

BL O/725/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3327788

BY

OASIS FASHIONS ONLINE LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

OASIS

AND

OPPOSITION NO. 414539 THERETO

BY

SMITHERS-OASIS COMPANY

Background and pleadings

1. Oasis Fashions Online Limited (hereafter “the applicant”) applied to register the trade mark **OASIS** on 27 July 2018. It was accepted and published in the trade marks journal on 31 August 2018, for the following goods:

Class 2: Paints and washes; coatings; varnishes; lacquers; thinners; dyes; colorants; pigments; inks; metal in foil and powder form for use in painting, decorating, printing and art; primers; acrylic paints; decorating paints; exterior paints; fabric paints; floor paints; interior paints; metallic paints; paint powders; paint preparations; paint primers; paint products [other than paint boxes for use in school]; paint sealers; paints for arts and craft; spray paint; parts and fittings for all the aforesaid goods; all specifically for painting home interiors or exteriors and none of the aforementioned goods being for use in the floral industry or in relation to flower arranging.

Class 8: Food preparation implements; cutlery for eating, preparing or serving food; biodegradable cutlery for eating, preparing or serving food; cutlery of precious metals for eating, preparing or serving food; boxes adapted for cutlery for eating, preparing or serving food; forks for eating, preparing or serving food; knives for eating, preparing or serving food; spoons for eating, preparing or serving food; parts and fittings for all the aforesaid goods.

Class 21: Household or kitchen utensils and containers; glassware, porcelain and earthenware; chinaware; crockery; cups and mugs; dishware; glasses; hollowware; porcelain ware; metal pans; glass pans; pots; none of the aforesaid goods for use in or directed towards the floral trade or specifically designed to receive flower arrangements in floral foam; brushes; articles for cleaning purposes for household purposes; none of the aforesaid goods for use in or directed towards the floral trade; kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; bakeware; dinnerware; drinking vessels and barware; ovenware; cooking pans; cooking pots; animal activated animal feeders; bird feeders; birdcages; brushes for pets; cages for carrying pets; cages for pets; combs for animals; pet grooming gloves; brushes for grooming pet animals; feeding vessels for pets; fish bowls;

food containers for pet animals; litter boxes for pets; litter trays for pets; pet feeding and drinking bowls; non-mechanised animal feeders; toothbrushes for pets; parts and fittings for all the aforesaid goods.

2. On 30 November 2018, Smithers-Oasis Company (hereafter “the opponent”) opposed all of the goods of the contested trade mark, on the basis of sections 5(1), 5(2)(a) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).
3. The Opponent relies on the following two earlier European Union Trade Marks (EUTMs) as the basis of its opposition under sections 5(1) and 5(2)(a) of the Act.¹
4. EUTM **6565444** is registered for the mark **OASIS**. This mark was filed on 9 January 2008 and registered on 16 February 2009. This earlier mark is relied upon to oppose only the class 2 goods of the contested application. The opponent relies only on a part of the earlier goods under this EUTM, namely:

Class 2: Paints, glazes and varnishes; spray paints, spray glazes, spray varnishes and spray sealants, spray artificial snow; not aimed at the motor industry.

5. The opponent claims that the marks at issue are identical and that some of the contested goods are identical to the earlier goods relied upon in class 2, and some are highly similar. The opponent states that section 5(1) applies for the goods that are identical and section 5(2)(a) applies for the goods that are highly similar; given that the marks are identical.
6. The second EUTM relied upon is No. **5867965** which is also registered for the mark **OASIS**. This earlier mark was filed on 30 April 2007 and registered on 27 March 2008. This earlier mark is relied upon to oppose only the class 8 goods of the contested application. The opponent relies only on a part of the earlier goods under this EUTM, namely:

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

Class 8: Hand tools and implements; hand tools for use in relation to plants, flowers and floral displays; cutting tools for use by florists and crafters; floral scissors, floral pruners, floral foam knives, floral knives, folding knives, retractable cutters, floral snips, flower thorn strippers, floral pruning shears, wire cutters, and wire pliers.

7. The opponent states that the marks at issue are identical and that the earlier 'floral knives, folding knives' are identical to the contested 'knives' so that section 5(1) applies, and that all of the other class 8 contested goods are similar to the remaining class 8 goods relied upon under EUTM 5867965, so that section 5(2)(a) applies; given that the marks are identical.
8. The opponent also opposes the class 21 goods of the contested mark on the basis of section 5(4)(a) relying on the unregistered mark **OASIS** which it states has been used throughout the UK since 1992 on the following goods:

Household containers; tableware; glassware, porcelain and earthenware; jars; candle holders and candle sticks; bottles; vases; bowls; plant pots; plates; plant holders; jugs; plant baskets; urns; dishes; crates; hurricane lamps.
9. The opponent claims that passing off would occur in respect of the applicant's class 21 goods.
10. The opponent states that it enjoys goodwill in the mark OASIS for the goods listed above, and that use of an identical sign by the applicant in respect of identical and similar contested class 21 goods, will lead to misrepresentation and damage, in the form of lost sales, dilution to its rights in the mark and detriment to its goodwill, in particular, if the goods of the applicant are not of the same quality as those of the opponent.
11. The applicant filed a counterstatement expressly denying that its application was contrary to section 5(1) and section 5(2)(a). It also denied that the opponent owns unregistered rights in the mark OASIS since 1992 or that it has used that unregistered mark on the goods claimed. It denied that the opponent has goodwill in the unregistered mark or that misrepresentation and damage would occur as a result

of the use of the contested mark. The applicant also requested proof of use of the two earlier EUTMs relied upon under 5(1) and 5(2)(a).

12. The trade marks upon which the opponent relies for the purposes of the opposition under section 5(1) and 5(2)(a) qualify as earlier trade marks under the provisions contained in section 6 of the Act. As the earlier trade marks had been registered for more than five years at the date the application was published they are subject to the proof of use provisions contained in section 6A of the Act.

13. The opponent submitted evidence to prove use of the earlier EUTMs and to support the claim of goodwill in the unregistered mark OASIS. I will summarise that evidence to the extent that I feel it is necessary, later in this decision. The applicant did not submit any evidence.

14. A hearing was requested which came before me on 21 July 2021 via video conference. The opponent was represented by Mr Richard Wylie of HGF Ltd, the applicant was represented by Ms Cathy Ayers of Wilson Gunn.

Evidence of the opponent

15. The opponent's evidence comprises a witness statement of Mr Stephen Short, who is the Managing Director of Smithers-Oasis U.K. Limited, the UK subsidiary and licensee of the opponent company Smithers-Oasis Company. Mr Short's witness statement is dated 29 January 2021 and is accompanied by exhibits 1-11.

16. Whilst this evidence is presented as a single body of information, I must analyse it to determine two different issues. Firstly, I must ascertain whether the evidence proves that the opponent has genuinely used the two earlier EUTMs relied upon under the section 5(1) and 5(2)(a) grounds of opposition against the class 2 and class 8 goods of the application. Secondly, I must consider whether the evidence is sufficient to prove that the opponent holds a goodwill in the unregistered sign OASIS in respect of the goods relied upon for the purposes of the section 5(4)a) ground of opposition against the class 21 element of the application.

Proof of use

17. Relevant statutory provision: Section 6A:

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

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements
which do not alter the distinctive character of the mark in the form in
which it was registered, and

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

(5) In relation to a 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 Union.

(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.”

18. Section 100 of the Act is also relevant and states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. 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 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].”

20. As the earlier marks relied upon are EUTMs, the comments of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. The court noted that:

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

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”. ”

21. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

22. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in question in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the

effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

23. The General Court ("the GC") restated its interpretation of *Leno* Marken in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory

of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

24. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the services at issue in the European Union during the relevant five-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The services for which use has been shown
- iv) The nature of those services and the market(s) for them
- iv) The geographical extent of the use shown

25. The relevant period in which the opponent must prove use is 28 July 2013 to 27 July 2018.

26. In his witness statement Mr Short states that the opponent was founded in 1954 and has headquarters in the USA. He states that it sells products in over 140 countries worldwide. Exhibit 1a provides details from Companies House records relating to the opponent company. Exhibit 1b provides a trade mark license agreement signed and dated in March 2018, between the opponent company and Mr Short's company, continuing an agreement that appears to have been in place since 1 April 2007.

27. Exhibit 2 provides webpages showing some of the opponent's worldwide locations. As a result of this activity, Mr Short claims that the opponent has significant goodwill and reputation connected with the name OASIS. This exhibit shows that the opponent has a presence across Europe, including Slovenia, Belgium, Germany, France, Spain and the UK.

28. Mr Short states that the product which paved the way for the success of the opponent's OASIS brand initially was a water absorbing foam product for florists.

Since then he states that the opponent's product range has expanded to more than 4000 items, including paints and products for the display of flowers.

29. Exhibit 3 is the certificate of incorporation of Smithers-Oasis UK showing that it was incorporated in 1981. Mr Short states that the UK has always been an important market for OASIS branded products, which have been sold in the UK for at least 40 years.
30. Mr Short's company Smithers-Oasis UK has offices in Washington Tyne & Wear, with 104 UK employees. His company is predominantly responsible for the distribution and sale of OASIS branded products in the UK.
31. Mr Short provides turnover figures for his company in the UK and for the 'Rest of Europe' between 2015 and 2017. He states that his company had a UK turnover of £12.8 million pounds in 2015, £12.5 million in 2016 and £12.8 million in 2017. He adds that these figures are typical of Smithers-Oasis UK's annual sales turnover. He also adds that turnover from the rest of Europe, excluding the UK, was £5.3 million in 2017, £4.5 million in 2016 and £4.6 million in 2015. Exhibits 4a and 4b are extracts from his company's accounts which provide the turnover figures for that period.
32. Exhibits 5a, 5b and 5c comprise sample pages from brochures and catalogues which Mr Short's company produces, that show the products it sells through the website 'oasisfloral.co.uk'. The catalogues are labelled as either Spring/Summer or Christmas collection catalogues. None of the pages provided within exhibit 5b appear to be dated. Exhibits 5a and 5c are dated 2015. The name of the website is clearly presented at the base of the vast majority of the pages provided. The catalogues show that Mr Short's company sells a broad range of floral design accessories and products as well a number of household and Christmas season decorative articles. The products shown for sale include: Floral arrangement products, foam based arrangements, Christmas decorative articles including stars, pine cones, star wands, moss and magnolia leaves; sacks and vases as well as candle holders, tealight holders, candlesticks, bottles, wooden crates, tin crates, wreaths, bowls, planters, bags made of paper and hessian, plates, Christmas film wrap, tissue paper, ribbon, snow spray, LED wax candles, spray paints in a wide range of colours, card holders, film wrap, fabric wrap, cupcake linings, watering

cans, willow baskets, transporter bags and vases, paper, lace and hessian wrap, flower food, jars, cards for valentines and mothers' day occasions, wooden pegs and buttons, LED lights, floral knives, floral pruners, scissors, stem strippers, foliage removers, thorn strippers.

33. Mr Short submits that his company sells OASIS branded products to the general public via the internet website 'www.oasishomeandhobby.co.uk' and to trade customers via 'www.oasisfloral.co.uk'. as well as via third party retailers. Exhibit 6a provides product listing and archive pages from 2016 and 2017. Mr Short asserts that these pages comprise a small sample of the products his company sells and should also be taken as representative of other years between 2012 and 2018. These pages support the information provided in exhibits 5a, 5b and 5c regarding the range and nature of the products sold by the opponent. I note that the range of hand tools on offer from the opponent is slightly wider under exhibit 6a and includes goods such as long bladed foam knives, folding knives with curved blades, penknives, multi-coloured knives, wire cutters, multi-knife packs and multi-purpose scissors, as well as floral knives and thorn strippers. The webpages in exhibit 6a are dated between 2016 and 2017. The mark at issue is shown on some of the goods on offer under the opponent websites, e.g. the OASIS spray colour paints.

34. Mr Short states that the websites referred to in his statement have more than 200,000 visitors combined each year. Exhibit 6b is said to comprise a Google Analytics report showing the number of visitors to the websites in 2017, however this exhibit comprises solely two pages which do not contain any indication of, or reference to the opponent, the websites referred to, or the mark at issue. The pages provided are headed O2 UK and are both dated '1 Jan 2017 – 31 December 2017'. Both provide the heading 'Audience overview' followed by sub-headings with statistics that I assume indicate numbers of visitors to a particular website. The sub-headings and statistics on those pages are as follows:

Users – 62.8k, Sessions - 91.5k, New users – 61.7k, Trend of users – 62,763

Users – 152k, Sessions - 230k, New users – 151k, Trend of users – 152,243

35. There is no reference at all to the name of the website(s) that these statistics relate to and no indication of the opponent or the mark OASIS on either page.

36. It is claimed that a large number of third-party retail outlets also sell the opponent's OASIS branded products. Exhibit 7 provides information relating to the website of one of the opponent's third-party retailers - Hobbycraft, one of the UK's largest craft store chains with 90 stores nationwide. Exhibit 7 provides examples of the opponent's OASIS branded products listed on the Hobbycraft website and historic examples taken from the archive.org website. This information shows that Hobbycraft provided a range of OASIS branded goods on its website, including: Oasis floral scissors for £7 on June 22 2017; the same goods for £6.49 on April 3 2015; Oasis Floral secateurs for £11 and Oasis branded green bowl, hobby wire, foam bowl, floral foam posy pad and pin holder & fix tack pack, all available on the website on July 7 2017.

37. Exhibits 8a – 8f comprise invoices from the opponent that relate to sales of the goods set out under paragraph 11 of Mr Shorts' witness statement. The goods Mr Short lists in his witness statement are the following:

Paints, glazes and varnishes; spray paints, spray glazes, spray varnishes and spray sealants, spray artificial snow.

Household containers; tableware; glassware, porcelain and earthenware; jars; candle holders and candle sticks; bottles; vases; bowls; plant pots; plates; plant holders; jugs; plant baskets; urns; dishes; crates; hurricane lamps, household ornaments and decorations.

Hand tools and implements; hand tools for use in relation to plants, flowers and floral displays; cutting tools for use by florists and crafters; floral scissors, floral pruners, floral foam knives, floral knives, folding knives, retractable cutters, floral snips, flower thorn strippers, floral pruning shears, wire cutters, and wire pliers

38. The product codes in these invoices can be cross-referenced with products that are available on the opponent's website. Mr Short states that these are intended to serve as examples only, as the opponent was constrained by the 300-page limit regarding the submission of evidence.

39. Invoices in exhibit 8a provide: The name of Mr Short's company SMITHERS-OASIS U.K. LTD displayed prominently at the head of each invoice; UK postcodes that indicate sales of goods to customers in the UK; much of the information is redacted but numbers of products sold can be established; a clear indication of the kind of goods being sold, e.g. 25cm Designer Cube, is also included. One invoice is to a London based customer and is dated 3 October 2012. This invoice (29264) shows sales of 60 packs of 12 carbon blade scissors, and a large number of 'Met Plastic Sq Plate' in a variety of colours. Further invoices are provided, e.g. Peterborough, dated 29 October 2012 for green candleholders. Images of these products have also been provided from pages of what appears to be the opponent's website.
40. Exhibit 8b provides further invoices. Again, the name of the opponent is prominent; UK postcodes support sales in the UK; sales are shown of e.g. magnets, wands, glasses, goblets, candelabra, wire, bowls, string, crystal candle holder, urns. An invoice to a London customer dated 17 October 2013, shows sales of foam articles, posy pads, tissue paper, foliage removers, heavy duty wire cutters, aluminium pruners, secateurs, dishes, tape, spray paints in a variety of colours, foam bricks and pillows, trays, cubes, bricks. Further invoices under exhibit 8b show UK sales in 2013 of e.g. long bladed foam knives, pruners and secateurs, foliage removers, carbon blade scissors, multi-purpose scissors and metallic wires, bulb bowls and vases. Images from the opponent's website are also provided showing a sample of those goods that were sold in 2013.
41. Exhibit 8c provides invoices from 2014. The opponent's name is prominent at the top of all invoices. The postcodes that can be discerned support UK sales across the period for a range of goods including: Mesh, 'Florallife' products which have been shown to be spray paints provided by Oasis; bowls, candelabra, bulb bowls, curling ribbon, fabrics in a variety of colours; glitter spray, foam products for floral arrangements, clear vases. Evidence is also provided of sales in 2015 to UK customers of goods including: ribbons, foam articles, adhesive tack, bowls, cubes and cylinders, wire, tissue paper, card envelopes, pruners, wire cutters, knives and scissors.
42. Exhibit 8d provides further invoices from 2015 showing sales of a wide range of goods including sales of 'Oasis s/colour' paint products in many colours. By cross-

referencing the product codes from the invoices within Exhibit 8, with codes and images of products in Exhibit 5a, it can be determined that the opponent has made significant sales of spray paints, in a wide range of colours, during the relevant period. 'Oasis s/colour' products carry a product code on the invoices within exhibit 8 that begins with the number 30 followed by a 5 number code that establishes a specific colour, e.g. product code '30-20945' identifies a metallic purple spray paint, as shown on page 23 of exhibit 5a. The same kind of information provided under exhibits 8a – 8d has been provided under exhibits 8e and 8f, covering the years 2016 and 2017. I note that the mark at issue is shown stamped onto a number of products displayed within these exhibits, e.g. Pages 19 and 20 of exhibit 8d show the mark OASIS stamped onto the blades of secateurs and scissors, and page 16 of 8f shows the mark stamped onto the blade of a Long Bladed Foam Knife.

43. Turning to the question of advertising and marketing activities, Mr Short sets out that his company's activities include a £2000 a month advertising package with The Florist. He adds that during the period covered by that campaign there were up to 15,000 visitors to the The Florist website per month who would have been exposed to OASIS branded products. The exhibit shows that this campaign ran between September and December 2015.
44. Exhibit 9 contains a report that relates to that particular advertising campaign with The Florist. It provides information showing use of the mark at issue on a variety of floral related products within the website of The Florist as well as use of the mark within the Facebook pages and Twitter feed of The Florist. The opponent's mark and floral products are promoted throughout all of this media however this information is largely undated. The single date that is discernible appears in a Facebook page extract from The Florist dated '22 November' which shows use of the mark OASIS and refers to Christmas 2015.
45. Exhibit 10 comprises an article published in 'The Florist' dated 15 September 2015 which states that, in the writers' view, the OASIS floral foam product is "the Kellogg's of the flower industry". This is clearly a promotional article intended to extoll the virtues of the opponent's OASIS Floral Foam products.

46. Mr Short states that his company website is a part of a digital marketing strategy which also involves social media accounts to engage customers and the wider public with the OASIS brand. He adds that the Smithers-Oasis UK Facebook site has 13,500 followers and over 11,000 likes. Exhibit 11 provides examples of the opponent's OASIS branded products being promoted on the OASIS Floral Products (UK) Facebook site. This information includes a vase available to purchase in March 2017, acrylic designer cubes for sale in January 2011, ceramic bowls in September 2016, glass bottles in March 2015, mini glass bottles in August 2017, glass goblets in April 2014 and clear glass martini vases with a twist in March 2011.
47. Having carefully analysed the evidence of the opponent, I conclude that genuine use has been shown of the earlier EUTMS during the relevant period and to a sufficient geographical extent, for at least a part of the goods relied upon in class 2 and class 8.
48. The evidence has shown the use of the mark OASIS on a range of goods in classes 2 and 8 during the relevant period, however Ms Ayers claims that the opponent's evidence falls short in several areas, and I have considered her submissions carefully.
49. In particular, I note her argument that on many of the goods for which the evidence shows sales, the OASIS mark does not appear to be placed or branded. Whilst this may be the case to some extent, I find that there are reasonable examples of the mark at issue on the goods under consideration. I also note that Ms Ayers states that the spray paints provided by the opponent are not OASIS products but are in fact branded as 'Floralife' products. This is not entirely correct, as the opponent does provide fairly reasonable evidence of a range of spray paint products sold under the brand 'Oasis s/colour'.
50. I accept the submission that a large part of the opponent's evidence relates to sales of its well-known foam and related foam accessories and foam products, which will largely be sold to or via floral specialists for use in flower arrangements of a professional nature, e.g. for weddings, but also through traditional retail channels for use by members of the public interested in flower arranging as a hobby. The evidence does, however, also show sales of 'non-floral' products such as spray

paints and glitter, bowls, candelabra, vases, candle holders and fishbowls, as set out in Ms Ayers' spreadsheet. The opponent also asserts that it sells goods such as Christmas decorations, bottles, wooden crates, tin crates, wreaths, bags made of paper and hessian, plates, Christmas film wrap, tissue paper, ribbon, snow spray, LED wax candles, card holders, film wrap, fabric wrap, cupcake linings, willow baskets, paper, lace and hessian wrap, jars, cards for valentines and mothers' day occasions, wooden pegs and buttons, and LED lights.

51. Whilst the evidence relating to the advertising and marketing activities of the opponent may be said to be somewhat limited in scope, it cannot be discounted and does form a part of my global consideration of the evidence. In this regard I take note of the opponent's use of social media, in combination with the advertising campaign run with The Florist.

52. Ms Ayers has suggested that the degree of redaction shown in the invoices of sales provided under exhibit 8, reduces the value of that evidence, particularly when evaluating the geographical scope of the opponent's business. I agree that the redaction of the invoices does add some difficulty to my analysis of this evidence, however, having studied the invoices in question carefully, I am content that I can extrapolate sufficient information with which to come to a conclusion that the opponent has made genuine use of its earlier marks during the relevant period. The invoices provide information as to the goods being sold; dates that support use during the relevant period, and postcodes that show the opponent has sold its goods across the UK quite widely. Each invoice is headed prominently with the name of Mr Shorts company, making it clear that the goods being sold come from 'OASIS'.

53. Whilst there are no indications of sales across the wider EU territory by way of sales invoices or order forms, I find that the information provided under exhibits 4a and 4b relating to turnover within the UK and across the rest of Europe between 2015 and 2017, supports the case of the opponent. The turnover figures in the UK for that three-year period amount to more than £37million. The figures for the rest of Europe amount to more than £12million during the same three-year period. I accept that no specific breakdown of goods sold across the rest of Europe has been provided, but I find that based on the body of evidence before me, I find that the goods sold across Europe will be the same kinds of goods as those sold by the opponent in the UK. I

also accept that the use shown within the UK clearly counts towards establishing genuine use within the EU generally. Ms Ayers has stated that the opponent's goods are sold via specialist wholesalers and retailers in the floral industry. I do not accept that the evidence limits the scope of the opponent's activities so precisely. Whilst the opponent has admitted that much of its business activities may be closely linked with the floral industry, it has also shown that it operates two websites, one focussed on the trade and the other aimed at the more general mass market of the UK public. Third party sales via Hobbycraft also support the argument that the opponent's goods, or at least some of those goods relied upon, are readily available to the general public.

54. I also take note of the comments made by Mr Wylie regarding the nature of his client's evidence. He states that the evidence was filed prior to the applicant's request to add limitations to the goods it has applied for. He states that as a result, the evidence provided may be less focussed than would otherwise have been the case. Whilst this is not something that detracts from the applicant's position in this matter, I accept that the opponent's evidence may possibly have been refined in places, had it been compiled in the face of the contested specifications of goods as they now stand.

55. I find that the evidence shows that the opponent has made genuine use of its earlier EUTM marks across a sufficient geographical extent and during the relevant period. I do not accept however, that the evidence supports genuine use for all of the goods relied upon under both of the earlier marks. That being the case I must now consider the question of a fair specification on which the opponent may rely.

Fair Specification

56. 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.”

57. 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.”

58. In submissions and during the hearing Ms Ayers stated that, in the event that I found the opponent’s evidence to be sufficient to establish genuine use, the evidence was so limited that, at very best, a fair specification could only be:

Class 2: Spray paints for use in the floral trade for decorating flowers and flower arrangements.

Class 8: Secateurs, pruners, thorn strippers, stem strippers, foliage removers, wire cutters, knives, and scissors for use in the floral trade for preparing flowers for sale or flower arrangements.

59. In reply, Mr Wylie stated that, were I to find that his client’s evidence did not support genuine use for all of the goods relied upon, a fair specification in class 2 should be “paints” or in the alternative “spray paints” and in respect of the class 8 goods a fair specification should be “hand tools implements” or in the alternative “scissors, knives and thorn strippers”.

60. Having assessed the evidence of the opponent carefully, taking note of the submissions made by Ms Ayers and Mr Wylie and the relevant case law set out above, I conclude that for the purposes of the section 5(1) and 5(2)(a) grounds of opposition a fair specification for the opponent’s two earlier EUTMs should be:

1. **Class 2:** Spray paints.
2. **Class 8:** Hand tools for the care, preparation and/or arrangement of plants, flowers and floral displays; cutting tools for use by florists and crafters; floral

scissors, floral pruners, floral foam knives, floral knives, retractable cutters, floral snips, flower thorn strippers, floral pruning shears, wire cutters, and wire pliers.²

61. In respect of EUTM 6565444, I do not accept Mr Wylie's submission that the evidence supports a claim of 'paint' generally. It is clear from the evidence that sales of paint by the opponent relate specifically to paint provided in spray cans. With no indication at all that the opponent sells paint in any other format or media, I feel that it is reasonable to restrict the scope of this EUTM to precisely those goods. I do not, however, accept Ms Ayers' submission that a fair specification should limit those goods to "use in the floral trade for decorating flowers and flower arrangements". The evidence is not that restrictive and does not show that these goods are sold purely for the purpose of decorating flowers and flower arrangements, for example exhibit 6a provides information from the OASIS Home & Hobby webpages (the opponent's website directed at the general public rather than the floral trade). On page 9 of that exhibit is an image of three cans of OASIS Spray colours paint. There is no indication that these goods are intended to be used only on plants or flowers or floral displays. Based on the evidence before me, I conclude that the opponent's spray paints may be used in a wide variety of ways. For example, Hobbycraft is a large hobby and craft retailer in the UK which sells the opponent's goods. That being the case, it is reasonable to assume that consumers of such spray paints, if purchased at Hobbycraft, will be purchasing them to use in arts and crafts projects that may have no connection with flowers and floral displays.

62. With regard to earlier EUTM 5867965, I conclude that the opponent's evidence is wholly insufficient to establish that it has used this mark in respect of the broad term 'hand tools and implements'. I find however that the term 'hand tools' may be accepted with a sufficient limitation relating to 'care, preparation and/or arrangement of plants, flowers and floral displays', as the evidence has shown that the opponent does provide a fairly wide range of hand tools that are specifically intended to be used for the purposes of preparation and arrangement of flowers and floral displays. Under the term 'Hand tools for the care...' I include the opponent's 'folding knives' as I do not find that the opponent's evidence supports a claim for 'knives' generally, but

² 1 - EUTM 6565444; 2 - EUTM 5867965

rather knives that are intended to be used in the care, preparation and arrangement of flowers and floral displays.

Decision

Section 5(1) of the Act states:

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

Section 5(2)(a) of the Act states:

“A trade mark shall not be registered if it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected.”

63. 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) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

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

64. Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks 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.

65. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 the marks

66. The contested trade mark is the plain word OASIS. The earlier EUTMs relied upon for the purposes of the opposition under sections 5(1) and 5(2)(a) also comprise the plain word OASIS. It has been accepted by both parties that these marks are identical.

Comparison of the goods

67. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

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

69. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

70. I have previously established a fair specification of goods on which the opponent may rely in respect of the section 5(1) and 5(2)(a) grounds of opposition.³ The parties' respective specifications are therefore as follows:

³ See paragraph 58

Earlier EUTMs	Contested application
<p>Class 2: Spray paints.</p> <p>Class 8: Hand tools for the care, preparation and/or arrangement of plants, flowers and floral displays; cutting tools for use by florists and crafters; floral scissors, floral pruners, floral foam knives, floral knives, retractable cutters, floral snips, flower thorn strippers, floral pruning shears, wire cutters, and wire pliers.</p>	<p>Class 2: Paints and washes; coatings; varnishes; lacquers; thinners; dyes; colorants; pigments; inks; metal in foil and powder form for use in painting, decorating, printing and art; primers; acrylic paints; decorating paints; exterior paints; fabric paints; floor paints; interior paints; metallic paints; paint powders; paint preparations; paint primers; paint products [other than paint boxes for use in school]; paint sealers; paints for arts and craft; spray paint; parts and fittings for all the aforesaid goods; all specifically for painting home interiors or exteriors and none of the aforementioned goods being for use in the floral industry or in relation to flower arranging.</p> <p>Class 8: Food preparation implements; cutlery for eating, preparing or serving food; biodegradable cutlery for eating, preparing or serving food; cutlery of precious metals for eating, preparing or serving food; boxes adapted for cutlery for eating, preparing or serving food; forks for eating, preparing or serving food; knives for eating, preparing or serving food; spoons for eating, preparing or serving food; parts and fittings for all the aforesaid goods.</p>

71. The contested: 'Paints; acrylic paints; decorating paints; exterior paints; fabric paints; floor paints; interior paints; metallic paints; paint products [other than paint boxes for use in school]; paints for arts and craft; spray paint' are all paints. These goods share the same nature, purpose, channels of trade and user and can be said to be in competition with the earlier 'spray paints'. These goods are identical.
72. The contested: 'Washes; coatings; varnishes; lacquers; thinners; dyes; colorants; pigments; inks; metal in foil and powder form for use in painting, decorating, printing and art; primers; paint powders; paint preparations; paint primers; paint sealers; parts and fittings for all the aforesaid goods' are all products intended to be 'painted' onto a surface for a variety of purposes, e.g. to protect and/or decorate that surface, or are to be used in the preparation of such goods prior to their use. These goods are highly similar in nature and purpose to paints. These goods may share user, uses and channels of trade with the opponent's 'spray paints' and may be in competition with the earlier goods. I find therefore that these goods are similar to a high degree.
73. I have previously dismissed the suggestion made by Ms Ayers that the opponent's earlier 'spray paints' should be considered only in respect of the floral industry or for the purposes of flower arranging. That being the case, the applicant's limitation to its class 2 specification, namely "all specifically for painting home interiors or exteriors and none of the aforementioned goods being for use in the floral industry or in relation to flower arranging" does nothing to distance the earlier goods from the contested goods in class 2.
74. I have also taken into account the submissions made by Ms Ayers with regard to the nature of paint and her assertion that there are different categories of paint. I agree that this is indeed the case, however as I have outlined above, I do not accept that the opponent's class 2 goods should be restricted to spray paints only for use in the floral display or flower arranging business sector. The opponent's goods may be intended to be sprayed onto a variety of surfaces including walls or floors and interior or exterior surfaces. The fact that these goods are provided in spray form rather than in a can does not remove the possibility of a wide range of intended forms of application. I note by way of example, that graffiti artists use spray paints widely and create their 'art' generally on exterior walls and other surfaces.

75. In conclusion, I have found the contested class 2 goods to be either identical or highly similar to the earlier goods relied upon under EUTM 6565444.

76. Turning to the contested class 8 goods, I find that these goods are all intended to be used to prepare, serve or eat food; or are boxes adapted for cutlery which is intended to be used to eat, prepare or serve food. The earlier class 8 goods on the other hand are hand tools to be used in the care, preparation and arrangement of flowers and floral displays. Whilst both sets of goods can be defined broadly as 'hand tools or implements' it is very likely that their respective purposes and channels of trade will be quite different. Whilst the user of cutlery may also be a consumer of e.g. floral knives and floral scissors, that consumer will readily appreciate the differences between these goods in terms of intended use. It is quite likely that the opponent's goods will be stored outside of the home, possibly in a garage or greenhouse in a garden, whilst the applicant's goods will be stored generally either in a kitchen drawer or cupboard or, in the event that the cutlery at issue is provided in a bespoke box, in a dining room or on display within the home.

77. I note the opponent's evidence has shown that the opponent sells multi-purpose scissors and knives, however these goods are limited to floral use by the scope of the EUTM registration specification. I conclude that the class 8 goods at issue are not in competition or complementary in any way. These goods are dissimilar.

Average consumer and the purchasing act

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

79. 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.”

80. In her skeleton arguments Ms Ayers stated that the opponent’s goods emanate from specialist wholesalers and retailers in the floristry sector. She submitted that the applicant’s goods will not be sold through the same channels. She claimed that they would be sold via websites and stores which are accessible to the general public and, where sold through ‘bricks and mortar’ stores, they would be sold via DIY stores and hardware stores in the case of Class 2 products, and hardware stores and department/home furnishing stores in the case of the Class 8 products. She claimed that the products will nearly always be selected by eye.

81. Mr Wylie has stated that the goods at issue are largely homewares and flower products and that, notwithstanding the applicant’s limitations to its specifications, goods such as glassware, containers, homeware, bows, plates, glasses etc could be precisely the same in their material features.

82. As I have concluded above in my comparison of the goods at issue, the goods of both parties can be said to be day to day items taken up by the average consumer, which I find to be both the general public, who will pay no more than a medium degree of attention in their selection of such goods; and a professional consumer in the floral business, who will pay slightly more attention to the selection of goods such as knives, pruners and thorn strippers, than a member of the public. I note Ms Ayers submissions in this regard, however, as established through evidence, the opponent’s goods are not solely provided by specialist wholesalers and retailers in the floristry sector.

83. The selection of the goods at issue will be primarily a visual process but may also be a combination of visual and aural selection, when that process takes place in a traditional retail establishment and involves a discussion with sales staff.

Distinctive character of the earlier trade marks

84. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

85. Mr Wylie has claimed that the earlier EUTMs have been used extensively, suggesting that this level of use may serve to enhance the degree of distinctiveness in his client's marks. Ms Ayers has stated that the evidence submitted by the opponent in relation to the class 2 and class 8 goods does not provide any proof that the mark OASIS has any enhanced level of distinctiveness acquired through use.

86. I have considered the submissions on this matter carefully. In respect of the class 2 and class 8 goods that the opponent has shown genuine use for, I find that that use has not been substantial enough to support a claim of enhanced distinctiveness. Whilst the evidence has established genuine use within the relevant territory, I do not

accept that it has been on such a scale, in respect of the class 2 and class 8 goods sold under the mark, to find that the earlier mark can be claimed to have an enhanced degree of distinctive character for those goods. I find that a large percentage of the opponent's sales will have been in the area of floral foam and floral foam products which are goods in class 21 that have not been relied upon in this opposition, insofar as it is based on sections 5(1) and 5(2)(a).

87. I therefore find the opponent's EUTMs to be inherently distinctive to a medium degree. The word OASIS is a dictionary word not uncommon in the English language, however in respect of the goods at issue, it can be said to have no obvious link or association.

Likelihood of Confusion

88. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

89. I have already found that:

- the marks are identical;
- the class 2 goods at issue are identical or highly similar;
- the class 8 goods at issue are dissimilar;
- the average consumer will be a member of the general public who will pay no more than a medium level of attention when selecting the goods at issue, and a professional consumer who will pay a slightly higher level of attention, but this will not be the very highest level;
- the purchasing process will be largely visual however the role that an aural assessment may play in the process has been considered;
- the earlier marks have a medium degree of inherent distinctiveness.

90. As the marks at issue are identical, I find that for the contested goods in class 2 which have been found to be identical or highly similar, confusion will occur. For the

class 8 goods, which have been found to be dissimilar, the opposition has failed. The opposition, insofar as it is based upon section 5(1) and section 5(2)(a) of the Act, has been partially successful.

91. I now go on to consider the remaining ground of opposition, namely section 5(4)(a), relying on the opponent's earlier unregistered sign OASIS, and opposition in respect of the applicant's class 21 goods.

Section 5(4)(a)

92. Section 5(4)(a) states:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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

(b)

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

93. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but

it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

94. In its pleadings the opponent has claimed that it has used the sign OASIS since 1992 throughout the UK, on the following goods:

Household containers; tableware; glassware, porcelain and earthenware; jars; candle holders and candle sticks; bottles; vases; bowls; plant pots; plates; plant holders; jugs; plant baskets; urns; dishes; crates; hurricane lamps.

Relevant date

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

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

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

96. There has been no suggestion by the applicant that it has used its mark prior to the date of application for registration. The relevant date is therefore the date on which the contested mark was applied for, namely 27 July 2018.

Goodwill

97. I bear in mind the guidance set out in the judgement of the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

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

98. Based on the evidence submitted by the opponent I conclude that it does hold a goodwill for at least some of the goods it has claimed it has been selling throughout the UK since 1992. Whilst the evidence does not extend as far back as 1992 for the purposes of establishing sales or turnover figures, it is clear that the opponent's UK subsidiary has been operating its business for a significant amount of time. Turnover figures are provided from 2015 and invoices show sales of goods across the UK under the mark from 2012.

99. Ms Ayers has in her submissions provided a breakdown of sales of the goods relied upon by the opponent under section 5(4)(a), since 2012. Those goods include bowls, plates, candle holders, candelabra, fishbowls, glasses and goblets, urns, vases, glass cylinders, planters, containers, trays, flower buckets, wooden boxes, pots and troughs.

100. I conclude, based on the evidence, that the opponent enjoys goodwill identified by the sign OASIS in respect of the following goods:

Household containers; tableware; earthenware; glassware, jars; candle holders and candle sticks; bottles; vases; bowls; plant pots; plates; plant holders; jugs; plant baskets; urns; dishes; crates.

Misrepresentation and damage

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

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990]

R.P.C. 341 at page 407 the question on the issue of deception or confusion is “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

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

And later in the same judgment:

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

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

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

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

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

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

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

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

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

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

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

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

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

103. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails deception of a substantial number of members of the public rather than confusion of the average consumer. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes.

104. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), Mr Iain Purvis QC, as a Recorder of the Court stated that:

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”

105. The opponent’s sign is identical to the contested mark.

106. The contested goods are largely a range of common household and kitchen items, as well as a range of animal and pet products.

107. Some of these goods can be said to be of a similar nature and purpose to those that the opponent is able to rely upon in this matter, and some can be said to be quite different. I find that for those goods which are similar in nature and purpose, or closely linked/ancillary, and which are likely to be purchased in the same kinds of retail establishments or websites, misrepresentation will occur, as the marks are identical. For the contested goods that are likely to be considered quite distinct from the opponent’s goods, and which are therefore likely to be marketed and sold in a different way, I do not believe misrepresentation will occur.

108. The contested class 21 goods that I consider to be of a similar nature and for which I find that misrepresentation will occur, are the following:

Household or kitchen utensils and containers; glassware, porcelain and earthenware; chinaware; crockery; cups and mugs; dishware; glasses; hollowware; porcelain ware; metal pans; glass pans; pots; none of the aforesaid goods for use in or directed towards the floral trade or specifically designed to receive flower arrangements in floral foam; kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; bakeware; dinnerware; drinking vessels and barware; ovenware; cooking pans; cooking pots; parts and fittings for all the aforesaid goods.

109. The contested class 21 goods that I find to be sufficiently distinct from the opponent's goods and for which I do not believe that misrepresentation will occur are:

Brushes; articles for cleaning purposes for household purposes; none of the aforesaid goods for use in or directed towards the floral trade; animal activated animal feeders; bird feeders; birdcages; brushes for pets; cages for carrying pets; cages for pets; combs for animals; pet grooming gloves; brushes for grooming pet animals; feeding vessels for pets; fish bowls; food containers for pet animals; litter boxes for pets; litter trays for pets; pet feeding and drinking bowls; non-mechanised animal feeders; toothbrushes for pets; parts and fittings for all the aforesaid goods.

110. As I have concluded that misrepresentation will occur in respect of some of the goods at issue, I find that damage will also occur as a result of lost sales of those products; dilution to the opponent's rights in the mark; and detriment to the goodwill it enjoys.

111. Therefore, the opposition, insofar as it is based on the opponent's earlier unregistered mark has been partially successful under section 5(4)(a) of the Act.

Conclusion

112. The opposition has been partially successful. Subject to appeal, the contested application will be refused for the following goods:

Class 2: Paints and washes; coatings; varnishes; lacquers; thinners; dyes; colorants; pigments; inks; metal in foil and powder form for use in painting, decorating, printing and art; primers; acrylic paints; decorating paints; exterior paints; fabric paints; floor paints; interior paints; metallic paints; paint powders; paint preparations; paint primers; paint products [other than paint boxes for use in school]; paint sealers; paints for arts and craft; spray paint; parts and fittings for all the aforesaid goods; all specifically for painting home interiors or exteriors and none of the aforementioned goods being for use in the floral industry or in relation to flower arranging.

Class 21: Household or kitchen utensils and containers; glassware, porcelain and earthenware; chinaware; crockery; cups and mugs; dishware; glasses; hollowware; porcelain ware; metal pans; glass pans; pots; none of the aforesaid goods for use in or directed towards the floral trade or specifically designed to receive flower arrangements in floral foam; kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; bakeware; dinnerware; drinking vessels and barware; ovenware; cooking pans; cooking pots; parts and fittings for all the aforesaid goods.

113. The application may proceed to registration for the following goods:

Class 8: Food preparation implements; cutlery for eating, preparing or serving food; biodegradable cutlery for eating, preparing or serving food; cutlery of precious metals for eating, preparing or serving food; boxes adapted for cutlery for eating, preparing or serving food; forks for eating, preparing or serving food; knives for eating, preparing or serving food; spoons for eating, preparing or serving food; parts and fittings for all the aforesaid goods.

Class 21: Brushes; articles for cleaning purposes for household purposes; none of the aforesaid goods for use in or directed towards the floral trade; animal activated animal feeders; bird feeders; birdcages; brushes for pets; cages for carrying pets; cages for pets; combs for animals; pet grooming gloves; brushes for grooming pet animals; feeding vessels for pets; fish bowls; food containers for pet animals; litter boxes for pets; litter trays for pets; pet feeding and drinking bowls; non-mechanised animal feeders; toothbrushes for pets; parts and fittings for all the aforesaid goods.

Costs

114. As neither party can be said to have been more successful than the other in this matter, I decline to make an award of costs and direct that the parties bear their own costs accordingly.

Dated this 1st day of October 2021

Andrew Feldon

For the Registrar

The Comptroller-General