

O/0186/23

TRADE MARKS ACT 1994

RELATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS 3624123 AND 3676765

BY CINDY CHAN

TO REGISTER THE TRADE MARKS:

Solv

IN CLASSES 21, 35 AND 44

AND

SOLV.

IN CLASSES 3, 5, 21, 30, 32 AND 35

AND

OPPOSITIONS THERETO UNDER NUMBERS 426966 AND 430995

BY SOLV-X PRODUCTS LTD

BACKGROUND AND PLEADINGS

Application number 3624123 (“the first application”)

1. On 9 April 2021, Cindy Chan (“the applicant”) filed application number 3624123 to register the trade mark **Solv** in the UK.¹ The application was published for opposition purposes on 18 June 2021 and registration is sought for goods in class 21 and services in classes 35 and 44.²

Application number 3676765 (“the second application”)

2. On 3 August 2021, the applicant filed application number 3676765 to register the trade mark **SOLV.** in the UK. The application was published for opposition purposes on 12 November 2021 and registration is sought for goods in classes 3, 5, 21, 30 and 32 and services in class 35.³

The related oppositions

3. On 20 September 2021, SOLV-X Products Ltd (“the opponent”) opposed the first application in full based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. On 11 February 2022, the opponent opposed the second application in full based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

5. The following pleadings relate to both oppositions.

¹ The application was filed in the name of Vector Consumer Limited but on 29 June 2021, following the filing of a Form TM21a on 3 June 2021, a change of owner details was recorded and Cindy Chan replaced Vector Consumer Limited as the owner of the application.

² These will be listed in the goods and services comparison.

³ These will be listed in the goods and services comparison.

6. Under sections 5(2)(b) and 5(3), the opponent relies upon trade mark number 906672299,⁴ which has a filing date of 5 February 2008 and a registration date of 21 January 2009 – in accordance with section 6A, the mark is subject to proof of use. The registration covers goods in classes 3, 4, 6, 8, 9, 10, 12, 14, 16, 17, 18, 20, 21, 22, 23, 25, 26 and 28,⁵ all of which were initially relied upon in these oppositions. The opponent subsequently narrowed down the specification relied upon to its goods in classes 3 and 21.⁶ The representation of the mark is as follows:



7. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are highly similar and the goods and services are highly similar.

8. Under section 5(3), the opponent claims to have a substantial reputation in its earlier mark for all the goods in its registration and that use of the applicant's marks would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

9. Under section 5(4)(a), the opponent relies upon the sign **Solv-X** which it claims to have used throughout the UK since 2007 in relation to all the goods for which its earlier mark is registered, i.e. those listed in paragraph 6, above. The opponent claims that due to its goodwill in the sign, use of the applicant's marks would be contrary to the law of passing off.

10. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of its earlier registered mark.

⁴ On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks for all right holders with an existing EU trade mark ("EUTM"). As a result of the opponent's EUTM number 6672299 being registered before the end of the transition period, a comparable UKTM (the earlier mark) was created. Comparable trade marks are recorded on the UK trade marks register and retain their EU filing date. They are enforceable rights in the UK, consisting of the same sign, for the same goods or services.

⁵ These are listed in the Annex to this decision.

⁶ These will be listed in the proof of use assessment.

11. Due to an oversight as a result of the time between the filing of the applications and, consequently, the bringing of the oppositions, the proceedings were not consolidated. However, since the parties and the grounds of opposition are the same, and the evidence filed by both parties is identical,⁷ it was decided that the two oppositions would be dealt with together, with one decision written to cover all relevant issues. The parties were notified of the same on 3 November 2022.

12. The opponent is represented by Murgitroyd & Company and the applicant by Serjeants LLP. Both parties filed evidence and submissions during the respective evidence rounds. Neither party requested a hearing, but both filed written submissions in lieu. The evidence and submissions will be summarised to the extent that it is considered necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

The opponent's evidence

13. The opponent filed evidence in the form of the witness statement of Colm O'Neill, dated 7 April 2022 (in the first opposition) and 24 August 2022 (in the second opposition), and its corresponding five exhibits (CO1 – CO5). Mr O'Neill is Managing Director of the opponent company. Written submissions accompanied the opponent's evidence.

14. In his witness statement, Mr O'Neill refers to the supplying of over 850 different goods to around 8,000 retail outlets and to the almost 50 years of activity by the opponent. He has provided the following turnover figures and advertising spend:

Year	Annual turnover in £
2020-21	4m
2019-20	3.7m
2018-19	3.5m
2017-18	3.5m

⁷ Save for seven additional invoices filed in the opposition to the second application.

2016-17	3.4m
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Year	Advertising spend in £
2021	50,000
2020	60,000
2019	30,000

15. Exhibit CO1 is said by Mr O’Neill to contain a presentation brochure illustrating the breadth of goods provided under the opponent’s registration. The exhibit comprises two undated pages displaying a range of Solv-X branded goods.

16. 157 pages of invoices have been provided at exhibit CO2 in the first opposition proceedings, dated between August 2017 and March 2021 and addressed to various locations across the UK. Seven further invoices were provided in exhibit CO2 in the second opposition proceedings, all dated July 2021. There is a vast range of goods included in the invoices but for reasons that will become apparent I do not intend to list them here. In his witness statement, Mr O’Neill explains that the invoices show, in particular, use in relation to class 3 and class 21 goods.

17. Mr O’Neill describes exhibit CO3 as “a collection of brochures and catalogues evidencing promotion of the goods covered by the Registration. In particular, it shows use of the Registration for those goods on which the Company specifically relies on (sic) for the purposes of the Opposition. It also includes pictures of how the goods are packaged and viewed by the end consumer.” The exhibit contains 121 pages of undated material showing a large selection of goods: own-brand goods showing the Solv-X mark and goods of other undertakings. Amongst these pages are tables containing hundreds of different goods, their product codes, prices and profit margins; it is unclear whether these goods are Solv-X branded, or not.

18. Exhibit CO4 is described by Mr O’Neill as a preview from a graphics agency depicting a branded van featuring the Solv-X mark. The van is said to advertise and promote the goods covered by the opponent’s registration. The images contained in the undated exhibit are below.



Figure 1



Figure 2



Figure 3



Figure 4

19. Due to the way in which the branding is displayed on the van, particularly in Figure 3 (the mark does not fit properly on the front of the van and appears to spill over the top of the van) and Figure 4 (the branding covers the point at which the two rear doors of the van meet), it is not clear whether these are images of a van that is branded and currently in use, or whether this is a preview of a van that has yet to be branded whereby the mark and branding has simply been positioned over the top of pictures of a van.

20. Exhibit CO5 contains trade mark registration certificates for the mark Solv-X in the EU and China.

The applicant's evidence

21. The applicant filed evidence in the form of the witness statement of Matt Banks-Crompton, dated 7 June 2022, and its corresponding 13 exhibits (MBC1 – MBC13). Mr Banks-Crompton is Managing Director of Vector Consumer Ltd, the company on behalf of which the applicant made the first application and at which the applicant works as Marketing Manager. Written submissions accompanied the witness statement. The applicant's evidence goes to the use of its applied-for marks and its claimed reputation in the same.

DECISION

Relevance of EU law

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

Proof of use

23. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A (1) This section applies where -

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

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

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

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

(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.”

24. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7. (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union.”

25. Accordingly, for the purposes of assessing proof of use, the earlier mark will be treated as an EUTM for the part of the relevant period before IP completion day and, as such, use in the EU may be sufficient.

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

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

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

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

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

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

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in

accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

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

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

28. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date

of the application in issue. In these proceedings, there are two applications in issue and, therefore, two periods in which the opponent must show genuine use: 10 April 2016 to 9 April 2021 in relation to the first application; and 4 August 2016 to 3 August 2021 in relation to the second application.

29. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the earlier mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK (or the EU, prior to IP completion day) during the relevant five-year periods. In making the 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 for which use has been shown;
- iv) The nature of those goods and the market(s) for them; and
- v) The geographical extent of the use shown.

30. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁸

31. Referring to the opponent's evidence of use, summarised earlier in this decision, I am satisfied that the opponent has made genuine use of its earlier mark in the UK within the relevant periods. The earlier mark is shown in multiple exhibits (I will return to variant use of the mark shortly), there is clear evidence of sales from the invoices, and the turnover figures range from £3million to £4million per year. I bear in mind that the majority of each relevant period falls before IP completion day and that, accordingly, the opponent is required to show use in the EU. However, given that there have been sales with a wide geographical spread over the UK and that use in one member state may be sufficient,⁹ I am satisfied that the evidence of use in the UK

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

⁹ See *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 and *TVR Automotive Ltd v OHIM*, Case T-398/13.

constitutes genuine use of the earlier mark. The opponent relies upon - and is therefore required to show use in relation to - the goods shown below.

Class 3 *Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use; emery boards.*

Class 21 *Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); hair brushes; brush-making materials; articles for cleaning purposes; steel wool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; mouse traps; corkscrews; vegetable brushes; ice cream scoops; bamboo skewers; skewers of wood; wooden spoons; cocktail sticks; pastry brushes; ice cube trays; dish brushes; clothes pegs; scourers; mops; dental sticks; toothbrushes.*

32. I must consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC (as he then was) 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.”

33. 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 (at [47]):

“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."

34. Firstly, I am inclined to point out that cross-referencing the opponent's specification with the numerous invoices was not straightforward; most of the invoices list between

20 and 60 different items on each. The opponent has made no attempt to direct me to any invoices that are particularly helpful or to highlight any of the goods in its specification – especially those in classes 3 and 21 – on the invoices. From what I can ascertain, the invoices show sales of the following goods from the opponent's relied-upon specification:

Class 3 *Emery boards*

Class 21 *Household or kitchen utensils and containers; combs and sponges; brushes (except for paint brushes); hair brushes; articles for cleaning purposes; corkscrews; vegetable brushes; ice cream scoops; bamboo skewers; cocktail sticks; pastry brushes; dish brushes; clothes pegs; scourers.*

35. I have been unable to locate, within the 170 pages of invoices, any of the remaining goods in the specification. If such goods are listed, they are not clear and the opponent has not highlighted them. I remind myself that where evidence is filed to support a wide range of goods, it is necessary for the owner of the mark to indicate what parts of the evidence relate to which goods.¹⁰ Therefore, I continue the proof of use assessment on the basis of the goods listed in the previous paragraph.

36. However, it is not clear from the descriptions listed on the invoices whether the above-listed goods bear the Solv-X mark, or whether they are goods bearing other undertakings' trade marks. I must be satisfied that the opponent has not only sold these goods, but that consumers believe the goods to originate from the opponent, i.e. that they bear the mark relied upon. It is clear from the evidence¹¹ that the opponent is in the wholesale business and sells to retailers not only Solv-X branded goods but goods of other brand-owners, such as hosiery (see Figure 5), bin liners (see Figure 6), glassware (see Figure 7) and food storage containers (see Figure 8), to name a few examples.

¹⁰ See *Palmerwheeler Ltd v PRNnet* BL O/484/13.

¹¹ Exhibit CO3.



Figure 5



Figure 6



Figure 7



Figure 8

37. Since the product descriptions on the invoices do not include brand names (other than a few examples of Solv-X goods) it is impossible to tell which goods are Solv-X branded and which are not. The way I have reached my decision on proof of use, in line with *New Yorker* (cited above), is by determining which goods were sold (using the invoices at exhibit CO2) that bore the Solv-X mark being relied upon (using the marketing material at exhibits CO1 and CO3). This is not a fool-proof method of determining which goods were available under the earlier mark during the relevant periods, but, without assistance from the opponent within its own evidence, it is, in my view, the most appropriate way to afford the opponent its best case based on the evidence it has provided.

38. Where I cannot clearly see in exhibits CO1 and CO3 the Solv-X mark on the goods or the packaging, I am not willing to assume that those goods listed in the invoices were certainly Solv-X branded products and not goods of other brands. I appreciate that using the material in exhibits CO1 and CO3 is generous given that the material is undated and, consequently, I have no way of knowing whether the images contained therein accurately depict what was on the market during the relevant period. However, Mr O'Neill's narrative evidence is that this material shows how the goods are packaged and viewed by the consumers and it seems reasonable to conclude, taking all the exhibits together, that a proportion of the goods I have identified from the many invoices were Solv-X goods.

39. Accordingly, of the goods listed in paragraph 34, above, as being itemised on one or more of the invoices, I find that taking the other pieces of evidence into account, the following are likely to have been sold bearing the trade mark relied upon:

Class 3 *Emery boards*

Class 21 *Household or kitchen utensils; combs and sponges; brushes (except for paint brushes); hair brushes; articles for cleaning purposes; corkscrews; vegetable brushes; ice cream scoops; bamboo skewers; cocktail sticks; pastry brushes; dish brushes; clothes pegs; scourers.*

40. *Household or kitchen utensils* and *articles for cleaning purposes* are broad terms. Bearing in mind the number of items listed in the evidence which would fall within these terms, and in light of the case law referred to above, I am satisfied that these terms are a fair description of what the opponent has shown use for.

41. The Solv-X marks shown in exhibits CO1, CO2 and CO3, which have assisted in my proof of use finding, are different coloured (though single-coloured) variants of the black and white mark relied upon by the opponent. In accordance with section 6A(4)(a) of the Act, use of the mark in a form differing in elements which do not alter the distinctive character of the registered mark will qualify as illustrating use of the mark.

42. Mr Richard Arnold QC (as he then was) summarised the relevant test in *Nirvana Trade Mark*, BL O/262/06 and Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

43. I bear in mind that use of a mark in black and white covers its use in colour.¹² I am satisfied that presenting the black and white form of the mark, as registered, in a different colour does not alter the distinctive character of the mark to the extent that it does not qualify as genuine use of the earlier mark. The marks used in exhibits CO1-3 are acceptable.

Section 5(2)(b)

44. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

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

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

Relevant law

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

The principles

¹² See *Specsavers*, Case C-252/12 and *J.W. Spear & Sons Ltd and Others v Zynga Inc*. [2015] EWCA Civ 290.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

46. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

47. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

48. Further, in *Kurt Hesse v OHIM*,¹³ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,¹⁴ the General Court (“GC”) stated that “complementary” means:

¹³ Case C-50/15 P

¹⁴ Case T-325/06

“...there is 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.”

49. In *Gérard Meric v OHIM*, the GC confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):¹⁵

“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 fur 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.”

50. I bear in mind that it is permissible to group goods and services together for the purposes of assessment: *Separode Trade Mark*:¹⁶

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

51. Section 60A of the Act is also relevant, which states that:

“(1) For the purposes of this Act goods and services-

¹⁵ Case T-133/05

¹⁶ BL O/399/10

(a) are not to be regarded as being similar to each other on the ground that they appear to be in the same class under the Nice Classification,

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

52. In light of my findings above, the competing goods and services are shown below:

The opponent’s specification (following proof of use)

Class 3 *Emery boards*

Class 21 *Household or kitchen utensils; combs and sponges; brushes (except for paint brushes); hair brushes; articles for cleaning purposes; corkscrews; vegetable brushes; ice cream scoops; bamboo skewers; cocktail sticks; pastry brushes; dish brushes; clothes pegs; scourers.*

The applicant’s specification

The first application

Class 21 *Facial cleansing sponges; Facial buffing pads; Facial sponges for applying make-up; Drinking straws; Drinking glasses; Drinking cups; Drinks containers; Drinking flasks; Drinking bottles; Drinking bottles for sports; Cosmetic, hygiene and beauty care utensils; Cosmetics applicators; Cosmetic utensils; Cosmetic sponges; Cosmetic spatulas; Cosmetic brushes; Cosmetics brushes; Holders for cosmetics; Applicators for cosmetics; Cosmetic powder compacts; Cosmetic bags [fitted]; Containers for cosmetics.*

Class 35 Marketing; Promotional marketing; Market research; Product marketing; Marketing information; Event marketing; Market campaigns; Direct marketing; Market surveys; Online marketing; Digital marketing; Marketing services; Internet marketing; Advertising and marketing; Direct market advertising; Market research studies; Advertising and marketing services; Advertising, marketing and promotion services; Providing marketing information via websites; Advertising via the Internet; Advertising services provided over the internet; Commercial information services, via the internet; Rental of advertising space on the internet; Online advertisements; Online advertising; Online ordering services; Online advertising services; Online business networking services; Online data processing services; Conducting virtual trade show exhibitions online; Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Sales administration; Sales promotion; Product sales information; Sales promotion services; Publicity and sales promotion; Online advertising on a computer network; Advertising; On-line advertising; Marketing research in the fields of cosmetics, perfumery and beauty products; Commercial information and advice services for consumers in the field of beauty products.

Class 44 *Hygienic and beauty care; Human hygiene and beauty care; Beauty care; Hygienic and beauty care for humans; Beauty information services; Hygienic and beauty care for human beings; Providing information about beauty; Information relating to beauty; Beauty care for human beings; Information relating to beauty care; Healthcare.*

The second application

Class 3 Masks (Beauty -); Beauty creams; Beauty serums; Beauty masks; Facial beauty masks; Beauty preparations for the hair; Body cleaning and beauty care preparations; Beauty serums with anti-ageing properties; Beauty tonics for application to the face; Anti-aging skincare preparations; Cosmetic products in the form of aerosols for skincare; Face wash; Face scrub; Face masks; Face oils; Body washes; Face creams; Facial wash; Body wash; Face and body lotions; Face and body creams; Hair care lotions; Hair care preparations; Hair care creams; Hair care serum; Hair care masks; Hair emollients; Hair oils; Hair creams; Hair masks; Hair balm; Hair oil; Hair

moisturisers; Hair conditioners; Hair shampoos; Hair spray; Hair nourishers; Hair serums; Hair conditioner; Hair lotion; Hair cream; Hair shampoo; After-sun creams; After sun moisturisers; Sun creams; Sun screen; Sun-tanning oils; Sun care lotions; SPF sun block sprays; Sun creams [for cosmetic use]; Preparations for protecting the hair from the sun; Acne cleansers, cosmetic; Facial cleansing grains; Cleansing gels; Cleansing oil; Cleansing lotions; Facial cleansers; Facial washes; Facial oil; Facial moisturizers; Facial toner; Facial lotions.

Class 5 *Acne medication; Acne treatment preparations; Niacinamide preparations for the treatment of acne; Dietary supplements; Food supplements; Food supplements in liquid form; Vitamin and mineral food supplements; Health-aid foods supplements containing ginseng; Nutritional supplements; Health food supplements made principally of vitamins; Health-aid foods supplement containing red ginseng; Prebiotic supplements; Herbal supplements; Vitamin supplements; Probiotic supplements; Vitamin preparations in the nature of food supplements; Dietary supplement drinks; Food supplements consisting of amino acids; Food supplements consisting of trace elements; Mineral food supplements; Anti-oxidant food supplements; Health food supplements made principally of minerals; Mineral supplements; Vitamin drinks; Gummy vitamins; Vitamin tablets; Vitamin drops; Powdered nutritional supplement drink mix; Dietary supplements in powder form; Powdered fruit-flavored dietary supplement drink mix; Vitamin and mineral supplements.*

Class 21 *Facial cleansing sponges; Body sponges; Make-up sponges; Facial buffing pads; Drinking cups; Drinks containers; Stirrers (Drink -); Drinking flasks; Drinking bottles; Cosmetic brushes; Cosmetics applicators; Cosmetic utensils; Cosmetic sponges; Cosmetic spatulas; Holders for cosmetics; Applicators for cosmetics; Containers for cosmetics; Cosmetic bags [fitted].*

Class 30 *Snacks made from muesli; Snacks manufactured from cereals; Cereal-based snack bars; Snacks manufactured from muesli; Chocolate flavoured beverages; Chocolate-coated bars; Chocolate based drinks; Cocoa drinks; Cocoa [roasted, powdered, granulated, or in drinks]; Coffee based beverages; Coffee drinks; Coffee based drinks; Cereal-based savoury snacks; Corn-based savoury snacks; Flour based*

savory snacks; Cereal based snacks; Rice cake snacks; Cheese curls [snacks]; Cheese balls [snacks]; Fruit cake snacks.

Class 32 *Drinking water with vitamins; Beverages containing vitamins; Non-alcoholic drinks enriched with vitamins and mineral salts; Protein drinks; Isotonic drinks; Juice drinks; Vitamin fortified non-alcoholic beverages; Vitamin enriched sparkling water [beverages]; Vegetable drinks; Guarana drinks; Cola drinks; Fruit drinks; Sports drinks; Energy drinks; Soft drinks; Frozen fruit drinks; Orange juice drinks; Carbonated soft drinks; Fruit flavored drinks; Colas [soft drinks]; Fruit juice drinks; Non-alcoholic drinks; Fruit flavoured drinks; Apple juice drinks; Drinking mineral water; Isotonic non-alcoholic drinks; Fruit flavored soft drinks; Non-carbonated soft drinks; Fruit-flavored soft drinks; Coffee-flavored soft drinks; Soft drinks for energy supply; Low-calorie soft drinks; Soft drinks flavored with tea; Fruit-based soft drinks flavored with tea; Powders used in the preparation of soft drinks.*

Class 35 *Marketing; Promotional marketing; Market research; Product marketing; Marketing information; Event marketing; Market campaigns; Direct marketing; Market surveys; Online marketing; Digital marketing; Marketing services; Internet marketing; Advertising and marketing; Direct market advertising; Market research studies; Advertising and marketing services; Advertising, marketing and promotion services; Providing marketing information via websites; Advertising via the Internet; Advertising services provided over the internet; Commercial information services, via the internet; Rental of advertising space on the internet; Online advertisements; Online advertising; Online advertising services; Online advertising on computer networks; Online advertising on a computer network; Advertising; Online ordering services; Online data processing services; Online business networking services; On-line advertising; Conducting virtual trade show exhibitions online; Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Sales administration; Sales promotion; Product sales information; Sales promotion services; Publicity and sales promotion; Marketing research in the fields of cosmetics, perfumery and beauty products; Commercial information and advice services for consumers in the field of beauty products.*

53. For all the goods underlined in the applicant's first and second specifications, I see no obvious similarity with any of the opponent's goods. The section 5(2)(b) ground in relation to those goods and services fails.

Class 3

Beauty preparations for the hair; Hair care lotions; Hair care preparations; Hair care creams; Hair care serum; Hair care masks; Hair emollients; Hair oils; Hair creams; Hair masks; Hair balm; Hair oil; Hair moisturisers; Hair conditioners; Hair shampoos; Hair spray; Hair nourishers; Hair serums; Hair conditioner; Hair lotion; Hair cream; Hair shampoo; Preparations for protecting the hair from the sun.

54. These goods in the applicant's second application can all be considered preparations for hair, i.e. substances applied to the hair to clean, protect or nourish it. The opponent's specification includes *hair brushes* in class 21. Whilst these goods are all used on hair, they have different core purposes. Users may overlap to the extent that consumers purchase a combination of all these goods to care for their hair. The goods do not share trade channels given their different natures, but the trade channels will converge when they get nearer to the consumer and the goods will be found in the same location in stores, though not on the same shelves, nor under the same category online. The goods are not in competition with each other, neither are they so important for one another that I consider them complementary in line with the case law. Overall, I find a low to medium degree of similarity between these goods.

Class 21

55. The applicant's *Facial cleansing sponges; Facial sponges for applying make-up; Body sponges; Make-up sponges; Cosmetic sponges; Cosmetic brushes* fall within the scope of the opponent's *combs and sponges; brushes (except for paint brushes)*. These goods can be considered identical in line with *Meric*. Since the applicant's *cosmetic, hygiene and beauty care utensils; cosmetic applicators; cosmetic utensils* and *applicators for cosmetics* could come in the form of combs, sponges or brushes I find these, too, identical with the opponent's goods listed in this paragraph.

56. The remaining cosmetic goods in the applicant's specification – *facial buffing pads; cosmetic spatulas; holders for cosmetics; cosmetic powder compacts; cosmetic bags [fitted]* and *containers for cosmetics* – have no similarity to the opponent's *combs and sponges; brushes (except for paint brushes)*, nor to any other goods in the opponent's specification.

57. The opponent's *household or kitchen utensils* can be described as tools or instruments used for a particular purpose, at home or in the kitchen specifically. The applicant's *drinking straws* and *stirrers (drink-)* can be considered utensils on the basis that they stir beverages or carry the contents of a beverage to the user's mouth. The applicant's goods fall within the scope of the opponent's goods and are identical in line with *Meric*.

58. I do not consider the applicant's *drinking glasses; drinking cups; drinks containers; drinking flasks; drinking bottles* and *drinking bottles for sports* to fall within the ordinary meaning of a utensil. They do, however, share trade channels with household and kitchen utensils and will be found in the same or adjacent aisles in stores. Whilst the goods are not in competition and do not have a complementary relationship, there is likely to be an overlap in users. Overall, I find a medium degree of similarity between the opponent's *household or kitchen utensils* and the applicant's goods listed in this paragraph.

Class 44

59. The applicant's services in this class have no obvious similarity with the opponent's goods, other than hair brushes, on the basis that undertakings who provide beauty services may use a hair brush as one of their tools. Other than that very tenuous link between the goods and services, I find no meaningful similarity between the applicant's class 44 services and any of the goods relied upon by the opponent. For the avoidance of doubt, the same reasoning as given in this paragraph applies to the few terms in the applicant's class 35 services which relate to cosmetics and beauty products, for which I have already found no similarity.

The average consumer and the purchasing act

60. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which the goods/services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

61. The relevant goods are those for which I have found a degree of similarity, i.e. some in classes 3 and 21. The relevant goods are everyday consumer goods, the average consumer for which is a member of the general public. The goods are most often self-selected from the shelves of retail stores or their online equivalents and so the purchase is predominantly visual. However, I do not discount aural considerations given that conversations may be had with retail assistants, for example. Consumers will consider factors such as cost, ease of use and suitability for their needs when making their selection. Overall, I consider that a medium degree of attention will be paid to the selection of the relevant goods.

Comparison of marks


62. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing

in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

63. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

64. The trade marks to be compared are as follows:

The applicant's marks		The opponent's earlier mark
The first application	Solv	
The second application	SOLV.	

65. The opponent attests to a likelihood of confusion on the basis of a high degree of similarity between the marks. The applicant submits that the shared element ‘SOLV’ is not sufficient to result in a likelihood of confusion.

66. The earlier mark is figurative and comprises the word ‘Solv’, the letter ‘X’ and a hyphen separating the two, all of which are in a fairly standard, italicised font in white. These elements are positioned on a black, oval background with a curved white line

towards the lower part of the oval. The word element 'Solv-X' is the dominant and distinctive element in the mark, with none of the characters dominating, and the oval device plays a much lesser role - simply as a background.

67. The applicant's marks consist of the word 'Solv', with the first application presented in sentence case and the second in upper case. The second application also contains a full stop following 'SOLV'. The full stop may go unnoticed and so plays a minor role in the overall impression of the mark, which rests in the one word 'Solv' for both marks.

68. Given the negligible difference between the applicant's marks, the following findings apply to both, particularly since notional use of a word mark allows for its use in lower, upper or sentence case.

Visual comparison

69. The marks coincide in the first four letters, SOLV, creating a point of visual similarity. The hyphen and letter 'X' in the earlier mark, as well as the oval device and the minor stylisation of the word element create some visual difference between the marks. The full stop is likely to go unnoticed and so does not make a material difference to the visual assessment. Taking everything into account and bearing in mind the distinctive and dominant elements, I consider the marks to be visually similar to a high degree.

Aural comparison

70. As with the visual comparison, the common element 'Solv' creates aural similarity. I consider the word will be pronounced as the ordinary dictionary word 'solve'. There is no reason why the letter 'X' in the earlier mark will not be articulated and so this creates a point of aural difference with the earlier mark being pronounced 'solve-ex'. The hyphen in the earlier mark and the full stop in the second application will not be articulated, neither will the oval device. Accordingly, there is a high degree of aural similarity between the marks.

Conceptual comparison

71. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.¹⁷ The assessment must be made from the point of view of the average consumer.

72. The word 'solv' in the marks will conjure the same meaning to consumers: to find an answer to a problem, as in the ordinary dictionary word 'solve'.¹⁸ The letter 'X' in the earlier mark adds another element to this concept albeit a minor one. Consumers will either not attribute much meaning to 'X' and see the earlier mark as the meaning of the word 'solve' followed by the letter 'X' or see the combination of the two elements as a reference to solving a mathematical equation. In either scenario, the element 'solv' overlaps in the marks and I find them to be conceptually similar to a medium to high degree.

Distinctive character of the earlier mark

73. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

¹⁷ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

¹⁸ Cambridge English Dictionary.

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

74. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

75. I will begin by assessing the inherent distinctive character of the earlier mark, which consists of the textual component ‘Solv-X’ and the oval device. Whilst I have found that consumers are likely to think of the ordinary dictionary word ‘solve’ upon seeing the earlier mark, the spelling is unusual and the letter ‘X’ adds a different element to the concept. ‘Solv-X’ does not mean anything in relation to the goods for which it is registered, nor is it a dictionary-defined word or phrase. Overall, I consider the mark to have a high degree of inherent distinctive character.

76. Turning now to consider whether the distinctiveness of the earlier mark has been enhanced through use, I refer to the opponent’s evidence of use, summarised earlier in this decision.

77. Whilst the opponent clearly has a successful business, with an annual turnover of between 3 and 4 million pounds between 2016 and 2021, it has not broken down its sales figures into any categories of goods for me to determine whether the turnover is spread fairly equally or whether there are particular goods which have contributed more significantly to the sales. With a registration covering a broad range of goods in 18 different classes, and a reference in Mr O’Neill’s witness statement to “over 850 goods” supplied by the opponent, it would have been useful for the opponent to have

broken down its sales figures. Further, it has not provided details of its market share for any of its categories of goods. The advertising spend totals £140,000 over 3 years; no advertising figures have been provided prior to 2019, despite Mr O'Neill referring to over 50 years of activity by the opponent. In any case, the advertising spend is not overwhelming and the only documentary evidence to support the figures are undated brochures and catalogues¹⁹ with no explanation as to how many were produced or to whom they were distributed. As previously explained, the images of a van, said to be branded with the earlier mark and used to promote the brand, are not convincing since they appear to be previews of how the van might look. There is no explanation in the witness statement as to when this van was branded and for how long it has been in use for me to determine the proportion of the relevant public who are likely to have come across it. The evidence as a whole is insufficient for me to be persuaded that the earlier mark is known to consumers in the UK to such an extent that the mark's distinctive character has been enhanced through use for any particular goods. In any case, the inherent distinctiveness of the mark remains high.

Likelihood of confusion

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

79. I have found the marks to be visually and aurally similar to a high degree and conceptually similar to a medium to high degree. I have found the earlier mark to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who, paying a medium degree of attention,

¹⁹ CO1 and CO3.

selects the goods mainly by visual means, though there may be an aural element to the purchase. I have found the similarity between the goods to vary from a low to medium degree to identical.

80. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc.*, BL O/375/10, where Iain Purvis QC (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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).”

81. I bear in mind that the earlier mark contains the entirety of the applicant’s marks and that this shared element is at the beginning of the marks. I also remind myself that the beginnings of marks tend to have more visual and aural impact than the ends.²⁰ Further, the full stop in the second application is likely to go unnoticed and the oval device and stylisation to the textual component in the earlier mark are not dominant and may be overlooked by the average consumer. That being said, the hyphen and letter ‘X’ in the earlier mark form part of the dominant and distinctive element. When comparing the marks side by side, the hyphen and letter ‘X’ are an obvious dissimilarity. However, the average consumer is often not able to compare marks side by side and instead relies upon its recollection of a trade mark. Bearing in mind that there could be a significant period of time between seeing the earlier mark and seeing either of the applicant’s marks, or vice versa, it seems likely to me that consumers may misremember the hyphen and letter ‘X’, appearing at the end of the earlier mark and instead remember the unusually spelled ‘solv’. On everyday consumer goods that share any degree of similarity, I consider there to be a likelihood of direct confusion, with consumers mistaking one mark for the other.

82. In case I am wrong in my finding of direct confusion, I turn to indirect confusion. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

²⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

83. The earlier mark has a high degree of distinctive character; whilst its distinctiveness resides in the mark as whole, the element common between the marks at issue – ‘solv’ – is also unusual. In my view, in circumstances where consumers notice the differences between the marks, they will see the addition (or removal) of a hyphen and the letter ‘X’ as a potential sub-brand. As previously stated, the full stop in the second application is likely to go unnoticed and the oval device in the earlier mark will be seen as decorative – a common way of undertakings either presenting their marks differently or rebranding their marks. To my mind, consumers will not see ‘solv’ in two different marks used on similar or identical goods and put it down to mere coincidence; they are far more likely to assume a connection between the two undertakings. I find there to be a likelihood of indirect confusion.

84. The section 5(2)(b) ground succeeds in relation to the following goods:

The first application

Class 21 Facial cleansing sponges; Facial sponges for applying make-up; Drinking straws; Drinking glasses; Drinking cups; Drinks containers; Drinking flasks; Drinking bottles; Drinking bottles for sports; Cosmetic, hygiene and beauty care utensils; Cosmetics applicators; Cosmetic utensils; Cosmetic sponges; Cosmetic brushes; Cosmetics brushes; Applicators for cosmetics.

The second application

Class 3 Beauty preparations for the hair; Hair care lotions; Hair care preparations; Hair care creams; Hair care serum; Hair care masks; Hair emollients; Hair oils; Hair creams; Hair masks; Hair balm; Hair oil; Hair moisturisers; Hair conditioners; Hair shampoos; Hair spray; Hair nourishers; Hair serums; Hair conditioner; Hair lotion; Hair cream; Hair shampoo; Preparations for protecting the hair from the sun

Class 21 Facial cleansing sponges; Body sponges; Make-up sponges; Drinking cups; Drinks containers; Stirrers (Drink -); Drinking flasks; Drinking bottles; Cosmetic

brushes; Cosmetics applicators; Cosmetic utensils; Cosmetic sponges; Applicators for cosmetics.

Section 5(3)

85. Section 5(3) states:

“(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 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.”

86. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the applicant’s marks. Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the applicant’s marks. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

87. Under section 5(2)(b), I found that the applicant’s marks were similar to the earlier mark.

Reputation

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

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

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

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

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

89. I recall that I found the opponent’s evidence insufficient to establish that the distinctive character of the earlier mark had been enhanced through use. The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the mark has a reputation. In particular, the sales figures are not broken down by any category of goods to enable me to determine which goods, if any, the opponent has a reputation for. There is also limited marketing expenditure and limited, undated examples of advertising the mark. Similar to my reasoning in paragraph 77, the evidence is insufficient for me to find that the mark is known by a significant proportion of the general public. For this reason, this ground of opposition falls at the first hurdle and it is not necessary to consider the matter further.

90. The section 5(3) ground fails.

Section 5(4)(a)

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

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

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

(aa) [...]

(b) [...]

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

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

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

Relevant law

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

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely

goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

Relevant date

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

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

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

95. The applicant has filed evidence of use of its marks, but none of it predates the filing dates of its applications. Consequently, the relevant dates for this opposition are the dates of the applications, i.e. 9 April 2021 in relation to the first application and 3 August 2021 in relation to the second application.

Goodwill

96. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

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

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

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

98. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (as he then was), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph

52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townsend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

99. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the

average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

100. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, "*very limited*",

the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.

101. The case law above makes it clear that goodwill must be more than trivial in extent, but that a business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill may be small.

102. The opponent claims to own goodwill in relation to all the goods in its earlier mark's registration. Bearing in mind my summary and assessment of the evidence earlier in this decision, there is no, or insufficient, evidence of the establishment of goodwill in relation to any goods other than those for which I have found genuine use. Whilst there are clear deficiencies in the opponent's evidence - particularly that the sales figures have not been broken down, there are no figures on market share for any of the goods and the evidence going to the advertising of the mark is underwhelming - that does not exclude it from having a protectable goodwill in relation to the custom that it has shown to have generated. There are clear sales of the goods for which I have found genuine use, across the UK for the four years leading up to the relevant dates, along with an annual turnover of between 3 and 4 million pounds in the same period. To my mind, this does not point to a trivial, but a protectable goodwill, albeit a small one.

103. In relation to the goods for which I have found similarity and, subsequently, a likelihood of confusion under section 5(2)(b), the 5(4)(a) ground takes the opponent's case no further and so I do not consider it necessary to go any further into this ground. In relation to the goods and services for which I found no similarity and, consequently, no likelihood of confusion, whilst I am cognisant of the fact that there is no requirement for similarity in passing off cases, in my view, based on the evidence before me, the goodwill is not large enough to bridge the gap between those dissimilar goods and services, for which the section 5(4)(a) ground therefore fails.

CONCLUSION

104. The opposition has partially succeeded, in relation to the goods listed at paragraph 84, under section 5(2)(b) and registration is refused for those goods.

105. The first application (number 3624123) will proceed to registration for the following goods and services:

Class 21 *Facial buffing pads; Cosmetic spatulas; Holders for cosmetics; Cosmetic powder compacts; Cosmetic bags [fitted]; Containers for cosmetics.*

Class 35 *Marketing; Promotional marketing; Market research; Product marketing; Marketing information; Event marketing; Market campaigns; Direct marketing; Market surveys; Online marketing; Digital marketing; Marketing services; Internet marketing; Advertising and marketing; Direct market advertising; Market research studies; Advertising and marketing services; Advertising, marketing and promotion services; Providing marketing information via websites; Advertising via the Internet; Advertising services provided over the internet; Commercial information services, via the internet; Rental of advertising space on the internet; Online advertisements; Online advertising; Online ordering services; Online advertising services; Online business networking services; Online data processing services; Conducting virtual trade show exhibitions online; Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Sales administration; Sales promotion; Product sales information; Sales promotion services; Publicity and sales promotion; Online advertising on a computer network; Advertising; On-line advertising; Marketing research in the fields of cosmetics, perfumery and beauty products; Commercial information and advice services for consumers in the field of beauty products.*

Class 44 *Hygienic and beauty care; Human hygiene and beauty care; Beauty care; Hygienic and beauty care for humans; Beauty information services; Hygienic and beauty care for human beings; Providing information about beauty; Information relating to beauty; Beauty care for human beings; Information relating to beauty care; Healthcare.*

106. The second application (number 3676765) will proceed to registration for the following goods and services:

Class 3 *Masks (Beauty -); Beauty creams; Beauty serums; Beauty masks; Facial beauty masks; Body cleaning and beauty care preparations; Beauty serums with anti-ageing properties; Beauty tonics for application to the face; Anti-aging skincare preparations; Cosmetic products in the form of aerosols for skincare; Face wash; Face scrub; Face masks; Face oils; Body washes; Face creams; Facial wash; Body wash; Face and body lotions; Face and body creams; After-sun creams; After sun moisturisers; Sun creams; Sun screen; Sun-tanning oils; Sun care lotions; SPF sun block sprays; Sun creams [for cosmetic use]; Acne cleansers, cosmetic; Facial cleansing grains; Cleansing gels; Cleansing oil; Cleansing lotions; Facial cleansers; Facial washes; Facial oil; Facial moisturizers; Facial toner; Facial lotions.*

Class 5 *Acne medication; Acne treatment preparations; Niacinamide preparations for the treatment of acne; Dietary supplements; Food supplements; Food supplements in liquid form; Vitamin and mineral food supplements; Health-aid foods supplements containing ginseng; Nutritional supplements; Health food supplements made principally of vitamins; Health-aid foods supplement containing red ginseng; Prebiotic supplements; Herbal supplements; Vitamin supplements; Probiotic supplements; Vitamin preparations in the nature of food supplements; Dietary supplement drinks; Food supplements consisting of amino acids; Food supplements consisting of trace elements; Mineral food supplements; Anti-oxidant food supplements; Health food supplements made principally of minerals; Mineral supplements; Vitamin drinks; Gummy vitamins; Vitamin tablets; Vitamin drops; Powdered nutritional supplement drink mix; Dietary supplements in powder form; Powdered fruit-flavored dietary supplement drink mix; Vitamin and mineral supplements.*

Class 21 *Facial buffing pads; Cosmetic spatulas; Holders for cosmetics; Containers for cosmetics; Cosmetic bags [fitted].*

Class 30 *Snacks made from muesli; Snacks manufactured from cereals; Cereal-based snack bars; Snacks manufactured from muesli; Chocolate flavoured beverages;*

Chocolate-coated bars; Chocolate based drinks; Cocoa drinks; Cocoa [roasted, powdered, granulated, or in drinks]; Coffee based beverages; Coffee drinks; Coffee based drinks; Cereal-based savoury snacks; Corn-based savoury snacks; Flour based savory snacks; Cereal based snacks; Rice cake snacks; Cheese curls [snacks]; Cheese balls [snacks]; Fruit cake snacks.

Class 32 Drinking water with vitamins; Beverages containing vitamins; Non-alcoholic drinks enriched with vitamins and mineral salts; Protein drinks; Isotonic drinks; Juice drinks; Vitamin fortified non-alcoholic beverages; Vitamin enriched sparkling water [beverages]; Vegetable drinks; Guarana drinks; Cola drinks; Fruit drinks; Sports drinks; Energy drinks; Soft drinks; Frozen fruit drinks; Orange juice drinks; Carbonated soft drinks; Fruit flavored drinks; Colas [soft drinks]; Fruit juice drinks; Non-alcoholic drinks; Fruit flavoured drinks; Apple juice drinks; Drinking mineral water; Isotonic non-alcoholic drinks; Fruit flavored soft drinks; Non-carbonated soft drinks; Fruit-flavored soft drinks; Coffee-flavored soft drinks; Soft drinks for energy supply; Low-calorie soft drinks; Soft drinks flavored with tea; Fruit-based soft drinks flavored with tea; Powders used in the preparation of soft drinks.

Class 35 Marketing; Promotional marketing; Market research; Product marketing; Marketing information; Event marketing; Market campaigns; Direct marketing; Market surveys; Online marketing; Digital marketing; Marketing services; Internet marketing; Advertising and marketing; Direct market advertising; Market research studies; Advertising and marketing services; Advertising, marketing and promotion services; Providing marketing information via websites; Advertising via the Internet; Advertising services provided over the internet; Commercial information services, via the internet; Rental of advertising space on the internet; Online advertisements; Online advertising; Online advertising services; Online advertising on computer networks; Online advertising on a computer network; Advertising; Online ordering services; Online data processing services; Online business networking services; On-line advertising; Conducting virtual trade show exhibitions online; Online retail services relating to cosmetics; Online retail store services relating to cosmetic and beauty products; Sales administration; Sales promotion; Product sales information; Sales promotion services; Publicity and sales promotion; Marketing research in the fields of cosmetics, perfumery

and beauty products; Commercial information and advice services for consumers in the field of beauty products.

COSTS

107. On balance, I consider that both parties have achieved a relatively equal level of success in these proceedings. In the circumstances, I do not consider it appropriate to make a costs award in favour of either party. Therefore, I order both parties to bear their own costs in these proceedings.

Dated this 23rd day of February 2023

E FISHER (née VENABLES)

For the Registrar

Annex

The earlier mark's specification

Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use; emery boards.

Class 4 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting; scented candles; birthday candles.

Class 6 Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; padlocks; metal hooks.

Class 8 Hand tools and implements (hand operated); cutlery; side arms; razors, electric razors and hair cutters; cutlery made of precious metal; nail clippers; tweezers; trimming knives; can openers; peelers; kitchen tongs; scissors; nail files.

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment, computers; fire-extinguishing apparatus; electric plugs; thirteen amp plugs; adaptors; two way adaptors; electric adaptors; electric fuses; thirteen amp fuses; extension leads.

Class 10 Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials; dummies; baby soothers; teething soothers; babies bottles; teats for babies bottles.

Class 12 Vehicles; apparatus for locomotion by land, air or water motors and engines for land vehicles; puncture repair outfits.

Class 14 Precious metals and their alloys and goods in precious metals and coated therewith, not included in other classes; jewellery; precious stones; horological and chronometric instruments; alarm clocks; travel alarm clocks.

Class 16 Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; party bags; adhesive tape; glue for stationery or household use; glue sticks; rubber bands; drawing pins; markers; pens; highlighters; envelopes; writing pads; notebooks.

Class 17 Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal, semi-finished plastics; PVC tape; insulating tape; masking tape.

Class 18 Leather and imitations of leather, and goods made of these materials, not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; bottle bags; luggage; luggage straps; luggage identity straps.

Class 20 Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; garden furniture; pillows and cushions; drinking straws; adhesive hooks of plastic.

Class 21 Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); hair brushes; brush-making materials; articles for cleaning purposes; steel wool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; mouse traps; corkscrews; vegetable brushes; ice cream scoops; bamboo skewers; skewers of wood; wooden spoons; cocktail sticks; pastry brushes; ice cube trays; dish brushes; clothes pegs; scourers; mops; dental sticks; toothbrushes.

Class 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials; cord.

Class 23 Yarns and threads, for textile use; sewing thread.

Class 25 Clothing; footwear; headgear; sleep masks; travel sleep masks.

Class 26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers; dressmakers' articles; hair accessories; hair grips; ponytail bands; hair scrunchies; safety pins.

Class 28 Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; balloons, blow out streamers; streamers; playing cards.