O/0165/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004112846
IN THE NAME OF DCP PROJECT LTD
TO REGISTER THE FOLLOWING TRADE MARK:

zonatural

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000452176
BY ZO SKIN HEALTH INC

Background and pleadings

1. On 16 October 2024**,** DCP PROJECT LTD ("the Applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 25 October 2024 in respect of the following goods:

   Class 3: Cosmetics; Skincare cosmetics; Hair cosmetics; Natural cosmetics.

2. On 27 January 2025, ZO Skin Health Inc ("the Opponent") opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all the goods in the application. The Opponent relies upon the following mark:

   # ZO SKIN HEALTH

   UK Registration no. UK00908708711
   Filing date: 24 November 2009
   Date of registration: 27 May 2010
   Relying upon the following goods and services:

   Class 3: Toiletries; cosmetics; non-medicated skin care preparations.

   Class 5: Pharmaceutical preparations; medicated skin care preparations.

   Class 44: Services for medical care, hygenic and beauty care; advisory services relating to cosmetics, medical products, pharmaceutical products, and pharmaceutical preparations; consultancy services relating to cosmetics, beauty and skin care; services for the care of skin.

3. 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 registered EUTM or International Registration designating the EU. As a result, the Opponent's earlier mark was converted into a comparable UK trade mark. Comparable UK marks now recorded in the UK trade mark register have the same

legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[1]

4. The Opponent submits that the applied for mark is similar to their earlier right and that the goods at issue are either identical or highly similar.

5. The Applicant filed a counterstatement within which it denied the claims made and put the Opponent to proof of use.

6. Both parties filed evidence during proceedings. Neither party requested a hearing, however both parties filed submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers.

7. The Applicant represents itself; the Opponent is represented by Humphreys & Co.

8. 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

9. The Opponent filed evidence in the form of the witness statement of Drew Bordages, Executive Vice President and General Counsel of ZO Skin Health, Inc., signed and dated 25 April 2025. The witness statement is accompanied by exhibit DB1. The purpose of this evidence is to show that the earlier mark has been used by the Opponent in relation to the goods and services relied upon.

[1] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

10. The Applicant filed evidence in the form of the witness statement of Dharmesh Patel, Director of DCP Project Ltd, signed and dated 25 June 2025. The witness statement is accompanied by exhibits A1 to E25. The purpose of this evidence is to offer definitions for the ZO element that is found in both of the respective marks, show the set-up of the Applicant's business and how it plans to use its mark, and provide state of the register evidence.

PRELIMINARY ISSUES

State of the register evidence

11. In relation to the state of the register evidence, I observe that the Applicant has provided numerous examples of entries on the UKIPO register of registered marks that contain either the element ZO or the word HEALTH.[2] In Mr Patel's witness statement, he claims this evidence demonstrates the common use of the prefix ZO and descriptive terms like HEALTH in the cosmetics industry. He states that these examples illustrate that such terms are widely used and not exclusively associated with any single entity.[3] However, I must take into account the case of *Zero Industry Srl v OHIM*, Case T-400/06, where the General Court ("GC") stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865,

[2] See Exhibits E1 - E25.
[3] Witness statement of Dharmesh Patel, paragraph 10.

paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71). "

12. The fact that there are a number of trade marks that contain the element 'ZO' or the word 'HEALTH' for class 3 goods, by itself does not assist the Applicant as the Applicant has filed no evidence to demonstrate that the marks found in exhibits E1 to E25 are actually in use in the marketplace. Therefore, the Applicant fails to show that widespread use of such marks on the relevant market has led consumers to become accustomed to differentiating between marks using these elements, leading to a weakening of the distinctive character of these elements. Indeed, I remind myself that state of the register evidence by itself has been described by AP's previously as irrelevant,[4] or by the High Court as worthless.[5] Instead, the outcome of this opposition will be determined after making a global assessment whilst taking into account all the relevant factors.

Applicant's preparations for genuine use and co-existence

13. I note that under the subheading '*Applicant's preparations for genuine use'* the Applicant relies on its marketing plan and the product packaging that it has created so far and argues that the marks have a distinct or independent commercial identity.[6] However, the Applicant does not have to show use of its mark, therefore this is immaterial to the decision that I must make. Further, the Applicant describes the use as 'preparation' for use of its mark on the goods and says that the natural hair clay product is not yet on sale pending laboratory testing, and that it has future expansion into skincare in mind.[7] This is particularly relevant when considering submissions under the subheading '*Marketing Context and Coexistence'* for reasons I will explain.

14. There appears to be some confusion as to what is being argued in relation to coexistence, with the Applicant arguing third party co-existence as well as co-

[4] See *BREXIT*, BL O/262/18 [10]
[5] *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd* [2022] EWHC 1244 (Ch) [56]
[6] See Applicant's written submissions, subheading 1, bullet point 5 and subheading 6, final paragraph.
[7] Applicant's written submissions, under subheading 6.

existence of the competing marks. In relation to what it describes as third party co-existence, I have already discussed this matter above under 'state of the register evidence'.

15. The Applicant also states that "*The Opponent filed 254 pages of evidence but provided no examples for* ***actual confusion despite years of use***" (my emphasis added) and the Applicant relies on the case C-234/06P *Bainbridge*, for supporting the assertion that coexistence without confusion is powerful evidence against a likelihood of confusion. However, having read that case, I do not consider it to say anything of the sort, indeed the case discusses whether a family of marks can be relied upon without the existence of use on the market. On the contrary, although evidence of actual confusion may be persuasive where it exists, the absence of confusion on the marketplace is rarely significant[8] as it may be a result of a wide variety of different factors.[9] Regardless, there can be no evidence of actual confusion as the Applicant's mark has yet to reach the market despite the contrasting submission regarding '*years of use'*. As such I place no weight on these submissions.

DECISION

Section 5(2)

16. The opposition is based upon Sections 5(2)(b) of the Act, which read as follows:

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

[8] See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, at paragraph 80.
[9] *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, at [291].

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

Proof of use

17. The Opponent's earlier marks had been registered for more than five years at the filing date of the application and therefore the proof of use provisions apply.

18. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

"(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) 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.
…"

19. 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."

20. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the Opponent's word mark is the five-year period ending with the Applicant's filing date 16 October 2024, i.e. 17 October 2019 to 16 October 2024.

21. It should be noted that as the Opponent's earlier mark is a comparable mark, Tribunal Practice Notice 2 of 2020 applies in that: "Where all or part of the relevant five-year period for genuine use under sections 6A, 46(1)(a) or (b), or 47 falls before IP Completion Day, evidence of use of the corresponding EUTM in the EU in that part of the relevant period before IP Completion Day will be taken into account in determining whether there has been genuine use of the comparable trade mark. For that part of the relevant period, for the purposes of the genuine use assessment, the UK will be taken to include the EU."

22. Consequently, I can take account of evidence of use in the EU up to and including IP Completion Day (31 December 2020).

Evidence of use

23. I note the following from the Opponent's evidence:

a) The Opponent was incorporated in March 2006,[10] and states that it has been using its mark ZO SKIN HEALTH in the UK since 2007 on medicated and non-medicated skin care preparations, cosmetics and toiletries,[11] including: skin peels, serums, sunscreen, skin creams, anti-ageing preparations, acne treatments, skin brightening preparations, cleansers, exfoliating preparations, skin hydrating preparations, cosmetic pads, skin polishes, eye creams, body creams, skin scrubs, face masks, and skin toners.[12]

b) The Opponent's products have been advertised to UK consumers online at the Opponent's UK website www.zo-skinhealth.co.uk. since at least as early as 2014 and continuously to date.[13] Snapshots of the Opponent's website are provided in evidence using the online internet archive 'The Wayback Machine'.[14] The evidence shows the screenshots of the website selling cosmetics including those for the face and body between 2019 and 2024. At

[10] Witness statement of Drew Bordages, paragraph 4
[11] Witness statement of Drew Bordages, paragraph 5
[12] Witness statement of Drew Bordages, paragraph 7
[13] Witness statement of Drew Bordages, paragraph 9
[14] Exhibit DB1, pages 1 to 42.

the top of each web page is the Opponent's mark in slightly stylised blue font, as:

ZO® SKIN HEALTH

Examples of how the Opponent's mark is used on the goods is shown below:

c) Mr Bordages claims that it also offered advisory, information and consultancy services in relation to cosmetics, medical products, pharmaceutical products and pharmaceutical preparations, beauty care and skin care, under the ZO SKIN HEALTH mark,[15] and refers to the evidence at exhibit DB1 pages 43 to 63. These show blog articles that appear to refer mainly to use of its cosmetics, however, I note that some of the cosmetics within its range are described as 'medical grade'.[16] Further, on the blog homepage one of the categories includes

[15] Witness statement of Drew Bordages, paragraph 10
[16] See for example Exhibit DB1 page 4

'Zo Medical Tutorial'.[17] Using the 'Way Back Machine' these are dated in 2023 and 2024, within the relevant period.

d) The unchallenged narrative evidence confirms that the Opponent has distributed its ZO SKIN HEALTH products to consumers in the UK through a large number of independent distributors, resellers and retailers since 2007 and continuously to date.[18] An indication of the number and geographical spread of ZO resellers throughout the UK currently is found in Exhibit DB1 at pages 64 to 68.

e) Turnover figures have been provided for the relevant period in relation to sales in the UK of the Opponent's products under the mark ZO SKIN HEALTH. These are replicated below:[19]

Year	$USD
2019	5,584,896
2020	7,667,464
2021	13,142,183
2022	17,172,416
2023	17,544,649
2024	17,069,173
TOTAL	**78,180,781**

f) Invoices for the distributor,[20] Wigmore Medical Limited. Whilst these amount to large figures it is unclear which goods are sold to the distributor.

[17] Exhibit DB1, pages 44 and 52
[18] Witness statement of Drew Bordages, paragraph 11
[19] See the witness statement of Drew Bordages, paragraph 12
[20] Exhibit DB1, pages 73 to 112

g) Invoices to customers spread across the UK that mainly appear to be trading as aesthetics clinics.[21] These are mainly for skin products, both medicated and medical grade skin cosmetics. Whilst there are mentions of prescriptions it is unclear what those prescriptions are for and difficult to determine if the prescriptions are for pharmaceutical preparations or medicated skin care preparations. These appear to be provided from the Opponent's sole UK distributor, Wigmore Medical Limited. The invoices list skin care products and the occasional body cosmetics predominantly under ZO, but also under the ZO SKIN HEALTH mark.

h) Marketing figures which are reproduced below:[22]

ZO SKIN HEALTH

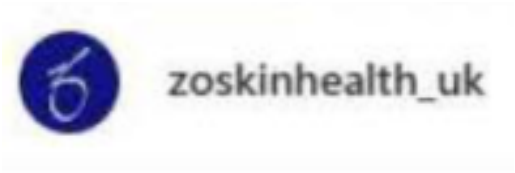
UK ADVERTISING SPEND

	A	B	C	D	E	F	G	H
1	Description	2019	2020	2021	2022	2023	2024	Grand Total
2	Climb Online		31,000	30,600	13,800			75,400
3	Hosting	120	575	575	480	660		2,410
4	Mktg Stock		2,395	7,551	4,024	8,360	28,617	50,946
5	Other		125	29	- 500	335	80	69
6	SalesForce						1,624	1,624
7	SEO	6,000	4,000					10,000
8	Training	30,158	37,205	4,812	6,821	3,188	310	82,493
9	UGC						1,695	1,695
10	Workshop	2,675		351		772	2,587	6,385
11	Marketing		2,256		1,206	1,099		4,561
12	Brochures/Flyers	5,726	2,853	2,635	948		10,667	22,831
13	Facebook/Google	815	13,713	1,614	16,460	139	150	32,891
14	Conference Costs		30,253	60,913	17,088	1,037		109,291
15	WHU Sponsorship		90,000	120,000	-			210,000
16	PR				75,000	75,000	75,000	225,000
17	**Marketing Total**	**45,495**	**214,374**	**229,079**	**135,327**	**90,589**	**120,730**	**835,594**
18								
19	Wigmore Management Fee			£ 1,875,000	£ 1,950,000	£ 2,115,000	£ 2,040,000	£ 7,980,000
20								
21	Grand Total	45,495	214,374	2,104,079	2,085,327	2,205,589	2,160,730	8,815,594
22								
23	*Wigmore management fee included:*		Training, merchandising, Trade shows					
24								

[21] Exhibit DB 1, pages 113 to 173
[22] Exhibit DB1, page 174

i) Social media pages under the handle ZO Skin Health UK on Facebook[23] and zoskinhealth_UK on Instagram,[24] however both are beside a profile picture of another mark as shown below:

(Facebook)



(Instagram)

The Facebook evidence shows that the Opponent's page has 17,000 followers and 14,000 likes and was initially created on 10 October 2014.[25] However, in relation to the number of followers or likes, this information appears to be correct at the time the evidence was collated and not necessarily at the relevant date. Nonetheless, the screenshots display posts dated 18 December 2019, 20 February 2020 and 24 October 2022, i.e. within the relevant period. I note that there are a few 'likes' for each of these posts, with the maximum number of 'likes' for a Facebook post in evidence being 23. That said, there appears to be a greater following on the Opponent's Instagram account although the precise number of followers during the relevant date is not provided. All the posts from the two accounts advertise cosmetics such as skin serums, creams and treatments.

j) Third party articles, such as an article from Elle magazine which is said to be 'updated 17 August 2020'. This article discusses the skincare routine of the celebrity Rosie Huntington Whiteley and names 'ZO Skin Health completion renewal pads',[26] with a link to purchase the product on Elle's website,[27] and 'ZO Skin Health oil control pads'.[28] A Metro online article said to be dated in 2020,[29] where the Eastenders actor Jessica Plummer names "@zoskinhealth" products

[23] Exhibit DB1, pages 175 - 178
[24] Exhibit DB1, pages 179 – 189
[25] Exhibit DB1, page 175
[26] Exhibit DB1, page 192
[27] Exhibit DB1, page 194
[28] Exhibit DB1, page 193
[29] Exhibit DB1, page 195

as the ones she uses at home. As well as articles naming ZO Skin Health skincare products (and in some cases links to those products) from Country and Townhouse online magazine, dated 2021,[30] Metro, dated 2021,[31] The Guardian, dated 20 August 2023,[32] and Cosmopolitan magazine, dated 18 September 2023.[33] I observe that these are mainly national publications which would have wide readership numbers viewing these articles. When the mark is referred to in these articles it is in standard text as expected, although I observe that the ZO element is almost always in capitals unlike the rest of the mark which often appears in lower case.

k) Brochures dated between 2019 and 2021 advertising skincare products for sale,[34] the narrative evidence confirms that these brochures are provided to distributors and resellers including beauty salons and technicians.[35] Within the brochures the mark often appears on pictures of the products themselves and also below the products as such:

[30] Exhibit DB1, pages 196 – 197
[31] Exhibit DB1, page 198
[32] Exhibit DB1, page 200
[33] Exhibit DB1, pages 201 – 205.
[34] Exhibit DB1, pages 206 – 250
[35] Witness statement of Drew Bordages, paragraph 11

As well as on the back of the brochure as:

l) During the relevant period the Opponent's brand was also one of the official sponsors of the West Ham women's football team,[36] with the mark used on the West Ham women's football team webpage being the same as the mark used on the Opponent's own website as displayed above at paragraph 21b).

Variant use

24. I have no submissions from either party in relation to whether the use shown is acceptable variant use of the mark as registered. In relation to where the mark is replicated in standard font within articles, or in slightly stylised font on the website and brochures as shown above, albeit with the addition of the ® symbol, I keep in mind *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, where the GC said:

> "39. … it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO – Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited)."

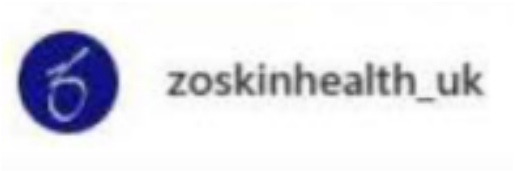
25. As a word mark protects the words themselves, irrespective of the font or case that they are presented in, I note that the words are clearly visible in these examples.

[36] Exhibit DB1, pages 1 and 199.

Further although they have been used in either blue, or in the case of the back of the brochure, in white, as can be seen from the case law above they can be used in any colour. Therefore, I consider that these instances of use are acceptable variants of the earlier mark as registered and, per the *Lactalis* case,[37] the ® symbol does not alter the distinctive character of the mark as it purely indicates that the mark has been registered.

26. I must also address use on the products and on the social media profiles. Taking the use on the social media profiles, which I have replicated here for ease:

(Facebook)



(Instagram)

27. In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") held that:

> "32. … the '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.

28. The words are present whether that is with or without a space between them. Per the *Lactalis* case, I do not find that the presence of 'UK' alters the distinctiveness of the earlier mark as it is merely descriptive of the geographical location of the market for which the goods are being targeted. Neither does the presence of the underscore do anything to alter the distinctive character of the mark as registered. I consider that the mark as registered being used in conjunction with another mark, that being the figurative device beside it (a white squiggle of indeterminate meaning inside a blue circle), does not prevent it from continuing to be perceived as the

[37] *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

origin of the products at issue. Consequently, I find that this is also acceptable variant use of the earlier mark.

29. As for the mark as displayed on the products, in my view this would also be acceptable use of the registered mark in conjunction with other marks as per the case law above.

This is because as shown above the mark as registered can be seen above the words 'BY ZEIN OBAGI MD' followed by a device element. For the same reasons as discussed, use of the mark alongside the device element will still be acceptable variant use. As for 'BY ZEIN OBAGI MD' this refers to the person who created the brand/branded product. As such, in my view, while it adds contextual information about the product, the registered mark is still indicative of its origin.

Sufficient use

30. 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.[38] I bear in mind that, although criticisms can be made of individual items of evidence, the registrar must stand back and take a view of the evidence in its entirety. Whilst a breakdown of turnover and advertising figures for each of the goods and services relied upon has not been provided, the overall

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

unchallenged turnover figures for the UK under the ZO SKIN HEALTH mark are over £78 million for the relevant period and the overall unopposed advertising figures total over £10 million for the same period. These are far from insignificant sums. Further, the invoice evidence indicates that the sales under the ZO SKIN HEALTH mark were made throughout the UK. There is evidence that the ZO SKIN HEALTH brand was an official sponsor of the West Ham women's football team during the relevant period, and recommended by third parties, whether it be through authors of third-party publications, such as online magazines and news articles, or via celebrity interviews. These third-party articles include national magazines and newspapers that would have a widespread readership. In these articles, the evidence shows the promotion predominantly of ZO SKIN HEALTH for skincare cosmetics. The Opponent has also established use of its mark on the social media platforms Instagram and Facebook within the relevant period, with posts promoting skincare cosmetics. There is also website and brochure evidence that the Opponent has used to promote and sell its cosmetic products under its brand. From the evidential picture overall, I am satisfied that the Opponent has created and maintained a market for its cosmetic and skincare goods under the ZO SKIN HEALTH mark (as registered or in acceptable variant form) within the UK during the relevant period.

Fair specification

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, which can also be considered when framing a fair specification, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in

relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

32. In assessing whether, or the extent to which, the evidence shows use of the registered marks in relation to the goods and services relied upon, I bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods and services for which there has been genuine use, but, rather, the particular categories of goods they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perception of the average consumer and the purpose and intended use of the

products or services in issue. However, I remind myself that 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 registrations.

33. I acknowledge from the Opponent's submissions that it invites a finding of genuine use for at least the entirety of its class 3 specification: *"Toiletries; cosmetics; non-medicated skin care preparations"*. I find that the evidence clearly shows use for the terms "*cosmetics*" and "*non-medicated skin care preparations*" as use is shown for skin cleansers, exfoliating pads, serums, eye creams, and various skin care creams, such as those for anti-aging or with SPF. However as for the term "*toiletries*" I am not prepared to accept that the evidence shows use of this term. In my view toiletries are more focused on hygiene products such as shower gels, shaving gel, deodorant and toothpaste/toothbrushes, rather than skincare products which I consider to fall under "cosmetics", cosmetics being used to describe products that enhance the appearance and texture of the skin. As such, I do not find the evidence to show use for "*toiletries*".

34. As for the class 5 terms, *"Pharmaceutical preparations; medicated skin care preparations"*, although I accept that some of the cosmetic products are marketed as containing 'medical grade' ingredients, these do not appear to be medical skin care preparations or pharmaceutical preparations per se. Further, whilst I note that on some of the invoices the word 'prescription' is listed, it is unclear exactly what the goods listed as prescription are, for example they could be tablets rather than preparations. Therefore, I am not satisfied from the evidence as a whole that genuine use is shown for the class 5 terms.

35. Finally addressing the class 44 services within the earlier specification for which use is being claimed, i.e. "*Services for medical care, hygenic and beauty care; advisory services relating to cosmetics, medical products, pharmaceutical products, and pharmaceutical preparations; consultancy services relating to cosmetics, beauty and skin care; services for the care of skin,"* whilst there is some evidence of blogs for these services, that is the only evidence that I have for these services. I do not have turnover figures relating to these services nor do I have any

invoices listing these services. As such I do not consider that use has been shown in relation to these services relied upon.

36. Consequently, I find that a fair specification for the goods shown in evidence to be:

Class 3: *"Cosmetics; non-medicated skin care preparations".*

Relevant case law for section 5(2)(b)

37. 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 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; Page 8 of 20

(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

38. Following my findings in relation to a fair specification for the use that has been shown by the Opponent, the goods for comparison are as follows:

Opponent's goods	Applicant's goods
Class 3: Cosmetics; non-medicated skin care preparations.	Class 3: Cosmetics; Skincare cosmetics; Hair cosmetics; Natural cosmetics.

39. In *Gérard Meric v OHIM,* Case T-133/05, the GC stated that:

"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".

40. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

Cosmetics; Skincare cosmetics; Natural cosmetics

41. The above goods are *identical* to the Opponent's earlier term *"cosmetics".* In regard to the applied for terms "*skincare cosmetics"* and "*natural cosmetics"* these are also identical under *Meric* as they are encompassed by the Opponent's broader term.

Hair cosmetics

42. In relation to "*hair cosmetics",* I understand these to be goods that enhance the overall appearance of hair, such as, by way of examples, hair dye, detangling sprays, hair styling products, heat protection products or hair oils. As such, I consider that the term "*hair cosmetics"* is encompassed by the Opponent's broader term "*cosmetics*". As such, it follows that the competing goods are identical under the principles of *Meric*.

Average consumer and the purchasing act

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

44. 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.

45. Due to the nature of the goods at issue, I find it necessary to identify two groups of average consumers, the general public and professionals such as beauticians and aestheticians.

46. The goods will be purchased by the general public as well as professionals, both of whom will take various factors into consideration such as quality, ingredients, price, and suitability for the user's needs (for example, in accordance with the purchaser's type of hair or skin). The cost of the purchase is likely to vary, although it is unlikely to be particularly high. The frequency of the purchase is also likely to vary, but they are likely to be bought fairly often.

47. Accordingly, the level of attention paid will be average (medium) for the general public and above average (above medium) for professional purchasers as they will have the additional business reputation to consider when choosing the products. However, the likelihood of confusion must be assessed from the perspective of the general public since they are the group who will pay the lower degree of attention.[39]

48. The goods are likely to be obtained from retail outlets or their online equivalent or from beauticians/aestheticians. As such, it is my view that the purchasing process will be predominantly visual in nature. However, aural considerations in the form of word-of-mouth recommendations or verbal discussions with professionals for instance, cannot be excluded entirely.

Distinctive character of the earlier trade mark

49. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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

[39] See: Case T-247/12, *Argo Group International Holdings Ltd. v OHIM* and *Idem* T -356/14 [25] - [26].

of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

50. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are suggestive or allusive of a characteristic of the goods or 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.

51. The Applicant claims that ZO is descriptive and weak as it derives from the Greek meaning life/living and therefore it cannot be monopolised.[40] I note from the exhibits in evidence that dictionary.com says that *'zo- is used as a prefix meaning "living being" or "animal". It is very occasionally used in scientific terms, especially in biology. The form zo- comes from Greek zôion, meaning "animal".'*[41] There are also various sources confirming Greek origin and attributing ZO with the meaning of living animal, to live or some variation of such. However, irrespective of the precise meaning, in my view this will not be understood by the average UK consumer.

[40] Applicant's written submissions, executive summary, point 1, and repeated in the introduction in the first bullet point.
[41] Exhibit A2

52. Moreover, I note that in the Collins English dictionary ZO is described as meaning *'a Tibetan breed of cattle, developed by crossing the yak with common cattle.'*[42] Notwithstanding this dictionary definition, and the fact that there may be some people that might understand ZO to have this meaning, absent of any evidence to the contrary, I do not find that a significant proportion of average consumers would have such knowledge.[43] Rather, in my view the average consumer would consider ZO to be an invented word or element.

53. The earlier mark is a word only mark that consists of the words ZO SKIN HEALTH. Having considered the goods at issue, the words SKIN HEALTH are very allusive, if not descriptive, of the cosmetic goods that are for the purpose of improving the health/appearance of skin. As such, it is the ZO element in which the distinctive character of the mark predominantly lies, an element that will be perceived by the average consumer as an invented element that has no meaning. Therefore, overall, I consider that the earlier mark's distinctive character rests in the ZO element of the mark.

54. I observe that enhanced distinctiveness has not been pleaded, however, if it were pleaded, I consider that the evidence as a whole does not strike me as indicative of a level of activity that would lead to the capacity of the mark, measured from the perspective of the average consumer, to more greatly identify the goods upon which the Opponent relies as coming from a particular undertaking, beyond its inherent capability to do so. Despite significant turnover figures and marketing figures, the uptake of engagement with users of the brand does not appear to be substantial on social media. Further I have no evidence relating to the market share held by ZO SKIN HEALTH.

Comparison of the marks

55. The respective trade marks pleaded under 5(2)(b) are shown below:

[42] Exhibit A1
[43] See BL O/048/08

Earlier trade mark	Contested trade mark
ZO SKIN HEALTH	**zonatural**

Overall

56. The Opponent's mark is a word only mark that consists of the words ZO SKIN HEALTH and for the reasons I have discussed above within the distinctive character section of this decision, I consider that the overall impression lies predominantly in the ZO element with the words SKIN HEALTH playing a lesser role.

57. The Applicant's mark is also a word only mark that consists of the single word zonatural, although for reasons that I will address within the conceptual comparison, consumers will identify the common word 'natural' within the applied for mark which will lead consumers to identify the first element 'zo'. Consequently, the overall impression rests within these elements in roughly equal measure.

Visual comparison

58. The marks are both word-only marks. As such, it is the words themselves that are protected irrespective of the case that they are presented in.[44] They coincide in the 'ZO/zo' element found at the beginning of each of the respective marks, a position where consumers will focus their attention.[45] The marks differ in their remaining elements, 'SKIN HEALTH', in the earlier mark, and in the contested mark 'natural'. However, these elements are allusive, if not descriptive, of the goods sold under the marks. Overall, I find that the marks are visually similar to a medium degree.

Aural similarity

59. In my view consumers will identify the common dictionary word 'natural' in the contested mark. As such, I find that this will be pronounced in the usual way, as will the words SKIN HEALTH in the earlier mark. The same word ZO/zo appears

[44] See *LA Superquimica v EUIPO*, T-24/17, para 39; *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16 and *Groupement Des Cartes Bancaires v China Construction Bank Corporation,* case BL O/281/14
[45] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

in both marks and it will be pronounced in the same way. Overall, due to the overlap in the ZO/Zo element found at the beginning of the respective marks, I consider the marks to be aurally similar to a medium degree.

Conceptual similarity

60. In relation to conceptual meaning of the competing marks the Applicant argues:

> "The Applicant's mark ZoNatural conveys "natural life/living naturally". This expression is directly descriptive of the brand ethos (natural, plant based, holistic products).
>
> By contrast, "ZO SKIN HEALTH" conveys medicalised, clinical skincare focus."[46]

61. I observe that the Opponent states the following in relation to the conceptual comparison of the respective marks:

> "Conceptually, the marks are identical or, if the public attributes no meaning to the letters 'ZO', they are conceptually neutral (because, again, the 'skin health' and 'natural' components are purely descriptive and non-distinctive in relation to the goods). In any event, there is a synergy between 'skin health' and 'natural', for example: natural cosmetics for skin health, or skin health cosmetics made from natural ingredients."

62. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[47] For the reasons that I have discussed above within the *distinctive character of the earlier mark* paragraphs, I consider the element ZO/zo will be perceived by the average consumer as an invented word/element.

[46] See Applicant's written submissions, subheading 4. Conceptual Meaning of "ZoNatural".
[47] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29.

Therefore, in relation to the earlier mark, the element ZO as an invented word will be perceived as being conceptually neutral. As for the additional words SKIN HEALTH which I accept are highly allusive, if not descriptive, these will be understood in line with their usual dictionary definition. Turning to the Applicant's mark, whilst the word 'zonatural' is an invented word, I keep in mind that being an invented word does not exclude the possibility that it is endowed with an allusive meaning.[48] The average consumer will invariably break down an invented word into components that suggest a meaning, or resemble known words[49] and, therefore, an invented word may still be capable of conveying a concept. In my view consumers will identify the well-known word 'natural', (which they will understand in line with its common dictionary definition), and this will lead consumers to also see the "zo" element which will be understood as an invented prefix. Consequently, the common element ZO/zo will be understood as being conceptually neutral with the differing elements being conceptually dissimilar but weak in distinctiveness as they are all allusive, if not descriptive.

Likelihood of confusion

63. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*).

64. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is

[48] See for example *Usinor v OHIM — Corus UK (GALVALLOY),* T-189/05, para 65
[49] See *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT), Case T-356/02, para 51, and Mundipharma v OHIM*

where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16 quoted below.

65. I have found the following:

- The goods are identical.
- The likelihood of confusion must be assessed from the perspective of the general public who will pay an average (medium) degree of attention.
- The nature of the purchasing act will be primarily visual although I do not discount aural considerations.
- The marks are visually and aurally similar to a medium degree, and their shared element is conceptually neutral with the differing elements being conceptually dissimilar but weak in distinctiveness as they are all allusive, if not descriptive.
- Distinctiveness of the earlier mark lies in the element ZO which will be perceived as an invented element as the words SKIN HEALTH are allusive, if not descriptive, of the nature and purpose of the goods at issue.

66. Even though the differing elements within the competing marks are all allusive, if not descriptive, they are not negligible, and as such in my view consumers are unlikely to misrecall the marks for one another. As such, I find that there is no likelihood of direct confusion.

67. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

68. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not

sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[50]

69. Furthermore, in *Liverpool Gin*,[51] Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

70. However, even where consumers recognise the differences between the respective marks in the words SKIN HEALTH in the earlier mark and the word 'natural' in the applied for mark, these are all lowly distinctive elements of the respective marks in relation to the cosmetic goods at issue. As such, consumers will focus on the shared ZO/zo elements of the competing marks. Given the fact that this is an invented element consumers are less inclined to believe that the presence of this element is merely coincidental and instead are likely to perceive its use as indicative of a brand extension, brand variation or sub brand under the same or economically linked undertakings. This is particularly the case as the differing elements of the competing marks are lowly distinctive words in relation to the goods which are totally identical or *Meric* identical in this case. In my view, the contested mark will be seen as a logical brand variation that retains its distinctive element whilst replacing lowly distinctive elements with another lowly distinctive element.

Final Remarks

71. Even if I had found that there was enhanced distinctiveness for the earlier mark, this would not change the overall outcome of my decision. If anything, per *Sabel,* it would point towards there being a greater likelihood of confusion between the competing marks.

[50] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17
[51] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

CONCLUSION

72. The opposition based upon section 5(2)(b) has been successful, and the application, subject to any appeal, will be refused registration for all the goods.

COSTS

73. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Applying the guidance in the TPN, I consider the following to be fair:

Official Fees:	£100
Preparing a statement of case and considering the other side's counterstatement	£200
Preparing evidence and considering the other side's evidence	£600
Preparing written submissions	£350
Total:	**£1,250**

74. I therefore order DCP PROJECT LTD to pay ZO Skin Health Inc the sum of £1,250. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of February 2026

Sarah Wallace
For the Registrar