

O-120-20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3327659

FOR THE FOLLOWING TRADE MARK:

Vitanaturals

IN THE NAME OF RAFAL WOZNIACKI

IN CLASS 3

AND OPPOSITION THERETO UNDER NO. 415276

BY

INSTITUTO NATURVITA, S.L.


Background and pleadings

1. On 27 July 2018 Rafal Wozniacki (“the Applicant”) filed an application to register the trade mark “Vitanaturals” for goods in class 3 namely *cosmetics*. The application was accepted and published on 26 October 2018.

2. Instituto Naturvita, S.L. (“the Opponent”) opposes the application on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Whilst the Opponent’s marks are registered for goods and services in other classes, for the purposes of this opposition the Opponent relies only on those goods in class 3 for each of its EU registrations, as set out below:

- i. **Mark:** NATURVITAL
Number: EU301523
Filing date: 8 May 1996
Registration date: 6 July 1998
Goods relied upon: Class 3: cosmetics, essential oils, hair lotions, shampoos, deodorants.

(“the First Earlier Mark”)

- ii. **Mark:** 
Number: EU8858235
Filing date: 4 February 2010

Registration date: 1 March 2011

Goods relied upon: Class 3: cosmetics; essential oils; shampoos; deodorants; hair dyes; hair spray; hair mousse; hair cream, gels, wax, shiners, conditioners, masks, extracts and hair lotions.

(“the Second Earlier Mark”)

3. Under section 5(2)(b) of the Act, the Opponent claims there is a likelihood of confusion because the respective goods are identical or similar and the marks are similar.

4. Under section 5(3) of the Act the Opponent claims that the earlier marks have a reputation in respect of the goods relied upon and that use of the Applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the Earlier Marks. In particular, the Opponent submits that the Applicant will benefit from the efforts made in the marketing and developing of its products and trade mark, jeopardising the position and standing of its goods and its brand in the market place.¹

5. With regards to its claim under section 5(4)(a) of the Act the Opponent claims that by virtue of the extensive use that has been made of its Earlier Marks throughout the UK since July 1998 in relation to “*Cosmetics; essential oils; hair lotions; shampoos; conditioners; deodorants; hair dyes; hair masks; hair tonics; hair serums; body wash; body moisturisers; anti fizz spray*” it has acquired goodwill for these goods and that use of the applied for mark would be a misrepresentation to the public resulting in damage to the aforementioned goodwill.

6. The Applicant filed a counterstatement denying the claims made, submitting that the two logos are significantly different and that the combination of the two words used

¹ Form TM7 Q5

in such a way means that it is impossible for the average consumer to confuse the two.

7. The Opponent is represented by BRANDED TM Limited t/a BRANDED!, whereas the Applicant is unrepresented. The Opponent filed evidence together with initial submissions whereas no evidence or submissions were filed by the Applicant. Neither party requested a hearing nor filed submissions in lieu. This decision is taken following the careful consideration of the papers.

Evidence

8. The Opponent's evidence consists of the witness statement of Mr Antonio Llinas Llobera, dated 23 April 2019, accompanied by 10 exhibits marked IN1-7 and INSL1-3.

9. Mr Llobera exhibits at INSL1 the witness statement of Mr Jose Luis Isern Jara, the Opponent's lawyer, dated 5 April 2019. Whilst ordinarily it would be incumbent on me to assess the weight I should give to a statement exhibited in this way, in this particular case I need not consider the matter further as Mr Jara's statement appears to be a duplicate of Mr Llobera's statement.² I do not propose, therefore, to summarise the contents of this statement. I also note that the exhibits within Mr Jara's statement have not been produced.

10. Mr Llobera confirms that he holds the position of Administrator for the Opponent which he describes as "my company". He confirms that the information contained within his statement is taken from company records and from his personal knowledge. He states that the company was incorporated in 1991 and also commenced trading from this date.

² Paras 1-13

11. Mr Llobera provides an outline of the registration details of the Earlier Marks relied upon and the goods and services offered for sale under the marks.

12. Exhibit IN1 consists of over 150 pages of print outs taken from the company's website "naturvital.co.uk" and includes a number of screenshots displaying the Second Earlier Mark on a range of products mostly for shampoos, conditioners, hair colours/hair dyes, hair loss treatment tonics, hair masks (hair loss intensive/ silver toner), hair control anti frizz sprays, hair loss treatment serums and hair rescue repair sprays. Only four pages are produced where the Second Earlier Mark is displayed for body washes and body moisturisers.³ Page 17 includes, what look to be radio buttons representing the Opponent's range of available products described as "Hair Loss Range", "Sensitive Range" "Hair Colours" "Hair Care" and "Body Care". Throughout the text of the webpages, reference is also made to the First Earlier Mark. Links to the company's social media accounts (Twitter and Facebook) are included within these webpages, inviting the consumer to "CONNECT WITH NATURVITAL" however pages from these sites are not included within this exhibit. The screen shots produced from the website have a print date of 4 April 2019, but otherwise are undated.

13. Mr Llobera states that the company receives significant exposure for its brand through Boots the Chemist Limited's customers. He explains that the Opponent has maintained a relationship with Boots the Chemist Limited since 2008 by consistently supplying goods to its warehouses for nationwide distribution. In support of this Mr Llobera exhibits at IN2 invoices dated between 28 August 2008 and 8 November 2018. The invoices are from Natur Vital Distribution Ltd T/A Natures Well, Dublin with a delivery address to The Boots Company Plc, Nottingham. The invoices do not display the mark however the products are referenced for example as "NV Hair Loss shampoo". The invoices are for hair care products to include shampoos, conditioners, hair loss treatments, hair loss serums, hair loss anti breakage masks and hair colours. The prices displayed are in Euros. Later in his statement, Mr Llobera describes

³ pages 167-170 Exhibit IN1

Naturvital Distribution Ltd T/A Natureswell or Natureswell as “distributors of [his] company’s products”.⁴

14. Mr Llobera produces at IN3 samples of national press articles where the company and both the earlier marks are featured. The article produced from Celebrity Angels is dated 4 August 2015 and is headed “Preventing Hair Loss with Natur Vital”. “Naturvital” is described within this article as a hair care company that specialises in hair loss products to include shampoos, conditioners, treatments and serums. The extract taken from Natural Health magazine is dated 14 April 2016 and refers to the Opponent’s “Naturvital Colour Safe” hair colours available to purchase from “naturvital.co.uk” for £9.99.

15. Mr Llobera confirms that between 2008 and 2018 in addition to word of mouth marketing, the Opponent has spent over £203,000 on advertising its goods and services under both Earlier Trade Marks. Mr Llobera produces a table showing the advertising costs broken down by year since 2008 (reproduced below). It is unclear from his statement whether this figure represents the total expenditure for advertising its goods or only the proportion that relates to advertising within the UK. The figures produced are however in pounds sterling.

YEAR/PERIOD	ADVERTISING COSTS (£)
2008	5,234.16
2009	22,335.98
2010	6,194.52
2011	16,287.16
2012	19,980.52
2013	16,555.75
2014	24,371.14
2015	25,435.36
2016	19,577.64
2017	9,581.57
2018	37,738.96

⁴ Para 15

16. Mr Llobera states that the Opponent advertises its goods via two advertising companies namely Lavery Rowe Advertising and WordStream and exhibits at INSL3 sample invoices between these companies and Naturvital Distribution Ltd T/A Natureswell or Natureswell dated 2015, 2016 and 2017. There is no reference to either mark within these invoices. Mr Llobera states that the Opponent's distributors share part of the advertising costs a percentage of which are later reimbursed by the Opponent.

17. Mr Llobera states that the total sales generated under both trade marks since 2008 was £11,098,296. He provides a table of the sales broken down by year (but not by product) up until 2018 as follows:

YEAR/PERIOD	SALES (£)
2008	413,640.00
2009	825,480.00
2010	905,400.00
2011	935,640.00
2012	1,191,888.00
2013	1,198,152.00
2014	1,154,016.00
2015	1,177,920.00
2016	1,014,552.00
2017	1,188,936.00
2018	1,092,672.00

18. Mr Llobera confirms that the Opponent's products displaying the marks are stocked and available to purchase by a number of leading UK retailers around the entire UK to include Boots, Lloyds Pharmacy and Amazon. He produces at IN7 screen shots taken from these retailers' webpages mainly taken from www.boots.com and www.lloydspharmacy.com. There is only one reference to the Opponent's products

being available via www.amazon.co.uk at page 246. Save for a print date of 4 April 2019 and 17 April 2019 these extracts are undated. The marks in both their forms are displayed for hair care products but only for shampoos, conditioners, hair loss tonic treatments and intensive treatment hair loss serums.

19. Mr Llobera states that the Opponent also uses its UK social media pages to advertise its goods and at IN4 produces sample extracts illustrative of the type of posts taken from its Facebook, Twitter and Instagram accounts dated 2016 and 2018. The Opponent's Instagram account is displayed as "naturvitaluk" showing it has 211 followers. The Opponent's Twitter account is referred to as @naturVital1 with 6764 followers and includes two posts dated 4 May 2018 and 22 May 2018. The account appears to have a start date of May 2016. Both marks are referred to within these accounts the first earlier mark within the text description and the second earlier mark displayed on photographs of the actual products.

20. Exhibit IN5 consists of screenshots taken from the Opponent's Company's Facebook Page dated 23 February, 27 June and 10 September 2018 and are described as demonstrating social media interactions and reviews from customers who use the Opponent's products. Both marks are displayed within these posts the second earlier mark on the products themselves and the first earlier mark as NaturVitalUK in the body of the text.

21. Exhibit INSL2 is described as examples of advertisements of the Opponent's products on Twitter, Facebook, Instagram and Amazon which Mr Llobera states demonstrates internet advertising in addition to national press advertising. Exhibit INSL2 includes copy screen shots taken from the Opponent's NaturVitalUK Twitter account consisting of 4 posts dated "18 sept 2017", "23 feb 2018", "3 ago[sic] 2018" and "23 Nov 2018". The printouts consist of various pictures of hair products displaying the second earlier mark. I am unable to decipher specifically which products are referred to as the photographs produced are of poor quality.

22. INSL3 consists of various sample invoices dated between 2015 and August 2017 described by Mr Llobera as examples of its advertising expenditure/costs. The invoices demonstrate various media campaigns to include television commercials and newspaper advertisements with various media outlets to include the Daily Express, Sunday Mirror and ITV. Mr Llobera states that these costs are shared between the Opponent and its distributors. One of the invoices for example is addressed to Naturvital Distribution Ltd, Dublin from Tristar Television Ltd, Luton in return for “Production of 20 second TV Commercial and transmit 100 free spots split across ITV3/+1, ITV4/+1 and ITV Encore/+1”. Within the UK these channels are not one of the main terrestrial channels but are available on free to air services accessible via cable or satellite.

23. This concludes the summary of the Opponent’s evidence. Whilst written submissions dated 5 April 2019 were filed at the same time, I do not propose to summarise them, however, I have taken them into account and will refer to them where necessary in my decision.

Proof of Use

24. In these proceedings, the Opponent is relying upon its two registrations as shown above, which qualify as earlier trade marks under section 6 of the Act. As its marks have been registered for more than five years, ending on the filing date of the application, they are subject to the proof of use provisions. In order for the Opponent to rely upon the goods listed within class 3 it must demonstrate that use has been made of its marks for these goods.

25. The relevant provisions regarding Proof of Use are set out as follows:

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

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

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

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

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

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

26. Section 100 of the Act is also relevant it states that:

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

27. Accordingly under section 6A(3)(a) of the Act the relevant period in which genuine use must be established is the five year period ending on the filing date of the applied for mark. Consequently, the relevant period is from 28 July 2013 to 27 July 2018.

28. What constitutes genuine use has been subject to a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J. summarised the law relating to genuine use as follows:

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

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

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark:

Ansul at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

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

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

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

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

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

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

29. As the earlier marks are EU trade marks, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

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

....

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

...

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

30. The court held that:

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

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

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

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

229. In *Case T-278/13 Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

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

an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

32. The General Court (“GC”) restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of a EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union. The Opponent’s evidence appears to be primarily directed towards showing use within the UK which on the basis of the above caselaw would be sufficient to demonstrate use of its EU marks rather than having to demonstrate use over the community area as a whole.

Form of the mark

33. Where the mark has been used in the format in which it is registered this will clearly be use upon which the Opponent may rely. I note that the Opponent has produced some evidence but not all, unchallenged by the Applicant, where both the word only mark and the stylised form has been used on its goods within the relevant period and therefore I need not address the issue of acceptable variants further.

Sufficient Use

34. Whether the use shown is sufficient, will depend on whether there has been real commercial exploitation of the earlier trade marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant five-

year period. In making the assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown
- b. The nature of the use shown
- c. The goods and services for which use has been shown
- d. The nature of those goods/services and the market(s) for them
- e. The geographical extent of the use shown

35. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is not genuine use.

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

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

the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

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

37. It is clear from the case law that a number of factors must be considered when assessing whether genuine use of the mark for the goods relied upon has been demonstrated by the evidence filed. The responsibility is on the Opponent to provide sufficiently solid evidence in support of its claim, a task which should be relatively easy to achieve.⁵ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁶

⁵ Awareness Limited v Plymouth City Council, Case BL O/236/13

⁶ Case T-415/09, New Yorker SHK Jeans GmbH & Co KG v OHIM, GC

38. I note that the Applicant has not challenged the evidence filed by the Opponent. Mr Llobera's witness statement sets out a narrative of a company which has been making and selling hair care products since 1998. The printouts from the websites are displayed in the format ending with ".co.uk" which indicates that they are websites directed at the UK public. I also note that the websites referred to are in English and the price where displayed is in pounds sterling. Although Mr Llobera produces sales figures, he does not specifically state whether they relate to the UK market, however, the amounts are in pounds sterling and his statement appears to be directed towards use within the UK. Whilst the figures are not broken down per product I am satisfied that at least a proportion of those sales relate to a number of the goods relied upon. The social media references do not demonstrate a large following nevertheless they do demonstrate a social media presence via Facebook, Twitter and Instagram within the relevant period. Notwithstanding that a number of the print outs from the Opponent's website are undated (other than having a print date of 4 April 2019) in combination with the invoices, sales figures, advertisement costs and social media posts, all of which are within the relevant period, it is clear that use is being made of both earlier marks within the UK which is supported by the table of sales produced.

39. I am satisfied therefore looking at the evidence as a whole that the Opponent has proved sufficient use of its marks in the UK during the relevant five year period. I am satisfied that the Opponent has demonstrated use in relation to shampoos, conditioners and hair dyes. In addition, it has demonstrated use for hair loss treatment tonics, hair loss masks, hair control anti frizz sprays and hair loss serums which would all be covered by the Opponent's hair lotions and hair creams in its specification.

40. In relation to *deodorants; essential oils; hair spray; hair mousse; hair gels, wax, shines, extracts* I see no evidence whatsoever that I can categorically point to that demonstrates even at a base level that the marks have been put to actual use in relation to these goods.

41. Similarly, no evidence has been filed in relation to *cosmetics*. Taking into account the average consumers ordinary understanding of the term cosmetics, it would be regarded as a product applied to the face or body to enhance a user's appearance. There is only one reference to body moisturisers within the evidence filed, which could potentially fall within this category. However, there is no evidence of actual sales and what is produced is not broken down by product. Therefore, even if I were to accept that body moisturisers were included in the term cosmetics, the evidence produced is insufficient to demonstrate use. The opponent is therefore unable to rely on cosmetics for the purposes of its opposition.

Fair specification.

42. It is clear that the Opponent has not proved use for its full specification of goods caught by the earlier marks. Therefore, I must now consider what a fair specification would be.

43. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

44. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation

to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

45. I take note of the above case law and in particular I must approach the evidence submitted, from the standpoint of what is a fair description of the use demonstrated, from the view point of the average consumer. The Opponent should not be allowed to monopolise the use of a trade mark in relation to a broad category of goods if it has only demonstrated use in relation to some within a narrower subcategory. This must be balanced against not limiting the Opponent’s specification too far so that the specification is unduly restrictive or overly specific.

46. The evidence shows that the Opponent has used both of its marks in relation to shampoos, conditioners, hair loss treatment masks, hair loss serums which could all be described as hair care products used to clean or protect hair. In addition, it has demonstrated use of its marks for hair dyes.

47. Accordingly, for the purposes of the opposition I consider a fair specification of goods upon which the Opponent may rely is:

First Earlier Mark

Class 3: hair lotions; shampoos.

Second Earlier Mark

Class 3: shampoos; conditioners; hair dyes; hair lotions; hair cream and hair masks.

Decision

48. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act which state as follows:

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

(a)

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

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

(3) A trade mark which-

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

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

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

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

(b)

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

Section 5(2)(b)

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

The principles:

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

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

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

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

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

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

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

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

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

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

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

Comparison of the goods

50. When conducting a goods and services comparison, I am mindful of the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

51. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

52. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

53. In order to determine whether there is a likelihood of confusion the competing specifications must either be identical or share similarity. As a result of my earlier assessment as to what goods the Opponent was able to rely upon, the respective parties' goods are as follows:

Applicant's Goods	Opponent's First Earlier Mark's Goods	Opponent's Second Earlier Mark's Goods
Class 3: cosmetics	Class 3: hair lotions; shampoos.	Class 3: shampoos; conditioners; hair dyes; hair cream; hair masks and hair lotions.

54. Neither party makes any submissions regarding the identity or similarity of the respective goods other than the Opponent submitting that the Applicant's goods are identical to those goods it relies upon.

55. The Applicant's goods include *cosmetics* which as I have already outlined covers a broad range of goods and is defined in the Cambridge dictionary as "substances put on the face or body that are intended to improve its appearance or quality" and would therefore include such things as creams and lotions.⁷ The Opponent's goods could all be described as hair care products. They are all products used to treat, colour and cleanse a person's hair. The respective products would share channels of trade, nature and purpose and there would be an overlap in users and uses. The products whilst not being displayed on the same shelves, are likely to be displayed within relative proximity to each other in retail premises. I do not consider that the respective goods would be in competition or be complementary to each other. On this basis, I consider that the degree of similarity between the Applicant's *cosmetics* and the Opponent's goods would be medium.

Average consumer

56. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. When considering the opposing trade marks, I must consider the level of attention paid during the purchasing process and how they are selected taking into account that the level of attention may vary according to the category of goods in question.⁸

57. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

⁷ <https://dictionary.cambridge.org/dictionary/english/cosmetics>

⁸ Lloyd Schuhfabrik Meyer, case c- 342/97.

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

58. Neither party has made submissions regarding the average consumer or the purchasing process and therefore my assessment is a notional one based on the goods as they appear on the register. In my view the average consumer for the goods at issue is a member of the general public selecting the goods from shelves of retail premises or their online equivalents. In terms of the purchasing process itself visual considerations are likely to dominate, as a result of exposure to the brand labels themselves or following television or magazine advertisements. I do not rule out aural considerations however following discussions with sales staff in a retail setting for example. I consider that the goods are relatively inexpensive and are likely to be purchased on a fairly frequent basis. There may be considerations regarding suitability, for those that have a sensitivity to certain ingredients or chemicals within the products. Consumers will also be drawn to purchase the goods based on their aroma or for ethical reasons. Overall, even taking these matters into account I do not consider that the level of attention paid will be more than average taking into account the nature of the goods.

Comparison of the trade marks


59. 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 proceed to 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 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.”

60. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider 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.

61. The respective trade marks are shown below:

Applicant’s Mark	Opponent’s First Earlier Mark	Opponent’s Second Earlier Mark
Vitanaturals	NATURVITAL	

62. The Applicant submits that:

“its brand name is a newly created word that consists of an Italian word “vita” which means life and an English word “natural” meaning “not artificial”. The word “natural” is plural that gives it even more original look and sound. The combination of the two aforementioned words is used in such a way that it is impossible for an average consumer to confuse the two.

The two logos are significantly different “natur vital” is two separate words that are placed one under the other. “Vitanaturals” is one word written on one line.

Natur Vital – 2 words, 5 letters each, total 10 letters

Vitanaturals – 1 word, total of 12 letters”

63. The Opponent submits that:

“7. The Opponent’s marks, NATURVITAL and NATURVITAL Logo and the Applicant’s mark Vitanaturals both contain the words VITA and NATUR. Both marks also end in “al” discounting the plural letter “s”. Both marks also contain a capital V. The marks are therefore visually, phonetically and conceptually similar insofar as the words are concerned.

8. The immediate impression of the Applicant’s mark upon a consumer is very similar to the mark of the Opponents (and many people would consider the word “VITA” to be conceptually interchangeable with or complimentary to the word “NATURAL”.”

64. All three marks are made up of the elements “Vita” and “Natur” seen in combination, in varying forms in the respective marks.

65. In the form TM8 filed, the Applicant refers to his mark in capitals with a leaf device included, however, this decision can only consider the marks as presented on the register. The Applicant’s mark consists of the twelve-letter word Vitanaturals presented in ordinary title case. The eye will be drawn naturally to the elements it recognises and therefore it will be perceived by the average consumer as being devised of two elements/words Vita and naturals. Of these two elements naturals will be recognised as a common English word alluding to the qualitative characteristics of the goods so it is weaker in distinctiveness.⁹ Vita is not immediately recognised as a

⁹ Appointed Person decision on appeal *Leonora Harper v Lorenz Snack-World Holding GmbH* BL O/795/18

word within the English language. It is the two elements in combination however in which the overall impression resides.

66. The Opponent's First Earlier Mark consists of the word only mark NATURVITAL presented in capitals. The mark will be understood to consist of two elements NATUR and VITAL. Again, the element NATUR will allude to the quality of the goods and thus be the less distinctive element of the two, because it will bring to mind and make the average consumer think of "nature". However, it is the combination of the two elements made up to make a new word as a whole, in which the overall impression resides.

67. The Opponent's Second Earlier Mark consists of two words NATUR and VITAL presented one above the other. The first letter of each word is presented in considerably larger font giving emphasis to each word such that they are clearly distinguished as two separate words. Above and below the words are two curved lines. The curved lines and the over-capitalisation of the first letter make a weak contribution to the mark as they will be seen as decorative. The overall impression resides in the two words NATUR and VITAL in combination.

Visual comparison

The Opponent's First Earlier Mark

68. The respective marks are presented in different cases, the Opponent's being in upper case and the application being presented in title case. Since trade marks registered as word marks may be used in any standard font or case these differences will have no bearing on the similarity assessment. The marks share similarity in so far as they both include common use of the elements Vita and Natur, albeit in an inverted sequence. The primary difference is the transposition of these elements and the addition of the letter "l" in the element "Vita" in the Opponent's mark and the

additional letters “als” in the element “natur” of the Applicant’s mark. Overall, I consider that the marks are visually similar to a medium degree.

The Opponent’s Second Earlier Mark

69. Visually the Opponent’s mark is presented as two clearly defined elements NATUR and VITAL; one above the other; which is a clear point of visual difference as the Applicant’s mark is presented as one word. The similarity as previously noted lie with the sequence of the elements Vita and Natur which are inverted in the respective marks. The Opponent’s mark includes some stylisation seen as decorative, these being absent from the Applicant’s mark. As before the additional letters “als” and “l” are absent from the respective marks. Overall, I consider the marks to be visually similar to a low to medium degree.

Aural Comparison

70. Aurally the Applicant’s mark will be pronounced as Vi-ta-nat-ur-als although I do not discount that there may be slight variations in how the vita element is pronounced. Irrespective of the stylisation, both the Opponent’s marks will be pronounced as Natur-vi-tal. Taking account of the transposition of the common elements and the differences between the respective marks I consider that overall the marks share a medium degree of aural similarity.

Conceptual Comparison

71. The Applicant submits that his mark is a “newly created word that consists of an Italian word “vita” which means life and an English word “natural” meaning “not

artificial”. The Opponent makes no specific submissions regarding the conceptual characteristics of its marks.

72. All three marks include the same core elements albeit that they are presented in a different order with slight variations. Whilst there may be a small proportion who perceive the words Vita/Vital as a reference to life or an abbreviation of vitality/vitamins, most will consider the words to be invented. In combination with the elements Natur/naturals neither mark has a conceptual message that is capable of immediate grasp by the average consumer other than alluding to something natural or from nature.¹⁰ The conceptual similarity therefore resides in the perception that the goods are made naturally, e.g. without artificial additives.

Distinctive character of the earlier marks.

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

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

¹⁰ Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.

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

74. Registered trade marks possess varying degrees of inherent distinctive character; descriptive words tend to have a low level of inherent distinctiveness, whereas invented words are regarded as possessing a high level of distinctive character and dictionary words that are neither descriptive nor allusive are somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

75. The Opponent has not pleaded that the distinctiveness of its marks have been enhanced through use but nevertheless filed evidence to support its claim that it had used its marks for the goods relied upon. Whilst I recognise that use of the marks has not been insignificant, I am not satisfied that the evidence is sufficient to demonstrate that its marks have acquired an enhanced level of distinctiveness within the UK. Mr Llobera’s statement shows that between 2013 and 2018 sales across its whole range amounted to over £8 million. There is no evidence regarding what proportion of the market share this represents or a breakdown as to how much was sold per product. In particular, it is unclear whether these figures solely represent sales within the UK market. I take judicial notice of the fact that the market share for hair care and beauty products would be extensive, running into hundreds of millions of pounds each year and therefore I consider that sales of £8 million over 5 years is not a significant

proportion of that market. Whilst there has been some evidence of an awareness of the brand via social media this is relatively small with only 211 followers via Instagram and 6764 via Twitter. On this basis I do not find that the evidence filed supports a claim for enhanced distinctive character and therefore I am only able to consider the position based on inherent characteristics.

The Opponent's first earlier mark

76. I have already noted that some average consumers will think that Vital is an invented word and invented words generally have a higher than average level of inherent distinctiveness. However, the mark also includes the element "natur" perceived as an abbreviation of the word nature/natural. Whilst not directly descriptive of the goods, "natur" will allude to the quality of the goods as being produced free from artificial additives. I bear in mind that the combination of the words is not an obvious one and that as a whole the mark has an average degree of distinctive character.

The Opponent's second earlier mark

77. The curved lines and the overcapitalisation of the first letters add some distinctiveness to the mark but not significantly so. As with the first earlier mark the distinctiveness lies with the two elements in combination and as noted above I consider that it possesses an average degree of distinctive character.

Likelihood of confusion

78. When considering whether there is a likelihood of confusion between the respective marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective services originate from the same or related source.

79. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

80. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider 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 that he has retained in his mind.

81. I have identified the average consumer to be a member of the general public, who would primarily select the goods via visual means but with aural considerations not being discounted. I have found an average level of attention will be paid during the

selection process. In so far as the Opponent's first earlier mark I have found the respective trade marks to be visually similar to a medium degree and in relation to the Opponent's second earlier mark a low to medium degree. Aurally, the marks are similar to a medium degree and conceptually they share a degree of similarity. I have also found both the Opponent's marks to have an average degree of inherent distinctive character. I bear in mind my assessment with regards the overall impression of each mark and take into account the distinctiveness of the common elements within the marks as a whole.¹¹

82. Taking account of the principle of imperfect recollection and the fact that consumers rarely have a chance to compare marks side by side I conclude that there is a strong likelihood that the Applicant's mark will be mistaken for the Opponent's earlier marks. The similarities between the use of "Vita" and "natur" for beauty, hair and cosmetics is such that, even when these elements are inverted, consumers are likely to misremember or mistakenly recall the words in combination and the order in which they appear. All three marks include portmanteau words made up of parts of multiple words combined to form a new word. They are all essentially a blend of the words natural/nature and vitality/vitamins in varying forms. The differences between the inclusion/absence of the letters "i" and "als" and the order in which these elements are presented within the marks are not sufficient to enable the average consumer to distinguish between them, especially bearing in mind the concept of imperfect recollection, for goods that are similar, selected primarily through visual means. It is my view that the average consumer will mistake one mark for the other leading to a likelihood of direct confusion. The fact that the Opponent's second earlier mark is presented one element above the other does not alter this view.

83. The opposition under section 5(2)(b) of the Act succeeds in full.

¹¹ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

Section 5(3)

84. I now turn to the opposition claimed under section 5(3). 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, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is

weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

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

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

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

85. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark.

Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more heads of damage claimed by the opponent will be suffered. It is unnecessary for the purposes of section 5(3) for the goods and services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between them. For the purposes of section 5(3) the relevant date for the assessment is the date of filing of the application namely 27 July 2018.

Reputation

86. It is first necessary for the Opponent to show that it has the necessary reputation to begin a claim under this section of the Act. Reputation is defined in *General Motors*, Case C-375/97, in which the CJEU held that:

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

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

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

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

87. Whether the Opponent has demonstrated a reputation for the goods claimed must be assessed on the basis of whether a significant part of the public associate the earlier marks with the goods. In making this determination I must take into account all the relevant factors to include “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. In relation to *cosmetics, deodorants and essential oils* no evidence was filed sufficient for me to find that use had been made of the marks for these goods. In addition, I have already found that for the remaining goods in class 3, the evidence is not sufficient to demonstrate that the earlier marks have an enhanced degree of distinctive character in the UK and no evidence was filed of its use across the EU.

88. I note that the assessment of whether the Opponent has a reputation for the goods claimed is a different test to the one undertaken for an enhanced level of distinctive character. In fact, proving reputation is not a particularly onerous task¹². The sales figures on an annual basis are relatively low amounting to between £413,640 and £1,198,152 and there is no indication of market share. The advertising campaign expenditure extends to just over £203,000 between 2008 and 2018 which over 10 years again is a relatively low figure taking into account the nature of the goods. The Opponent has only provided two magazine articles dated August 2015 and April 2016 which make reference to the marks. The evidence of the media coverage shows that the Opponent's products were advertised to the public in daily newspapers and on UK tv channels but the invoices are dated between October 2015 and August 2017. The evidence filed supports awareness about the brand through its social media accounts, however, this is not extensive. For example, the screenshot produced from the Opponent's Twitter account, showed that it joined in May 2016 and as at the print date of 4 April 2019 it had 6764 followers; which appears to be a modest figure in social media terms.

¹² *Enterprise Holdings Inc. v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), Arnold J.

89. I do, however, take particular note that its hair care products are being offered for sale and available to purchase through Boots the Chemist and Lloyds Pharmacy (via their retail stores and respective websites). In support of this, the Opponent produced invoices showing sales of its products to Boots the Chemist Ltd, which included those dated 13 Dec 2017, 22 Feb 2018 and 8 Nov 2018 for shampoos, conditioners, hair loss treatments and hair colours. It also produced screen shots taken from Boots' website with print dates of 4 April 2019 showing the Opponent's shampoos, conditioners, hair loss tonic treatments and hair loss serums being offered for sale. The sales figures noted for 2018 was £1,092,672. Such exposure through a leading UK retailer would mean that a significant number of consumers would be aware of the brand through these outlets especially in light of the geographic extent of these stores within the UK.

90. Taking all these factors into account and assessing the strength of the Opponent's reputation based on the evidence filed I am willing to accept that it has the requisite reputation, to an average degree, for *shampoos; conditioners; hair dyes; hair masks; hair creams and hair lotions*.

Link

91. As noted above my assessment of whether the public will make the required mental 'link' between the marks must take into account all of the relevant factors. Those factors identified in *Intel* are:

- The degree of similarity between the conflicting marks. For the reasons set out earlier I found that the marks are visually similar to a low to medium/medium degree; aurally similar to a medium degree and share a conceptual similarity.
- The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or

dissimilarity between those goods or services and the relevant section of the public. The Opponent's marks have a reputation for *shampoos; conditioners; hair dyes; hair masks; hair creams and hair lotions* and the Applicant's mark covers *cosmetics*. The goods share channels of trade, nature and purpose and there would be an overlap in users and uses. The products whilst not being displayed on the same shelves, are likely to be displayed within relative proximity to each other in retail premises. I do not consider that the respective goods would be in competition or be complementary to each other. I consider that the goods are similar to a medium degree.

- The strength of the earlier marks' reputation. The Opponent's marks have an average reputation in the UK.
- The degree of the earlier marks' distinctive character, whether inherent or acquired through use. As noted above, I consider the Opponent's marks to be of an average degree of inherent distinctiveness neither mark having acquired enhanced characteristics through use.
- Whether there is a likelihood of confusion. I have found that there would be a likelihood of direct confusion for the reasons set out in paragraphs 78-82.

92. Considering all the factors and taking into account the visual, aural and conceptual similarities between the marks, together with the reputation of the earlier marks and the similarities of the goods offered by each party, I conclude that in relation to *shampoos; conditioners; hair dyes; hair masks; hair creams and hair lotions* a significant part of the relevant public will make a link between the marks. I find that a substantial number of the public would believe that the *cosmetics* being offered under the Applicant's mark are being offered by the Opponent or are linked in some way to the Opponent.

Unfair advantage

93. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

94. In *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods offered under the later trade mark was required to establish unfair advantage. This however may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark.¹³

95. The Opponent argues that the ability for the Applicant to establish itself quickly in the market, piggy backing off the Opponent's marks would be unfair and potentially jeopardise their own position in the haircare, beauty and cosmetics industry. It argues

¹³ *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC).

that if the Applicant's goods were not of the same high standard as those of the Opponent's then this would have a detrimental effect on the sales of its products leading to the Opponent falling into "disrepute" and the resulting "concomitant detriment could be irreparable to the Opponent's business." In relation to the detriment caused to the distinctive character of the earlier marks the Opponent argues that given the close similarity between the marks consumers would be unsure as to the origin of the goods and whether they were the genuine goods of the Opponent changing their economic behaviour as a result.

96. I have seen no evidence that supports the Opponent's claim that its goods enjoy a reputation for high quality or that the Applicant's goods are substandard and therefore this claim is not made out. However, given all of my findings, the public encountering the Applicant's mark for *cosmetics* would due to the link, think that the use of the other marks for *shampoos; conditioners; hair dyes; hair masks; hair cream and hair lotions* are related. In my view this would take unfair advantage of the earlier marks' reputation and as submitted by the Opponent gain a foothold in the industry quickly without having to make an equivalent investment or marketing effort themselves. I accept also that as a result of the similarities between the marks the economic behaviour of customers would change and the applied for mark would gain a commercial advantage.

97. The grounds of opposition under section 5(3) therefore succeeds.

Section 5(4)(a)

98. For a claim under section 5(4)(a) to succeed the Applicant must demonstrate goodwill, misrepresentation and damage. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

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

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

Relevant date

99. The Opponent’s claim under section 5(4) must be determined as at the “relevant date”. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O410-11, Daniel Alexander QC, sitting as the Appointed Person, considered what constituted the relevant date for the purposes of this section and concluded as follows:

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

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

100. There is no indication that the applied for mark has been used prior to the application date in the UK and therefore the relevant date is the date of the application namely 27 July 2018.

Goodwill

101. 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.”

102. It is for the Applicant to provide evidence to show that it had goodwill on the relevant date within the UK. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

103. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

104. Goodwill arises out of trading activities. Despite the absence of evidence of purchases by actual customers, it is clear from the invoices and the webpages that the Opponent's goods have sold and that those sales have not been insignificant which is reflected in the figures produced by Mr Llobera. Furthermore, the Applicant has not challenged this evidence. I accept that the sales figures are not substantial given the size of the market, but the figures clearly show that sales have been growing steadily each year culminating in revenue of £1,092,672 in 2018. The Opponent has a

relatively small following on social media and has demonstrated an active business throughout the UK, as a result of Boots the Chemist Ltd and Lloyds Pharmacy stocking its products. Although the evidence produced from its website and those of its retailers were mostly undated, it does show that its hair care products were available online up until April 2019 through these retailers' websites and that the business was drawing custom from its own website prior to and after the relevant date. Although no specific evidence has been produced as to the geographical extent of its activities I accept that Boots is a nationwide retailer and therefore it is reasonable to conclude that sales would have occurred throughout the UK.

105. Mr Llobera produced a table as outlined in paragraph 17 above showing it had generated total sales of over £11 million over 10 years. It is clear from this unchallenged evidence that there were consistent sales by reference to both marks for shampoos, conditioners, hair dyes, hair masks, hair lotions and hair creams up to and including the filing date of the application. Taking the evidence as a whole, and my findings as to the use the Opponent has made of its marks I conclude that there was goodwill at the relevant date in a business associated with the sign NaturVital for shampoos, conditioners, hair dyes, hair lotions, hair cream and hair masks. I am satisfied that the Opponent has met the burden placed on it to prove goodwill at the relevant date in relation to both its marks.

Misrepresentation

106. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. set out the relevant test namely that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

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

And later in the same judgment:

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

107. I note that the test for misrepresentation requires a substantial number of members of the public to be deceived and that this test differs to the one undertaken for a likelihood of confusion where it necessitates that the average consumer is confused. However, in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether in reality the difference between the two legal tests would produce different outcomes. In light of my assessment regarding the similarities between the marks aurally, visually and conceptually, for goods that were similar to a medium degree, I am satisfied that a substantial number of the Opponent's customers or potential customers would be deceived. Applying a

different legal test to that undertaken regarding a likelihood of confusion I nevertheless come to the same outcome.

Damage

108. In *Bocacina Limited v Boca Cafés Limited, Dercio De Souza Junior, Malgorzata De Souza* [2013] EWHC 8090 (IPEC), Mr Daniel Alexander QC, sitting as an Enterprise Judge, noted that:

“There is no dispute that if there is goodwill and misrepresentation, there would be damage.”

109. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

110. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

111. In my view it follows that as a result of the similarity between the marks and the closeness of the respective goods would ultimately lead to a reasonably foreseeable diversion of sales from the Opponent to the Applicant resulting in the Opponent suffering financial loss. The claim under section 5(4)(a) therefore also succeeds.

Overall conclusion

112. The oppositions based upon sections 5(2)(b), 5(3) and 5(4)(a) have succeeded in full and subject to any successful appeal, the application will be refused.

Costs

113. As the Opponent has been successful, it is entitled to a contribution towards its costs. awards of costs in proceedings are based upon the scale as set out in Tribunal Practice Note 2 of 2016. Applying this guidance, I award costs to the Opponent on the following basis:

Preparing a notice of opposition £400

and reviewing the counterstatement:

Preparing evidence and submissions:	£700
Official Fee:	£200
Total:	£1300

114. I order Rafal Wozniacki to pay Instituto Naturvita, S.L. the sum of £1300 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 26th day of February 2020

Leisa Davies
For the Registrar