O/0127/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003910527

BY ARACARI SALES LIMITED

TO REGISTER THE TRADE MARK:

Vivid

IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 442745

BY VIVID VITALITY LTD

AND

IN THE MATTER OF APPLICATION NO. UK00003912165

BY VIVID VITALITY LTD

TO REGISTER THE TRADE MARK:

VIVID

IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 442869

BY ARACARI SALES LIMITED

BACKGROUND AND PLEADINGS

1. This decision involves cross-consolidated proceedings wherein Vivid Vitality Limited ("VVL") and Aracari Sales Limited ("ASL") brought actions against one another. I will summarise the relevant proceedings below, beginning with VVL's opposition on the basis that it was brought first.

VVL's opposition

2. On 11 May 2023, ASL applied to register the **Vivid** word mark ("**527 Mark**") shown on the cover page of this decision in the UK. The application was published for opposition purposes on 26 May 2023, and ASL seeks registration for the following goods:

Class 5 Food supplements; Medicated food supplements; Dietary food supplements.

3. The application was fully opposed by VVL on 29 August 2023, based upon sections 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under section 5(2)(a), VVL rely upon the following mark:

VIVID

UK trade mark registration no. UK00002651316
Filing date 7 February 2013; Registration date 21 June 2013.
("VVL's First Earlier Mark")

4. Under section 5(2)(b), VVL relies upon the following marks:

Comparable UK trade mark (EU) registration no. UK00912068771

Filing date 15 August 2013; Registration date 19 March 2014.
("VVL's Second Earlier Mark")

Comparable UK trade mark (EU) registration no. UK00915929011
Filing date 14 October 2016; Registration date 1 February 2017.
("VVL's Third Earlier Mark")

5. I bear in mind that VVL's Second and Third Earlier Marks are comparable EU marks. Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

6. Under sections 5(2)(a) and 5(2)(b), VVL relies upon all of the goods and services covered by all three earlier marks, contained in Annex 1 to this decision. VVL claims that there is a likelihood of confusion on the basis that there is a high degree of overlap between the parties goods, and that the marks are identical or highly similar.

7. Under section 5(3), VVL relies upon all of the goods and services covered by all three earlier marks, contained in Annex 1 to this decision. VVL claims that they believe the link between the parties "is clear and obvious", which is strengthened by the fact that there are "two key distribution routes" where VVL has a strong presence. VVL claims that they have been in business for over a decade, providing goods under its marks for over 9 years, and that the "goods are natural variants of its current product range and the potential damage caused" by ASL would not only negatively impact the

launch of VVL's class 5 goods but "may well affect the perception of [VVL's] products in classes 30 & 32".

8. Under section 5(4)(a), VVL relies upon the following three signs:

VIVID

9. VVL claims to have used the above signs throughout the UK since 2014 for "all the goods for which it is registered" or "ALL GOODS / SERVICES". I therefore find that VVL is relying upon all of the goods and services which are listed in Annex 1 to this decision. Nevertheless, VVL states that they possess substantial goodwill for their VIVID brand in relation to teas, herbal teas and related drinks products. VVL also states that there would be a misrepresentation on the basis that ASL's identically named supplements "could actually be derived from the same ingredients that [VVL] uses and could offer exactly the same health and well-being benefits", and therefore ASL's goods could be mistakenly purchased in the belief that they are the goods of VVL. VVL therefore states that damage or likely damage would occur in the potential diversion of sales, or if ASL produced an inferior or unsafe product.

10. ASL filed a counterstatement denying all of the claims made and subject all of VVL's earlier marks to proof of use.

ASL's opposition

11. On 16 May 2023, VVL applied to register the **VIVID** word mark ("**165 Mark**") shown on the cover page of this decision in the UK. The application was published for opposition purposes on 2 June 2023, and VVL seeks registration of the following goods:

Class 5 Food supplements; medicated food supplements; dietary food supplements; medicinal tea; herbal tea for medicinal use.

12. The application was fully opposed by ASL on 4 September 2023 under sections 5(1) and 5(2)(a) of the Act.

13. Under both sections, ASL relies upon its **527 Mark**. Under section 5(1), ASL claims that the marks and goods are identical. Under section 5(2)(a), ASL claims that the marks are identical and the goods are either identical or closely similar.

14. VVL filed a counterstatement admitting that the marks are identical and the goods are identical or highly similar. I consider it reasonable to infer that VVL made these admissions on the basis that they rely upon its own aforementioned opposition to defeat ASL's opposition.

15. VVL is represented by Abion UK Limited and ASL is represented by Broadfield UK LLP. Both parties filed evidence in chief. ASL filed written submissions during the evidence rounds and VVL filed evidence in reply. Neither party requested a hearing, however, ASL filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

17. VVL's evidence consists of the witness statement of Mr James Shillcock dated April 2024 and the confidential statement of Mr Shillcock dated 8 April 2024. Mr Shillcock is the director of VVL, a position he has held since 26 January 2011. Mr Shillcock's statement is accompanied by 35 annexes (1 to 14E and A to K).

18. Mr Shillock's evidence is subject to a confidentiality order granted by a different hearing officer, dated 16 July 2024. The order covers his confidential statement and accompanying annexes A to K.

19. ASL's evidence includes the witness statement of James Northcott dated 8 April 2024. Mr Northcott is the director of ASL and his statement is accompanied by 10 exhibits (JN1-JN10).

20. VVL's evidence in reply consists of the second witness statement of Mr Shillcock dated 9 June 2024. Mr Shillcock's statement is accompanied by 9 annexes (1-9).

21. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

MY APPROACH TO THE OPPOSITIONS

22. VVL's opposition could have an impact on ASL's opposition, in that the level of success (if any) will determine what goods ASL can rely upon in its opposition against VVL's mark. However, if ASL's **527 Mark** is successfully opposed in full, it will not constitute as an earlier mark for the purpose of its opposition against VVL's mark, and ASL's opposition would consequently fall away.

DECISION

VVL's opposition under Sections 5(2)(a) and 5(2)(b)

23. Section 5(2) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected

(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."

24. VVL's marks qualify as earlier marks in accordance with section 6(1)(a) of the Act as their filing dates are earlier than the filing date of ASL's mark. As VVL's marks have completed their registration process more than five years before the filing date of the mark in issue (**527 Mark**), they are subject to proof of use pursuant to section 6A of the Act.

Proof of use

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

26. Section 6A of the Act states:

"(1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

27. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five years ending on the filing date of ASL's **527 Mark**, i.e. 12 May 2018 to 11 May 2023.

28. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].
>
> (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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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]."

Evidence of use

29. Mr Shillcock confirms that the products sold under the Vivid brand are matcha powders and drinks, and in his witness statement, he provides the following undated photo of VVL's VIVID matcha goods:

30. At paragraph 11 of his witness statement, Mr Shillcock also provides a list of "SKUs" that have been available to consumers since 2013, including;

1. Vivid Matcha lime ginger honey 330ml
2. Vivid Matcha grape & elderflower 330ml
3. Vivid Matcha pear & rhubarb 330ml
4. Vivid Matcha unsweetened 330ml
5. Vivid Matcha unsweetened lemon 330ml
6. Vivid Matcha unsweetened elderflower 330ml
7. Vivid Matcha green tea brainbox pack

8. Vivid Matcha green tea powder 30g pouch
9. Vivid Matcha green tea sachets 1g sachets (7 x 1g)

31. I note that the "Vivid Matcha lime ginger honey 330ml" and "Vivid Matcha grape & elderflower 300ml" goods are pictured in the white and orange drink containers contained in paragraph 29 above. An undated photo of the "Vivid Matcha green tea brainbox pack" which was developed exclusively for their retailer Holland & Barrett is also contained at paragraph 12 of Mr Shillcock's statement, as follows:

32. However, Mr Shillcock does not confirm when the brainbox goods were sold or how many. Mr Shillcock also provides the following photos in his witness statement, which he dates as being from 2015 (before the relevant period), showing "Vivid Matcha unsweetened 330ml" and "Vivid Matcha green tea powder 30g pouch" displayed in Wholefoods Market, the stores of which are based in Kensington and Piccadilly, London:

33. Mr Shillcock describes Wholefoods Market as being one of the words leading retailers, albeit he does not provide any evidence to support this statement. The only evidence in regard to Wholefoods Market is contained in **annex 4**, which includes an email chain between it and VVL dated 2 and 3 September 2013. Wholefoods Market states that it is toying with the idea of making a matcha section for their upcoming Fulham store in March 2014, whilst also ordering "24 units of samples for the meeting" with the Executive VP, coordinators and store team leaders to discuss "innovation" in their stores. The photographic evidence dated from 2015 suggests that following the email communication in 2013, they stocked VIVID matcha products in their London stores. However, I have not been provided any evidence to confirm how many VIVID products were subsequently ordered and sold by Wholefoods Market during the relevant period.

34. Mr Shillcock states that VVL launched at other retailers including Selfridges, Planet Organic, Ocado and Waitrose. To support this, Mr Shillcock has provided the following evidence:

a) **Annex 5** contains an email chain between VVL and Selfridges dated between 11 June 2013 and 14 October 2013. The emails discuss Selfridges stocking Vivid. Albeit the email evidence does not explicitly state what "Vivid" product they were to stock, the email subject is clearly headed "Vivid Matcha". Whilst the emails discuss the amount Selfridges was to purchase/stock, the emails do not clearly show what the outcome of this discussion was i.e. how many goods were actually purchased by Selfridges.

b) **Annex 6** contains one invoice from VVL to Waitrose dated 27 February 2014, showing the purchase of 12 x 52 "VIVID MATCHA GRAPE&ELDER" and 12 x104 "VIVID MATCH LIME GING&HO". I find that these goods match items number 1 and 2 of the SKU list provided by Mr Shillcock in paragraph 30 above.

c) **Annex 7** contains an email chain between VVL and Chilled Food dated between 7 January 2015 and 20 January 2015. This confirms that Vivid drinks will be launching in "London Stores on the 9th Feb".

d) **Annex 8** contains an email chain between VVL and Holland and Barrett dated between 11 August 2014 and 22 September 2014 setting up VVL as a supplier. In paragraph 39 of Mr Shillcock's witness statement, he confirms that Holland & Barrett are their longest standing national customer.

e) **Annex 9** contains an undated screenshot of Holland and Barrett's website listing Vivid Matcha Green Tea Powder for sale. While the product has 5 reviews, they are dated, for example, "5 months ago". Therefore, without specific dates, I am unable to ascertain when these goods were purchased.

f) **Annex 10** contains an email dated 4 March 2017 from Tesco to VVL, setting up their "supplier number". This is supported by paragraph 24 of Mr Shillcock's witness statement, whereby he confirms that Vivid launched with Tesco's in 2017 and they traded with them until their contract was terminated in 2021.

35. VVL also produced a range of superfood latte supplement powders which Mr Shillcock states was sold on Vivid's website (vividdrinks.com) and also "developed exclusively for Ocado for a limited time only" between 2018 to 2019. I note that the superfood latte supplement powders were packaged as follows:[1]

[1] An undated photo from Mr Shillcock's witness statement

36. In 2019, VVL scaled back their product range to focus exclusively on matcha powder.[2] However, Mr Shillock does not confirm from what specific date or month that their range was reduced.

37. Mr Shillcock states that since Vivid was launched, the brand has generated over £2 million in gross sales in the UK. He provides the following breakdown of Vivid sales at paragraph 33 of his witness statement, including those which were made during relevant period:

	Units	**Sales Value (£)**
Feb 2018 – Jan 2019	114,612	224,773
Feb 2019 – Jan 2020	31,750	97,009
Feb 2020 – Jan 2021	37,622	174,189
Feb 2021 – Jan 2022	42,870	193,693
Feb 2022 – Dec 2022	44,862	261,000
Jan 2023 – Dec 2023	19,554	170,470

38. I bear in mind that any unit or sales figures that are from before May 2018 and after May 2023 fall outside of the relevant period. I also note that I have not been provided with a breakdown of these sales by product. However, based on paragraph 36 above, it is reasonable to infer that all of the sales made from February 2020 to December 2022 would have only pertained to its matcha powder goods, which is likely to encompass matcha powder pouches and sachets.

39. In regard to the marketing evidence provided by VVL, I note that the majority of it is dated before May 2018. For example, VVL won the best new drinks brand by FoodBev.com, but this was back in 2013[3] (5 years before the relevant date). I also note that a .com website can be accessed all over the world, and therefore, without any further supporting evidence, I am unable to determine or confirm how many UK consumers would have read or been exposed to this article. Furthermore, while I have been provided with a list of events in paragraph 27 of Mr Shillcock's witness statement

[2] Paragraph 17 of Mr Shillcock's witness statement
[3] **Annex 10F**

that were attended by, or sponsored by VVL, these were all held from 2013 to 2015, being at least 3 years before the relevant date.

40. I also bear in mind that in 2017, VVL "invested in a significant advertising campaign on the London Underground, across 150 sites at major tube and rail stations", the list of which is contained in **annex 12**. To support this, I have been provided with an undated photo of the poster which Mr Shillcock states was used at these stations:

41. This evidence may have been relevant if Mr Shillcock confirmed when in 2017 these posters were erected, and for how long they were displayed for, on the basis that they could have stayed displayed during or at the beginning of, the relevant period. However, without this information, I am unable to determine if UK consumers were exposed to this advertising during the relevant period. Therefore, I find that VVL's marketing evidence is of no assistance.

Assessment of genuine use

42. As far as the form of the marks are concerned, I am satisfied that they have all been used as registered in the photographic evidence. I will now consider whether the evidence shows that the earlier mark has been genuinely used during the relevant 5 year period.

43. 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.[4] As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

44. 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."

45. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. 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

[4] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

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 the form of, for example, a birth certificate will be required. It all depends 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."

46. The case law summarised in the passage from *easygroup* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL

O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

47. Where proof of use is required, it is typical to see evidence such as turnover figures and invoices showing the sale of its goods to distributors (such as supermarkets) and/or UK customers. While I have clearly been provided with annual sales figures for the relevant period (which have been broken down by year), I have not been provided with any supporting evidence such as invoices or receipts showing the sale of VVL's matcha goods to the general public, nor have I been provided with invoices of sales made to distributors which are dated within the relevant period. On this point, I bear in mind that in the *PILLOW TALK* case,[5] Thomas Mitcheson KC, sitting as the Appointed Person, upheld the Hearing Officer's decision to reject, as evidence of use of a trade mark, the statement: "average annual turnover of the goods in Class 28, using the 'Pillow Talk' mark, during the relevant period, was £45,000" on the basis that additional material in support of this statement (that was likely to exist) was non-existent.

48. The only invoice evidence provided which shows the sale of VVL's goods to Waitrose is dated 4 years before the relevant period, and the remaining evidence which shows that its goods were stocked by other retailers is incredibly limited. For example, the email exchange between VVL and Selfridges and Chilled Food in 2014 shows that Vivid goods were *going* to be stocked, but there is no supporting evidence such as invoices showing how many goods were actually purchased and subsequently sold in store. The Tesco and Holland & Barratt evidence shows that VVL was set up as a supplier in 2014 and 2017, but again, I have no supporting invoice evidence

[5] BL O/1160/23

showing these goods being sold to these suppliers, or how these goods were displayed in their stores. I also note that the only screenshot evidence of the goods being sold by Holland & Barratt on their website is undated and the reviews within the screenshot do not contain specific dates in order for me to ascertain when these goods were purchased by the general public.

49. I also note that Mr Shillcock makes reference to VVL having a website whereby consumers could purchase their goods. However, I have not been provided with any screenshot evidence showing how its website was presented to consumers. Moreover, it is a .com website which can therefore be accessed by consumers worldwide. On this basis, it is unknown whether this website was aimed at users based in the UK. I have also not been provided with any evidence of UK user engagement with the website (such as user or viewing figures) or any confirmation as to what sales were made from it. Furthermore, based on the evidence before me, I am unable to determine what were sales directly to customers and which ones were to their retailers. This leads to another limitation with VVL's evidence, being that it is not clear how, or whether, VVL's marks were shown to the end-consumer or an intermediary, such as their listed retailers. The only thing that I can infer, in regard to the sales figures provided, is that the goods sold between 2019 to 2023 were likely to be matcha powder only.[6] Nevertheless, VVL has not provided any dated evidence from the relevant period which shows the packaging of its matcha powder goods.[7]

50. Unlike the *PILLOW TALK* case, I have been provided with more than just an approximate sales figure for the relevant period. However, parallel to the *PILLOW TALK* case, I find that the absence of any dated material during the relevant period amounts to "a fundamental inadequacy" which allows me to be sceptical of the sales figures provided.[8] Thus, taking all of the above into account, I find that none of VVL's evidence supports Mr Shillcock's statement on the sales made under the Vivid marks during the relevant period, and I therefore reject it as it is insufficiently solid. Moreover, without any invoice evidence dated from the relevant period, VVL's annual turnover

[6] Paragraph 17 of Mr Shillcock's witness statement
[7] It can only be determined that the photo which contains the "Superfood latte supplement powders", developed for Ocado, shows how these goods were packaged when they were available between 2018 to 2019.
[8] Paragraph 14 of *PILLOW TALK* BL O/1160/23

alone does not allow me to discern the scale, frequency, and territorial extent of the use of VVL's marks in the UK, which are all important factors in establishing genuine use. I also find that invoice evidence is plainly information which should have been available and relatively easy to provide, which would have allowed me to determine what and how many goods were sold to the aforementioned retailers, or if there were sales directly to customers geographically spread across the UK. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by VVL is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, as highlighted above, there is very little evidence of other activity in this case. I also bear in mind that I have not been provided with any marketing figures, and the evidence of marketing is of no assistance as it all pertains to before the relevant period (and usually a number of years before).

51. Therefore, taking the evidence as a whole, including the absence of any information regarding advertising material aimed at the end-user or retailer from the relevant period, combined with no dated screenshots of VVL's goods being offered for sale, and the absence of invoice evidence from the relevant period, leads me to find that VVL's evidence is insufficiently solid in showing that its marks have been genuinely used during the relevant period on any of its goods or services. The consequence of my finding is that the First, Second and Third Earlier Marks may not be relied upon under sections 5(2)(a) and 5(2)(b) in these proceedings. As these are the only registered earlier rights being relied upon by VVL in these proceedings, the section 5(2) claims fail.

52. For the sake of completeness, I bear in mind that I have not referred to any of VVL's confidential evidence. This is on the basis that it does not refer to use of the mark during the relevant period. [redacted]. Consequently, it does not assist them.

Section 5(3)

53. Section 5(3) of the Act states:

> "5(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 repute of the earlier trade mark."

54. Section 5(3) also relies on VVL having earlier trade marks. However, as noted above, VVL has failed to establish use of its earlier marks and therefore the First, Second and Third Earlier Marks may not be relied upon under section 5(3) either. As these are the only registered earlier rights being relied upon by VVL in these proceedings, the section 5(3) claim also fails.

Section 5(4)(a)

55. Section 5(4)(a) of the Act states as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

aa)…

b) …

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

56. Subsection (4A) of section 5 of the Act states:

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

57. 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

58. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated 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) proceedings as follows: 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before

the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

59. Mr Northcott has not provided any dated evidence of use of its mark. On this basis, I have only the prima facie relevant date to consider i.e. the filing date of ASL's **527 Mark**, 11 May 2023.

Goodwill

60. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

61. 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 off 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 that 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;

54 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."

62. 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."

63. As noted above, the evidence provided by VVL is extremely limited. However, under section 5(4)(a), I am able to consider all of the evidence which is dated before 12 May 2018. Therefore, I note that the breakdown of the £2 million gross sales for the brand VIVID, between 2013 to 2023, is as follows:

	qty units	Sales Value £
July2013 - Jan 2014	67,680	58,073
Feb 2014 - Jan 2015	252,732	201,607
Feb 2015 - Jan 2016	346,760	290,297
Feb 2016 - Jan 2017	231,844	210,189
Feb 2017 - Jan 2018	245,265	436,990

Feb 2018 - Jan 2019	114,612	224,773
Feb 2019 - Jan 2020	31,750	97,009
Feb 2020 - Jan 2021	37,622	174,189
Feb 2021- Jan 2022	42,870	193,693
Feb 2022- Dec 2022	44,862	261,400
Jan 2023- Dec 2023	19,554	170,470
	1,435,551	2,318,690

64. While these sales figures have not been broken down into the different products sold by VVL, in paragraph 17 of his witness statement, Mr Shillcock states that in 2019, VVL scaled back their product range to focus exclusively on matcha powder. Therefore, I can infer that all of the sales made from February 2020[9] to the relevant date were likely to be matcha powder. Moreover, from the evidence provided, I note that matcha powder can come in the form of pouches and sachets, and the only dated evidence I have of this packaging is circled in red in the following photo which Mr Shillcock dates as being from 2015 in Wholefood Market:

65. Mr Shillcock has also provided marketing evidence that might point to a level of awareness across the consumer base. In paragraph 27 of his witness statement, he

[9] As Mr Shillcock has not confirmed when in 2019 they limited their product range, based on the breakdown of sales before me, I can only confidently infer that the sales from February 2020 would be matcha powder only.

provides a list of events that were attended by, or sponsored by VVL, from 2013 to 2015. However, the accompanying evidence provided in **annexes 10B, 10C, 10D** and **10E** is extremely limited. For example, in **annex 10B,** it contains photographic evidence that VVL's sign was used on a photo backdrop for celebrities at the Sony Brits Music awards in 2015. However, Mr Shillcock has not stated how many attendees encountered the photo backdrop or how many people in the UK watched the event (assuming the photo backdrop appeared in the television coverage). I also have no narrative evidence confirming whether the photographs contained in the email evidence was published in any articles or on social media, for example. I am therefore unable to determine how many members of the UK public would have seen the photos or been exposed to VVL's mark from this event alone. Moreover, while **annex 10E** shows that VVL confirmed via email that they were to attend the London Coffee Festival in 2014, I have no accompanying photographs from that event to show how VVL marketed its goods, if any attendees brought VVL's matcha goods, or again, how many consumers were exposed to VVL's mark being used on its goods at this Festival.

66. While I have been provided with the London Underground poster evidence which was erected in 2017 at 150 "major tube and rail stations", I find that this evidence is limited. This is on the basis that, firstly, I have not been provided with any specific dates, including how long the posters were displayed for, in order to determine how long UK consumers were likely to be exposed to VVL's advertising. Secondly, the underground poster contained in paragraph 40 contains depictions of VIVID's unsweetened green tea drinks. However, Mr Shillock confirms in his witness statement that from 2019 onwards, VVL scaled back their product range to focus exclusively on matcha powder. Therefore, the only marketing evidence that points towards a level of awareness across UK customers is via products that were no longer produced and distributed by VVL by 2019.

67. At this point, I consider it important to return to the classic description of goodwill from the House of Lords in *Inland Revenue*, as being a "force", cited in paragraph 60 above. It is inherent in the nature of a "force" that it may weaken or strengthen over time. Under section 5(4)(a), I am required to assess the level of goodwill at a particular point in time, and I also consider that the effect of activities that generate goodwill may dissipate over time. For example, while the opponent may have attended the London

Coffee Festival in 2014, I note that this event occurred 9 years prior to the relevant date and therefore does little to support the claim that, as of the relevant date, goodwill existed. Again, bearing in mind the deficiencies of the VVL's London Underground evidence, I consider that this marketing evidence was likely to have generated some goodwill in 2017 (albeit I do not know exactly when). However, this is, at least, 6 years before the prima facie relevant date I must consider. The only consistent evidence that I have before me are VVL's sales which, whilst £2 million in turnover in 10 years may not be trivial, it is not particularly notable.[10] When considered in the context of the matcha market, I consider that the level of sales provided are low in comparison to the likely size of the UK market for matcha.

68. In a multifactorial assessment such as this, low sales figures need to be weighed against other factors, such as the nature of the market, patterns of custom, and evidence of promotional and marketing activity. In this case, I only have one invoice from VVL to Waitrose dated 27 February 2014, which is over 8 years before the prima facie relevant date. Therefore, I have no invoice evidence to show repeat or consistent custom from UK retailers or general public consumers. The only sufficient evidence of advertising is from 6 years before the prima facie relevant date. The only dated evidence that shows VVL's goods being sold in its Wholefood Market is from 2015 which is therefore around 8 years before the prima facie relevant date. Therefore, taking all of these factors into account, I find that VVL has not shown more than a goodwill of trivial extent. A significant factor in my making this finding is the lack of dated evidence from after 2018 demonstrating its sales via invoices, evidence of VVL's promotional activities or evidence showing use of its VVL's marks on its goods (for example, dated screenshots of its products being offered for sale on its own website or third party retailers websites).

69. I bear in mind that the law of passing off does not protect a goodwill of trivial extent.[11] In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities

[10] Whilst I note that these sales are not broken down by VVL's particular goods, I accept that I am not required to look at the evidence in the same level of granularity as I would were I to be assessing the use made of a trade mark: see *Mercis B.V. v Bunnyjuice Inc*, BL O/0064/24, paragraphs 54-60.
[11] *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

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

70. Therefore, taking all of the above into account and considering the position as at the relevant date, VVL's evidence falls short of proving the existence of any protectable level of goodwill in their business. The section 5(4)(a) claim therefore fails at the first hurdle.

CONCLUSION OF VVL'S OPPOSITION

71. VVL's opposition is unsuccessful, and ASL's **527 Mark** may proceed to registration for all of the goods applied for.

72. On this basis, ASL's **527 Mark** can be relied upon as an earlier mark for the purposes of its opposition of VVL's **165 Mark**, which I shall now consider.

ASL's opposition under sections 5(1) and 5(2)(a) of the Act

73. Section 5(1) of the Act reads as follows:

> "5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

74. Section 5(2)(a) reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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."

Identity of the marks

75. It is a prerequisite of sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held that:

"54… a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer."

76. ASL's and VVL's "Vivid"/"VIVID" word marks are self-evidently identical.

Comparison of goods

77. The competing goods are as follows:

ASL's goods	**VVL's goods**
Class 5 Food supplements; Medicated food supplements; Dietary food supplements.	Class 5 Food supplements; medicated food supplements; dietary food supplements; medicinal tea; herbal tea for medicinal use.

78. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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."

79. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

80. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM* – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

81. In *Kurt Hesse v OHIM,* Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

> "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

Food supplements; Medicated food supplements; Dietary food supplements.

82. The above terms appear identically in both parties' specifications.

Medicinal tea; Herbal tea for medicinal use.

83. At paragraph 19 of the ASL's grounds of opposition, they state that VVL's above goods are closely similar to their "medicated food supplements" and "dietary food supplements". They state that the "respective goods serve the same purpose, they are often manufactured by the same undertakings, they are directed at the same public, and they appear in the same specialised shops, or in the same supermarkets dealing in food supplements". At paragraph 5 of VVL's counterstatement, they state that they wholly agree with this statement, as they have been "producing and widely retailing such goods for over 10 years in the UK under the VIVID mark".

84. On the basis that the parties agree that there is an overlap in trade channels, purpose and user, I find that these are non-contentious points. I also find that due to their overlap in purpose, the goods may be in competition, if they offer the same health

or medical benefits. To the extent that the goods are all consumed, the parties goods will overlap in method of use. However, I appreciate that VVL's goods may either be drunk or eaten, whereas ASL's goods would only be eaten.

85. For the sake of completeness, I note that Mr Shillcock has provided evidence at **annexes 14A** to **14E** which he states shows that vitamin and supplement brands also sell teas. However, the evidence does not demonstrate this. For example, the evidence that pertains to the brand Huel in **annex 14b** shows that their mark was only registered for protein powders, dietary supplements, milks and powered food. It does not show that their mark was registered for teas, nor does the undated screenshot evidence of Huel's website show the sale of teas. In **annex 14c** Mr Shillcock has provided a printout of a Twinnings trade mark which is registered for herbal tea but is not registered for supplements. Therefore, I find that the evidence contained in **annexes 14A** to **14E** does not assist me.

86. Taking all of the above into account, bearing in mind that VVL admitted that its respective goods are identical or highly similar, I find that VVL's above goods are similar to a high degree to ASL's "medicated food supplements" and "dietary food supplements".

87. It is a prerequisite of section 5(1) that the goods be identical. Therefore, the opposition based upon section 5(1) succeeds for the following goods:

Class 5	Food supplements; Medicated food supplements; Dietary food supplements.

88. I will now proceed with the rest of ASL's opposition based upon section 5(2)(a) for the goods which I have found to be similar to a high degree.

Section 5(2) case law

89. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

(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.

The average consumer and the nature of the purchasing act

90. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

91. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average

consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

92. The average consumer for the parties goods will be members of the general public, however, I do not discount that it could also include a professional user such as a dietician. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The goods will also be purchased relatively frequently, especially if they are consumed daily as part of a diet.

93. The average consumer will take various factors into consideration such as the cost, quality, ingredients, and the suitability for their specific needs. I consider that the level of attention paid during the purchasing process for the goods will be medium.

94. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, pharmacy or online equivalent. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

Distinctive character of the earlier trade mark

95. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not 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 promotion of 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)."

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

97. As ASL has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider. ASL's mark is composed of the ordinary dictionary word "Vivid". I consider that this word is neither

allusive or descriptive of ASL's class 5 goods. Consequently, I consider that it is inherently distinctive to a medium degree.

Likelihood of confusion

98. I bear in mind that the parties marks are identical. Therefore, whilst confusion can be direct or indirect, my focus shall be on direct confusion, which involves the average consumer mistaking one mark for the other.

99. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including the following:

- I have found the opponent's mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods to be members of general public, and also professional users such as dietitians. The users will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical or similar to a high degree.

100. According to the interdependency principle, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa.[12] It therefore follows that as I have found the goods to be identical or similar to a high degree, on the basis that the marks are identical, the average consumer will clearly mistake one mark for the other.

101. I subsequently find there to be a likelihood of confusion for all of the goods that I have found to be identical or similar to a high degree. The opposition against VVL's **165 Mark** based upon section 5(2)(a) of the Act is fully successful.

[12] *Canon* paragraph 17

CONCLUSION

VVL's opposition

102. As noted in paragraph 71 above, VVL's opposition was unsuccessful in its entirety. ASL's **UK00003910527** Mark may proceed to registration for all of the goods applied for, that being:

Class 5 Food supplements; Medicated food supplements; Dietary food supplements.

ASL's opposition

103. As noted in paragraph 101 above, ASL's opposition was successful in its entirety. Therefore, VVL's **UK00003912165** application is refused in its entirety.

COSTS

104. ASL has been successful in both defending VVL's opposition and in its own opposition to VVL's mark, and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award ASL the sum of £1,000 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and Considering TPL's counterstatement	£250
Considering TPL's Notice of opposition and preparing a counterstatement	£250
Considering TPL's evidence, preparing and	£300[13]

[13] On the basis that the amount of evidence filed by TPL was light, and ASL filed limited evidence and submissions which were also not particularly helpful, I award ASL less than the usual scale for such.

filing evidence and submissions

Official Fee	£200
Total	**£1,000**

105. I therefore order Vivid Vitality Limited to pay Aracari Sales Limited the sum of £1,000. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of February 2026

L FAYTER

For the Registrar

ANNEX 1

VVL's First Earlier Mark

Class 32

Fruit drinks, fruit juices and iced teas.

Class 35

Retail services connected with the sale of tea, fruit drinks, fruit juices.

VVL's Second Earlier Mark

Class 30

Iced teas.

Class 32

Fruit drinks; fruit juices.

Class 35

Retail services connected with the sale of tea, fruit drinks, fruit juices.

VVL's Third Earlier Mark

Class 30

Tea; tea leaves; tea extracts and essences; green tea; tea powder; tea for infusions; flavourings of tea; tea-based beverages; Japanese green tea; Flavourings of tea for food or beverages; instant powder for making tea.