

O/0290/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3695447
BY LUCA MEISE
TO REGISTER THE TRADE MARK:**

**INDATE C
O**

IN CLASSES 5, 29, 32 AND 44

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 431893
BY FOODSTATE, INC.**

Background and pleadings

1. On 15 September 2021, **Luca Meise** (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number **3695447** (“**the contested mark**”). The contested mark was published in the Trade Marks Journal for opposition purposes on 17 December 2021. The contested mark claims a priority date of 25 May 2021.¹ Registration is sought for the following goods and services:

Class 5: Pharmaceuticals, medical and veterinary preparations; Sanitary preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; nutritional supplements containing probiotics, Dietary supplements for human beings and animals, Prebiotics; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants; Preparations for destroying noxious animals; Fungicides, herbicides.

Class 29: Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk, cheese, butter, yoghurt and other dairy products; Yogurt drinks; Edible oils and fats; Bacterially fermented beverages derived from milk, Yogurt drinks, Fermented beverages made from plant-based milk substitutes, including soya, coconut and almond.

Class 32: Beer; Non-alcoholic beverages; Mineral and aerated waters; Fruit beverages and fruit juices; Syrups and other non-alcoholic preparations for making beverages.

Class 44: Dietary and nutritional advice; Providing information relating to dietary and nutritional guidance.

2. On 16 March 2022, **FoodState, Inc.** (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods and services of the application. To support its

¹ Priority is claimed from European Union Trade Mark No. 18478401

claim, the opponent relies upon its comparable UK trade mark **914197511**,² **INNATE** (“the earlier mark”). The earlier mark was filed on 4 June 2015 and registered on 7 October 2015 in respect of the following goods, all of which are relied upon for the purpose of the opposition.

Class 5: Vitamin, mineral and nutritional dietary supplements; vitamins; minerals; nutritional preparations and substances.

3. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. As it had been registered for more than five years at the priority date claimed by the application, it is subject to the proof of use requirements specified within section 6A of the Act.

4. The opponent essentially argues that the competing marks are highly similar, and the opponent’s goods are similar to the applicant’s goods and services. On this basis, the opponent contends that there is a likelihood of confusion, including the likelihood of association. The opponent also made a statement of use in respect of all the goods of the earlier mark.

5. The applicant filed a counterstatement denying the ground of opposition. Within its counterstatement, the applicant denies that the marks are similar and denies that the opponent’s goods are similar to the applicant’s goods and services. It disputes that there is a likelihood of confusion. Moreover, the applicant requested that the opponent demonstrates proof of use of the earlier mark.

6. The opponent is professionally represented by Groom Wilkes & Wright LLP, whereas the applicant is professionally represented by Meissner Bolte (UK) Limited. Evidence has been filed by the opponent in these proceedings, alongside its evidence the opponent also filed its written submissions. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. However, the applicant filed written submissions in lieu of an oral hearing. Whilst I do not intend to

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number **14197511** being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, it has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing date remains.

summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

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

Evidence

8. The opponent's evidence comprises the witness statement of Elsa Pombeiro, dated 29 August 2022, together with Exhibits 1-3. Elsa Pombeiro confirms that they are Chief Financial Officer of the opponent company, a position they have held since December 1999. Elsa Pombeiro also claims to be the owner of the company. The purpose of the statement is to give evidence as to the history of the opponent, as well as its use of the earlier mark. I have reviewed the evidence and will return to it to the extent I consider necessary during the course of this decision.

Decision

Proof of use

9. 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), (aa) 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.”

10. 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”.

11. As a result of the above provisions, for the purposes of assessing proof of use, the earlier mark will be treated as an EUTM for the part of the relevant period which was before IP completion day, (i.e. until 31 December 2020). As such, prior to this date, the relevant territory in which the opponent must demonstrate genuine use is the EU.

12. The onus is on the opponent, as the proprietor of the earlier mark, to show use made of the mark as section 100 of the Act states:

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

13. 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 priority date claimed by the application at issue, i.e. 26 May 2016 to 25 May 2021.

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

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v 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].”

15. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.

16. 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/services at issue in the UK (or the EU, prior to IP completion day) during the relevant 5-year period. In making the required assessment I must consider all relevant factors, including:

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

- v) The geographical extent of the use shown

17. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. (as he then was) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

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

18. Elsa Pombeiro gives evidence that the opponent company was established in 1989.³ It is said to provide a range of dietary supplements which have been sold in various countries around the world (including in the UK) under the INNATE brand.⁴ Elsa Pombeiro claims that the opponent has used the earlier mark in relation to the goods for which it is registered within the 5-year period preceding 15 September 2021; in support of this, Elsa Pombeiro provides a breakdown of approximate net sales figures for the UK dated between 2016 to 2020. The following figures are provided: \$62,501 for 2016, \$76,600 for 2017, \$67,506 in 2018, \$53,778 in 2019 and finally \$5,221 in 2020.⁵ I am mindful that there is no documentary evidence of sales and the figures do not differentiate between the goods in class 5. Furthermore, despite alluding to the products being sold in other countries around the world, these countries have not been specified and I have no further details of sales made within these countries. Consequently, I am unable to ascertain whether sales have been made prior to IP completion day in countries across the EU other than the UK.

19. Included in the evidence are three labels that Elsa Pombeiro claims are from nutritional and multivitamin products sold in the UK which show the INNATE mark.⁶ These labels refer to particular multivitamins and dietary supplements, yet these labels are not evidenced on the goods themselves. When considered in light of the corroborating website evidence (discussed below), I am prepared to accept that there are goods bearing these labels for sale. However, I have no information to ascertain whether these goods were for sale within the relevant period.

20. The opponent has provided three screenshots from amazon.co.uk which show dietary supplements, including vitamins and minerals, for sale under the mark INNATE. The images are not the clearest, but the products appear to be for sale in pound sterling,⁷ which suggests the targeting of consumers in the UK. However, these screenshots are undated. I note that the prospective delivery date is given as 26 August, but there is no indication of the year. The applicant argues that “[...] it would appear that this evidence [exhibit 2] was prepared around the time the opponent was

³ Elsa Pombeiro’s witness statement, paragraph 5

⁴ Elsa Pombeiro’s witness statement, paragraphs 5 -7

⁵ Elsa Pombeiro’s witness statement, paragraph 9

⁶ Exhibit 1

⁷ Exhibit 2

preparing to file its evidence, (i.e. 30 August 2022), which can be inferred from the delivery options [...]”. I agree that when viewed in conjunction with the witness statement, it is likely that the screenshots were obtained in August 2022 and, therefore, postdate the relevant period.

21. The evidence also encompasses images from three different websites⁸, which Elsa Pombeiro states are: uk.iherb.com, spectrumsupplements.co.uk, and vitaminsuk.com.⁹ These images show dietary supplements for sale under the earlier mark on each of these websites. However, these images are also undated. The only date provided is 17 August 2015, next to the words “Date First Available” shown beside the product “Innate Response formulas” on iHerb’s website. However, it is unclear if this is the date the product was first available/released or the date the product was first available to purchase from iHerb’s website. Either way, the date is outside the relevant period and, therefore, the images cannot be relied upon as showing the position in the relevant period. While the goods might have first been available on 17 August 2015, there is no evidence that the goods were still available to purchase via the website during the relevant period.

22. Even if the webpages referred to above were dated, there is no information in relation to how many views these websites have had in the relevant period, or how many sales have been generated from these websites, say, in the form of relevant invoices.

23. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹⁰ I do not discount that there has been some use of the INNATE mark. Nevertheless, as indicated above, not every commercial use of a mark may automatically be deemed to constitute genuine use. Whilst an annual breakdown of approximate turnover figures has been provided for 2016-2020, from the evidence I am unable to ascertain with any degree of certainty how this turnover was generated. I have not been provided with a breakdown of sales figures for the

⁸ Exhibit 3

⁹ Elsa Pombeiro’s witness statement, paragraph 12

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

individual goods within class 5 that the opponent relies on. I also have no invoices or order confirmations to verify the exact goods sold in connection with the turnover figures. Furthermore, evidence relating to the size of the EU and UK markets for the goods has not been provided making it impossible to determine the opponent's share of the same. Even without this evidence, it is my impression that the market for nutritional dietary supplements is large, both in the EU and the UK. Overall, and without any evidence to the contrary, I consider the turnover figures to be modest in the context of potentially substantial markets. Neither do I have evidence of any advertising expenditure or activities conducted in the UK or EU during the relevant period.

24. From the evidence, I am unable to conclude with any degree of certainty that the opponent has attempted to create or maintain a commercial outlet for its goods in the EU or UK. For instance, although I have screenshots of products bearing the INNATE mark available for sale on various websites, this evidence is undated making it impossible to ascertain whether the products were available to purchase during the relevant period, i.e. 26 May 2016 to 25 May 2021. Even if this evidence was dated within the relevant period, I have no information in relation to the number of people from the UK or EU that viewed the websites, or whether any sales were generated as a result of the goods being available on these websites. There is no documentary evidence, such as invoices, for example, demonstrating that the opponent had UK or EU-based customers during the relevant period. Consequently, in my view, the evidence does not establish that the opponent's mark has been used in relation to goods relied upon within the EU or UK during the relevant period. There is insufficient evidence or information that would enable me to assess the scale and extent of the use of the earlier mark, the territory in which the use has occurred, or how geographically widespread any such use has been. Likewise, there is a lack of evidence to determine whether such use is warranted in the economic sectors concerned to maintain or create a share in the market for the goods protected by the mark.

25. I accept that the genuine use provisions do not exist in order to assess economic success or large-scale commercial use. However, in my view, the evidence provided falls far short of the sufficiency and solidity needed to meet the standard of proof

required. I am not satisfied, on the balance of the evidence, that the opponent has demonstrated genuine use of its mark for the goods registered. Accordingly, the earlier mark may not be relied upon to support the opponent's claim under section 5(2)(b) of the Act. Without establishing genuine use in relation to any goods for which the earlier mark is registered, it follows that the opposition must fail.

Conclusion

26. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal, the contested mark will proceed to registration in the UK for all the applied-for goods and services.

Costs

27. As the applicant has been successful, it is entitled to a contribution towards its Costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the applicant the following as a contribution toward costs:

Considering the opponent's statement and preparing a counterstatement	£200
Considering the opponent's evidence ¹¹	£100
Preparing written submissions	£350
Total	£650

28. Accordingly, I hereby order **FoodState, Inc** to pay **Luca Meise** the sum of **£650**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or

¹¹ The award for this activity falls below the scale minimum. This section of the scale is for a party considering evidence as well as preparing its own evidence. As the applicant did not file any evidence, and only had to consider evidence that fell far below the permitted maximum amount, I consider this sum to be appropriate in the circumstances.

within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of March 2023

Sarah Wallace

For the Registrar