

BL O/1076/22

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3619964
BY EVERYDAY SENSE LIMITED
TO REGISTER THE TRADE MARK:**



**IN CLASSES 5 AND 10
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 426455
BY TEOXANE S.A.**

Background and Pleadings

1. On 01 April 2021, Everyday Sense Limited (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number 3619964 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 04 June 2021, in respect of goods in Classes 5 and 10.¹
2. On 27 August 2021, Teoxane S.A. (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods contained in the application.
3. The opponent relies upon the following comparable United Kingdom Trade Mark (“UKTM”):²

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4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion and association on the basis that the marks and goods at issue are similar. In accordance with section 6A of the Act, the earlier mark is subject to proof of use; the opponent made a statement of use in relation to all the goods relied upon.
5. The applicant filed a defence and counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of all goods relied upon.

¹ The specification will be listed in the goods comparison.

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 1037521 being registered at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing dates remain.

³ The full specification is listed in the proof of use assessment.

6. The opponent is represented by Dehns; the applicant is unrepresented. During the evidence rounds, both the opponent and applicant filed evidence under witness statements. Neither party requested a hearing, nor did they file submissions in lieu. The evidence will be summarised to the extent that it is considered necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

7. The opponent filed evidence in the form of the witness statement of Patrice Calvayrac, dated 10 February 2022, and his corresponding three exhibits (PC1-PC3). Mr Calvayrac is Group Chief Financial Officer of Teoxane SA, the opponent company, a position held since May 2018; and the witness statement of Clare Louise Mann, dated 11 February 2022, and her corresponding four exhibits (CLM1-CLM4). Ms Mann, a Trade Mark Attorney and partner at Dehns Patent and Trade Mark Attorneys, is authorised to make the statement as the legal representative for the opponent.

8. The applicant filed evidence in the form of the witness statement of Apoorva Shah, dated 01 August 2022, and his corresponding two exhibits (AS1-AS2). Mr Shah is Director of Everyday Sense Ltd, the applicant company.

9. I have considered the evidence and will refer to it, where necessary, during this decision.

DECISION

Relevance of EU law

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

Proof of use

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

“6A (1) This section applies where

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

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

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

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

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

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

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

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

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

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

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

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

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

15. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made within the relevant territory in the relevant period, and in respect of the goods as registered.

Relevant case law

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

“114. The 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*, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky - Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C- 495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Behher 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].”

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue, namely 02 April 2016 to 01 April 2021.

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

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

And further at paragraph 28:

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

19. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.⁴ Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."

20. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

"[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in

⁴ Case BL O/424/14

the form of, for example, a birth certificate will be required. It all depends on who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.”

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

21. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

Form of the mark

PURE SENSE



TEOSYAL® PURESENSE

23. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) found that “use of a mark, in its literal sense,

generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark”, but that “a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

24. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

25. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

26. As a result, in accordance with *Colloseum*, I consider the marks shown above are examples of use of the opponent’s registration as registered. Whilst it is acknowledged that the registration is for the words PURE SENSE and there is use of these words preceded by the word TEOSYAL[®], the mark as registered will still be perceived as indicative of the origin of the goods. Furthermore, I find that, in

accordance with *Nirvana* (cited above), the conjoining of the words PURE SENSE does not affect the distinctive character of the of the registered mark given that it will be perceived as the two words. Likewise, the distinctive character of the words is not affected by presenting them in the colour blue or placing them on a blue background. Accordingly, I find that the marks shown above are acceptable variants of the opponent's registration.

Genuine use

27. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the UKTM, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period. Given that the earlier mark is a comparable mark, the relevant territory during the five-year period is the UK, though use in the EU before IP completion day may be sufficient. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods for which use has been shown;
- iv) The nature of those goods and the market(s) for them; and
- v) The geographical extent of the use shown.

28. 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.⁵

29. The opponent claims to have used its earlier mark in relation to the following goods:

Class 5 Sterile implantable products administered through injection by healthcare specialists and use for filling wrinkles, fine lines, skin depressions and for increasing lip volume; non⁶ of the aforesaid goods being sold through retails stores, supermarkets or pharmacies.

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

⁶ I consider this to be a grammatical error which should read "none".

30. In his witness statement, Mr Calvayrac gives evidence that the opponent was founded in 2003 in Switzerland and has subsidiary companies in France, UK, Spain, Italy, Germany, Poland, Russia, UAE, Singapore, Australia and Brazil. Mr Calvayrac submits that the opponent's company manufactures hyaluronic acid dermal fillers and skincare products and is a major player in aesthetic medicine and skincare, selling products in over 90 countries worldwide including the UK and various member states of the EU. Mr Calvayrac adds that the opponent has used the trade mark continuously since 2016.

31. Exhibit PC1 contains an English language product brochure and German language product advertisements. There are no dates visible on any pages of the brochure or the product advertisements however, Mr Calvayrac's witness statement states that the brochure is dated from 2018. The earlier mark is visible on the majority of the 11 pages contained in the exhibit, however due to the reproduction quality of the pages numbered 9, 10 and 11 (relating to product advertisements), the mark is unreadable.

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Year	UK	Europe
2016	4,519,051	9,411,794
2017	4,951,270	11,178,161
2018	4,676,671	11,620,362
2019	3,907,628	12,891,529
2020	2,949,136	12,153,611

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Year	UK	Europe
2019	339,000	2,149,000
2020	197,000	1,247,000

34. The turnover figures are supported by 4 invoices produced in Exhibit PC2. The invoices demonstrate sales of goods, bearing the earlier trade mark, to the

opponent's UK subsidiary. The invoices are dated between 2016 and 2021. The invoices show use of the earlier mark in relation to 'dermal fillers' and 'medical devices'. The product descriptions align with those shown in the brochure evidence. While the brochure evidence, by itself, would not be sufficient to show use it does corroborate the invoice evidence and assists in my assessment of genuine use. By examining these invoices, I am satisfied that there have been sales to the UK between 2016 and 2021 for products listed in the brochure evidence. The earlier mark is visible on all of the invoices and as such I am satisfied that the sales of these goods were made under that mark. The invoice amounts are shown in euros.

35. Exhibit PC3 relates to internet printouts obtained from 'The Wayback Machine', (a digital archive website). The printouts show goods bearing the earlier trade mark for sale in the UK. While there are no clear dates on these printouts, in his witness statement Mr Calvayrac submits that they all relate to the relevant 5 year period.

36. Moving now to Ms Mann's submissions. In her witness statement, Ms Mann submits that the opponent's goods in Class 5 relate to dermal fillers, sometimes referred to as 'injectables'. In support of this statement Exhibit CLM1 contains a selection of internet extracts showing the word 'injectables' being used in the UK in relation to goods offered by the opponent.

37. Exhibit CLM2 relates to internet printouts obtained from various websites, relating to Botulinum Toxin (Botox). Ms Mann submits that Botulinum Toxin (Botox) is a product that falls into the category of 'injectables' and is commonly offered alongside the opponent's goods. Ms Mann adds that the products are not sold in retail environments but rather to medical professionals who will be well aware of the differences.

38. Exhibit CLM3 relates to internet printouts obtained from an NHS (National Health Service) website. The printouts relate to the treatment of urinary incontinence using Botulinum Toxin (Botox) injections.

39. Exhibit CLM4 relates to internet printouts taken from 'fillerworld.com' featuring dermal filler and Botulinum Toxin (Botox) products. Ms Mann submits that this

evidence demonstrates that these goods can be purchased through the same trade channels in the UK.

40. All four exhibits produced by Ms Mann are undated and do not feature the opponent or the opponent's mark. However, I appreciate that such evidence appears to have been filed not as proof of use of the earlier mark but in relation to the comparison of the parties' goods.

41. As the earlier mark is a comparable mark the opponent is entitled to show use in the EU prior to IP completion day. I bear in mind that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM, even where there are no special factors, such as the market for the goods being limited to that area of the Union.⁷

42. I remind myself that use does not have to be quantitatively significant to be genuine. It is apparent that the opponent has used the mark in relation to implantable products, such as dermal fillers, that are administered through injections by healthcare specialists, during the relevant period, and that these goods have been available to purchase in the UK as the evidence sufficiently demonstrates sales of the opponent's relevant goods to the opponent's UK subsidiary within the relevant period. As such, I am satisfied that the opponent has attempted to create and maintain a market for the goods at issue in the UK, under the mark. Accordingly, I am satisfied that the opponent has demonstrated genuine use of its mark in the UK during the relevant period.

Fair specification

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

⁷ *TVR Automotive Ltd v OHIM* T-398/13

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 (at [47]):

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

The opponent's Class 5 goods

45. The opponent relies upon the following goods:

Class 5 Sterile implantable products administered through injection by healthcare specialists and use for filling wrinkles, fine lines, skin depressions and for increasing lip volume; non of the aforesaid goods being sold through retails stores, supermarkets or pharmacies.

46. From the evidence I have been provided with, I find that the opponent has shown use of its trade mark in relation to the sale of *injectable dermal fillers* which could reasonably relate to the *sterile implantable products administered through injection* relied upon. Accordingly, the opponent may rely on all the Class 5 goods contained in its specification for the purpose of these proceedings.

Section 5(2)(b)

47. Sections 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because-

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

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

Relevant law

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

49. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International

Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

50. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

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

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

52. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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 light of my findings above, the competing goods are shown below:

The opponent's specification (following proof of use)

Class 5 Sterile implantable products administered through injection by healthcare specialists and use for filling wrinkles, fine lines, skin depressions and for increasing lip volume; non of the aforesaid goods being sold through retails stores, supermarkets or pharmacies.

The applicant's specification (as opposed)

Class 5 Incontinence napkins; Incontinence garments; Napkins for incontinents; Diapers for incontinence; incontinence pads; Incontinents (Napkins for -); Disposable diapers for incontinence; Pants, absorbent, for incontinence; Disposable pads for incontinence; Diapers for incontinents; Underpads for incontinents; Pants, absorbent, for incontinents; Nappies for babies and incontinents; Disposable liners for incontinence diapers; Nappies of paper for incontinents; Nappy pants for incontinents; Disposable napkins for incontinents; Incontinents (Pants, absorbent, for -); Pant liners for incontinents; Disposable diapers of paper for incontinents; Nappy liners of paper for incontinents; Disposable napkins of paper for incontinents; Disposable napkins of cellulose for incontinents; Disposable nappies made of cellulose for incontinents; Nappy liners of cellulose for incontinents; Disposable nappies made of paper for incontinents; Sanitary pads; Menstruation pads; Babies' diapers ;Incontinence diapers; Paper diapers; Disposable diapers; Adult diapers; Baby diapers; Cloth diapers; Diaper liners; Disposable paper diapers; Diapers for pets; Babies' diapers [napkins]; Napkins (Babies' -) [diapers]; Babies' diaper-pants; Disposable adult diapers; Babies' swim diapers; Disposable baby diapers; Diapers for babies; Babies' napkins [diapers]; Diapers [babies' napkins]; Diaper-pants (Babies' -); Disposable pet diapers; Medicated diaper rash ointment; Babies' diapers of paper; Paper diapers for babies; Disposable babies' diaper-pants; Paper diapers for infants; Nappies as baby diapers; Paper liners for diapers; Diapers made of paper; Diapers made of cellulose; Disposable training pants [diapers]; Infants' disposable diapers of paper; Babies' napkin-pants [diaper-pants]; Disposable swim diapers for babies; Swim diapers, reusable, for babies; Infants' diapers [disposable] of paper; Infants' disposable diapers of cellulose; Infants' diapers [disposable] of cellulose; Disposable liners for babies' diapers; Swim diapers, disposable, for babies; Disposable diapers of cellulose for incontinents; Babies' diapers of cellulose or paper; Absorbent diapers

of paper for pets; Babies' disposable diaper pants of paper; Absorbent diapers of cellulose for pets; Disposable diapers of cellulose for babies; Triangular-shaped diapers [paper] for babies; Disposable diapers of paper for babies; Babies' disposable diaper pants of cellulose; Diaper changing mats, disposable, for babies; Disposable babies' diapers of paper and cellulose; Disposable swim diapers for children and infants; Nappy covers; Disposable nappies; Babies' nappies; Nappy cream [medicated];Nappies for babies; Babies' nappy-pants; Disposable nappy liners; Medicated nappy rash lotions; Paper nappies for infants; Paper nappies for babies; Medicated nappy rash ointments; Nappies of cellulose for babies; Swim nappies, reusable, for babies; Ointments for treating nappy rash; Swim nappies, disposable, for babies; Nappies of paper for babies; Babies' nappies [paper or cellulose];Nappy changing mats, disposable, for babies; Disposable nappies made of cellulose for babies; Disposable nappies made of cellulose for infants; Disposable nappies made of paper for babies; Disposable nappies made of paper for infants; Panty liners; Panty liners [sanitary];Protective panty liners; Sanitary panty liners; Protective liners for panties; Disposable liners of cellulose for napkins; Medicated talcum powder; Talcum powder (Medicated -) for babies; Medicated body powder; Athletes' foot powders; Medicated baby powders; Babies' napkins; Napkin-pants (Babies' -).

Class 10 Incontinence sheets; Sheets (Incontinence -);Incontinence bed pads; Sheets for incontinents; Incontinence mattress protectors; Female urinary incontinence devices; Incontinence sheets for use with infants; Sheets made of rubber for incontinence; Incontinence sheets for use with babies; Apparatus for use in the control of incontinence; Water bags for medical purposes; Hot therapy apparatus; Hot therapy instruments; Heat therapy apparatus; Baby bottles; Baby dummies; Baby nursers; Babies' bottles; Pacifiers [babies dummies];Dummies [baby soothers].

54. With regard to the similarity of the goods the opponent states the following:⁸

“The goods covered by the mark applied for and the earlier mark are similar. All relate to the general field of healthcare. A main function of the Opponent’s

⁸ Submissions filed with the TM7.

goods is to improve the appearance of the skin/body so they can be described as skincare products. The applicant's powders and ointments in Class 5 are also skincare products so have the same overall purpose of the Opponent's goods. The Opponent's goods are sometime referred to as injectables. They are commonly used in combination with injectables which can be used to treat incontinence. Many of the Applicant's goods in Classes 5 and 10 are for dealing with the condition of incontinence. In view of the similarities between the parties' marks and goods, the Opponent submits that there is a likelihood of confusion on the part of the public, which includes the likelihood of association."

55. With regard to the similarity of the goods, in its submissions the applicant states the following:⁹

"Upon analysing the opponent's product in this category, we cannot find any product that is comparable to the range of categories that Sure Sense has applied for registration of their brandname [sic] e.g. Diapers and incontinence products. There are major differences in the brand names and usage of Teoxane's products to that under the Sure Sense brand.

As claimed by the opponent, categorises [sic] of Class 5 and Class 10 that Sure Sense has made an application for has no mention of 'injectables' or 'fillers' (Dermal or lip) in the category of products applied.

Sure Sense products are intended to provide leak protection against incontinence e.g. diapers, menstrual products, period pants, underwear and liners and are Non Invasive [sic] products (that donot [sic] contain Botox).

Sure Sense products are not attempting to cure any medical conditions but assisting to provide protection with externally worn products to lead an everyday normal life for people suffering from incontinence.

⁹ Submissions filed in the evidence rounds.

Sure Sense products are over the counter only and donot [sic] require any healthcare specialists to administer or any medical prescription to be eligible for usage.”

56. The opponent’s goods are *sterile implantable products administered through injection by healthcare specialists* for the sole purpose of filling wrinkles, fine lines, skin depressions and for increasing lip volume (as per the registered specification) and are therefore used in order to improve or enhance the appearance of lips and skin. Furthermore, as claimed in Class 5 of their registration, the opponent’s goods will only be administered by healthcare specialists and will not be sold through retail stores, supermarkets, or pharmacies.

57. Conversely, the applicant’s goods in Class 5 are, *napkins, diapers, pants, nappy pants, liners, pads, etc.* (intended for babies, and to provide leak protection against incontinence and menstruation); and *medicated nappy creams, nappy rash lotions and ointments, medicated talcum powder, athletes’ foot powders and medicated baby powders.*

58. I am unable to agree with the opponent’s submissions that the applicant’s ‘skincare products’ in Class 5 have the same overall purpose as the opponent’s Class 5 goods. The applicant’s ‘skincare products’ in Class 5 relate to powders, lotions, creams and ointments for the treatment of nappy rash and athletes’ foot, whereas the opponent’s Class 5 goods are implantable products administered through injection for filling wrinkles, fine lines, skin depressions and for increasing lip volume, therefore I see no obvious similarity between these goods.

59. I agree with the opponent’s viewpoint that the main function of its goods is to improve the appearance of the skin/body. However, whilst the applicant’s powders, lotions, creams and ointments can also be described as ‘skincare products’, they have the specific purpose of treating nappy rash and athletes’ foot and not for improving the appearance of wrinkles, fine lines, skin depressions and lip volume.

60. The opponent is claiming similarity between its goods and the applicant’s incontinence products on the basis that their Class 5 goods are sometimes referred to as ‘injectables’ which are commonly used in combination with ‘injectables’ which

can be used to treat incontinence. However, whilst it may be the case that 'injectables' can be used to treat incontinence, whether the goods at issue are similar or not must be based on those goods covered by the registration and application. Furthermore, even if the opponent had shown use of its 'injectables' for the purpose of treating incontinence, which it has not, it would not be able to rely upon such goods given that the registered specification specifically limits the use of its implantable products for filling wrinkles, fine lines, skin depressions and for increasing lip volume. Therefore, the fact that such goods may also be used in combination with 'injectables' used to treat incontinence has no bearing on whether the goods are similar or not as I can only compare the goods at issue.

61. Whilst I note that the opponent has grouped all the competing goods at issue under the very broad field of 'healthcare',¹⁰ I find that the competing goods have no relevant factors in common. Merely because the goods at issue can be considered as 'healthcare' goods is not a sufficient factor for a finding of similarity. It has to be put forward that the healthcare industry encompasses a wide range of goods with very different natures. Furthermore, the healthcare products might be manufactured by different undertakings specialised in a specific field within the healthcare industry. Therefore, although the competing goods may well be considered 'healthcare' products the contested goods have different natures, different users and satisfy different purposes to the opponent's goods. Moreover, they differ in their usual producers and are not in competition, nor are they complementary, in the sense that one product is indispensable for the use of the other. Consequently, I find that the contested goods and the opponent's goods are dissimilar.

62. The opponent has made no submissions in relation to the comparison between the applicant's Class 10 goods and its Class 5 goods beyond its suggestion in its statement of grounds that they are similar. However, again, I see no obvious similarity between the above-listed specifications.

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

¹⁰ Written submissions.

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

64. Since I have found no similarity between the competing goods, there can be no likelihood of confusion under section 5(2)(b).

CONCLUSION

65. The opposition has failed and the application may proceed to registration in full.

COSTS

66. The applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited the applicant to indicate whether it wished to make a request for an award of costs and, if so, to complete a pro-forma including a breakdown of its actual costs. The applicant failed to return the pro-forma. As it incurred no official fees in the defence of its application, I make no award of costs in this matter.

Dated this 7th day of December 2022

**Sam Congreve
For the Registrar**