

O/0458/23

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3301964
IN THE NAME OF DR WILLIAM N JOHNSON
FOR THE TRADE MARK**

TETRA-KAP

IN CLASSES 20 & 28

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NUMBER 504571**

BY TETRA LAVAL HOLDINGS & FINANCE S.A.

Background and pleadings

1. On 6 April 2018, Dr William N Johnson filed an application for the trade mark TETRA-KAP (number 3301964) for the following goods:

Class 20: *Closures.*

Class 28: *Toy Bricks.*

2. The application was published on 27 April 2018 and completed its registration procedure on 6 July 2018. On 8 February 2022, Tetra Laval Holdings & Finance S.A. (“the applicant”) filed an application to have the registration declared invalid. The grounds upon which the applicant bases its invalidation application are sections 5(2)(b) and 5(3) (section 47(2)) and section 3(6) (section 47(1)) of the Trade Marks Act 1994 (“the Act”).

3. The applicant relies upon the following five earlier trade mark registrations for its section 5(2)(b) and 5(3) grounds, as follows:

(i) 921965

TETRA PAK

Class 20: Containers or crates, all included in Class 20, for storing and transporting beverages in packages or containers.

Filing date: 4 March 1968; registration date: 12 February 1971.

(ii) 1096761

TETRA PAK

Class 20: Containers and blanks for forming containers, articles made of plastics for use in packaging, all included in Class 20.

Registration of this mark shall give no right to the exclusive use of the letters “PAK”.

Filing date: 8 June 1978; registration date: 20 October 1982.

(iii) 901202522

TETRA PAK

Class 20: Bottle caps and bottle closures (not of metal); drinking straws; transport pallets (not of metal); containers of plastic.

Filing date: 10 June 1999; registration date: 2 October 2000.

(iv) 910982783

TETRA PAK

Class 20: Goods (not included in other classes) of wood, cork, cane and substitutes for all these materials, or of plastics; bottle caps and bottle closures (not of metal); closures, not of metal, for containers; sealing caps; transport pallets (not of metal); containers, not of metal; trays and crates, not of metal.

Filing date: 21 June 2012; registration date: 5 January 2013.¹

(v) 912917795



Class 20: Packages of wood, cork, cane and substitutes for all these materials, or of plastics; bottle caps and bottle closures (not of metal); closures, not of metal, for

¹ The mark is a UK registration derived from a European Trade Mark ("EUTM") as provided for in the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (see Tribunal Practice Notice 2/2020). The EUTM, and therefore this UK 'comparable' mark, benefit from seniority dates derived from earlier UK applications stretching back many years. Two of those applications are marks (i) and (ii) relied upon in these proceedings. Nothing turns upon the seniority dates.

containers; sealing caps; transport pallets (not of metal); bottles and containers, not of metal; trays and crates, not of metal.

Colour claimed: Blue; Red; White.

Filing date: 28 May 2014; registration date: 23 October 2014.

4. Under section 5(2)(b) of the Act, the applicant claims that the parties' goods are identical or similar, and the marks are visually, aurally and conceptually highly similar, leading to a likelihood of confusion.

5. Under section 5(3) of the Act, the applicant claims a reputation in its marks for the registered goods relied upon such that the relevant public will believe that Dr Johnson's goods come from the applicant or an undertaking linked to the applicant, leading to unfair advantage. Further, the applicant claims that the contested mark will 'ride on the coat tails' of the earlier marks, unfairly benefitting from their repute. The applicant also claims that use of the contested mark will erode the distinctiveness of the earlier marks and damage their repute if used in relation to goods of poor quality. I will say more about the section 5(3) pleadings later in this decision.

6. Under section 3(6) of the Act, the applicant claims that Dr Johnson was fully aware of the earlier marks at the date on which the application for the contested registration was filed. Owing to approaches made on more than one occasion by Dr Johnson to the applicant, the latter claims that the application for the contested registration was filed speculatively, with the sole purpose of obtaining financial compensation from the applicant. The applicant claims that Dr Johnson had no intention of using the mark in the UK.

7. Dr Johnson filed a defence and counterstatement, denying the grounds of the application for a declaration of invalidity. He states:

"The defamatory statement made by the opponent that I acted 'dishonestly and in bad faith' is totally without foundation. In an email sent by my lawyer, Mr John

Mcllvaine of Webb Law to Tetra Pak's lawyer (7 April 2021) the following was said:

"We are somewhat disturbed at the inference that we intended to use the Tetra Kap trademark in association with the Tetra Pak organisation and thus 'ride on their coat tails'. This was never our intention from the outset. However we would point out that Tetra is a common word in the English dictionary and is a Greek word describing a four-sided figure. KAP is a commonly used word in industries across the world such as the KAP Motor Company. Our intention was always to approach Tetra Pak from the beginning as we did with our closure technology (TOPO a four-sided closure) going back over many years, with many discussions with various people within the Tetra Pak group. In order to resolve the current situation we would be prepared to GIFT this trademark of Tetra Kap to Tetra Pak by way of a good will gesture, and by doing so re-emphasise that it was never our intention to use it independently of Tetra Pak or to imply any association with their organisation or their clients."

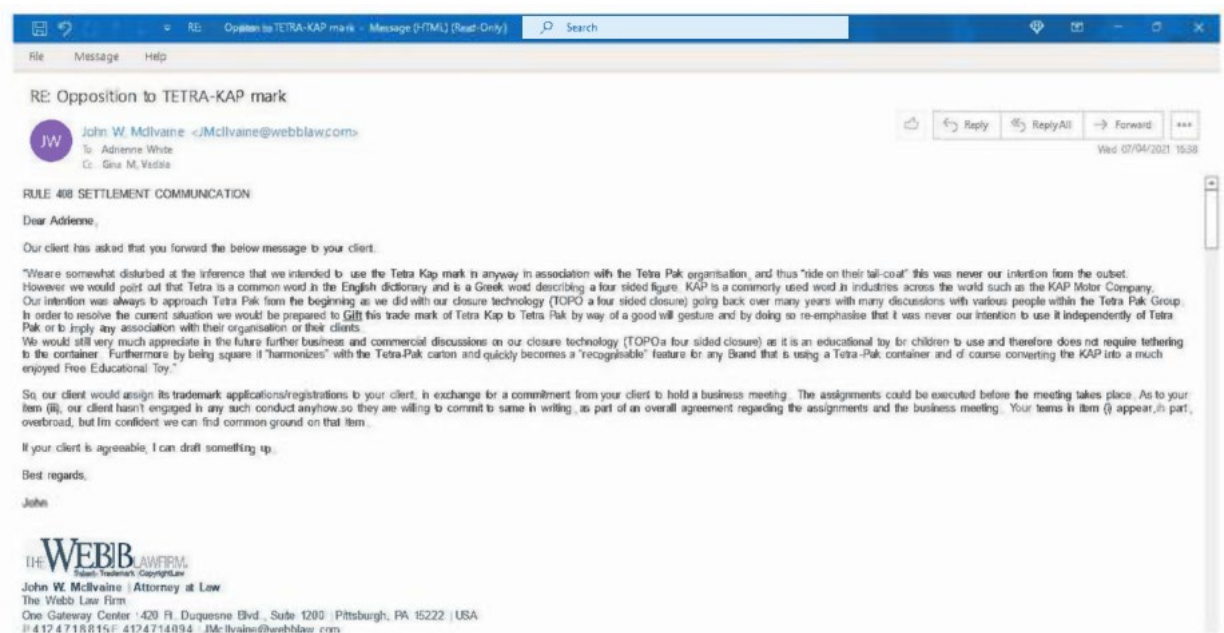
A response to this email was never received. As clearly stated, I have only ever acted with complete transparency to the point that I offered the trademark as a gift for Tetra Pak's exclusive use. To therefore be accused of 'dishonesty' and acting in 'bad faith' is defamatory and deplorable. Full correspondence available on request.

1) The trademarked goods and services are not similar as per the Applicant's claim. My goods relate to a children's toy in the form of a closure which has four-sides, hence the use of the word Tetra which is a common word used by the English language and subsequently in the English dictionary to describe or signify a four-sided figure. This is dissimilar to the Applicant's goods which relate to square cartons. The word 'Kap' is used in many different instances and as far as I can see the Applicant has never used the word Kap in any marketing to date.

2) The only relevance that the Applicant has a reputation for, which might lead the public to believe they are used by the same undertaking is the word Tetra.

I have never approached or offered the trademark Tetra-Kap to any other organisation and I have absolutely no intention to offer it to anyone other than Tetra Pak. How can therefore [sic] be any economic advantage or confusion to the public?

3) We deny that there is any basis for the Applicant's claim of unfair advantage, nor detriment to their reputation or to the distinctive character of the earlier Trademarks. It is critically important at this point to be aware that on 7 April 2021 I, via my solicitor Webb Law contacted the Applicant's solicitors for the sole purpose of offering my trademark Tetra Kap as a good will gift for free to do as they wished for any purpose they may desire. This shows with transparent clarity that I had no intention of taking advantage of their Trademarks nor to "ride on their coat tail". It is obvious that any gift given in good will is not expecting any monetary reward which was made very clear in my email as shown below:



4) Given the clear significance of the above point, it is totally wrong, scurrilous, defamatory and libellous to say the claim of registration was made in bad faith and was therefore dishonest. Of course, I was fully aware of the Applicant's Trademark but I had the right to proceed with the registration as the Trademark concerned a toy closure which is an entirely new innovation. The fact that it was offered to the Applicant as a good will gesture, for free with the only request to

have a meeting was clearly very honest, it was done with good will and good intent. The Applicant submit that I have no intention to use the Trademark for all the goods applied for – of course I had the intention of using it, that was my reason for approaching Tetra Pak indeed to use it. Can there be any clearer intention of wishing it to be used than that? On April 7 by offering the free use of the Trademark Tetra Kap, there was no intention of financial gain. It is worth noting that, I have never received a response to the email of 7 April.”

8. The applicant is not put to proof of use of the earlier marks which are potentially subject to proof of use under section 6A of the Act as a result of having been registered for five years or more at the date on which the contested registration was filed (except for earlier mark (v)), and at the date on which the invalidity application was filed (all of them). The applicant expressly ticked ‘no’ on Form TM8, the defence and counterstatement, to the question as to whether the applicant was required to submit proof of use. Since no request for proof of use has been made, the applicant may rely upon all the goods of its earlier marks as identified in its pleadings.

9. The applicant is represented by Womble Bond Dickinson (UK) LLP and Dr Johnson represents himself. Both parties filed evidence. The applicant’s evidence was accompanied by written submissions. Neither party requested a hearing, but both filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers, referring to them as necessary.

Evidence

10. The applicant has filed two witness statements from Denis Shamo, the second being evidence in reply to Dr Johnson’s evidence.² Mr Shamo is the applicant’s Director of Trademarks and the purpose of his first witness statement is to show what he refers to as “the applicant’s dealings with the registrant”, and the applicant’s use of its marks. Dr Johnson’s evidence is aimed at rebutting the section 3(6) ground and to

² Mr Shamo’s witness statements are dated 13 June 2022, with exhibits, and 14 November 2022.

show what contact had taken place between the parties, or people he believes to be connected to the applicant.³

Section 5(2)(b) of the Act

11. Section 47(2)(a) of the Act states:

“47. (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

12. Section 5(2)(b) states:

“5. (2) A trade mark shall not be registered if because –

(a) ...

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

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

13. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

³ Witness statement and exhibits dated 11 July 2022, amended on 16 September 2022.

trade mark is applied for, the application is to be refused in relation to those goods and services only.”⁴

14. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act 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.⁵

The principles

(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;

⁴ This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

⁵ 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(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

15. The applicant submits that goods made of plastic, covered by earlier mark (iv), includes the contested toy bricks. Earlier mark (iv) provides the widest specification coverage and appears to represent the applicant's best case. I will come back to the other earlier marks if necessary.

The applicant's goods	The contested goods
(iv) 910982783 Class 20: <i>Goods (not included in other classes) of wood, cork, cane and substitutes for all these materials, or of plastics; bottle caps and bottle closures (not of metal); closures, not of metal, for containers; sealing caps; transport pallets (not of metal); containers, not of metal; trays and crates, not of metal.</i>	Class 20: <i>Closures</i> Class 28: <i>Toy Bricks</i>

16. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa).⁶ *Closures* in the contested registration are identical on this basis because the term covers the earlier mark's "bottle closures" and "closures, not of metal, for containers". *Closures* are also identical to the earlier mark's "Goods (not included in other classes) of wood, cork, cane and substitutes for all these materials, or of plastics" because the latter encompasses *closures*.

17. *Toy Bricks* are not identical to the applicant's goods, requiring an assessment to be made as to whether the respective goods are similar and, if they are, how similar. In comparing the respective specifications, all relevant factors should be considered,

⁶ *Gérard Meric v OHIM*, Case T-33/05, General Court of the European Union.

as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* 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.”

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

19. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court of the European Union (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”⁷

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should

⁷ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. Paragraph 16.3 of the applicant's statement of grounds says:

"The goods in class 28 covered by the Registration are similar to those in class 20 covered by the Earlier Rights. The class 28 goods have some points of connection with the Applicant's goods. For example, the goods "Goods (not included in other classes) of wood, cork, cane and substitutes for all these materials, or of plastics" could include "Toy Bricks". Considering the various materials of the Applicant's goods and the varying types of "Toy Bricks", the goods are similar. These goods can be made of the same materials and coincide in distribution channels and sales outlets."

22. The Nice Classification explanatory notes for class 20 state:⁸

"Class 20 includes mainly furniture and parts therefor, as well as certain goods made of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastic.

This Class includes, in particular:

- metal furniture, furniture for camping, gun racks, newspaper display stands;
- indoor window blinds and shades;
- bedding, for example, mattresses, bed bases, pillows;
- looking glasses, furniture and toilet mirrors;

⁸ *World Intellectual Property Organisation*, Nice Classification of Goods and Services, version 12-2023.

- registration plates, not of metal, for example, bolts, screws, dowels, furniture casters, collars for fastening pipes;
- letter boxes, not of metal or masonry;
- certain dispensing apparatus, not of metal, automatic or non-automatic, for example, towel dispensers, queue ticket dispensers, dispensers for dog waste bags, toilet paper dispensers.

This Class does not include, in particular:

- special furniture for laboratories (Cl. 9) or for medical use (Cl. 10);
- outdoor blinds of metal (Cl. 6), not of metal and not of textile (Cl. 19), of textile (Cl. 22);
- bed linen, eiderdowns and sleeping bags (Cl. 24);
- certain dispensing apparatus that are classified according to their function or purpose, for example, fluid dispensing machines for industrial use (Cl. 7), ticket dispensing terminals, electronic (Cl. 9), dosage dispensers for medical use (Cl. 10), adhesive tape dispensers (Cl. 16);
- certain mirrors for specific uses, for example, mirrors used in optical goods (Cl. 9), mirrors used in surgery or dentistry (Cl. 10), rearview mirrors (Cl. 12), sighting mirrors for guns (Cl. 13);
- certain goods made of wood, cork, reed, cane, wicker, horn, bone, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastic, that are classified according to their function or purpose, for example, beads for making jewellery (Cl. 14), wooden floor boards (Cl. 19), baskets for domestic use (Cl. 21), plastic cups (Cl. 21), reed mats (Cl. 27)."

23. *Toy Bricks* fall in class 28. The explanatory notes for class 28 state:

"Class 28 includes mainly toys, apparatus for playing games, sports equipment, amusement and novelty items, as well as certain articles for Christmas trees.

This Class includes, in particular:

- amusement and game apparatus, including controllers therefor;

- novelty toys for playing jokes and for parties, for example, carnival masks, paper party hats, confetti, party poppers and Christmas crackers;
- hunting and fishing tackle, for example, fishing rods, landing nets for anglers, decoys, hunting game calls;
- equipment for various sports and games.

This Class does not include, in particular:

- Christmas tree candles (Cl. 4), electric lights for Christmas trees (Cl. 11), confectionery and chocolate decorations for Christmas trees (Cl. 30);
- diving equipment (Cl. 9);
- sex toys and love dolls (Cl. 10);
- clothing for gymnastics and sports (Cl. 25);
- certain gymnastic and sporting articles, for example, protective helmets, goggles and mouthguards for sports (Cl. 9), sporting firearms (Cl. 13), gymnasium mats (Cl. 27), as well as certain fishing and hunting equipment, for example, hunting knives, harpoons (Cl. 8), hunting firearms (Cl. 13), fishing nets (Cl. 22), that are classified according to other functions or purposes.”

24. Of relevance is the last part of the explanatory notes for class 20, which states that class 20 does not include (my underlining):

“certain goods made of wood, cork, reed, cane, wicker, horn, bone, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastic, that are classified according to their function or purpose, for example, beads for making jewellery (Cl. 14), wooden floor boards (Cl. 19), baskets for domestic use (Cl. 21), plastic cups (Cl. 21), reed mats (Cl. 27).

25. *Toy Bricks* fall within class 28 because all toys fall in class 28. The purpose of toy bricks is that they are played with. They would not fall in class 20, even if made out of plastic or any of the other materials covered by the earlier mark’s specification, because they have a specific function or purpose as toys, which means they fall into class 28. The term in the earlier mark’s specification specifically states “not included in other classes”. Although the applicant starts paragraph 16.3 by saying the goods

are similar, it then proceeds to claim that its goods “could include” toy bricks. This is a submission that the goods are identical on the *Meric* principle. They are clearly not.

26. The applicant’s claim that the goods are similar is predicated on toy bricks being made from “wood, cork, cane and substitutes for all these materials, or of plastics”, goods covered by the earlier mark (but not included in other classes) so that the goods “can coincide in distribution channels and sales outlets” and:⁹

“There is a close connection between the goods in class 28 and those covered in class 20, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those goods lies with the same undertaking. Although the nature, purpose and method of use of these goods and the goods in class 28 are not the same, they are similar because they are complementary, and the goods in class 28 would likely be contained in the goods in class 20 and are generally provided in the same places where the goods are offered for sale and sold. Furthermore, they target the same / similar public.”

27. On this basis, the applicant’s goods would be similar to anything made out of wood, cork, cane and substitutes for all these materials, or of plastics: a vast amount of products. I do not accept this. The submission about distribution channels and sales outlets is of too high a level of generality. All sorts of things can be sold in supermarkets, but that does not make them all similar. The goods of the earlier mark are not similar to *Toy Bricks*. There are also no goods in the specifications of the other earlier marks which are similar to *Toy Bricks*.

The average consumer and the purchasing process

28. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the parties’ goods and services and how they purchase them.

⁹ Written submissions filed 13 June 2022, paragraphs 4.31 and 4.32.

“Average consumer” in the context of trade mark law means the “typical consumer.”¹⁰ The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

29. The applicant submits that the average consumer is the general public as well as business or retail customers with specific professional knowledge or expertise in the packaging sector. I consider that the average consumer for the parties' goods which are similar; i.e. closures, is much more likely to be businesses, looking for suitable closures for containers which they either sell *per se* or which they fill to sell the contents of the containers. The purchaser will need to ensure requirements as to costs, availability, suitability and appearance are met. This will entail a relatively high degree of attention to the purchase. Closures will be purchased primarily visually, but I do not discount an aural element; for example, if advice is sought from a manufacturer or retailer.

Comparison of marks

30. The marks to be compared are:

Earlier mark (iv)	Contested mark
TETRA PAK	TETRA-KAP

31. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the

¹⁰ *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).

marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

32. 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 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.

33. The earlier mark comprises two components. For packaging-related goods, the second component has less distinctive weight than TETRA in the overall impression. The same is true of the contested mark, in relation to closures, although it has more distinctiveness for toys than for closures. In both parties' marks, TETRA is the longer element and is at the front of the mark, so is the more dominant element in the overall impression. The hyphen in the contested mark adds little to the overall impression.

34. The marks both comprise two components, the first of which is identical: TETRA. It is this element which will be read first. The second element in both marks is three letters long. The letters are the same, and the A is central to both. The visual differences between the marks arise a) from the P and K being at the beginning and end of PAK, whilst they are the other way around in KAP; and b) the hyphen between TETRA and KAP in the contested mark. The marks are visually highly similar.

35. Both marks comprise three syllables. The first two sound identical because the first (two-syllable) element is identical. The third syllable has an identical short A vowel sound. The aural difference arises from the P and K being the other way around in the third syllable of the contested mark. However, the same consonant sounds are present (a P and a K). The marks are aurally highly similar.

36. In the context of the class 20 goods, PAK is strongly evocative of 'pack', meaning (as a noun) "bundle, package or packet". As a verb, it means to "make or form into a pack". KAP is strongly evocative of 'cap', meaning as a noun "a cover or case".¹¹

The applicant has not submitted that TETRA means anything. Dr Johnson submits that it is a common word in the English dictionary and is a Greek word describing a four-sided figure.

37. The second components of the marks have degree of conceptual similarity because they both evoke packaging. If the average consumer would attribute to TETRA the meaning which Dr Johnson has given, the marks are conceptually similar to a medium to high degree. If TETRA would be seen as an invented word, the marks have a low degree of conceptual similarity, based upon the evocation of packaging in the second element, but no conceptual similarity arising from the first element.

Distinctive character of the earlier mark

38. 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.¹² I will begin by considering the inherent distinctive character of the earlier mark before looking at the use that the applicant has made of its mark.

39. PAK is a banal way of misspelling 'pack', which is meaningful for containers and closures which are packaging. I find that if TETRA is seen as meaning a four-sided figure, and therefore has some allusiveness to containers with four sides, the mark is inherently distinctive to no more than a medium degree. However, I consider that a significant number of average consumers will not know of that meaning and will see TETRA as an invented word. For them, the mark is inherently distinctive to a reasonably high degree.

¹¹ Online *Oxford English Dictionary*.

¹² *Sabel BV v Puma AG*, Case C-251/95.

40. Distinctive character is a measure of how strongly an earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

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

41. Only UK use is relevant because the assessment of a likelihood of confusion, and whether enhanced distinctive character is a factor in that assessment, is from the perspective of the average consumer in the UK. The relevant date for the purposes of assessing whether the distinctive character of the earlier mark(s) had been enhanced is the date on which the contested mark was filed: 6 April 2018.

42. Mr Shamo’s first witness statement explains the applicant’s group structure. He states that the applicant’s UK business is undertaken by Tetra Pak Limited and Tetra Pak Processing UK Limited. Mr Shamo explains that the applicant’s business is focused on technologies for the efficient production, packaging and distribution of food. Exhibit DS5 comprises internet archive copies from the Wayback Machine showing the word only and the composite earlier marks in use on tetrapack.com between 1998 and 2018. Mr Shamo explains that the domain name tetrapack.co.uk links to the localised UK page for the UK in respect of the main website (tetrapack.com/en-gb). The applicant has a substantial following on Facebook, Twitter, Instagram and

LinkedIn, but the figures are not apportioned by country and there is nothing to show that they pre-date the relevant date.¹³

43. Some of the applicant's evidence of media and marketing exposure is not well-focussed on the goods it relies upon, for the marks it relies upon. Exhibit DS7 shows examples of the applicant's traditional business-to-business ("B2B") advertising. Two collages of food industry press reports are included for 2016, but are too small to see much of the detail. The headlines in the first collage indicate that the reports are about healthy drinks, not packaging. That year there was also a "Future of Healthy Drinks Campaign", during which the applicant met with various stakeholders (such as industry groups, nutritionists, retailers and UK government departments). The second collage does appear to relate to packaging, and again is almost impossible to read, but I can see references to "Tetra Recart".

44. The evidence for 2017 includes a press article from the *Mirror* which reports that Tetra Pak did a survey about school children drinking milk. There is no explanation as to what or who Tetra Pak is, and the article is about the benefits of milk. However, an article in *The Grocer*, about the same survey, does introduce Tetra Pak as a packaging firm and an event in Westminster for MPs was about the applicant's packaging and sustainability. This resulted in various MPs tweeting about the applicant and its packaging to their thousands of followers. In 2019, there was press coverage about the applicant's commitment to sustainable packaging in various industry publications, as well as *The Guardian*, but this is the year after the relevant date. There is a substantial amount of evidence for 2020, 2021 and 2022, but the relevant date is 6 April 2018. I note a corporate newsletter was produced in 2009/2010, but there is no information about the level of circulation, and this is quite some time prior to the relevant date. Exhibit DS8 comprises examples of the applicant's "recent" direct business-to-consumer ("B2C") advertising and marketing. Mr Shamo states:

"Historically, the Tetra Pak Group has advertised mostly to the industry (e.g. food producers, retailers, and co-packers), and has done less direct outreach

¹³ Exhibit DS6.

to food consumers about the virtues of buying products in a Tetra Pak package. However, this type of outreach has increased in recent years with the various B2C campaigns. Food producers and retailers, who are the Applicant's trade mark sublicensees, promote the Applicant's packages to end users."

45. Mr Shamo states that B2C outreach has increased in recent years, and the evidence reflects that: it dates from 2020, not from prior to the relevant date. The evidence relating to Facebook animations is all undated. In relation to Facebook static advertisements, I can see that one dates from 24 December 2018 ("Static 1"), with 1,702,210 impressions and 72,520 link clicks. However, this is after the relevant date.

46. Mr Shamo states that because the applicant is not publicly traded, country-level turnover and sales information is highly confidential. There are no figures for the UK. The applicant could have provided UK figures with a request for confidentiality, but did not. Consequently, the "more than 3.22 billion Euro" turnover for Europe and Central Asia, a vast area, in 2017 (the year prior to the relevant date) tells me nothing about turnover in the UK. I note that in Exhibit DS1, at page 24, the UK does not feature in the top 10 countries for customers of the applicant in 2013, which were China, Brazil, USA, Russia, Mexico, Thailand, Japan, Spain, Pakistan and Vietnam. I cannot make inferences from the figures provided.

47. Mr Shamo states that Tetra Pak:

"... has been part of the UK market for nearly seven decades". Frankly, the Tetra Pak Group has not retained full records of all third party recognition (e.g. media and press coverage) covering this period...."

48. As will be clear from my comments above, the evidence could have been better marshalled in respect of what it needs to prove in this case.¹⁴ The details of awards given to the applicant for its packaging date from 2022, four years after the relevant

¹⁴ See the analogous points made by Mr Daniel Alexander QC, sitting as the Appointed Person, in *Gerry Weber International AG v Guccio Gucci SPA* BL O/424/14.

date.¹⁵ Exhibit DS10 comprises records of third-party recognition. Those that clearly pre-date 6 April 2018 include:

- an article on bakeryandsnacks.com dated 20 May 2002 about the applicant's expansion into the market for food containers;
- an article on beveragedaily.com dated 2 September 2013 about applicant recycling its cartons;
- an article in *Food & Drink Business Europe* dated 6 February 2013 about the applicant's Tetra Prisma carton with DreamCap for a breakfast drink, in 500 Asda and 750 Tesco stores;
- an article in *Retail Times* dated 7 June 2013 regarding the applicant's research into flavoured milk consumption;
- an article in *Retail Times* dated 20 September 2013 about the applicant's cartons being used by a third party for portion sized children's milkshakes;
- an article in *Retail Times* dated 4 April 2017 about the applicant's smaller size packs for beverages on-the-go;
- a headline in *Retail Times* dated 16 June 2013 about Marks & Spencer launching long life milk in Tetra Pak cartons;

49. The evidence which the applicant has filed does not prove that at the relevant date, 6 April 2018, the inherent distinctiveness of the earlier mark(s) in the UK had been enhanced for the goods relied upon in these proceedings. There is not enough evidence which is dated prior to the relevant date to make such a finding. If I had found enhanced distinctive character in relation to containers, I would also make a finding about the similarity between containers and the contested *closures*. However, given the evidence does not prove enhanced distinctive character, this is unnecessary and, in any event, does not improve upon the applicant's case based on the identical goods in class 20.

¹⁵ Exhibit DS9.

Likelihood of confusion

50. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the parties' goods are either identical or not similar. If goods are not similar, there can be no likelihood of confusion, *per Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*¹⁶ The section 5(2)(b) ground of opposition fails in respect of:

Toy Bricks

51. In respect of the contested goods in class 20, I find that there is a likelihood of confusion. The most likely type of confusion is direct confusion, which occurs when marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind.¹⁷ The marks are highly similar visually and aurally. They are either similar conceptually to a medium to high degree or to a low degree. Furthermore, although PAK and KAP have their own, distinct meanings, they are both constituent parts of packaging. For identical goods, for which these elements are allusive, there is a strong likelihood that they will be imperfectly recalled, especially when it is considered that TETRA, for at least a significant part of average consumers, is inherently distinctive to a reasonably high degree. Even if consumers know that it refers to a four-sided figure, both marks contain this word at the beginning with a similar looking and sounding allusive second component. A relatively higher level of attention paid by businesses

¹⁶ "22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

¹⁷ *Lloyd Schuhfabrik Meyer*, at [26].

buying the parties' closures will not remove the likelihood that the marks will be mistaken for one another.¹⁸

52. A likelihood of direct confusion is my primary finding. However, in case I am wrong about that, I will consider whether there is also a likelihood of confusion based upon the average consumer believing that the similarities between the marks, even though the differences are recognised, means that the marks are used by the same or economically linked undertakings. This type of confusion is known as indirect confusion and was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

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

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

¹⁸ *Apple Computer, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) GC*, Case T-328/05.

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).”

53. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.¹⁹ Arnold LJ said, of the explanation given in *LA Sugar* about how indirect confusion arises:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

54. The contested mark contains the same dominant first element followed by an allusive or descriptive second element, which is the same pattern as for the earlier mark. The assumption will be that the parties’ marks are brand variants, brand updates or indicate expansions to what goods are offered. The changed second component of the mark may be seen as an expansion through licensing, for example. There is a likelihood of confusion, of both the direct and indirect types.

¹⁹ [2021] EWCA Civ 1207

Section 5(2)(b) outcome

55. The section 5(2)(b) ground of opposition fails in respect of *Toy Bricks*.

56. The section 5(2)(b) ground of opposition succeeds in respect of *Closures*.

Section 5(3) of the Act

57. 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”.

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

58. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

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

59. For a successful claim under section 5(3), cumulative conditions must be satisfied by the applicant: similarity between the marks; a qualifying reputation in the earlier mark(s); a link between the marks (the earlier mark(s) will be brought to mind on seeing the later mark); and one (or more) of the claimed types of damage. It is not necessary that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks.

60. Approaching the matter from an assessment against earlier mark (iv), the first condition of similarity between the marks is satisfied, as found earlier in this decision.

61. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*:

“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.”

62. As the earlier trade mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union”.

63. In its statement of case filed with its application for a declaration of invalidity, the applicant stated that the fact that the applicant own well-established rights in a ‘family’ of TETRA marks increases the likelihood of confusion. It was not necessary to consider this in relation to section 5(2)(b) as that ground succeeds in relation to the goods which are identical and would have failed for the goods which are not similar even if there was a family of marks. The applicant also relies on its ‘family’ of marks in the section of its statement of case relating to section 5(3) of the Act. Four marks are set out which are not specified in the statutory form TM26(1), the application for a declaration of invalidity:

1096758 TETRA BRIK (class 20)

901910504 TETRA RECARTE (class 20)

1096768 TETRA REX (class 20)

904193389 TETRA WEDGE (class 20)

64. Reputation is a knowledge threshold, as set out in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at paragraph 69:

“(6) Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria.”

65. As set out in the leading caselaw on a ‘family’ of trade marks, *Il Ponte Finanziaria SpA v OHIM (“Bainbridge”)*, Case C-234/06 P, for the relevant public to perceive a family of marks on the basis of a common element, the earlier marks which form the family of marks must be present on the market. This must be proven in evidence: it is

not enough that they appear on a trade mark register. The only one of these marks which appears in the evidence prior to the relevant date is TETRA RECART, in the second press clippings collage dating from 2016. The family of marks claim does not take the applicant any further forward.

66. The evidence shortcomings set out earlier in this decision also apply to the reputation hurdle for section 5(3). However, for mark iv) for this ground, turnover from the EU can be taken into account. The combined turnover figures are for the EU and Central Asia. The figures are not particularised. That said, I think it is reasonable to infer that the large 2017 figure of “more than 3.22 billion Euro” turnover for Europe and Central Asia must mean that a sufficient proportion relates to the EU. Consequently, I will consider the ground.

67. The applicant’s evidence relates to packaging, chiefly containers for drinks, rather than closures. However, although the goods are not identical (and they do not have to be identical or similar for this ground), they are complementary because containers, especially those which contain liquid, require closures and there would be no function for a closure without something to close. The applicant has a reputation in the EU by inference from the scale of the EU and Central Asia figures. However, without particularisation, it is not possible to say what the level of reputation was at the relevant date in the UK. Despite a qualifying reputation in the EU, the lack of UK evidence means that I am reluctant to find that the relevant public in the UK would have made a link in respect of the contested *closures* prior to the relevant date. Clearly, however, the applicant has succeeded against *closures* under section 5(2)(b) of the Act, so even if there was a link for the UK relevant public, the result would have been the same: a link causing the relevant public to believe that the goods emanate from the same or an economically linked undertaking, causing unfair advantage by reason of confusion.

68. As found earlier, *Toy Bricks* are not similar to closures. They are also not similar to containers and packaging. Although it is not necessary for goods to be similar under section 5(3) of the Act, it is not irrelevant either in considering whether a link will be made between the marks. The relative distance between the goods is important. There is a huge distance between *Toy Bricks* and packaging. If an earlier mark has strong reputation, the more immediate and corresponding the strength of a link will be.

Any reputation the earlier mark has is for business consumers, not the general public, which is the relevant public for *Toy Bricks*. It is certainly not a case where the evidence shows that the earlier mark has acquired such a strong reputation that it goes beyond the relevant public for the earlier goods.²⁰ Without particularisation as to what the level of UK turnover is, I cannot find that the distance would be bridged by reputation and a link made between the earlier goods and *Toy Bricks*. The applicant's other earlier marks do not put it in any better a position. The ground fails against all the contested goods.

Section 5(3) outcome

69. The section 5(3) ground fails.

Section 5(4)(a)

70. 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.”

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

²⁰ *You-Q BV v Apple Corps Ltd*, C-294/12 P, CJEU.

“(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.”

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

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

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

73. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“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.”

74. In a case where the contested mark is unused, it is the date when the application was made for the contested mark (in this case, 6 April 2018) which is the relevant date

for the purposes of section 5(4)(a) of the Act. However, if the contested mark has been used prior to the date of application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. If an applicant for registration was not passing off when it commenced use of the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the application date.²¹ Dr Johnson has not filed evidence that he has used his mark, which means that the relevant date is 6 April 2018. The applicant must show that it had sufficient goodwill at that date to bring the claim. I consider that it has shown evidence of a goodwill in relation to containers at the relevant date. However, as for the considerations earlier in this decision, the evidence has shortcomings which mean that I am unable to find that the level of goodwill was anything other than modest at the relevant date.

75. This means that the section 5(4)(a) ground takes the applicant no further forward than the section 5(2)(b) ground. It succeeds in relation to *closures* because these goods are complementary to containers. However, the distance between the field of the applicant's activity and *toy bricks* is too great to cause misrepresentation on the basis of what has been shown in the evidence in respect of trade in the UK prior to the relevant date. Although it is possible in some circumstances to bridge such a distance, the evidence must support reasons as to why misrepresentation will occur, despite the distance between the goods. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman*

²¹ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander KC, sitting as the Appointed Person.

Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd. (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

76. In the *Lego* case, referred to in the citation above, it was still relevant that the goods were far apart (plastic construction toy kits v. plastic garden sprinklers), despite LEGO being a household name.²² In the present case, if TETRA PAK was a

²² *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] F.S.R. 155.

household name at the relevant date, the evidence does not show it to have been so. The section 5(4)(a) ground succeeds in relation to *closures* but fails in respect of *toy bricks*.

Section 5(4)(a) outcome

77. The section 5(4)(a) ground succeeds in relation to *closures* but fails in respect of *toy bricks*.

Section 3(6)

78. Section 3(6) of the Act states:

“(6) A trademark shall not be registered if or to the extent that the application is made in bad faith.”

79. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from, *inter alia*, *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, and *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11. The relevant parts of the court’s summary are as follows:

“1. -

2. -

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the

consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].”

79. It is necessary to ascertain what an applicant for registration knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal: [2010] RPC 16).

80. Mr Shamo exhibits correspondence between the parties from between 19 October 2020 to 10 January 2022, which post-dates the relevant date.²³ Mr Shamo points out that the correspondence shows that Dr Johnson approached the applicant about working together prior to this set of correspondence. Both parties have filed evidence about their contact with each other, so I consider that if the evidential content would have been covered by the without prejudice rule, privilege has nevertheless been waived by both parties.

81. I note the following email from Dr Johnson, dated 19 October 2020, to the applicant. The ‘purpose of contact’ was given as “Packaging”. The email said (verbatim):

“On April 6th 2018 we successfully applied for Trade Mark Tetra- Kap, REg. No,UK3301964. In September 2019 at the Plastic Industries Award Ceremony in London William J Inventions Ltd was Awarded "Best Consumer Design Product of the Year for it's Closure Design For liquid holding containers. Would, with the new completely recyclable Tetra- Pak container, be further enhanced by having as it's own unique Patented and Registered Trade Mark Recyclable Closure bringing with it a totally Distinctive unmissable THE TETRA-KAP(Reg.) To see the many other distinct advantages that the TETRA-KAP would bring

²³ Exhibit DS3.

please go to the Website www.willyjohnson.com. We would be pleased to discuss any aspect of further interest that you might have at this time. This is not the first time we have approached you but not with such an update as to what we have now achieved. With my best wishes and congratulations on your great achievement concerning recycling, Yours sincerely, Dr. Willy Johnson.”

82. Mr Shamo states that the applicant received a further email from Dr Johnson on 6 December 2021, which was in response to an email from the applicant. The applicant’s email said:

“Dear Dr Johnson,

I understand you have addressed Mr Jörn Rausing regarding your new ideas, may I kindly ask you do direct any questions you might have to me instead. This is to allow that the right people in our organisation who are there to evaluate new ideas get copies. If I am not mistaken, I thought that we several years ago looked in to some of your invention and couldn’t at the time find a fit to our portfolio. If you now have something new to share, please send me a short description of what you have invented and I will be happy to ask someone to review the potential usefulness to us.

Kind regards

Jörgen Haglind”

83. Dr Johnson’s email said:

“Dear Mr Haglind,

Indeed you are right, we have shared previous emails and sadly, after an extensive go between some years back, Tetra Pak decided that ToPo® was of no interest to them at that time.

However I have never given up on the concept that the screw top closure could have a very important “Secondary Use” as a functional item which would appeal both to family use in many different ways but in particular help in the field of early learning. However most importantly to the Environment.

I discovered “Newness” one day when I realised that PAK inverted was KAP which was a superb name for a four sided ToPo® and so Tetra-Kap was born and registered with the UK Trade Mark Office on April 6th 2018 and granted.

At the same time the problem of plastic destroying the environment was becoming more than acute and I realised that by converting a plastic screw-top closure from a “single use” item into a truly collectable and desirable one was a gift to Sustainability.

The continuing search by Tetra Pak for “Sustainability, Go Nature, Go Carton” encouraged me to try once more to approach you.

In short the idea of Tetra Pak having it’s own unique closure under the Brand name Tetra-Kap® - a Brand that would be offering so much benefit to both the Environment and to the market place – encompassed by your mantra “Sustainability. Go Nature. Go Carton”.

With Tetra Pak and Tetra-Kap there is a perfect harmony leading to Sustainability.

There is so much more that I could say but you asked for “shortness” and I believe I have complied with that request! More can be found on www.willyjohnson.com

Thank you for your quick response and I hope you find this of enough interest to “review the potential usefulness”?

With my best wishes,

Willy Johnson.”

84. Dr Johnson’s witness statement provides a chronology of the contact he has had with the applicant, reproduced here, verbatim:

1986: I, William Johnson met with Mr and Mrs Hans Rausing and his brother Gad of Tetra Laval at the former's family home, near East Grinstead. In this meeting we discussed how I, as an inventor might be able to contribute to the growth of their business with a new packing idea for eggs. After an excellent lunch and on leaving their home Mr Rausing and his brother invited me to always return to them with any ideas relating to packaging. The Egg packaging idea was, however, turned down.

2016: I put forward a design patent for a new type of bottle top closure which turned a plastic screw top into a reusable/collectable toy. There were 2 designs; one circular and the other square (TETRA) in shape. Given the good standing I had with the Rausing's, I approached Tetra Laval as an obvious candidate. We were in correspondence for a considerable duration of time. They eventually decided they were not interested in taking up the patented designs for the new invention.

2018: The trademark Tetra Kap was filed and approved in the UK – there was no opposition.

At the time I thought of the wording Tetra-Kap, I obviously realised that with the spelling 'Kap' inverted from 'Pak' this could be of enormous interest to Tetra Pak. From this point it was my sole purpose to only offer the trademark and device to Tetra Pak for their exclusive use. There was never any intention from the outset to 'piggy back' on their product success nor 'hang on to their tail coat' – I am an inventor NOT a manufacturer and I have not made a penny from this invention to date nor have I approached any other company other than Tetra Pak for the use of the trademark.

2019: The Plastics Industry awarded my designs for the bottle top closure 'The Consumer Product Design of the Year'. (See exhibit 1) I then submitted a trademark application for Tetra-Kap in the USA.

October 2020: I was discharged from St Thomas's Hospital having been admitted to Intensive Care on the 8 September suffering from a heart attack. Having died for 4 minutes I was given a triple heart by-pass. If there was any

delay in correspondence during this time and during my recovery time long into 2021 resulting in Tetra Pak thinking I was not co-operating with their requests, it was simply due to this and my total inability to work and the fact I was bed ridden recovering.

December 2020: Tetra Pak refused the USA application and requested it be withdrawn.

January 2021: My wife died of Covid-19. Still being unfit to work from my heart attack, I was now completely emotionally unable to work also.

March 2021: Now feeling in a fit state to resume work, I immediately set into motion the withdrawal of the Tetra Kap application with the USA trademark office as per Tetra Pak's request which finally went through on the 19 April (see Notice of Abandonment exhibit 2).

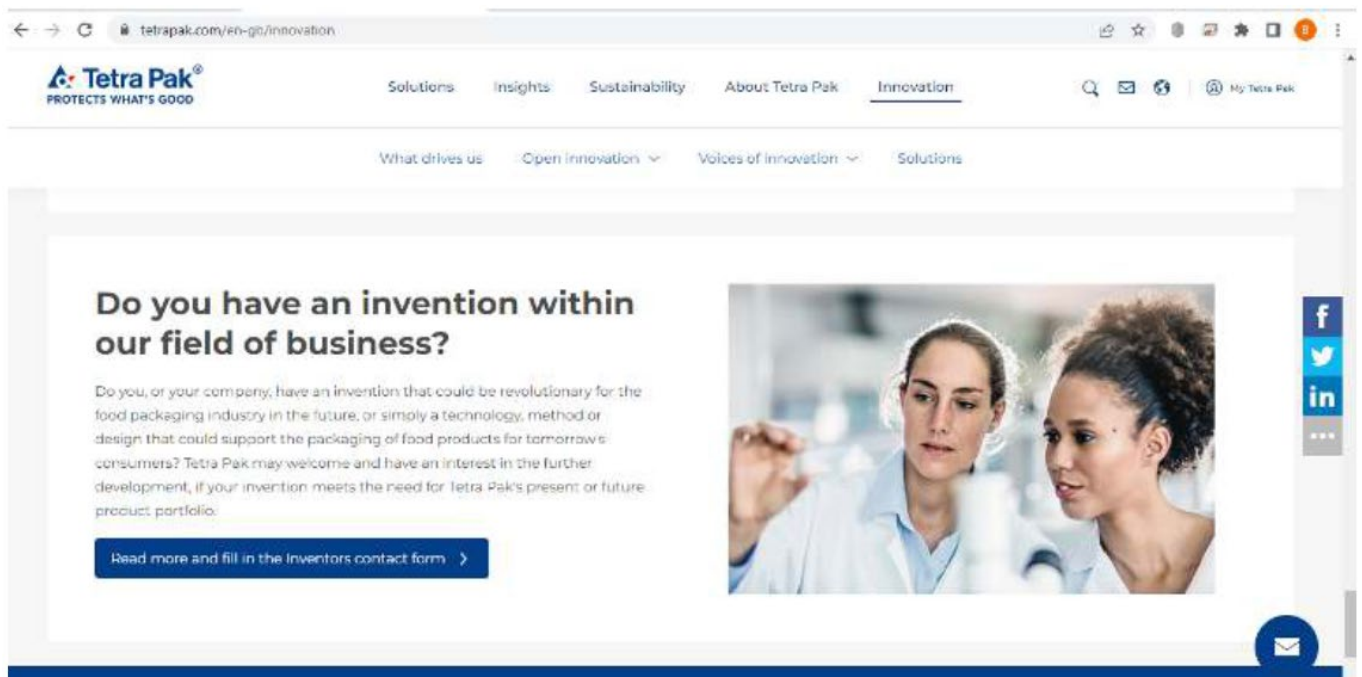
7 April 2021: Having withdrawn the USA trademark, I approached Tetra Pak via my solicitors to offer them and only them the offer of the UK trademark as a gift – for free. My solicitor to date has never received a response to this.

30 April 2021: After my offer of a free gift to Tetra Laval (and them only) - I personally received notification that I was being taken to the tribunal.

November-December 2021: With the knowledge that I am being taken to a tribunal, in one last ditch attempt to show that my intentions in trademarking Tetra-Kap was only ever for the use of Tetra-Pak, I directly approached Mr Jorn Rausing head of the company. In line with their website (see exhibit 3) which declares they are open to considering innovation from outside their business – I wrote an email introducing myself and alerting him of my previous endeavours to offer Tetra-Kap as a free gift for the sole use of Tetra-Pak. The matter was passed on from Mr Jorn Rausing to Mr Jorgen Haglind who welcomed me to share further information with him.

Closing statement: I have only ever acted with good intentions and in good faith, I was recently awarded Marquis’s Albert Nelson Lifetime Achievement Award – for my 60 year contribution in the field of invention. I am 83 years old, not only did I recently lose my wife to Covid but I have also been extremely ill (triple heart by-pass). The way that the opposition have handled this case since April 2021 – submitting their statements and accusations on the very last day of the deadline to keep me guessing is clearly an attempt to cause as much stress to me as possible. Their accusations of ‘acting in bad faith’ and ‘dishonestly’ are in my opinion, libellous and defamatory. I would like to re-iterate that the only company I have ever approached is Tetra Pak for the use of Tetra Kap and as clear as day, I offered it as a FREE GIFT – the only thing I asked for in return was a meeting.”

Exhibit 3 consists of the following screen shot:



85. The applicant filed reply evidence. Mr Shamo states that Mr Johnson did not voluntarily withdraw his US trade mark application: the application was deemed withdrawn following a default decision in the present applicant’s opposition, which was successful following a non-response by Dr Johnson. This is shown in Exhibit DS1 to Mr Shamo’s second witness statement, which comprises prints from the database of the US Patent and Trademark Office. Nothing turns upon this evidence.

86. Mr Shamo states that the applicant responded to Mr Johnson with a polite refusal to adopt either the contested mark or the underlying product. It also told Mr Johnson (via each parties' Counsel) that no meeting or business discussion could take place while the trade mark issues in the US and the UK remained unresolved.

87. Dr Johnson considers the claim of bad faith, of dishonesty, to be defamatory. As set out in the caselaw extract above, "dishonesty is to be understood in the context of trade mark law". Dr Johnson is applying his own standards of good faith or bad faith. The caselaw sets out that the test as to what he knew and the actions he then took at the relevant date is an objective one. In *Walton International Ltd v. Verweij Fashion BV* [2018] EWHC 1608 (Ch), Arnold J stated at paragraph 186:

"The tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct was dishonest (or otherwise fell short of the standards of acceptable commercial behaviour) judged by the ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry."²⁴

88. Accordingly, Dr Johnson's own feelings about whether his application for the trade mark was honestly made are irrelevant.

89. In terms of what he knew at the relevant date (the date of application), Dr Johnson knew of the applicant and its mark TETRA PAK before he applied for his trade mark. The clearest indication of this is where he states, as of April 2018:

"At the time I thought of the wording Tetra-Kap, I obviously realised that with the spelling 'Kap' inverted from 'Pak' this could be of enormous interest to Tetra Pak."

²⁴ The judge found that this was an approach consistent with the judgement of the Supreme Court in *Ivey v. Genting Casinos UK Ltd* [2017] UKSC 67.

90. Dr Johnson goes on to say:

“From this point it was my sole purpose to only offer the trademark and device to Tetra Pak for their exclusive use.”

91. A trade mark registration is a trade monopoly. It is an item of property (intellectual property). It is not an altruistic favour which a registrant then offers to a third party which it has already identified as being interested, prior to filing the trade mark application. A trade mark registration is a negative right which can be used to prevent parties with similar marks or signs from using those marks in the course of trade. From a third party's point of view, there is also a danger that the registration may be used in a way which damages its business and reputation, whether by the proprietor or by anyone to whom the registration may later be sold or assigned.

92. The essential function of a trade mark is to guarantee the trade mark as an indication of trade origin for the goods and/or services for which it registered by distinguishing those goods and services from those of other undertakings. Filing a trade mark application in the hope of, or with the aim of, a third party using it without having that party's consent would constitute an abuse of process because the trade mark in question cannot perform such a distinguishing function. A trade mark application filed as an abuse of process is a trade mark application filed in bad faith.

93. The subsequent decision by Dr Johnson, after application, to offer the registration to the applicant as a free gift, does not absolve him of having acted in bad faith at the relevant date. Even if he had already decided, at the relevant date, to offer it as a free gift, this does not avoid a finding that the application was made in bad faith. Firstly, for the reasons set out above, the trade mark application was not filed for the essential purpose of a trade mark. Secondly, it was filed speculatively on the assumption that it would be of 'enormous' interest to the applicant. The third reason that the 'free gift' aspect of the defence does not help Dr Johnson is that a gift is given unconditionally. He states that all he wanted in return was a meeting. The extract from his Counsel's letter, attached to the defence form and counterstatement and set out earlier in this decision, sheds a harsher light on his request than for a simple meeting. The letter said:

“So, our client would assign its trademark applications/registrations to your client, in exchange for a commitment from your client to hold a business meeting.”

94. The ‘gift’ was not unconditional and so was not a gift. Dr Johnson was prepared to assign the mark in exchange for a business meeting. The context is clear from what comes before this ‘offer’: that the ‘TOPO’ closure technology, which converts to a toy, ‘harmonizes’ with the square TETRA PAK carton because it is square. Dr Johnson wanted to secure the applicant’s business for his invention in exchange for the trade mark, whether or not he charged money for assigning the trade mark.

95. It is no defence to point to the applicant’s website where it invites inventors to discuss their ideas with the applicant. It is naïve to think that a company would invite business propositions regarding inventions for which conflicting trade mark applications had already been filed. It is also no defence that the section 5(2)(b) ground failed against *Toy Bricks* for want of similarity according to the parameters of the relevant caselaw. It is clear from Dr Johnson’s evidence and his counterstatement that the closure product he has invented turns into a toy which ‘harmonizes’ with the applicant’s four-sided containers. Finally, it is not a defence that tetra describes a four-sided figure and that “KAP is a commonly used word in industries across the world such as the KAP Motor Company”. This is trade mark use of KAP; the territory in question is the UK, not the world in general, and the consideration is the marks as wholes, not one part of the contested mark. Dr Johnson clearly knew that the mark was similar to the applicant’s mark(s) because he states that he considered it to be of enormous interest to the applicant because KAP was in inversion of PAK.

96. In *Alexander Trade Mark*, Case BL O/036/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“8. The key questions for determination by the Hearing Officer were: (1) what, in concrete terms, was the objective that [the applicant] had been accused of pursuing? (2) was that an objective for the purposes of which the contested

application could not be properly filed? (3) was it established that the contested application was filed in pursuit of that objective?"

97. The applicant has accused Dr Johnson of filing his trade mark application whilst being fully aware of the earlier marks at the date on which the application for the contested registration was filed. It claims that, owing to approaches made on more than one occasion by Dr Johnson to the applicant, the application for the contested registration was filed speculatively, with the sole purpose of obtaining financial compensation from the applicant. The applicant claims that Dr Johnson had no intention of using the mark in the UK. These are, for the reasons given above, an abuse of the trade mark registration system. I consider that the evidence establishes all of the applicant's claims. The financial compensation was the securing of a business opportunity with the applicant, for Dr Johnson's invention, in return for the trade mark registration. This means that Dr Johnson did not intend to use the mark because, as he states in his evidence and in his counterstatement, his intention was for the mark to be used by the applicant. He had no consent from the applicant at the date of application and no reason to believe that the applicant would use the mark. He had no intention to use the mark itself, which means that the mark could not fulfil its essential function.

98. Dr Johnson's intention on 6 April 2018 is a subjective factor which must be judged objectively. Whether he recognised it or not on that date, the evidence shows that the filing of the application departed from accepted standards of honest commercial practices and therefore amounts to a form of commercial dishonesty. The application was filed in bad faith. The section 3(6) ground succeeds.

Section 3(6) outcome

99. The section 3(6) ground succeeds.

Overall outcome

100. The application for a declaration of invalidity succeeds against all the goods of the registration. In accordance with section 47(6) of the Act, registration 3301964 is deemed never to have been made.²⁵

Costs

101. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice 2/2016. I make no award for the applicant's written submissions in lieu of a hearing because they were largely a repeat of the statement of grounds and the submissions made earlier in the proceedings, which are covered in the evidence award. I award costs as follows:

Statutory fee for the invalidity application	£200
Preparing a statement and considering the counterstatement	£400
Preparing evidence, submissions and considering the proprietor's evidence	£900
Total	£1500

²⁵ "(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed."

102. I order Dr William N Johnson to pay to Tetra Laval Holdings & Finance S.A. the sum of **£1500**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of May 2023

Judi Pike

For the Registrar