial and natural nails, gel polish, artificial nail preparations, nail care preparations, nail gel, hand operated hygienic and beauty implements, nail buffers, nail files, nail clippers, nail scissors, manicure and pedicure tools, nail brushes, electrical dryers for the hands and nails, led lights.

54. I consider that Swirl's "preparations for care of the skin including charcoal" may overlap with Stockroom's above services. I consider that there may be some limited

overlap in trade channels, such as online pharmacy stores. They will also overlap in user. However, I do not consider there will be any overlap in nature, purpose and method of use. They are neither in competition nor complementary because the goods and services are not important or indispensable for each other. Consequently, I consider Swirl's goods and Stockroom's services to be similar to a very low degree.

The average consumer and the nature of the purchasing act

55. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

56. The average consumer for the goods will be members of the general public, however, I do not discount that it could also include a professional user such as a beautician or nail technician. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, ingredients, aesthetic and the suitability for their specific needs. Therefore, the level of attention paid during the purchasing process will be medium.

57. The average consumer for the services will also be members of the general public, however, I do not discount that it could also include a professional user such as a beautician or nail technician. The cost of the purchase is likely to vary and the frequency is likely to be low. The average consumer will take various factors into consideration when selecting the services such as the location, cost, availability of products and the range of products on offer. Therefore, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

58. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, or online equivalent. The services are likely to be purchased from specialist retailers or online equivalent. Visual considerations for both are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

Comparison of the trade marks

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

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

60. 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.

61. The respective trade marks are shown below:

Swirl's trade mark (the opponent)	Stockroom's trade mark (the applicant)
Purity Plus	Purity

62. Swirl's mark consists of the words 'Purity Plus'. The overall impression of the mark lies in the combination of these words.

63. Stockroom's mark consists of the word 'Purity'. There are no other elements to contribute to the overall impression which lies in the word itself.

64. Visually, the marks coincide in the presence of the word 'Purity'. This acts as a point of visual similarity. However, Swirl's mark contains the additional word 'Plus' at the end of the mark. I bear in mind that the beginnings of marks tend to make more of an impact than the ends. Overall, I consider the marks to be visually similar to between a medium and high degree.

65. Aurally, 'Purity' will be given its ordinary English pronunciation in both marks. 'Plus' will also be given its ordinary English pronunciation in Swirl's mark. Consequently, the marks are aurally similar to between a medium and high degree.

66. Both marks contain the word purity, which is the state or quality of being pure.⁵ Swirl's mark contains the additional word plus, which suggests that it is excessively

⁵ <https://www.collinsdictionary.com/dictionary/english/purity> (British English)

pure, or even purer than pure. This acts as a small conceptual point of difference. Consequently, I consider the marks to be conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

67. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

68. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and 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 that has been made of it.

69. Swirl has not pleaded that its mark has acquired enhanced distinctiveness. However, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. Swirl has provided sales figures to enable me to assess the extent of the use that has been made of the mark. For the period of 1 January 2015 to 30 November 2020, Mr Hilton submits that the total sales amounted to £351,446.03, for the relevant goods, bearing the mark Purity Plus. Mr Hilton also submitted that it is clear from the sales information provided by Swirl that they have supplied products under the mark to stores, retailers and wholesalers throughout the UK. However, I note that no market share figures have been provided and that the turnover figures do not appear to represent a particularly significant market share in what must be a fairly extensive market in the UK. Swirl has also not provided any information or figures in relation to advertising. Taking the above into account, I do not consider that Swirl has demonstrated that the distinctive character of the mark has been enhanced through use.

70. I will now consider the inherent distinctiveness of Swirl's mark.

71. The words 'Purity Plus' both have ordinary English dictionary meanings. Together, they convey the concept that something is excessively pure. It is not descriptive of the goods for which the mark is registered. However, it is allusive and suggestive that the goods do not contain any harmful substances, and that they are made from clean or natural ingredients, such as charcoal. Taking the above into account, I consider Swirl's mark to be inherently distinctive to between a low and medium degree.

Likelihood of confusion

72. 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 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, 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.

73. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually, aurally and conceptually similar to between a medium and high degree.
- I have found the earlier mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer as members of the general public and professionals such as beauticians or nail technicians, who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties goods to vary from being similar to a very low degree to identical.

74. Taking all of the factors listed in paragraph 73 into account, particularly the visual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the additional word 'Plus' in Swirl's mark will be overlooked by the average consumer. I do not consider there to be a likelihood of direct confusion.

75. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

76. I bear in mind the decision of *Comic Enterprises v Twentieth Century Fox* [2016] EWCA 41 at §§75-84. In that case Kitchin LJ explained at §80:

80. ...whether a particular instance of confusion is “right way round” or “wrong way round” may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign. Further, in both cases the consumer thinks that the goods or services in issue come from the same undertaking or economically linked undertakings, and they may be equally damaging to the distinctiveness and functions of the mark.

77. I consider that the common use of the word ‘purity’ will lead the average consumer to conclude that that the marks originate from the same or economically linked undertakings. Taking the above case law into account, I consider that the average consumer will see the additional word ‘plus’ in Swirl’s mark and perceive it as an alternative mark for a sub-brand of ‘purity’. Therefore, as the average consumer will see the marks as being used by the same or economically linked undertakings, I

consider there to be a likelihood of indirect confusion for those goods that I have found to be similar to a medium degree, and identical.

78. For the goods and services that I have found to be similar to only between a low and medium degree or a very low degree, I consider that the distance between the goods and services will be sufficient to offset the similarity of the marks. In my view, the average consumer would put the commonality of the word 'purity' down to a coincidence rather than indicating economic connection. Consequently, for those goods and services I do not consider that there is a likelihood of indirect confusion.

79. The opposition based upon section 5(2)(b) has succeeded in relation to the following goods and services:

Class 3 Cosmetic and beauty care products.

Class 35 Online retail store services relating to cosmetic and beauty products and cosmetic and beauty care products.

Section 5(3)

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

“5(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 repute of the earlier trade mark.”

81. As noted above, the mark relied upon qualifies as an earlier mark pursuant to section 6 of the Act. I note that section 5(3) is also subject to proof of use, and

therefore, Swirl can only rely upon the narrower specification according to my revocation for non-use and proof of use findings that I have set out above.

82. 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* and Case C-323/09, *Marks and Spencer v Interflora* and 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 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* 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 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*).

83. The conditions of section 5(3) are cumulative. Firstly, Swirl and Stockroom's marks must be identical or similar. Secondly, Swirl must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of

the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur and/or that the contested mark will, without due case, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that the goods and services be 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.

84. The relevant date for the assessment under section 5(3) is the date of application i.e. 21 May 2020.

Reputation

85. 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.”

86. In determining whether Swirl has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”

87. The earlier mark is a UKTM. Consequently, Swirl must establish a reputation in the UK. As previously highlighted, Mr Hilton in his witness statement gave evidence that it is clear from the sales information provided by Swirl that they have supplied products under the mark to stores, retailers and wholesalers throughout the UK. Even on the basis that all of the customers contained in the Inventory- Customer Sales evidence are based in the UK, I do not consider the evidence sufficient to prove a reputation. No market share figures have been provided, and the turnover figure that has been provided does not appear to represent a particularly significant market share in what must be a fairly extensive market in the UK. I also note that Swirl has not provided any figures for advertising expenditure or examples of advertising in the UK. Consequently, Swirl’s evidence does not demonstrate a reputation in the UK for the goods relied upon.

88. The opposition under section 5(3) fails.

CONCLUSION

Revocation

89. The registration UK00002594131 in the name of Swirl Consumer Products Limited T/A FMCG will be revoked for the following goods:

Class 3 Soaps, perfumery, essential oils, cosmetics, hair lotions, deodorants for personal use, preparations for cleaning hair and body.

90. The effective date of revocation is 20 May 2020.

91. The registration UK00002594131 in the name of Swirl Consumer Products Limited T/A FMCG will remain registered for the following amended specification:

Class 3 Preparations for care of the skin including charcoal.

Opposition

92. The opposition is partially successful in respect of the following goods and services, for which application no. UK00003492300 is refused:

Class 3 Cosmetic and beauty care products.

Class 35 Online retail store services relating to cosmetic and beauty products and cosmetic and beauty care products.

93. The application no. UK00003492300 can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

Class 3 Cosmetic nail care preparations; nail strengtheners; cosmetic nail care preparations for artificial and natural nails; gel polish; artificial nail preparations; nail care preparations; nail gel; nail cosmetics.

Class 35 Online retail store services relating cosmetic nail care preparations, nail strengtheners, cosmetic nail care preparations for artificial and natural nails, gel polish, artificial nail preparations, nail care preparations, nail gel, hand operated hygienic and beauty implements, nail buffers, nail files, nail clippers, nail scissors, manicure and pedicure tools, nail brushes, electrical dryers for the hands and nails, led lights.

COSTS

94. Stockroom has enjoyed a greater degree of success in both the revocation and the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in

the award of costs made to reflect Stockroom's only partial success. In the circumstances, I award Stockroom the sum of **£950** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering Swirl's Statement (x2)	£200
Preparing and filing written submissions	£200
Considering Swirl's evidence	£350
Official Fee for revocation	£200
Total	£950

95. I therefore order Swirl Consumer Products Limited T/A FMCG to pay The Stockroom (Kent) Limited the sum of £950. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of September 2021

L FAYTER
For the Registrar