

O/0238/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004039015
BY EXCEPTIONAL PRODUCT LLC
TO REGISTER:**

CLEANESPRESSO

AS A TRADE MARK IN CLASS 3

AND

**THE OPPOSITION THERETO UNDER NO. 448278
BY LIU SHUJUAN**

AND

**IN THE MATTER OF REGISTRATION NO. UK00003847304
IN THE NAME OF LIU SHUJUAN
FOR THE FOLLOWING TRADE MARK:**

CleanEspresso

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 507233
BY EXCEPTIONAL PRODUCT LLC**

BACKGROUND AND PLEADINGS

1. This decision involves proceedings wherein Exceptional Product LLC (“Exceptional”) and Liu Shujuan (“LS”) brought actions against one another. I will summarise the relevant proceedings below, beginning with Exceptional’s invalidation application, on the basis that it was brought first.

Exceptional’ invalidation

2. LS is the registered proprietor of the trade mark shown below:

UK00003847304

CleanEspresso

Filing date: 08 November 2022

Registration date: 27 January 2023

Class 3: *Cleaning products, namely, cleaning preparations, and chemical cleaning preparations for cleaning coffee brewing and dispensing equipment.*

3. On 15 April 2024, Exceptional applied to have LS’ mark declared invalid under Section 47 of the Trade Marks Act 1994 (“the Act”) based upon Section 5(4)(a) of the Act. Under this ground, Exceptional relies upon the sign ‘CLEANESPRESSO’ which it claims to have used throughout the UK since 2014 for *coffee and espresso machine cleaning products*. Exceptional claims that use of LS’ mark would be contrary to the law of passing off.

4. LS filed a counterstatement denying the claims made.

LS’ opposition

5. On the same day as filing the application for invalidity (i.e. 15 April 2024), Exceptional applied to register the following trade mark in the UK:

UK00004039015

CLEANESPRESSO

Class 3: *Coffee machine cleaning products.*

6. Exceptional's mark was published for opposition purposes on 26 April 2024. On 25 June 2024, LS opposed Exceptional's trade mark. LS' opposition is brought under Section 5(2)(b) of the Act relying upon her trade mark registration no. UK00003847304 which Exceptional applied to invalidate, and which I have set out above. Under this ground, LS' position is that the marks are virtually identical and covers similar goods. In particular, LS' position is that although the goods of the competing marks are described differently, they are, in fact, identical.

7. Exceptional filed a counterstatement wherein it denies the validity of LS' mark referring to the invalidity proceedings it brought against it. Aside from denying the validity of LS' mark, Exceptional admits that the marks and the goods are identical or highly similar.

8. Upon the filing of the counterstatement in respect of the opposition and in light of Exceptional's request, the Tribunal consolidated the proceedings under the power given to it under Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties by way of written correspondence dated 19 September 2024.

9. Both parties filed evidence in chief as well as Exceptional filing evidence in reply.

10. Exceptional is represented by Paweł Wowra and LS is represented by Appleyard Lees IP LLP.

11. Neither party requested a hearing, but they both filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

12. 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

13. Exceptional's evidence in chief came in the form of a witness statement from Shane Lapan dated 3 September 2024 alongside 9 exhibits (being those labelled SLPEX1-SLPEX9). Mr Lapan also filed a second witness statement (in reply to LS' evidence) dated 5 February 2025 alongside 5 exhibits (being those labelled SLPEX1-SLPEX5). Mr Lapan is the CEO of Exceptional, a position he has held since 2021. The purpose of Mr Lapan's first witness statement is to provide evidence of Exceptional's use of the sign 'CLEANESPRESSO' in the UK, whilst his second witness statement replies to LS' evidence that she created the mark 'CleanExpresso' and that her use of such mark predates any intent by Exceptional to enter the UK market.

14. LS' evidence in chief came in the form of two witness statements, one from LS herself and one from Liu Congfei who is the legal representative of a Chinese company that sells cleaning preparations for coffee machines in the UK under a license from LS. Both LS and Mr Congfei's witness statements are dated 14 November 2024 and are accompanied by 9 and 7 exhibits, respectively (being those labelled LS1-LS9 and LC1-LC7).

15. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

MY APPROACH

16. The ability of LS to rely on her earlier trade mark in the opposition to Exceptional's trade mark application depends on the outcome of Exceptional's invalidity against LS' earlier trade mark registration. Hence, I shall start with Exceptional's application for invalidity which is based on Section 5(4)(a).

EXCEPTIONAL'S INVALIDITY AGAINST LS'S REGISTRATION NO. UK00003847304

17. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

18. Subsection (4A) of Section 5 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.”

19. The relevant parts of section 47 state:

“47. (1) [...]

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

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

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

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

20. 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)."

21. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date for Section 5(4)(a)

22. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC), as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Allan 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.’ ”

23. LS has filed evidence claiming that she has used her registered mark (which is subject to Exceptional's application for invalidity) prior to applying to register it. Hence, before turning to Exceptional's evidence about goodwill, I need to establish whether LS' contested mark was used prior to the filing date of 08 November 2022.

24. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC) as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act where one or both of the parties have used the mark(s) at issue prior to the date of the application to register the contested mark(s). He explained that:

"41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

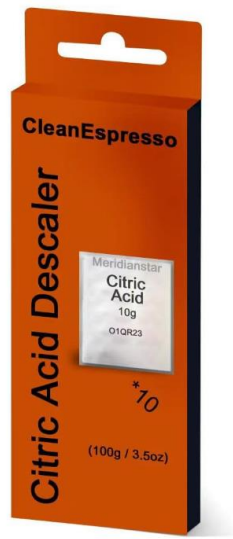
42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

25. In *Smart Planet Technologies, Inc. v Rajinda Sharma* [BL O/304/20], Mr Thomas Mitcheson QC (now KC), as the Appointed Person, pointed out that “*the start of the behaviour complained about*” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in future. If the user of the applied-for mark was not passing off at the time such use commenced (usually because no one else had acquired a protectable goodwill under a conflicting mark at that time), he or she will not normally be passing off by continuing to use the mark.

26. I now turn to LS’ evidence.

27. In her witness statement LS states that she created the mark "CleanEspresso" and that such mark has been actively used in the UK since 2011 in relation to citric acid sachets intended for descaling kettles, coffee makers, and brewing equipment. LS also states that the goods have been sold in the UK initially by LS herself through the Amazon.co.uk platform until 2021 and that although initial sales were not substantial, they were uninterrupted over a significant period of time. In support of her claims, LS produces an undated screenshot from Amazon UK (www.amazon.co.uk), showing a sterilizer and kettle descaler (citric acid) under the brand ‘CleanEspresso’. Although the product is shown as “currently unavailable” the page indicates that the product was first available on 15 August 2011 and displays a number of customers reviews from 2012, 2013, 2015, 2017 and 2019. The webpages exhibited show that the product concerned looks like that:¹

¹ LS1



Roll over image to zoom in



Sterilizer & Kettle Descaler 10 x 10 Grams Citric Acid

Brand: CleanEspresso

4.0 ★★★★★ 35 ratings

Currently unavailable.

We don't know when or if this item will be back in stock.

Brand	CleanEspresso
Item form	Granule
Scent	Lemon
Specific uses for product	Descaler
Material feature	Natural
Item volume	150 Millilitres

[See more](#)

About this item

- Foil Fresh, Batch Numbered, UK Factory Produced Citric Acid Sachets. It is an ideal natural way to descale baby sterilizers.
- Also used on bottle warmers and many other household appliances.
- Perfect for Elderflower Cordial, Home Brew etc.
- Just one Sachet will make your Sterilizer/Kettle as good as new.
- Descales kettles, coffee makers, humidifiers, sinks, showers, taps and ceramic tiles

28. Since the screenshots display a printing date of 15 November 2024, it only proves that this is how the product appeared on that date. However, there is no way of verifying the content of the webpages prior to the printing date, in particular there is no way of knowing whether the packaging of the product sold in 2011 looked exactly the same as that which is shown in the exhibit produced in evidence. To prove that, LS should have filed an archive version of the webpages which she has not done. It will become clear why I state this.

29. LS further states that sales were interrupted in 2021 and resumed in July 2023. She also explains that sales are now conducted by the Chinese company Shanghaizhenyoumeishangmaoyouxiangongsi under a license agreement² concluded on 7 July 2023 and are made exclusively through Amazon UK. A copy of the agreement is exhibited; it states that the license is exclusive, it is for the sale of goods covered by LS' 'CleanEspresso' mark and relates to the UK. Further copies

² LS3

(undated) of webpages from Amazon UK confirm that the seller of products from the 'CleanEspresso' store is Shanghaizhenyoumeishangmaoyouxiangongsi.³

30. The rest of LS' evidence relates to two products sold by Shanghaizhenyoumeishangmaoyouxiangongsi which are said to have been launched in the UK on 13 July 2023 and 7 January 2024, respectively. As these dates are after the filing date of 08 November 2022, they are not pertinent for the purpose of establishing the start of the behaviour complained about. Likewise, evidence about promotional activity relating to these products is irrelevant because it concerns campaigns run since 1 November 2023 (which is after the filing date of 08 November 2022). Hence, I shall say no more about this evidence.

31. Turning to Mr Congfei's evidence, it merely reiterates the same facts in relation to which LS gave evidence. In particular, Mr Congfei confirms that his company Shanghaizhenyoumeishangmaoyouxiangongsi is LS' licensee and sells cleaning preparations for coffee machines throughout the UK. However, as it will be recalled, the license agreement is dated 7 July 2023 and Mr Congfei states that trade under LS' mark started on 13 July 2023. Consequently, this evidence too is irrelevant because it concerns facts occurred after the filing date of 08 November 2022; hence, I shall say no more about.

32. In response to LS' evidence, Mr Lapan filed evidence aimed at discrediting LS' evidence that she marketed and sold goods under the mark 'CLEANESPRESSO' in the UK since 2011. It stated as follows:

"Upon closer inspection of the 2011 Amazon Listing, I believe that the image appears to have been photoshopped and/or manipulated. A particularly suspicious feature was a paper-like section that does not, in my view, visually align with a genuine product package. Further, I noticed that another brand name "Meridianstar" appears on the 2011 Amazon Listing. I have set out below my discovery process which drew me to this conclusion."

³ LS4

33. In support of these allegations, Mr Lapan exhibits SLPEX1 which he describes as follows: *“This is an amazon.co.uk listing sold by Meridianstar, dated 15 April 2011 under ASIN number B004WNLCU8 and launched around a similar time as the 2011 Amazon Listing. The product in the above-referenced Meridianstar Amazon listing contained a white powder that closely resembled the paper-like section in the 2011 Amazon Listing.”*

34. Admittedly, the image from LS’s evidence (LS1) shows that the packaging of the ‘CleanEspresso’ citric acid product displays a ‘Meridianstar’ paper label. However, the product shown at SLPEX1 is a tartaric acid product and although it is marketed under the brand ‘Meridianstar’ it is a different product, the webpage indicating that it can be added to food and drink to give a sour taste. I reproduce the image of both products below:



35. At SLPEX2, Mr Lapan introduces what he describes as a “web capture of Meridianstar’s website, which displays, in particular, the “Citric Acid” image on the 2011 Amazon Listing and the “Tartaric Acid” image on SLPEX1”. Mr Lapan further states that “to the best of [his] knowledge, Meridianstar appears to be a third-party

brand whose products are used for cleaning kettles, coffee machines, humidifiers, bottle warmers, sinks, showers, taps and ceramic tiles.” The webpages exhibited are from the website www.meridianstar.co.uk. They are undated, displaying only a printing date of 5 February 2025, and show (a) various citric acid products for sale explaining that it is used in many applications including cleaning and flavouring (b) various tartaric acid products for sale explaining that it is used as a preservative for food although some uses also refer to “tanning leather” and “silver mirrors”.

36. At Exhibit SLPEX3, Mr Lapan produces an extract from www.camelcamelcamel.com, a website which, it is said, “*is designed to monitor the prices of products sold on Amazon and archives historical webpages*”. Mr Lapan says that this webpage “*displays a product called "Sterilizer & Kettle Descaler 10 x 10 Grams Citric Acid" with an identical ASIN no. B004QO8GZC to the 2011 Amazon Listing and that the webpage indicates that the product is manufactured by Meridianstar*” and “*contains the same "Citric Acid" paper-like image shown on the 2011 Amazon Listing*”. Mr Lapan is correct in saying that the Amazon evidence introduced by LS (i.e. the evidence showing the ‘CleanEspresso’ packaging with the Meridianstar paper label) identifies a product with the same ASIN number B004QO8GZC as that of the product sold by Meridianstar, both products being also described as “*Sterilizer & Kettle Descaler 10x10 Grams Citric Acid*”. For ease of reference, I reproduce the two products’ description here:

Meridianstar’s product description:

Sterilizer & Kettle Descaler 10 x 10 Grams Citric Acid

ASIN: B004QO8GZC • UPC: 110091600000 • EAN: 011009160000 • PRODUCT GROUP: Home •
CATEGORY: Kitchen & Home • MANUFACTURER: Meridianstar • MODEL: CAS77929

CleanEspresso’s product description:

Product information

Technical Details

Brand	CleanEspresso
Colour	silver
Volume Capacity	0.15 litres
Material	Plastic
Special Features	Descaler

Additional Information

ASIN	B004QO8GZC
Customer Reviews	4.0 ★★★★★ ratings 4.0 out of 5 stars
Date First Available	15 Aug. 2011

Feedback

Would you like to [tell us about a lower price?](#)

37. Lastly, at SLPEX4 Mr Lapan produces a web capture showing the result of a search conducted on the website www.upcitemdb.com, which he describes as a database that allows users to search for a Universal Product Code (UPC). Mr Lapan says that extracting the UPC information from the website www.camelcamelcamel.com (SLPEX3), the UPC no. 110091600000 (see above Meridianstar's product description) leads to a webpage which states "*UPC 110091600000 is associated with Steriliser & Kettle Descaler 10 X 10 Grams Citric Acid*" and lists the brand as Meridianstar. For ease of reference, I reproduce the relevant part of the webpage here:

UPC 110091600000 has following Product Name Variations:

1. Steriliser & Kettle Descaler 10 X 10 Grams Citric Acid

More Info

UPC-A:	110091600000
EAN-13:	0110091600000
Country of Registration:	United States
Brand:	Meridianstar
Last Scanned:	2017-11-01 05:26:21

38. Lastly, at SLPEX5 Mr Lapan exhibits a copy of a webpage from www.amazon.nl showing a product sold by Meridianstar under ASIN no. B004QO8GZC. The product, which is described as "*Sterilizer & Kettle Descaler 10 x 10 g Citric Acid*" is shown as being "first available" on 15 January 2020. Mr Lapan points out that the product image displayed on this Amazon listing matches that displayed on the 2011 UK Amazon

listing, and that the ASIN number for the two products is identical. For ease of reference, I reproduce the relevant part of the webpage here:

05/02/2025, 12:20 Sterilizer & kettle descaler 10 x 10 grams citric acid: Amazon.nl: Bab

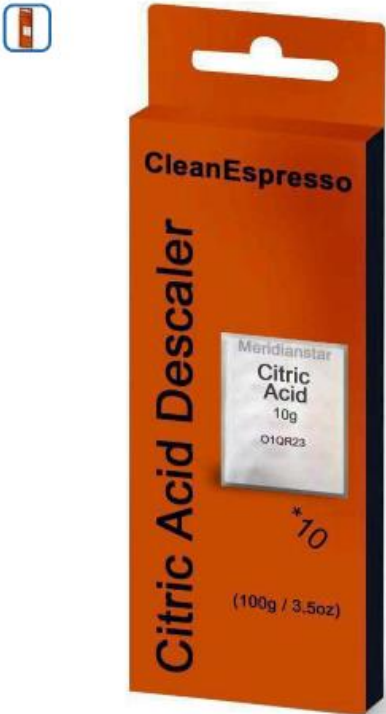
amazon.nl Will be delivered to Amsterdam 1079 Update Location AI Search by Amazon.nl NL Hello, login Account a

All Bestsellers Deals Gift certificates Prime Gift ideas and inspiration

Health & care Bestsellers Cleaning & household Baby & child care Contact lenses & glasses Home care Diet & n

Gratis bezorging bij je eerste bestelling | Ontdek nu

Baby products > Food & drink



Sterilizer & kettle descaler 10 x 10 grams citric acid
Brand: Meridianstar
[Search this page](#)

Currently not available.
We do not know if or when this item will be back in stock.

Brand	Meridianstar
Shape of item	Granule
Smell	Lemon
Specific use of product	Coffee maker
Item volume	150 milliliters
Number of	100 name

[View more](#)

About this item

- Foil fresh, batch numbered, UK factory produced citric acid sachets. It is an ideal natural way to descale baby sterilizers.
- Also used on bottle warmers and many other household appliances.
- Perfect for Elderflower Cordial, Home Brew etc.

Hover over the image to zoom in

39. Exceptional's allegation that LS' evidence has been fabricated is a serious allegation. Nevertheless, even if I do not think that Exceptional's evidence goes as far as showing that the image of the product packaging shown at LS1 has been manipulated, it certainly casts doubt on LS' claim that the use of the mark 'CleanEspresso' on Amazon UK in relation to the product shown at LS1 is (or was in 2011) use by LS or with her consent. I say this because the evidence produced by Exceptional clearly shows that the 'CleanEspresso' product depicted in LS1 is a product associated with the brand Meridianstar (be it the manufacturer or the seller) and the ASIN no. B004QO8GZC and UPC no. 10091600000 confirm this. Further, the very same screenshot produced by LS (LS1) demonstrates that the 'CleanEspresso' product sold on Amazon UK since 2011 displays a paper label with the brand

Meridianstar. Whilst, admittedly, the listing for the Amazon UK product identifies 'CleanEspresso' as the brand, the listing for the Amazon NL product (which is exactly the same as the product sold on Amazon UK) identifies Meridianstar as the brand. For ease of reference, I reproduce the two listing here:

Amazon NL



Amazon UK



40. This is clearly the same product sold by Meridianstar and the paper label on the Amazon UK product (which LS claims to be her product) confirms this. However, at no point did LS mentioned Meridianstar in her witness statement. On the contrary, LS said that she was the creator of the mark 'CleanEspresso' and that the goods were sold by herself in the UK from 2011 until 2021. However, there is no one piece of evidence which shows how the packaging of the product allegedly sold by LS in 2011 looked like, the copy exhibited only displaying a printing date of 5 November 2024. But even if the product sold in 2011 looked the same as that available on Amazon UK on 5 November 2024, it does not overcome the fundamental issue that the latter is a Meridianstar product, and that there is nothing to indicate an economic connection

(e.g. a license) between LS and Meridianstar. This would suggest that notwithstanding LS' claim that she sold the 'CleanEspresso' product on Amazon UK since 2011, the product shown by LS appears to belong to a third-party manufacturer (or seller), and there is nothing to suggest that LS licensed the use of the mark 'CleanEspresso' to Meridianstar at any point in time. In this connection, it must also be noted that in 2011 LS had no registered right in the mark 'CleanEspresso' and could not have licensed the mark to Meridianstar. In fact, LS was able to license the mark 'CleanEspresso' to Shanghaizhenyoumeishangmaoyouxiangongsi only after she obtained registration on 27 January 2023, i.e. on 7 July 2023, and the screenshots from Amazon UK confirm that after the license was granted, the seller was Shanghaizhenyoumeishangmaoyouxiangongsi.

41. I am also fortified in my conclusion that Meridianstar (as opposed to LS) was behind the sale of the 'CleanEspresso' product offered on Amazon UK since 2011 by the fact that the 'CleanEspresso' products sold by Shanghaizhenyoumeishangmaoyouxiangongsi are different products which appear in different packaging with different ASIN number (B0CGDM26WT and B0CRPX1SY9) which correspond to those given by LS in her witness statement – this raises the question of why LS did not provide the ASIN number for the goods allegedly sold before the license was granted. Lastly the images of the 'CleanEspresso' products sold by Shanghaizhenyoumeishangmaoyouxiangongsi show no reference to Meridianstar as shown by the images which I reproduce below:





42. Before I finish, I should make three points which I believe are relevant:

1. Whilst LS was able to provide details about sales and ASIN number of products sold by her licensee after the license was signed on 7 July 2023, there is no information about the sales or ASIN number of products allegedly sold prior to the license. This undoubtedly adds weight to Exceptional's theory that LS' evidence is misleading.
2. The fact that the listing for Amazon UK product shows 'CleanEspresso' as the brand whereas the listing for Amazon NL shows Meridianstar as the brand does not take away from the conclusion that it is the same product sold by the same company under the same trade mark. This is demonstrated by the use of an identical packaging and ASIN number, and by the paper label which mentions Meridianstar on both products.
3. LS did not file any evidence in reply to Exceptional's evidence aimed at discrediting her claims that she sold goods in the UK under the mark 'CleanEspresso' since 2011. However, in her submissions in lieu she stated:

"11. Bearing all of the above in mind, it is surprising to read allegations regarding photoshopped evidence when the Proprietor has provided not only

website printouts but also real photographs of the product and its original packaging, which she still possesses.

12. Additionally, the Applicant relies on an Amazon Netherlands printout from 2020, which is nine years after Liu Shujuan's UK sales began. The existence of such a listing does not disprove the Proprietor's prior use; rather, it suggests that a third party may have been reselling "CleanEspresso" branded products acquired at some point in time. This in no way undermines the legitimacy of Liu Shujuan's claim as the original creator of the mark.

13. The Proprietor has presented overwhelming evidence confirming that the mark "CleanEspresso" has been in active commercial use in the UK since 2011, with continued presence through a licensing agreement and verified Amazon UK sales. The allegations against the authenticity of the evidence are unfounded, and reliance on an Amazon Netherlands listing from 2020 is irrelevant to the question of prior use in the UK. Therefore, the cancellation action should be dismissed, and the Proprietor's rights in the "CleanEspresso" mark should be upheld."

43. I think paragraph 12 undermines LS' own evidence. This is because, that paragraph contains an admission that Meridianstar is a third party, the argument being that Meridianstar might have resold the 'CleanEspresso' product offered on Amazon NL. However, the product offered on Amazon NL is the same as that offered on Amazon UK which LS claims it is her own product, and both products display the Meridianstar paper label and have the same ASIN number meaning that they are both Meridianstar's products (which, by the way, appears to be a US company). Contrary to what LS contends, this undermines her evidence that the product sold on Amazon UK was sold by LS or with her consent.

44. Accordingly, LS having failed to establish that she has used the contested mark in the UK prior to the filing date, there is no earlier date to consider. The only relevant date to consider is therefore 08 November 2022.

Goodwill

45. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

46. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

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

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

47. 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.”

48. Goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

49. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), as the Appointed Person, reviewed the following authorities

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.”

50. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

51. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the

trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, “*very limited*”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under LUMOS.⁴

52. I now turn to Exceptional’s evidence.

53. Mr Lapan explains that Exceptional was not the original seller of products sold under the brand ‘CLEANESPRESSO’. The brand was launched in 2013 in relation to coffee machine cleaning products and the first sales in the UK are from 2014.

54. The rights in the ‘CLEANESPRESSO’ brand were transferred on 14 December 2021 from Running Dog Media, LLC and Toughrooster LLC to Exceptional. A copy of an assignment which details the transfer to Exceptional of the ‘CLEANESPRESSO’ marks (registered and unregistered) and the goodwill of the business connected with those marks is exhibited.⁵ It contains a reference to (i) a trade mark registration for ‘CLEANESPRESSO’ and the goodwill of the business associated with such a trade mark and (ii) the webpage amazon.co.uk through which the ‘CLEANESPRESSO’ products are sold in the UK, both of which form part of the assignment.

55. In support of his evidence Mr Lapan provides the following:

- a) Screenshots⁶ (undated) from Amazon UK showing a product identified by the ASIN no. B0725948BY and described as “*CleanEspresso Espresso Machine Cleaning Tablets*” which is shown as first made available for sale on 11 September 2014. The webpages indicate that the product is manufactured by Exceptional Life Products – this, Mr Lapan explains, is a trading name of Exceptional – and has received over 2,000 customer ratings. The product appears as follows:

⁴ See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); (COA)

⁵ SLPEX1

⁶ SLPEX2



📌 2 Gram Espresso Machine Cleaning Tablets - CleanEspresso Model BR-040 - For Breville Espresso Machines

Brand: CleanEspresso
4.7 ★★★★★ 2,054 ratings | [Search this page](#)

Currently unavailable.
We don't know when or if this item will be back in stock.

Brand	CleanEspresso
Item form	Tablet
Scent	Unscented
Specific uses for product	Espresso Machine
Material feature	Descaler

Item weight: 85.05 gram
See more

About this item

- 2 GRAM TABLETS - Don't be fooled by 1gram tabs that cannot hold up to the cleaning cycle pressure.
- BETTER TASTING ESPRESSO by Removing Oily BuildUp Inside Your Machine. Get The Ultimate Cleaning Experience With

And the product details are:

Product details

Is discontinued by manufacturer : No

Product Dimensions : 8.89 x 3.81 x 3.81 cm; 85.05 g

Manufacturer : Exceptional Life Products

ASIN : B0725948BY

Item model number : BR-040

Customer reviews: 4.7 ★★★★★ 2,054 ratings

b) Other screenshots⁷ (undated) from Amazon UK showing other 'CLEANESPRESSO' products as follows:

1. ASIN no. B06XYW6LR5. The product name is "(25 Pack) Jura Espresso Machine Cleaning Tablets – CleanEspresso Model JU-25 – for Jura Espresso Machines" and it is shown as first made available for sale on 30 March 2017, with 86 customer reviews. The product appears as follows:

⁷ SLPEX3



(25 Pack) Jura Espresso Machine Cleaning Tablets - CleanEspresso Model JU-25 - for Jura Espresso Machines

Brand: CleanEspresso
4.6 ★★★★★ 86 ratings

Currently unavailable.
We don't know when or if this item will be back in stock.

Brand	CleanEspresso
Item form	Tablet
Specific uses for product	Coffee Maker
Unit count	25.0 count
Contains liquid contents	No
Manufacturer	CleanEspresso
UPC	881314465996

[Report an issue with this product](#)

2. ASIN no. B06XZF4NM. The product name is *“(40 Pack) Sage Espresso Machine Cleaning Tablets – Sage Coffee Machine Cleaner by CleanEspresso”* and it is shown as first made available for sale on 30 March 2017, with 590 customer reviews. The product appears as follows:



(25 Pack) Jura Espresso Machine Cleaning Tablets - CleanEspresso Model JU-25 - for Jura Espresso Machines

Brand: CleanEspresso
4.6 ★★★★★ 86 ratings

Currently unavailable.
We don't know when or if this item will be back in stock.

Brand	CleanEspresso
Item form	Tablet
Specific uses for product	Coffee Maker
Unit count	25.0 count
Contains liquid contents	No
Manufacturer	CleanEspresso
UPC	881314465996

[Report an issue with this product](#)

2. ASIN no. B07TFBNJTM. The product name is *“Espresso Machine Cleaning Tablets for Sage Machines + 6 Charcoal Replacement Water Filters – Model SAG+6 – Espresso Machine Accessories by CleanEspresso”* and it is shown as first made available for sale on 23 June 2019, with 137 customer reviews. The product appears as follows:



(40 Pack) Sage Espresso Machine Cleaning Tablets - Sage Coffee Machine Cleaner by CleanEspresso

Brand: CleanEspresso
4.6 ★★★★★ 590 ratings

Currently unavailable.
We don't know when or if this item will be back in stock.

Brand CleanEspresso
Item form Tablet
Scent Sage
Specific uses for product Coffee Maker
Special feature Concentrated
Number of items 20

See more

About this item

- Concentrated

Customer ratings by feature

These are all 'CLEANESPRESSO' products made available for sale on Amazon UK prior to the relevant date of 08 November 2022.

56. Mr Lapan says that Exceptional's 'CLEANESPRESSO' products have been promoted via Amazon UK. Further, he provides a screenshot from Amazon UK showing that between May 2017 and August 2022 Exceptional spent £48,580 in adverts and made £201,065.98 in sales across 11,617 orders.

57. Tables outlining UK sales of 'CLEANESPRESSO' products for various periods of time are also included in Mr Lapan's witness statements and are as follows:

Year	UK Sales
2017 (22 June 2017 – 21 December 2017)	£14,356.18
2018 (4 January 2018- 13 December 2018)	£2,372.65
2019 (10 January- 2 May 2019)	£192.92
TOTAL:	£16,921.75

Year	UK Sales
2019 (14 May 2019 – 24 December 2019)	£10,388.29
2020	£108,569.80
2021	£126,622.48
2022 (1 January 2022 – 29 October 2022)	£89,689.33
TOTAL:	£335,269.90

58. The tables above indicates that from 22 June 2017 until 2 May 2019 nearly £17K worth of sales were achieved in the UK. Sales went considerably up from 14 May 2019 until the end of 2021 with further £245K being achieved. This would make a total of approximately £262K between 2017 and 2021 which is above the total sales given by Mr Lapan of £201K between May 2017 and August 2022. Added to this there were further £89K sales between January and October 2022 bringing the total to £351K. Admittedly, there is a discrepancy between the total sales given by Mr Lapan of £201K between May 2017 and August 2022 and the total I have calculated of £262K between 2017 and 2021. However, I do not think that this is fatal, and Mr Lapal has provided another document showing how sales are broken down - the second table appears to have been calculated from that document and whilst there might be some small discrepancies, I think it is down to a genuine error which does not affect the weight I give to this evidence.

59. Lastly, Mr Lapan provides copies of third-party articles⁸ date prior to the filing date of LS' registration which mention the 'CLEANESPRESSO' products and show a picture of the products corresponding to that of Exceptional Amazon UK products. From the web address at least one of the articles appears to relate to the UK. In this connection, I should explain that whilst Exceptional's Amazon printouts are also undated, Exceptional's evidence has not been challenged; but, most importantly, the Amazon printouts filed by Exceptional name Exceptional as the manufacturer of the 'CleanEspresso' products consistently with Mr Lapan's claims that the products were Exceptional's products. Conversely, LS' evidence indicates that a third-party company

⁸ SLPEX9

was responsible for the sale of the goods which LS claims she sold prior to the license being granted.

Conclusion on goodwill

60. Whilst, as I have mentioned, there is a slight discrepancy in the figures Mr Lapan has provided, this is not fatal. The evidence establishes that Exceptional's predecessor in title sold goods in the UK under the sign 'CLEANESPRESSO' since 2014, although sale figures are provided only from 2017 onwards. Between 2017 and October 2022, (i.e. prior to the relevant date of 8 November 2022), Exceptional sold a total of £335K worth of goods under the sign 'CLEANESPRESSO', all of which were cleaning products for coffee machines. Since this evidence is unchallenged and is supported by documents detailing how the sales are broken down, I take the total at face value and need not look behind it. Exceptional also spent nearly £50K (which is a reasonable amount of money) in promoting its goods on Amazon UK prior to the relevant date. Bearing in mind that the goods are relatively inexpensive and were sold through one single platform (i.e. Amazon UK), the sales achieved under the sign 'CLEANESPRESSO' and the money invested by Exceptional in promoting the sign, combined with the continuity and length of use, are such that I consider that at the relevant date Exceptional had sufficient goodwill to sustain an action for passing off.

61. Lastly, in its submissions in lieu LS argued that the sign 'CLEANESPRESSO' is highly descriptive, directly referring to the purpose of the goods - cleaning espresso machines – and that given its descriptive nature, it is very likely that Exceptional was not the first to conceive of this name. Be that as it may, I reject the submission. While such an argument has merit for directly descriptive terms (such as was the case in *McCain International Limited v Country Fair Foods Limited and Another* [1981] R.P.C. 69 (COA)), it is not applicable here. First, it would be unusual to refer to a coffee machine as just "espresso", and so the sign is not descriptive but allusive. Second, the use made by Exceptional is clearly as a brand name as shown by the Amazon listing and by the third-party articles, both of which refer to 'CLEANESPRESSO' as the brand. Thirdly, even weakly descriptive signs can be used to such an extent that they become distinctive of the business (and associated with the goodwill) which uses them. In this case, there is enough trade over a prolonged period of time with

customers capable of establishing sufficient goodwill in the sign so as to make it distinctive of Exceptional.

62. Having establish sufficient goodwill for Exceptional to sustain its passing off claim, I find that Exceptional's claim succeeds as the sign/mark and the goods at issue are identical, meaning that misrepresentation and damage are inevitable.

63. Since Exceptional application for invalidity has succeeded in full, LS' mark is declared invalid *ab initio*. This means that LS cannot longer rely on her mark in the opposition against Exceptional's trade mark application; accordingly, the opposition falls away.

CONCLUSIONS

64. Exceptional's application for a declaration of invalidity under no. 507233 is successful and LS' trade mark no. UK00003847304 will be declared invalid.

65. LS' opposition to Exceptional's application no. UK00004039015 fails and the mark will proceed to registration.

COSTS

66. Exceptional has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award Exceptional the sum of £2,100 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of invalidity and considering the counterstatement: £300
Filing a counterstatement and considering the notice of opposition: £300
Filing evidence: £1,000
Written submission: £300
Official Fees: £200
Total: £2,100

67. I therefore order LIU SHUJUAN to pay EXCEPTIONAL PRODUCT LLC the sum of £2,100. 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 20th day of March 2026

TERESA PINTO
For the Registrar