

O-925-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 3477285 & 3477289

BY MATRIX FARMA SRL

TO REGISTER:

BIO LOGIQUE

&



AS TRADE MARKS IN CLASSES 3, 5 & 30

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER

NOS. 421727 & 421728

BY

B.R. (SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE)

BACKGROUND & PLEADINGS

1. On 25 March 2020, Matrix Farma SRL (“the applicant”) applied to register the trade marks shown on the cover page of this decision for the goods in classes 3, 5 and 30 shown in paragraph 50 below. The goods are identical in both applications.

2. On 12 October 2020, the applications were opposed in full by B.R. (Société Par Actions Simplifiée) (“the opponent”). The basis of the oppositions are identical in that both rely upon grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and are based solely upon the trade mark shown below, in relation to which, the opponent indicates it relies only upon the goods shown:

European Union Trade Mark (“EUTM”) no. 10343011 which was filed on 14 October 2011 (claiming a priority date of 15 April 2011 from an earlier filing in France) and which was entered in the register on 26 April 2012:



“Mark Description/Limitation

The trademark consists of the word element BIOLOGIQUE RECHERCHE and of a representation of a bouquet of flowers.

Colour Claimed: Blue, beige.”

Class 3 - Cosmetics, Face and body skin care creams, Hair lotions, Shampoos; Cosmetic preparations for slimming purposes Cosmetic preparations for firming the skin Make-up removing preparations; Beauty masks; Tissues impregnated with cosmetic lotion.

Class 10 - Cosmetic apparatus and instruments.

Class 44 - Hygienic and beauty care for human beings; Hygienic and beauty care for the face and body, including massage; Beauty salons; information in the field of cosmetics and hygienic and beauty care.

3. In relation to its objection under section 5(2)(b) of the Act, the opponent argues that as the competing trade marks are highly similar and the competing goods and services are either identical/similar, there exists a likelihood of confusion on the part of the average consumer.

4. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent states that its trade mark enjoys a reputation for all the goods and services upon which it relies. Having answered “Yes” to question 3 in the Notice of opposition which reads:

“Is it claimed that the similarity between the [trade marks being relied upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?”

the opponent states:

“15. It will be shown in evidence that the Opponent, by virtue of the considerable use that has been made of the Earlier Trade Mark throughout the United Kingdom since at least as early as 2016, and the recognition and goodwill that has been generated as a result of this use, enjoys a reputation in the Earlier Trade Mark in the United Kingdom for the following goods and services for which reputation is claimed [as relied upon under section 5(2)(b)].

16. The Later Trade Mark is highly similar to the Opponent’s Earlier Trade Mark. It will be shown in evidence that the Earlier Trade Mark has a strong reputation in relation to the aforementioned goods and services and that the use of the Later Trade Mark upon any of the Opposed Goods and Services

will be linked by consumers to the Earlier Trade Mark and call the Earlier Trade Mark to mind. Within the cosmetics and beauty industry, there is a practice of using similar, variant marks to refer to subsequent product launches by the same proprietor, and that is relevant to this 5(3) claim. Given that consumers will perceive an economic link between the Earlier Trade Mark and the Later Trade Mark, indirect confusion will occur and the Application should be refused for all goods under Section 5(3) of the Act.

17. Further and in the alternative, consumers will perceive the Later Trade Mark as an extension to the Opponent's existing range of goods under the Earlier Trade Mark...

18. Use of the Later Trade Mark in relation to the Opposed Goods and Services will take unfair advantage of the distinctive character and repute of the Earlier Trade Mark by attempting to ride on the coat-tails of the Earlier Trade Mark in order to benefit from its power of attraction, reputation and prestige, and to exploit, without being required to make efforts of its own in that regard, the marketing effort expended by the Opponent in order to create and maintain the image of its mark. The use without due cause of the Later Trade Mark would take unfair advantage of the Earlier Trade Mark, by freeriding on the investment the Opponent has made through its extensive marketing efforts...

19. Use of the Later Trade Mark in relation to the Opposed Goods and Services covered by the Application will also dilute the distinctive character of the Earlier Trade Mark and will weaken its ability to identify the goods/services of the Opponent. Therefore, use of the Later Trade Mark will be detrimental to the distinctive character of the Earlier Trade Mark...

20. Finally, use of the Later Trade Mark in relation to the Opposed Goods and Services will result in detriment to the repute of the Earlier Trade Mark. The Opponent's goods and services are of an extremely high quality and benefit from significant marketing and quality control by the Opponent. If the Applicant's goods are not of a similar quality they will taint the repute of the

Earlier Trade Marks and render them less attractive to consumers, thereby changing their economic behaviour as they will choose not to purchase the Opponent's goods. In this regard it is not necessary to show consumers' actual change in behavior: a serious risk that it will change suffices."

5. The applicant filed counterstatements. Although in paragraph 8 of its counterstatements the applicant states: "We can notice both similarities as well as identity between goods in class 3", when considered as a totality, they constitute a denial of the grounds upon which the oppositions are based. The oppositions were consolidated following the filing of the counterstatements.

6. In these proceedings, the opponent is represented by Boulton Wade Tennant LLP; the applicant represents itself. Although only the opponent filed evidence, the applicant filed written submissions during the evidence rounds. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. While neither party requested a hearing, the opponent elected to file written submissions in lieu. I shall bear all of the written submissions in mind referring to them to the extent I consider it appropriate later in this decision.

7. 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.

DECISION

8. The oppositions are based upon sections 5(2)(b) and 5(3) of the Act which read 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.

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

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.

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

9. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2, which qualifies as an earlier trade mark under the provisions of section 6 of the Act. Given the interplay between the date on which the opponent’s trade mark was entered in the register and the application dates of the trade marks being opposed, the earlier trade mark is subject to the proof of use provisions contained in section 6A of the Act. In its Notices of opposition, the opponent states that it has used its earlier trade mark in relation to all the goods and services upon which it is relying and, in its counterstatements, the applicant asked the opponent to make good on that claim.

Proof of use

Section 6A:

10. This reads as follows:

“(1) This section applies where

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the

mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

11. In reaching a conclusion, I must apply the same principles as I would if I were considering an application for revocation based upon non-use. The relevant five-year period is 26 March 2015 to 25 March 2020.

12. I begin by reminding myself that section 100 of the Act 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.”

13. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use as follows:

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

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

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29];

Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]-[51].

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

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

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

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

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

14. The earlier trade mark being relied upon is an EUTM. As a consequence, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant i.e.

“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).”

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 market 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.”

15. 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 issues 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.”

16. The General Court (“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.

17. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 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 goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown.

The opponent's evidence

18. This consists of a witness statement, dated 21 April 2021, from Pierre Delapalme, the opponent's co-president, a position he has held since June 2008. Mr Delapalme explains he has worked in the health and beauty industry for over 25 years. He states that the opponent uses the trade mark BIOLOGIQUE RECHERCHE throughout the European Union and in the UK "both in plain word form and in stylised form [shown in paragraph 2]" adding that in the UK, "the opponent distributes products under the mark via its UK distributor, Aesthetic Brands Ltd" of London. He further states that:

"4...The opponent sells over 100 skincare, bodycare and haircare products bearing the mark, all falling within one of the broader categories of: (a) For the face: cleansers, lotions, boosters, masques, essential serums, targeted serums, essential creams, intensive creams, specific creams, finishing serums, (b) For the body: exfoliators, wraps, boosters, serums, oils and complexes, creams and hair care products."

19. Mr Delapalme refers to the above goods as the "products". He states that exhibit 1 consists of: "...extracts from our website at www.biologiquechercheuk.co.uk which, he further explains, "launched in the United Kingdom in April 2015." As far as I can tell, the pages provided are undated. I do, however, note that the words "Biologique Recherche" appear on the pages as does the following:



20. The goods shown are described as: “Cleansers”, “Lotions”, “Boosters”, “Masques”, “Quintessential Serums”, “Targeted Serums”, “Essential Creams”, “Intensive Creams”, “Body Wraps” and “Body & Hair.” Mr Delapalme explains that the opponent’s products “are extremely high quality and are used by both skincare professionals and end consumers...” and he goes on to list four characteristics of the goods which, I note, includes:

“7...A high concentration (over 20% in most products) of botanical, marine and biological extracts....No artificial fragrances in any of the products...”

21. The opponent has, he states being using its trade mark “in relation to the products” in the UK since 2014, with its distributor distributing its goods “through many avenues in the UK” including its flagship store Embassy of Beauty (which opened in London in 2018) and through Liberty of London and Harrods department stores. Exhibit 2 consists of what Mr Delapalme describes as “A list of retailers where end consumers may purchase the products”. The pages provided are from biologiquerecherche.co.uk, bear printing dates of 20 April 2021 and a copyright date of 2019-20, list 9 addresses in London (which includes the 3 mentioned above), 1 in Greater London and 2 in the rest of the UK i.e. in Leamington Spa and Romsey.

22. It is stated that the opponent “maintains an active social media presence with frequent posts on Facebook and Instagram...”. Exhibit 3 consists of what is described as “screenshots showing the landing pages for these sites”, with Mr Delapalme explaining that his “company’s products are frequently liked and tagged by other social user media users”. He adds that between February 2020 and April 2021, its Instagram followers increased from 7853 to 8701. The pages provided bear the trade marks mentioned in paragraph 19 above. Where they can be dated the pages from Facebook are from 10 February 2017 (bearing a page creation date of 23 January 2015) and 6 February 2020. The page from 2020 indicates that “1254 people like this” and “1303 people follow this”. The pages from Instagram (which also contain both trade marks mentioned in paragraph 19) bear printing dates of 20 April 2021 and a copyright date of 2021. At the point of printing, the opponent had 500 posts and 191k followers.

23. Exhibit 4 consists of a selection of “UK press articles, from both print and online media” all of which I have read and which includes the following:

- beautygeekuk.com dated 18 September 2013 entitled: “Biologique Recherche: An introduction to my skincare prescription.” The article contains images of packaging bearing the trade mark shown in paragraph 19 and includes, inter alia, references to “...so off I trundled to EF Mediaspa in Kensington...” and “...firstly, this is a serious, serious, SERIOUS skincare range that is only really designed for those who are extremely committed to good skincare practices and have the funds to back it up...”. The article attracted 31 comments dated between October 2013 and January 2017;
- carolinehirons.com dated April 2015 entitled “Biologique Recherche Lotion P50”. The article contains an image of the opponent’s packaging bearing the trade mark shown in paragraph 19 and includes a reference to: “...P50 is available in the UK from EF Mediaspa...is around £50 for the 150ml size...”. The article attracted a range of comments which included: “I have started using the P50W lotion as the lady in their liberty counter has suggested...(4 years ago)”, “Just an FYI if you are in the UK you can buy over the phone from biologique renerche [sic]. They do a phone consultation first and are really lovely...(5 years ago)”, “I have been using Biologique Recherche in my clinic in Leamington Spa...a fantastic natural solution to all skin conditions and a preventative for ageing...My clients love the result (6 years ago)”;
- harpersbazaar.com/uk/beauty/skincare dated 25 October 2018 entitled “The Brand Biologique Recherche – The brand behind the cult P50 liquid exfoliator just got a bit more accessible”. The article contains images of packaging bearing the trade mark shown in paragraph 19 and contains, inter alia, the following: “Until now, the full selection has been very difficult to get hold of in the UK – shoppers would have to go either through a clinic or, for the past five years, to Liberty London. But this week, the brand’s flagship store opens on Kensington Church Street. Embassy of Beauty is brand new retail and treatment space – upstairs to The Skin Instant Lounge for a consultation with a...For those unable to make it into London, the website provides a similarly

tailored experience. Indeed, to even learn the prices of the products, you'll have to set up an account and go through the consultation process...";

- popsugar.co.uk dated 24 March 2018 entitled "Biologique Recherche Review - Beauty Editors are Losing Their Minds Over This Miracle Product". The article contains images of the opponent's P50 packaging bearing the trade mark shown in paragraph 19 and includes a reference to: "We're blown away: somehow a toner became the buzziest product circulating around beauty teams everywhere...".

24. I note that Mr Delapalme also draws attention to articles from *Hello! Magazine* (from July 2019) in relation to which he notes that "retail prices for selected products range from £63 to £158" and from *OK! Magazine* (from June 2019) which he notes "shows a masque retailing for £154". He further states:

"12...The products bearing the mark are of extremely high quality, attract a cult following...

13. As sales are through many channels, we do not know the total amount of retail sales in the United Kingdom for the products, but it is over one million Euros per year.

14. Turnover of imports of the products bearing the mark into the United Kingdom have been as follows for the last three years, and as set-out in a screen-shot taken from the opponent's online accounting system, showing turnover for the opponent's distributor in the UK...".

25. Exhibit 5 consists of a page containing a heading reading "Ventes par client/pays" (which I take to mean "sales per customer") below which appears the name "Aesthetic Brands". Against the periods 2018, 2019 and 2020, there appears the following: €522,911.50, €898,165.83 and €426,800.86 respectively.

26. Exhibit 6 consists of a spreadsheet in which the sales figures shown in exhibit 5 are broken down into a range of product categories under the headings "Face",

“Body”, “Hair” and “Accessories” (I note the figures for 2019 and 2020 vary very slightly from those shown in exhibit 5). Exhibit 7 consists of three invoices containing references to Tax Points of 1 March and 15 May 2018 (in the amount of £162 and £5676 respectively) and 11 February 2020 (in the amount of £2112). The device trade mark shown in paragraph 19 above appears at the top of each page as does a reference to Biologique Recherche UK. Although the names of those to whom the invoices were issued has been redacted, all of the addresses are in London and two of the invoices appear to contain an indication that payment should be made to, or has been received by, Aesthetic Brands Ltd.

27. That concludes my summary of the evidence filed to the extent I consider it appropriate.

The applicant’s submissions in reply

28. These comments come from the applicant’s CEO Andrei Diaconescu. While I do not intend to summarise them here in any detail, I have read them and will take them into account when reaching a decision. I do, however, note that a number of the applicant’s criticisms of the opponent’s evidence is based upon the following comment (to which I shall return later in this decision):

“3. We believe that a witness statement issued by a representative of the proprietor provides insignificant evidentiary value unless it is corroborated by independent evidence.”

The goods in class 3 being relied upon

29. In its Notices of opposition, the opponent indicates it is relying upon the following goods in class 3:

Cosmetics, Face and body skin care creams, Hair lotions, Shampoos;
Cosmetic preparations for slimming purposes Cosmetic preparations for firming the skin Make-up removing preparations; Beauty masks; Tissues impregnated with cosmetic lotion. (my emphasis)

30. The specification of the earlier trade mark being relied upon as it appears on the database of the European Union Intellectual Property Office (“EUIPO”) in the original language of the application (i.e. French), reads:

“3 Savons, produits de parfumerie, huiles essentielles, cosmétiques, crèmes de soins pour la peau du visage et du corps, lotions pour les cheveux, shampoings, dentifrices, encens, désodorisants à usage personnel (parfumerie) Préparations cosmétiques pour l'amincissement Préparations cosmétiques pour le raffermissment Produit de démaquillage; masques de beauté, à l'exclusion des lingettes Produits de rasage, lotions après rasage, serviettes imprégnées de lotion cosmétique, produits pour le soin des ongles.”

31. The UKIPO’s trade marks database records the opponent’s specification in class 3 as:

Soaps, Perfumery products, Essential oils, Cosmetics, Face and body skin care creams, Hair lotions, Shampoos, Dentifrices, Incense, Deodorants for personal use (perfumery) Cosmetic preparations for slimming purposes Cosmetic preparations for firming the skin Make-up removing preparations; Beauty masks, Excluding wipes Shaving preparations, Aftershave lotions, Tissues impregnated with cosmetic lotion, Nail care preparations (my emphasis).

32. As I understand it, the phrase I have underlined in paragraph 30 translates as “beauty masks, excluding wipes”. As it appears to me that the exclusion relates only to beauty masks, that is the basis upon which I intend to proceed.

Assessment of the opponent’s evidence

33. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C., as the Appointed Person stated:

“22. The burden lies on the registered proprietor to prove use...However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is

likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

And further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

34. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C., as the Appointed Person stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J.

observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

35. I begin by reminding myself that (i) the relevant period in which proof of use must be established is 26 March 2015 to 25 March 2020, and (ii) that as the earlier trade mark being relied upon is an EUTM, the relevant market is the European Union. Although the opponent is relying upon an EUTM, all of its evidence relates to use in the UK. However, as I mentioned earlier, as 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 use of an EUTM, that is not fatal to the opponent's case based upon genuine use.

36. As I mentioned earlier, the applicant has made a number of criticisms of the opponent's evidence, some of which have merit. For example, exhibit 1 appears to be undated and is, as the applicant suggests, "probably at the date of filing the first witness statement." Some of the evidence is clearly from before the relevant period. However, the applicant's major criticism relates to the source of the information provided, coming as it does from an officer of the opponent company. In its submissions filed in lieu, the opponent responded to that criticism in the following terms:

"18...The evidence has come from Mr Pierre Louis DELAPALME, co-president of the Opponent, who is in a position where he can be expected to have knowledge of the facts. The evidence has been given by way of a Witness Statement signed under a Statement of Truth which, under the provisions of the UK Trade Marks Rules, is the normal form for evidence in matters such as the present case. The Applicant suggests that Mr DELAPALME's evidence is of low probative value as he is an officer of the Opponent. However, this does not reflect the approach of the Tribunal and UK courts, and the Applicant has not made a request to cross examine..."

37. I agree with the opponent's position and will assess the evidence on the basis of the guidance mentioned in the case law shown above.

38. The evidence provided shows the trade mark being relied upon being used on packaging in the format shown in paragraph 19 above. Although in use the trade mark is accompanied by the word "PARIS", as this word is geographical in nature and descriptive and non-distinctive, it does not alter the distinctive character of the earlier trade mark. Having explained that the opponent's website in the UK launched in April 2015, the trade mark appears in (i) exhibit 2 i.e. the list of retailers (which bears a copyright date of 2019-20, (ii) exhibit 3 i.e. the Facebook pages from February 2017 and February 2020, (iii) exhibit 4 i.e. on the packaging of goods shown in the press articles dating from April 2015, 24 March and 25 October 2018

and in Hello! Magazine and OK! Magazine, which are said to date from June/July 2019. As the relevant date in these proceedings is 25 March 2020, not all of the turnover figure provided by the opponent for 2020 can be taken into account; however, a significant proportion of the turnover achieved does count in the opponent's favour. I am also satisfied that during the period 2018-20, the opponent's UK distributor, Aesthetic Brands Ltd, sold €1.8m of products bearing the trade mark to a range of retailers in the UK and issued invoices in this regard. The opponent has, however, provided no indication of any amounts it has spent promoting the trade mark nor has any indication been provided of the market share it enjoys.

39. As to the goods and services being relied upon, I note that in its submissions in lieu, the opponent states:

“14. Contrary to the arguments of the Applicant, the Opponent has submitted sufficient evidence of its use of the Earlier Mark in relation to the Earlier Goods and Services, particularly the goods relied on in Class 3...” (my emphasis)

And:

“18...When this is done, contrary to the submissions of the Applicant, it is clear that the Opponent has used the mark during the relevant period in relation to the Earlier Goods and Services, and the Opponent should therefore be entitled to rely on the Earlier Mark in relation to the Earlier Goods and Services, in particular but not limited to cosmetics and face and body skin care creams...” (my emphasis)

40. In his statement, Mr Delapalme refers to the goods upon which the opponent has used its trade mark as the “products” and in exhibit 6 he lists the opponent's “product categories.” That listing contains a reference to “Accessories”, below which appears a reference to “Machines, HC, accessories”, which amounts to some €38k in the period 2018-2020. However, I am unable to identify any goods in class 10 in the evidence and the opponent has not pointed to any in either its evidence or written submissions. On the basis of the evidence provided, I am not in a position to

determine whether the opponent has made genuine use of its trade mark in relation to goods in class 10 and, as a consequence, it is not entitled to rely upon such goods in these proceedings.

41. As for the services in class 44, the evidence indicates that the opponent's flagship store, Embassy of Beauty, opened in London in 2018 and that it also provides consultation services in relation to its products by telephone and via its website. However, as no further information has been provided in relation to any of the services being relied upon (for example, number of customers, turnover figures, promotional spend), once again, I am not in a position to determine whether the opponent has made genuine use of its trade mark in relation to such services and, like the goods in class 10, the opponent is not entitled to rely upon such services in these proceedings.

42. That leaves the goods in class 3 to consider. In his evidence, Mr Delapalme refers to a wide range of products which appear to fall within a number of the categories contained in the specification of goods being relied upon. I also note that in its written submissions, the opponent refers to "in particular but not limited to cosmetics and face and body skin care creams."

43. Although far from perfect, on the basis of the totality of the evidence provided, it would, I think, be unrealistic for me not to conclude that within the relevant period the opponent made genuine use of its earlier trade mark in relation to a range of products for skincare, bodycare and haircare.

What constitutes a fair specification?

44. Having reached the above conclusion, I must now decide what constitutes a fair specification. Proceeding on the basis indicated at paragraph 32 above, the specification being relied upon is to be interpreted as:

Cosmetics, Face and body skin care creams, Hair lotions, Shampoos,
Cosmetic preparations for slimming purposes Cosmetic preparations for

firming the skin Make-up removing preparations; Beauty masks, Excluding wipes, Tissues impregnated with cosmetic lotion.

45. 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.”

46. 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.”

47. I begin by noting that collinsdictionary.com defines “cosmetics” as “beauty preparations; make-up”. I am satisfied that is how the average consumer will understand the term. As one can see, it is a very broad term that would include a wide range of goods including, for example, lipstick, mascara etc. Applying the above case law and having considered how the average consumer would describe the goods upon which the opponent has used its trade mark, a fair specification based upon the evidence provided is, in my view, as follows:

Preparations for bodycare, skincare and haircare.

48. That is the basis upon which I shall conduct the comparison which follows. However, if, on appeal, it was felt that the opponent had made genuine use of its earlier trade mark in relation to the goods and services relied upon in classes 10 and 44, it would, in my view, put the opponent in no better position.

The objection based upon section 5(2)(b) of the Act

Case law

49. The following principles are gleaned from the decisions of the courts of the European Union 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

50. The comparison is as follows:

Opponent's goods (following proof of use)	Applicant's goods
Class 3 - Preparations for bodycare, skincare and haircare.	Class 3 - Cosmetics; cosmetics preparations; skin care preparations; cosmetic skincare products; essences for skin care; creams; facial cream;

	<p>under eye cream, eye gel; eye cream with blueberry extracts; creams consisting of malonic acid; creams with caffeine ingredients; moisturisers; moisturising creams, lotions and gels; post treatment soothing cream, anti-ageing / skin rejuvenation cream, hand cream; cream foundation; night cream; skin cream; sunscreen cream; conditioning creams; creamy foundations; cosmetic cream; exfoliant cream; day cream; anti-aging cream; anti-wrinkle cream; beauty creams; barrier creams; fair complexion creams; body mask cream; skin cleansing cream; cosmetic nourishing creams; creams for cellulite reduction; toning creams; skin whitening creams; creams for firming the skin; dermatological creams; cosmetic creams for skin care; skin lightening creams; nutritional creams; retinol cream for cosmetic purposes; cosmetic moisturiser; skin moisturisers; moisturising preparations; body moisturisers; facial cosmetic moisturisers; hair moisturisers; moisturising concentrates; cosmetic moisturising gels; serums; serums for cosmetic purposes; beauty serums; non-medicated skin serums; serums for prevention of UV damage; corrective skin serums; serum impregnated with tretinoin or carboxylic acid; toners; skin</p>
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toners; facial cosmetic toners; non medicated skin toners; toners for cosmetic use; sunscreen; non-medicated toilet preparations; non-medicated beauty preparations; cosmetic preparations for slimming purposes; cosmetics; cosmetic preparations for skin care; beauty masks; cleansing milk for toilet purposes; cloths impregnated with a detergent for cleaning; cosmetic kits; exfoliators; moisturisers.

Class 5 - Dietetic food and substances adapted for medical use; dietary supplements for human beings; food supplements; multivitamins; vitamin and mineral food supplements; effervescent vitamin tablets; pharmaceutical preparations; dietary food supplements; dietary and nutritional supplements; vitamins and vitamin preparations; pharmaceutical products derived from natural sources; medical preparations for the treatment of stress; stress-relieving preparations; anti-fatigue supplements; medicated food supplements.

Class 30 - Confectionery; condiments; coffee, tea, cocoa and artificial coffee; coffee; instant coffee; coffee based beverages; mixtures of coffee and chicory, coffee essences, coffee

	<p>extracts, artificial coffee, coffee preparations; chicory and chicory mixtures, all for use as substitutes for coffee; tea; tea products; iced tea; tea and iced tea mix powders; carbonated and non-carbonated tea-based beverages; black tea, carbonated tea, green tea, fruit tea, herbal tea, tea essences, tea extracts, instant tea, tea mixtures; cocoa and cocoa powder, drinks in powder form containing cocoa, including in instant form; cocoa products; chocolate; pralines; muesli and chocolate bars; energy bars; flour; cereal preparations; flour and preparations made from cereals; confectionery; bread, pastries and confectionery bread; pastries; pastry; non-medicated confectionery; edible ices; sugar; honey; golden syrup; condiments; spreads; sauces; spices; prepared meals and constituents for meals; preparations made from cereals for food for human consumption; biscuits; cakes; pudding; ices; salad dressings; sandwiches; desserts; edible ices.</p>
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51. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

52. 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.

53. 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."

54. 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 that the responsibility for those goods lies with the same undertaking".

55. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

"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".

Class 3

56. As I mentioned earlier, in its counterstatements, the applicant stated:

"We can notice both similarities as well as identity between goods in class 3".

57. Of course, that comment was made before my proof of use assessment. Nonetheless, I note that the applicant's specification contains references to (i) a wide range of creams, (ii) includes a number of broad terms, for example, "cosmetics", "cosmetic preparations", "skin care preparations", "cosmetic skincare products", and (iii) includes a range of essences, gels, lotions, moisturisers, serums, toners and milks¹. As many of the applicant's goods would be encompassed by one or other of the terms in the opponent's specification following the proof of use assessment, they are to be regarded as identical on the *Meric* principle. Where that is not the case, given the likely overlap in, at least, the users, intended purpose, method of use and trade channels, any goods in the application which are not to be treated as being identical are, in my view, similar to a high degree.

Classes 5 & 30

58. In its Notices of opposition, the opponent argues that the applicant's goods in the above classes are similar to, inter alia, its "Cosmetic preparations for slimming purposes" and "cosmetic preparations for firming the skin". As such goods are, in my view, encompassed by the revised specification following my proof of use assessment, that is the basis upon which I shall proceed. The opponent further states:

"13...These goods/services are all similar in terms of uses, users, physical nature and/or intended purpose, and trade channels in that dietetic and non-dietetic foodstuffs are frequently marketed as being beneficial to the user's appearance and wellbeing, and that there is a huge market of pharmacies, high-street chemists such as Boots and Superdrug, and health-food retailers such as Holland & Barrett, who stock all the respective goods given their similar purpose."

¹ I have interpreted the term "cleansing milk for toilet purposes" as meaning "cleansing milk for toiletry purposes."

59. The applicant responded to those submission in its counterstatements. It began by pointing out that the undertakings mentioned by the opponent also sell a wide range of other goods. It adds:

“11. As for the intended purposes, cosmetics and beauty products are generally available for external use and their purpose is to improve appearances, whilst goods in Class 5, like dietary supplements, multivitamins, pharmaceutical preparations, include eatable products and aim health and the general wellbeing. To give a specific example, we cannot include in the same category dietary food with no sugar for diabetics with cosmetic preparations for slimming purposes.

12. As for users, uses and physical nature, goods in Class 5 are mostly of products that are ingested, like vitamins and dietary food, and users are mostly consumers that show a need, while goods in Class 3 are for skin appliance and user show a desire more than necessity. To extract a general idea the medical and pharmaceutical fields represent a different category than the beauty and cosmetics field.

13. Regarding goods in Class 30, in our opinion, the difference is more emphasized between products such as food, snacks, confectionery, salts, seasonings, flavorings, condiments on one hand, and cosmetic and beauty goods and services included in Classes 3, 10, 44 on the other hand. Hence, there are no relevant characteristics in common between these classes. As mentioned above the trade channel is not sufficient to conclude a similarity of goods and services, especially when the opponent mentions stores with such a wide range of products. Regarding the intended purpose, goods in Class 30 include food, flavorings and condiments and do not entail any similarity to cosmetics. The users represent a wider variety of the public, targeting people essential needs such as cooking and eating. As for the nature, similar to Class 5, this category of goods represents edible/eatable products.”

60. In its submissions filed in lieu of a hearing, the opponent further states:

“26...The Later Goods in Classes 5 and 30 can broadly be categorised as dietetic and non-dietetic foodstuffs, respectively. These foodstuffs are frequently marketed as being beneficial to a user’s health, wellbeing and appearance. It is submitted that the Earlier Goods...in Classes 3...are similar to the Later Goods in Classes 5 and 30.

28. In terms of intended purpose, the Later Goods in Classes 5 and 30 and the Earlier Goods in...Class 3...are all products...that can have health benefits and which can be marketed to enhance beauty and appearance, as well as an individual’s health and wellbeing. The goods...also target the same relevant public.

29. The Later Goods in Classes 5 and 30 and the Earlier Goods...in Class 3...share the same distribution channels, being commonly available for purchase together in pharmacies, high-street chemists such as Boots and Superdrug, and health-food retailers such as Holland & Barrett. This was admitted by the Applicant in its Counterstatements...

30. Furthermore, the Class 3 goods covered by the Earlier Registration, such as “*Cosmetic preparations for slimming purposes; Cosmetic preparations for firming the skin*”, may be in competition with goods of the Applications in Classes 5 and 30, given their same function, and/or they may be used in a complementary way. For example, an individual using a skin firming cosmetic in Class 3 may complement this with a vitamin and/or mineral supplement that helps to improve the condition of the skin in Class 5; and an individual using a cosmetic preparation for slimming purposes in Class 3 may complement this with a non-dietetic food product in Class 30 and/or a pharmaceutical preparation for weight loss and/or a dietetic slimming supplement in Class 5, or may use the latter products instead of the Class 3 product.”

General comments

61. Although no evidence has been provided in this regard, I am satisfied that by the date of the applications the average consumer would have been well aware that large UK undertakings such as Boots, Superdrug and Holland & Barrett conduct a trade in a wide range of goods including those which fall within classes 3, 5 and 30. There is, therefore, likely to be an overlap in the trade channels of the applicant's and the opponent's goods as there will be in the users. The nature of the competing goods and their methods of use are, however, likely to differ.

Class 5

62. It appears to me that the average consumer of the goods upon which the opponent's trade mark has been used may, for example, chose to correct what it considers to be deficiencies in those areas of his/her body and improve their outward facing appearance by using either the opponent's goods externally or by ingesting the applicant's "dietetic food and substances adapted for medical use; pharmaceutical preparations; pharmaceutical products derived from natural sources." As a consequence, there is an overlap in the intended purpose of the goods and it creates a degree of competition between them. However, in the sense outlined in the case law, there is, at least as far as I can tell, no meaningful degree of complementarity between the goods. Weighing the relative importance of the various similarities and differences I have identified, results in what I consider to be a low degree of similarity between the opponent's goods in class 3 and the applicant's goods mentioned above. In my view, there is no meaningful degree of similarity between the opponent's goods and the remaining goods in the application. I shall, however, return to this point when I consider the likelihood of confusion.

Class 30

63. It appears to me that the intended purpose of the opponent's goods in class 3 differ and there is, despite the opponent's submissions to the contrary, no meaningful degree of either competition or complementarity between such goods and those of the opponent simply because the competing goods may be marketed

as being beneficial to an average consumer's health and well-being. Considered overall, I find there is no meaningful degree of similarity between the opponent's goods and those of the applicant in this class.

64. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

65. Proceeding on that basis, with the exception of “dietetic food and substances adapted for medical use; pharmaceutical preparations; pharmaceutical products derived from natural sources” in class 5, the opposition to the applicant's remaining goods in class 5 fails as does the opposition to all of the applicant's goods in class 30.

The average consumer and the nature of the purchasing act

66. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods in classes 3 and 5 I have found to be identical/similar. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, 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.”



67. The average consumer of the remaining goods is either a member of the general public or a professional user such as a beautician or dietician. As the goods at issue are most likely to be self-selected from the shelf of a bricks-and-mortar outlet or from the equivalent pages of a website, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations in the form of, for example, oral requests to sales assistants or word-of-mouth recommendations can be ignored. As the goods at issue are either for use upon the person or are or to be ingested, when making a selection, the average consumer is likely to have a range of factors in mind, for example, method of use, ingredients, fragrance, compatibility with existing medical conditions and cost. As a consequence, I would expect the average consumer to pay a higher than normal degree of attention when selecting the goods at issue.

Comparison of trade marks

68. 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 them, 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.”

69. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade marks
	<p>BIO LOGIQUE ("the first trade mark") &  ("the second trade mark")</p>

70. This aspect of the proceedings has attracted a good deal of comment from both sides. Although I do not intend to record these competing submissions here, I have borne them all in mind in reaching the conclusions which follow.

Overall impression

The opponent's trade mark

71. The opponent's trade mark consists of a number of components. The first, is a device presented in the colour beige which the opponent describes in its "mark description" (see paragraph 2) as a "bouquet of flowers". In its written submissions, the opponent refers to it not being unusual for "natural cosmetics and beauty goods and services to be marketed using images of nature...". Although the opponent has filed no evidence in this regard, I agree and am satisfied that at the date the applications for registration were filed that is a matter with which the average consumer would have been familiar. Consequently, although given its size the device will contribute to the overall impression conveyed, its pale colouring combined with

the propensity of other traders to use “images of nature” means any distinctiveness the device may enjoy will be, at best, low.

72. The words “BIOLOGIQUE RECHERCHE” are presented one above the other for the most part in block capital letters in the colour blue. Although given their size and positioning both words will make an important contribution to the overall impression conveyed, the stylisation of the letters “L”, “Q” and “E” add little or nothing to the overall impression conveyed by the words themselves.

73. As French is routinely taught in schools in the UK, many average consumers are likely to have a basic understanding of the language. Such a consumer is, I am satisfied, likely to appreciate that “BIOLOGIQUE” is a word in the French language meaning “BIOLOGICAL”. However, even for those average consumers in the UK not familiar with French, given its obvious visual similarity to the English language word “BIOLOGICAL”, that, I think, is how such a consumer will construe the word. As for the French language word “RECHERCHE”, once again those average consumers who have an understanding of French may appreciate this word equates to the English language word “RESEARCH”. However, given the significant visual differences, I see no reason why an average consumer who is not familiar with French will construe it as meaning “RESEARCH.” Much more likely, in my view, is that such a consumer will treat it as either an invented word or a word in a foreign language (possibly French) with which they are unfamiliar.

74. For those average consumers familiar with French, the words are likely to form a unit in which the first word qualifies the second, the totality being understood as meaning “biological research”. That is clearly the opponent’s intention, given the reference in its evidence to “biological extracts”. Considered in the context of natural goods in class 3, that meaning is, at best, highly allusive. For those average consumers unfamiliar with French, given my comments above about the word “BIOLOGIQUE”, it is the word “RECHERCHE” which is likely to make the greatest contribution to both the overall impression conveyed and distinctiveness.

The applicant's trade marks

75. The applicant's first trade mark consists of two components, both are presented in block capital letters. As neither component is highlighted or emphasised in any way, the overall impression conveyed and distinctiveness lie in the two components of which it is composed. Appearing as it does in many English language words such as "BIOLOGY" and "BIOLOGICAL", "BIO" is a combining form that will be familiar to the average consumer meaning, broadly speaking, "life". As for the French word "LOGIQUE" once again given its obvious visual similarity to the English language word "LOGIC", that is how it is likely to be construed by even non-French speakers.

76. The applicant's second trade mark consists of the same two components as its first trade mark, albeit presented in a slightly stylised but unremarkable upper case font. Between the two components appears the third component i.e. the device of a tree in which the roots of the tree form an underling of the other components. I have already commented on the other components above. Insofar as the device component is concerned, although given its size and positioning it will contribute to the overall impression conveyed, for the same reasons, I reach the same conclusion as I did in relation to the "image of nature" in the opponent's trade mark. Finally, as the ® symbol to the left of the final letter "E" simply indicates that, if successful, the trade mark applied for has been registered, it has no distinctive character and will make no impact on the overall impression conveyed. Considered overall, it is the non-device components that are likely to make by far the greatest contribution to both the overall impression conveyed and the trade mark's distinctive character.

Visual similarity

77. Although presented as one word and two components respectively, the competing trade marks coincide in the letters "B-I-O and L-O-G-I-Q-U-E." The word "RECHERCHE" is alien to the applicant's trade marks and although the opponent's trade mark and the applicant's second trade mark both contain "images of nature", the devices are quite different. Weighing the importance of the similarities and differences results in a medium degree of visual similarity between the opponent's

trade mark and the applicant's first trade mark and a between low and medium degree of visual similarity with its second trade mark.

Aural similarity

78. It is well-established that when a trade mark consists of a combination of words and figurative components it is by the word component(s) the trade mark is most likely to be referred to. That is the basis upon which I shall proceed. While I note the applicant's submission to the effect that as "BIO" and "LOGIQUE" are split-up in its trade marks "the pronunciation will be different from the single word BIOLOGIQUE", I do not agree. Proceeding on that basis, those components in the competing trade marks are aurally identical. However, as the word "RECHERCHE" in the opponent's trade mark will also be verbalised, the applicant's trade marks are aurally similar to the opponent's trade mark to a medium degree.

Conceptual similarity

79. As I mentioned earlier, many average consumers are likely to conceptualise the word "BIOLOGIQUE" in the opponent's trade mark as meaning "BIOLOGICAL", with the "image of nature" reinforcing that concept. For those consumers familiar with the French language, the words in the opponent's trade mark will create the concept of "biological research", however for those who are not, the word "RECHERCHE" is unlikely to create any concept. Insofar as the applicant's trade marks are concerned, although containing the same letters that appear in the word "BIOLOGIQUE", as these letters are presented as two separate components i.e. "BIO" and "LOGIQUE", they may, as the applicant submits, "make a suggestion "about the logic of bio (bio organic), meaning the logic of natural products...". Equally, the average consumer may simply construe the two separate components as a totality meaning "BIOLOGICAL". Regardless, for many average consumers all the trade marks at issue are likely to evoke the concept of goods that are natural, a concept which is reinforced by the presence of the "image of nature" in the applicant's second trade mark. Considered overall, for many average consumers the competing trade marks are conceptually similar to a fairly high degree.

Distinctive character of the earlier trade mark

80. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

Inherent distinctive character

81. In its written submissions, the opponent argues that its trade mark is:

“37...highly inherently distinctive, having no descriptive function for the English-speaking public in the UK...”

82. As I mentioned earlier, for those average consumers familiar with French, the words in the opponent’s earlier trade mark are likely to be understood as meaning “biological research”. When combined with a non-distinctive device of an “image of nature” in the context of goods in class 3 which have been developed through biological research and/or contain biological extracts, any inherent distinctiveness the earlier trade mark enjoys is likely to be, at best, low. When considered from the perspective of a non-French speaking average consumer, although the word “BIOLOGIQUE” is likely to be construed as “BIOLOGICAL”, the word “RECHERCHE” will be accorded no meaning and will, as a consequence, be highly distinctive. Considered in that context, the opponent’s earlier trade mark possesses a between low and medium degree of inherent distinctive character.

Enhanced distinctiveness

83. That, of course, is not the end of the matter as the opponent has filed evidence which I have summarised earlier in this decision. Although the opponent claims use in the UK since 2015, it has only provided turnover figures for the years 2018 to 2020 (which amount to a little over €1.8m) but, as I mentioned earlier, not all of the figure for 2020 can be taken into account. In addition, no indication has been provided of the amount spent in the UK promoting the trade mark or the market share the opponent's trade mark enjoys. Insofar as the latter is concerned, the size of the general market in which the opponent operates is, in my view, likely to be significant (most likely amounting to many tens if not hundreds of millions of pounds each year).

84. I have not, however, overlooked the fact that the opponent's evidence indicates that its products (which given their price appear to be at the upper end of the market) have been sold in a number of prestigious retail outlets (for example, Liberty and Harrods) and have, as inter alia exhibit 4 demonstrates, made a significant impression on both members of the general public and those in the industry, resulting in one of the opponent's products (the P50 liquid exfoliator) being described as a "cult" product. Bearing all of the above in mind, while I am prepared to accept that the inherent distinctiveness of the earlier trade mark has been enhanced through use to a small degree, it is not, in my view, to a sufficient extent that it is likely to impact on the overall outcome of the assessment I have to make.

Likelihood of confusion

85. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

86. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

87. Earlier in this decision I concluded that:

- the opponent has made genuine use of its earlier trade mark, a fair specification for which is “preparations for bodycare, skincare and haircare”;
- if not identical, the applicant’s goods in class 3 are highly similar to the opponent’s above named goods in class 3;
- there is a low degree of similarity between the applicant’s “dietetic food and substances adapted for medical use; pharmaceutical preparations; pharmaceutical products derived from natural sources” and the opponent’s above named goods;
- the average consumer of the goods is either a member of the general public or a professional user such as beautician or dietician;
- whilst not ignoring aural considerations, such consumers will select such goods by predominantly visual means whilst paying a higher than normal degree of attention during that process;
- the opponent’s trade mark is visually similar to the applicant’s first trade mark to a medium degree and to between a low and medium degree to its second trade mark;
- the opponent’s trade mark is aurally similar to both of the applicant’s trade marks to a medium degree;

- the opponent's trade mark is conceptually similar to both of the applicant's trade marks to a fairly high degree;
- the opponent's trade mark enjoys, at best, a between low and medium degree of inherent distinctive character which has, through use, been enhanced but not to a material extent.

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

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

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

89. In other words, simply considering the level of distinctive character possessed by the earlier trade mark is not enough. It is important to ask "in what does the distinctive character of the earlier trade mark lie?". Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

90. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would

be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

91. Earlier in this decision I concluded that the opponent’s goods are identical/highly similar to the applicant’s goods in class 3 and similar to a low degree to named goods in the application in class 5. However, even if I am wrong in concluding that there is no meaningful degree of similarity between the opponent’s goods and the remaining goods in class 5, such goods can, in my view, be no more similar than the goods I have specifically identified as being similar to a low degree. Proceeding on that basis and notwithstanding the identity/degree of similarity in the goods and the degree of similarity in the competing trade marks, having concluded that the average consumer will pay a higher than normal degree of attention to the selection of the goods at issue (thus making him/her less prone to the effects of imperfect recollection), I think it highly unlikely that such a consumer will overlook, in particular, the word “RECHERCHE” in the opponent’s trade mark. Consequently, even in relation to the applicant’s first trade mark, I think the likelihood of direct confusion is remote. Although I have already concluded that the “image of nature” in the applicant’s second trade mark is of low distinctiveness, nonetheless it represents a further point of visual difference leading to the same conclusion.

92. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

93. I begin by noting that the decision in *LA Sugar* only represents examples of when indirect confusion may be relevant (see in this respect the decision of the Court of Appeal in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021]

EWCA Civ 1207 at [12]). I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as the Appointed Person), stressed that a finding of indirect confusion should not be made merely because the two trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

94. In my view, the only similarity of relevance between the competing trade marks stems from the presence in the opponent's trade mark of the word "BIOLOGIQUE", in relation to which I have concluded that even an average consumer who is unfamiliar with French is likely to construe as relating to goods which are "BIOLOGICAL" in nature. When considered in the context of goods in classes 3 and 5, the word "BIOLOGIQUE" has, in my view, only a low degree of distinctive character. Consequently, I think it is far more likely that rather than assuming a trade connection between the competing trade marks, the average consumer is much more likely to conclude that the presence of the word "BIOLOGIQUE" in the opponent's trade mark is to indicate to them that the goods sold under the trade mark are biological in nature. In those circumstances, such a consumer is, in my view, very unlikely to rely upon this word alone to signify trade origin and will, instead, rely upon the totality of the competing trade marks to perform that function. In short, in my view, there is no likelihood of indirect confusion.

Conclusion under section 5(2)(b) of the Act

95. The opposition has failed.

The objection based upon section 5(3) of the Act

96. 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*. The law appears to be as follows:

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

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

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

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

“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.”

98. In Case C-408/01, *Adidas-Salomon*, the CJEU held:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

99. In *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, the CJEU held that:

“20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that

condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of 'reputation' assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, 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 (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29 As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

100. As I mentioned earlier, although the trade mark relied upon by the opponent is an EUTM, the opponent has only provided details of its use in the UK. That, however, is not fatal to the opponent’s case for the reasons explained by Mr Geoffrey Hobbs QC, as a Deputy Judge of the High Court in *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), where he held that:

“76. Article 9(1)(c) provides protection for Community trade marks which have a reputation “in the Community”. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by art.9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration. Since the territory of registration is part of

the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under art.34(2) of the CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community.”

Reputation

101. In *Spirit Energy Limited v Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for section 5(3) purposes. The opponent traded in solar energy equipment and installations and had used its trade mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the trade mark had fallen in the years leading up to the relevant date. Additionally, the trade mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the trade mark was not sufficient to establish a reputation for the purposes of section 5(3) of the Act.

102. I have already commented on the opponent's evidence earlier in this decision. In doing so, I concluded that although the earlier trade mark's inherent distinctiveness had been enhanced through use, it was not to such an extent that the

opponent was entitled to rely upon enhanced distinctive character for the purpose of its objection under section 5(2)(b) of the Act. Although I accept the tests for enhanced distinctiveness and reputation are different, I reach the same conclusion in relation to reputation. Without the necessary qualifying reputation the opposition based upon section 5(3) of the Act cannot succeed and is dismissed accordingly.

103. However, in the event I am wrong in that regard, I will consider the position on the basis that the opponent has the necessary qualifying reputation to get its objection off the ground. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

104. In determining whether the public will make the required mental ‘link’, the following factors in *Intel* are to be considered: (i) the degree of similarity between the conflicting trade marks, (ii) the nature of the goods for which the conflicting trade marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods, and the relevant section of the public, (iii) the strength of the earlier trade mark’s reputation, (iv) the degree of the earlier trade mark’s distinctive character, whether inherent or acquired through use, and (v) whether there is a likelihood of confusion.

105. I have considered many of the above factors under section 5(2)(b) of the Act and, where appropriate, adopt those conclusions here. I begin by reminding myself of the comments in *Intra-Press* and the identity/high degree of similarity with the applicant's goods in class 3 and the at best low degree of similarity with the applicant's goods in class 5. In those circumstances, even if the opponent's trade mark has a reputation, it is, in my view, likely to be relatively modest and, for essentially the same reasons I concluded there would be no likelihood of confusion, I also conclude that no link will be formed in the mind of the average consumer. That conclusion is even more pronounced in relation to the majority of the applicant's goods in class 5 (in relation to which in my primary conclusion I found no meaningful degree of similarity) and to the goods in class 30 in relation to which I reached the same conclusion. Without the creation of a link, there can be none of the adverse consequences for the opponent envisaged by this section of the Act and, as a consequence, the opposition based upon section 5(3) fails.

106. However, even if I am wrong and a link is made, the average consumer is, in my view, likely to regard it as the result of two unrelated undertakings using a word that means "BIOLOGIC(AL)". When considered in relation to goods where that is an important characteristic, such a link is unlikely to result in an unfair advantage to the applicant or to detriment to the earlier trade mark.

Conclusion under Section 5(3) of the Act

107. The opposition fails.

Overall conclusion

108. The opposition has failed on all grounds and, subject to any successful appeal, the application will proceed to registration.

Costs

109. The applicant has been successful and is, in principle, entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal

Practice Notice 2 of 2016. However, as in an email to the Tribunal dated 9 September 2021, the applicant stated: “[It] requests no award on costs”, I make no order as to costs.

Dated this 20th day of December 2021

C J BOWEN

For the Registrar