

BL O/0318/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3670327 BY

EDEN PARFUMS LIMITED

TO REGISTER AS A SERIES OF TWO TRADE MARKS

CRISTIANO RONALDO ORIGINS

AND

CRISTIANO RONALDO
ORIGINS

IN CLASS 3

AND

THE OPPOSITION THERETO

UNDER NO 431652 BY

ORIGINS NATURAL RESOURCES, INC.

BACKGROUND AND PLEADINGS

1. On 19 July 2021, Eden Parfums Limited (“the applicant”) applied to register the series of two trade marks, shown on the front page of this decision, for the following goods in class 3:¹

Soaps, namely, antiperspirant soap, baby hand soap, bar soap, bath soaps in liquid, solid or gel form, beauty soap, body cream soap, cakes of toilet soap, cosmetic soap, cream soap, deodorant soap, detergent soap, granulated soap, hand soap, laundry soap, liquid soaps, loofah soaps, organic soap bars, perfumed soap, shaving soap, skin soap, soap in the form of bath toys, soap powder, soaps for body care, soaps for personal use, soaps for toilet use, toilet soap, soap bars; perfumery, essential oils, cosmetics; dentifrices; perfumes; scents; fragrances; eau de parfum; eau de toilette; cosmetic kits comprised of make-up, compacts containing make-up, brushes, lipsticks, mascara, eyeliners, bronzers, concealer, blushers, foundations, eye shadows, lip-gloss, lip liner, decorative transfers and skin jewels for cosmetic purposes; make-up; make-up kits comprised of brushes, lipsticks, mascara, eyeliners, bronzers, concealer, blushers, foundations, eye shadows, lip-gloss, lip liner, decorative transfers and skin jewels for cosmetic purposes; eau de cologne; cologne; pre-shave and after-shave lotions, balm, cologne, creams, gels and milk; after-shave; scented body spray; after sun block, lotions, creams, gels, milks and balms; body care products and preparations, namely, moisturizers, waxes, exfoliating treatments, anti-wrinkle creams, skin firming creams, cleansers, toning creams, hand creams, cuticle cream, cuticle conditioners, nail creams, softeners and hardeners, body wash, body scrubs, body gels, body emulsions, body masks, facial scrubs, shower gels, fake tan treatments, self-tanning treatments, anti-spot and anti-blemish treatments, age retardant gel and lotions, anti-aging creams, aromatherapy creams, aromatherapy oils, aromatherapy lotions, baby oil, bathing lotions, beauty creams, beauty lotions, beauty gels, beauty masks, beauty milks, beauty serums, and exfoliant creams; preparations for the body, namely, body and beauty care

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).


preparations, exfoliants for the skin, facial cleansers, facial concealers, facial masks, facial scrubs, facial washes, massage oils and skin emollients; hand lotions and toilet waters; anti-perspirants; deodorants; fragranced anti-perspirants; fragranced deodorants; non-medicated skin creams and lotions.

2. The application was published on 3 December 2021, following which Origins Natural Resources, Inc. (“the opponent”) filed a notice of opposition against all the goods in the application.

3. The opponent bases its case on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. For its opposition under sections 5(2)(b) and 5(3), the opponent relies on the following marks and goods:

Mark details:	Goods relied on:
<p>UKTM: 1263081</p> <p>ORIGINS</p> <p>Filed: 20 March 1986</p> <p>Registered: 30 August 1988</p>	<p>Class 3</p> <p>Perfumes, essential oils, cosmetics, non-medicated preparations for the care of the body; deodorants for personal use.</p>
<p>UKTM: 1375726</p> <p>ORIGINS</p> <p>Filed: 7 March 1989</p> <p>Registered: 21 September 1990</p>	<p>Class 3</p> <p>Soaps; shampoos; non-medicated toilet preparations for the care of the hair and/or the scalp; hair lotions; all included in Class 3.</p>

<p>UKTM: 1490251</p> <p>ORIGINS</p> <p>Filed: 31 October 1994</p> <p>Registered: 17 November 1995</p>	<p>Class 3</p> <p>Perfumes, cosmetics, non medicated toilet preparations; essential oils; preparations for the care of the skin and body; anti-perspirants; preparations for the care of the hair.</p>
<p>UKTM: 900112540</p>  <p>ORIGINS</p> <p>Filed: 1 April 1996</p> <p>Registered: 17 February 1999</p>	<p>Class 3</p> <p>Soaps for personal use; perfumery, essential oils, cosmetics, hair lotions.</p>

The section 5(2)(b) ground

5. Section 5(2)(b) of the Act prevents registration of a mark that is similar to the opponent's earlier marks, for goods and/or services that are the same or similar to those of the opponent, such that there will be a likelihood of confusion.

6. Under the 5(2)(b) ground the opponent claims:

“12. The marks in the Opponent's Registrations are closely similar to the mark in the Application.

13. The Applicant's Products are the same as or are similar to the Opponent's Registered Products.

14. *The similarity in the marks and the identity/similarity of the products combines to create a likelihood of confusion. The Application should be refused under section 5(2)(b) of the Act.*

15. *The said likelihood of confusion is increased by the factual distinctiveness acquired by the marks in the Opponent's Registrations through long-standing use."*

The section 5(3) ground

7. The 5(3) ground of opposition requires the opponent to show that, at the relevant date, its earlier marks had a reputation in the United Kingdom (UK), such that use of the contested mark, without due cause, would allow them to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's earlier trade mark(s).

8. With regard to the 5(3) ground, the opponent relies on the same marks and goods as it does under the 5(2)(b) ground and concludes that:

"The mark in the Application is closely similar to the marks in the Opponent's Registrations and use of the former would bring to mind and/or establish a link with the latter materially affecting the behaviour of consumers. In view of the foregoing, the use of the mark in the Application for the Applicant's Products would without due cause:

(a) provide the Applicant with an unfair advantage for the said products in view of the substantial reputation established by the Opponent in its said mark. In particular the use of the mark in the Application for the said products would create an unfair benefit for the Applicant by linking the Applicant's Products to the power of attraction, prestige, and reputation established and carefully nurtured throughout the United Kingdom, over many years by the Opponent in its marks, such that the image of the Opponent's marks and the characteristics they project would thereby be transferred to the Applicant and the Applicant's Products.

(b) reduce the distinctiveness of the marks in the Opponent's Registrations and diminish the ability of the Opponent to distinguish its said goods from those of others. In particular the use of the mark in the Application for the Applicant's Products would blur the distinctive character of the Opponent's marks as enjoyed by the Opponent throughout the UK for the Opponent's Registered Products, causing the relevant public less likely immediately to recognise and rely on the Opponent's marks thereby impeding or nullifying the Opponent's ability effectively to market those goods."

The section 5(4)(a) ground

9. The 5(4)(a) ground of opposition requires the opponent to show it had goodwill in a business at the relevant date and that the sign ORIGINS is associated with or distinctive of that business.

10. For its opposition under section 5(4)(a) of the Act, the opponent claims substantial goodwill based on its use of ORIGINS, since 2000, throughout the UK. The opponent claims that the sign has been used for beauty and skincare preparations, cosmetics, make-up, soaps, shampoos, cleansers, perfumes and essential oils. With regard to services, the opponent claims that use has been made of the ORIGINS sign for training, information, advice and assistance services for the selection and application of its products and for services to support the retailers that market the Opponent's products and services. In its statement of grounds, the opponent submits:

8. The Applicant's Products are the same as or are similar to the Opponent's Products and Services and are otherwise materially related. The mark in the Application wholly contains and is highly similar to the Opponent's Mark. In view of the foregoing, use of the mark in the Application for the Applicant's Products would at the date of the Application and at all other material times, have constituted a misrepresentation that those products were and are connected with the Opponent. Such misrepresentation would have caused damage to the Opponent and its business and would continue to do so. The use of the mark in the Application for the said products was therefore liable to

be prevented by the Opponent at the date of the Application, and at all other material times, under the laws of passing off and it continues to be so.

11. The applicant filed a counterstatement in which it denies the grounds of opposition and puts the opponent to proof of use of its earlier marks.

12. The opponent is represented by Beck Greener LLP. The applicant is represented by Sandiford Tennant LLP. Both parties filed evidence and skeleton arguments in advance of a hearing. I make this decision following careful review of the papers and submissions before me.

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

Preliminary issue

14. The application is made for a series of two marks. The first is the words Cristiano Ronaldo Origins. The second mark in the series is for the same words on a white rectangular background, with the trade mark akin to letter head. Since the words are the same and neither mark has any additional stylisation, I will refer to the series as CRISTIANO RONALDO ORIGINS or the word mark.

DECISION

15. Given the opponent's length of use and its claimed reputation, the ORIGINS brand having been established in 1990, I will begin with the 5(3) ground of opposition.

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

“A trade mark which-

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

17. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law is as follows:

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

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

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

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or

similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

18. In *General Motors*,² the CJEU held that:

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

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

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

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

19. The conditions of section 5(3) are cumulative. First, the application must be similar to the earlier marks. Secondly, the opponent must satisfy me that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must establish that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark(s) being brought to mind by the later mark. Finally, assuming that the earlier conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the

² Case C-375/97

opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors that must be assessed when deciding whether the public will make a link between the marks.

The opponent's evidence of reputation

20. The opponent's evidence is provided by Luke Evans. Mr Evans is an officer of Estée Lauder Companies UK. He joined the company in 2011 as National Sales Director. He is currently the Vice President and General Manager for the UK and Ireland, with responsibility for Estée Lauder, Aerin and Aramis brands. He has held this position since January 2023. He confirms that ORIGINS is part of the Estée Lauder group and submits:

“Between March 2020 and January 2023 I was responsible for, amongst others, the ORIGINS brand in the UK and Ireland. I have full access to Origins' books and records relevant to this matter.”

21. Mr Evans states that ORIGINS was founded by Leonard Lauder, son of Estée Lauder, in 1990. He describes ORIGINS as:

“...a beauty brand known for its mindfully formulated and naturally derived ingredients. It supplies skin care, cosmetics, perfumes, and related products and services”.

22. He describes the ORIGINS business as follows:

“8. The ORIGINS business is international. Its skincare, cosmetics and perfume preparations have been continuously sold in the United Kingdom under the ORIGINS trade mark for more than twenty years. ORIGINS products were initially marketed in the UK through bricks and mortar retailers including concessions in high profile department stores. They continue to be sold through such outlets. However, sales through authorised online retailers, as well as via the ORIGINS' UK website at www.origins.co.uk, have become increasingly important over the years.”

23. Mr Evans provides evidence dated before and after the relevant date (which is the filing date of the contested application, namely 19 July 2021). The relevant material is summarised in the following paragraphs.

24. Mr Evans provides contemporary prints from the ORIGINS website,³ showing one product per category of goods sold by the opponent. He confirms that these examples were current at the date of his witness statement, but that each category of goods was also being sold under the ORIGINS brand in July 2021 (the relevant date). The categories shown are cleansers, eye care, toners, serums, moisturisers, masks, hand care, perfumes and men's products. The example from the ORIGINS men's range is DR ANDREW WEIL for ORIGINS MEGA-MUSHROOM Soothing Hydra Mist. The perfume product appears as follows:



25. Mr Evans describes the ORIGINS UK website as the opponent's shop window and provides examples of the www.origins.co.uk homepage from 2006 to 2021, accessed via Waybackmachine.⁴

26. With regard to the appearance of the ORIGINS products, Mr Evans submits that every product in the range has the ORIGINS trade mark clearly printed on the product packaging.

27. A page dated 13 October 2006 has the following at the top:

³ See exhibits LE2

⁴ See exhibit LE4



28. No products are shown, but the tabs at the top of the page are Home, Skin care, Bath & Body, Colour, Sensory therapy, Fragrance, Haircare, Origins for men and Great gifts.

29. A page dated 6 October 2008 has the following at the top of the page:



30. I note that all web pages after this date have the words Powered by Nature. Proven by Science below the tree and ORIGINS elements. No products are shown on the page but the tabs at the top include ORIGINS ORGANICS, Dr Andrew WEIL for Origins, Skin care, Bath & Body, Colour, Sensory Therapy, Fragrance, Hair care and Origins for men. A further list of tabs next to a search bar includes a Facebook button, 'about origins', 'stores & events', 'what's new', 'bestsellers' and 'great gifts'. There are links that have text, with a space where an image is obviously missing. The text includes, 'Get Green with Origins, Origins Great Skincare Giveaway!', as well as 'Youthopia', described as 'Skin Firming Cream'; 'Optimise Skin Defences', with an image described as 'Mega-Mushroom Face Cream' and 'A Perfect World', with an image described as 'A Perfect World? Moisturiser'.

31. A page dated 14 December 2009 has the same green and white logo and the same tabs at the top as the previous example. In addition, it has text without images for 'Welcome to Origins', 'Origins Limited Edition Gift Sets', '2009 New Top Sellers', 'Stocking Fillers' and 'Ginger Collection', as well as information about Christmas delivery and free samples.

32. A page dated 21 April 2010 has the same green and white logo and the same tabs at the top as the previous two examples. It has text without images for 'Welcome to Origins, a Natural Skin Care Specialist', 'New From Nature, Brighter by Nature High-Potency

brightening peel with fruit acids', '2010 New Top Sellers', 'New Skin Care Guide' and 'What's New', as well as information about delivery and free samples.

33. A page dated 26 February 2011 appears to be taken from the front page of the ORIGINS website, as the words 'Welcome to Origins, a Natural Skincare Specialist' can be seen at the top of the page. The following pop up appears in the centre of the page:



34. Below the image is the description for an age-erasing eye cream with mimosa, with a 'shop now' button below it. Links are provided for 'customer favourites', 'NEW Hydrate, Energise and Protect. Leaves a flawless finish' and 'Find out your skin needs'.

35. A page dated 22 September 2012 has the same green and white tree logo and wording as shown in paragraph 28, above. The following product is shown below it:



36. It is described as, 'Plantscription SPF 15 Anti-aging foundation and has a 'LEARN MORE' button below it. In the side bar of the same page a range of products is shown under the heading 'Nature's Plant Power'. The goods are described as 'Plantscription age correctors bring a sigh of relief to ageing skin'. The goods appear to have the same tree

and word ORIGINS logo on the front as is shown on the foundation, above, although the reproduction is small and not easy to see.

37. In the same side bar is: 'Have a question? Origins Beauty Advisors are now available to chat live online'. There is also a section headed 'Must-haves for a natural beauty, in hues inspired by nature's palette, discover new shadows & blush'.

38. A page dated 1 September 2013 shows the same green and white logo at the top. A drop-down menu from the tab, 'Bath & Body' enables customers to search by category, range or must-haves. Categories include, inter alia, body scrubs, body moisturisers, body washes, hair care, hand & foot care and fragrances. A different 'Shop by Category' list is shown on the front page of the website and includes, cleansers, toners, Origins for men, lip care, masks and exfoliators. Ranges include A Perfect World, Calm to Your Senses, Dr Andrew Weil for Origins, Ginger, Gloomaway and Salts of the Earth. Customers are also invited to 'Shop by Skin Concern', for example, Age Fighting Protection, Reduce Lines and Wrinkles and Firm, Lift & Tighten. Four images are shown under the heading, 'Shop by Star Collection'. They are Plantscription (4 signs of aging visibly reduced), A Perfect World (Age Fighting Protection), Brighter by Nature (Reduce Dark Spots & Even Skin Tone) and Dr Weil Mega-Mushroom (Relief for redness & sensitivity). The four images look to have the tree and the word origins on the front of the packaging, though they are small reproductions and are difficult to see.⁵

39. A page dated 25 June 2014 shows the new 'Wake Up Blend' product, GinZing. The product appears as follows:



⁵ Two of the products are shown elsewhere in evidence and do have the described branding on the front

40. On the same web page there is a free exclusive sample selection with every £50 purchase. Three samples are shown, each has the tree logo with the word ORIGINS underneath. I cannot read the product descriptions. Also available is Expert Advice via live chat and the chance to 'Experience the UK's #1 masks for FREE'. Two grey tubes are shown next to the text. Both have the tree logo in white with the word ORIGINS below.

41. A page dated 8 November 2015 has the following green and white logo at the top:




42. At the bottom of the page there are three products below the words, 'WHAT'S NEW'. They appear to be from a 'Comfort Mood' range and include 'Whipped Vanilla Body Souffle' (£28); 'Ultra-rich Vanilla Body Butter' (£30) and 'Silky Vanilla Hand Cream' (£17.50). The images are small, but it appears that the tree logo is used next to the slightly stylised word 'ORIGINS' at the bottom of the label on the front of each item.

43. On a page dated 7 January 2017, the logo is cut off at the top of the web page. The only part that can be seen is the bottom part of the tree logo with the word ORIGINS below it. The tabs at the top of the page are New, Face, Bath & Body, Mens, Gifts, Offers, Our Story and Madeline Shaw. Two products are shown on the page:

TOP SELLER

*Best For
Acne & Oil Control
Dry, Normal, Oily Skin*




**CLEAR IMPROVEMENT®
ACTIVE CHARCOAL MASK TO CLEAR PORES**

★★★★★ · 61

£24.00

*Best For
Hydration
Dry, Normal Skin*



**DRINK UP®
10 MINUTE MASK TO QUENCH SKIN'S THIRST**

★★★★★ · 10

£24.00

44. A page dated 1 August 2018 has the following tabs: New, Face, Bath & Body, Mens, Gifts, Offers, Our Values, Madeline Shaw and Flagship Stores. The page shows the following product:



**HYDRATES
ENERGIZES
PROTECTS
PERFECTS**

WITH SPF 40

[SHOP NOW](#)

£30

ORIGINS
GINZIN® SPF 40
Energizing, Flax Seed Moisturizer
Broad Spectrum SPF 40

45. On a page dated 25 August 2019, the logo has been cut off at the top. I can see the bottom of the tree logo with, what looks to be the stylised word ORIGINS next to it. The page promotes a 'BANK HOLIDAY SURPRISE', which is a free skincare gift when you spend £35 and a free 'FULL SIZE GLOW-CO-NUTS' when you spend £65.

46. The next page, dated 14 October 2020, has the same partial logo at the top. The images have not loaded. The top of the page shows tabs for Gifts, New, Best Sellers, Skincare, Makeup, Bath & Body, Offers and About. The wording on the page is 'Introducing NEW GinZing' and 'FREE PLANTSCRIPTION SERUM 15ML With All Orders'.

47. Mr Evans states that 'for many years' ORIGINS products have been sold in the UK from stores including concessions in mid to high-end department stores, such as John Lewis, Selfridges and Harrods and high street pharmacies, such as Boots.

48. Mr Evans provides Waybackmachine pages for those retailers.⁶ The ORIGINS logo with the word below the tree logo is shown on a page taken from www.boots.com on 25 May 2020. Each of the product labels has the tree logo and the slightly stylised word ORIGINS below it.

49. A page from John Lewis and Partners is dated 29 September 2020⁷. It has an ORIGINS banner with the tree logo above the slightly stylised word ORIGINS. The words underneath the logo are: 'Skincare powered by nature, proven by science. Discover Origins' range of moisturisers, cleansers, serums and more'. A selection of ORIGINS products is shown to the right of the banner. Below it is the word ORIGINS followed by (94), which is presumably, the number of products that were available at that date.

50. A page taken from Selfridges is dated 9 August 2020. A search for ORIGINS has returned 36 results. The product description and prices have been cut off at the bottom of the page. The products shown in three photographs on the page under 'Our favourites' are 'Original Skin', 'Super Spot Remover' and one of the GinZing products. Each product label has the tree logo with the slightly stylised word ORIGINS below.

51. A page from Harrods is dated 30 September 2020. The images are missing. The text shows that 79 Origins products were found. The descriptions for the first three are: ORIGINS x Dr Weil Mega-Mushroom Relief and Resilience Fortifying Emulsion (100ml); ORIGINS GinZing Oil-Free Energy Boosting Gel Moisturiser (50ml) and ORIGINS Clear Improvement Moisturiser (50ml). Each of the product labels has the tree logo and the slightly stylised word ORIGINS below it.

⁶ See exhibit LE5

52. Mr Evans states that the opponent also sells its ORIGINS products through third-party online retailers, such as 'Look Fantastic'. He says:

“LookFantastic is the UK's best-known online beauty product retailer...LookFantastic has been an important UK online outlet for us. For instance, for the year 2016 the retail value of UK sales of ORIGINS products through the LookFantastic website was more than £1,000,000.”

53. A page from the site is dated 9 March 2021 and has been accessed via internet archive Waybackmachine. The following appears on the page, alongside 'ORIGINS' and a 'SHOP NOW' button:⁷



54. Mr Evans has also provided the 'about us' page for Look Fantastic that says it is Europe's number one online premium beauty retailer, with a portfolio of over 660 premium brands, shipping to more than 200 countries. Its 'About Us' page states that it had 10 million visits per month in 2017.

55. Mr Evans states that at the relevant date, Next, Asos and Marks & Spencer were also selling ORIGINS products online.

56. UK sales figures are given as in excess of £20,000,000 per year, since 2012.⁸

⁷ See exhibit LE6

⁸ See Mr Evans' witness statement at paragraph 19

57. Mr Evans provides invoices, one for each year 2015–2020, to show the type of documentation sent to customers.⁹ The invoice values range from £220.32 to £1053.32 and are for goods sent to Berkshire, Surrey, Suffolk, Cheshire, Cambridgeshire and Leeds. At the top of each invoice is the following:



58. The goods are listed by range, for example, Ginzing Eye Cream, Plantscription Power Serum and Dr Weil Mega Mushroom Face Serum.¹⁰

59. Mr Evans states that in the period 2017 to 2020, ORIGINS spent in excess of £500,000 per year on marketing and advertising and confirms that is on a par with expenditure in other years. Mr Evans states that the money was spent on:

- Printed material and visual display advertising.
- Store window displays.
- Digital, e.g. search engine optimisation, UK website and social media, including UK Instagram, Facebook, Pinterest, and Twitter accounts and pages.
- Email advertising.
- Organising ORIGINS retail events.
- GWP (gift with purchase).
- Distributing testers and samples.
- Public relations, that is, fostering media and social media interest for the products and getting them talked about.
- eMessaging

⁹ See exhibit LE7

¹⁰ See exhibit LE7, pages 6 and 9

60. Mr Evans' provides some examples.¹¹ An advertisement from 2017 is co-branded with Cosmopolitan magazine. It is described as the GinZing SPF40 launch and is said to have reached 13,404 'delivered page views'. A campaign from 2018 is titled, 'Mega-Mushroom Re-Focus'. 216,540 newsletters were delivered. An example from 2019 relates to a new 'Drink Up Intensive Overnight, with Avocado and Swiss Glacier Water'. It looks as though the promotion related to samples of the new product as Mr Evans says, *"2,000 samples of the product were claimed"*.

61. Mr Evans provides examples of press and media references that he submits are dated from 2012 to July 2021.¹² However, the first is dated in 2011. They include the following:

A brief history of Origins, by Ann Chesters, The Guardian, dated 4 October 2011

62. *"Launched in 1990 by Leonard Lauder, son of Estee, Origins was the first prestige skincare brand to focus on using natural ingredients in its products"*. The article reports on the brand's environmental efforts using wind and hydro power in its production processes and highlights products such as, Origins VitaZing SPF15 Energy-boosting moisturiser (£26) and Origins Plantscription Anti-Ageing Serum (£45) as well as the new Plantscription eye treatment (£45).

Elixirs of Youth, Forget facelifts and roll back the years with at-home anti-ageing products, by Rebecca Newman, Evening Standard Magazine (undated)

63. The article highlights Origins Youthtopia – Lift Firming Cream (£45 at John Lewis). *"Based on the guggul tree root used in Ayurvedic medicine results from Origin's new organic cream are exemplary"*.

Beauty of Charity, Daily Express, 11 March 2013

64. Origins Plantscription SPF25 Anti-Ageing Cream, £46.

¹¹ See exhibit LE8

¹² See exhibits LE9 and LE10

“Origins has teamed up with Global Re-Leaf as part of the Plant A Tree campaign and pledged to plant a tree for each tub of cream sold. Raspberry plant stem cell technology smooths skin while UV filters protect it. Since the campaign began, Origins has helped plant over 265,000 trees”.

The Beauty Power List, Fastest Selling Products, Marie Claire, 1 April 2015

65. *“These star performers have people queuing around the block for their beautifying prowess. It’s time to invest”.* Origins Plantscription Anti-Ageing Power Serum, £48 is pictured under in a circle, next to the words, *“One bottle sold every 30 seconds”.*

How skincare got clean: the best paraben-free brands to buy into now, The Telegraph, 19 June 2016

66. Under a picture of ORIGINS Original Skin, the text reads,

“Since its inception in the late 1980s, Origins has had a minimalist approach to beauty – excluding key synthetics in favour of plant-based, high-performance skincare”.

9 Products To Help You Become A Morning Person When You’re Not, British Vogue, 16 January 2019

67. ORIGINS GinZing is pictured with the words:

“Origins has created the ultimate wake-up spritz chock full of invigorating ingredients – coffee, spearmint, lemon and orange – delivering instant hydration without being harsh on the skin. Use first thing in the morning and during the day for a quick pick-me-up”.

I just ticked everyone’s Xmas presents off in less than half an hour with 25% off at Origins, Marie Claire, 21 November 2020

68. Below the article are featured products that include Origins Skincare Superstars, Best-Selling Must-Haves gift set, Origins GinZing Ultra Hydrating Energy-Boosting Cream and Origins Clear Improvement Active Charcoal Mask. The final line reads, *“Its gift sets and skincare galore at the Origins Black Friday Sale...”*.

20 Of The Most Exciting New Beauty Products To Add To Basket Now It’s 2021, British Vogue, 5 January 2021

The sixth product in the list of 20 is ‘Origins Drink Up Nourishing Avocado Lip Butter’.

69. In each of the articles, the product photographs show packaging with the tree logo and the slightly stylised word ORIGINS below, other than one example of a tanning moisturiser that just features the slightly stylised word ORIGINS.

70. Mr Evans provides a single example from each of the ORIGINS social media pages, these are contemporaneous with his witness statement. He also provides the number of followers, or subscribers for Facebook (2.1m),¹³ Instagram (95.8k)¹⁴ and YouTube (5.36k),¹⁵ although I note these are figures that were accurate at the time of filing his statement, rather than at the relevant date. A YouTube channel has been operated by ORIGINS since 2006. Its Facebook page was established in 2010, the Instagram page in 2014. Some of the YouTube videos were posted three years before the date the page was printed, meaning that they fall within the relevant period. They include ‘Origins GinZing Into The Glow Serum’, Origins Mega-Mushroom Treatment Lotion’ and two different videos for ‘Origins GinZing Oil-Free Energy-Boosting Gel’.

71. Mr Evans states that ORIGINS has won awards in the UK for its products. He provides 83 examples for the period 2012–2018. These include:

2013		
Organisation	Award	Product
Marie Claire	Nomination	Dr Weil Mega Bright Serum

¹³ See exhibit LE11
¹⁴ See exhibit LE12
¹⁵ See exhibit LE13

Red Magazine	Red's Best of Beauty	Plantscription Youth Renewing Face Oil
Cosmopolitan	Beauty Awards – Best Eyeshadow	GinZing Brightening Eye Shadow
Zest	Best Night Cream	Night A Mins
2014		
Tatler Beauty Awards	Highly Commended Body Exfoliator	Incredible Spreadable
Cosmopolitan	Best Face Exfoliator	GinZing Scrub Cleanser
In Style Best Beauty Awards	Best De Puffing Eye Gel	No Puffery Mask
Women's Health – Future 50 Beauty Awards	Best CC	Smarty Plants
Women's Health	Best Body Exfoliator	Clear Improvement
2015		
Cosmopolitan	Best Serum	Original Skin
Woman and Home	Best Cleanser	GinZing Scrub Cleanser
2016		
Tatler	Best Foaming Mask	By All Greens
Vogue	Vogue100	Super Spot Remover
2017		
Woman's Way Ageless Beauty Awards	'Picked by the team' Award	Origins High Potency Night A Mins Cream
Stylist Beauty Awards	Best Blemish Treatment	Origins Super Spot Remover Blemish Treatment Gel
2018		

Women's Health Awards	Best Day Cream	Origins Original Skin Matte Moisturiser with Willowherb
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72. Mr Evans concludes his evidence with prints taken from the Mumsnet forum. These are dated between 2012 and 2020.¹⁶ He says:

"I think it is significant from these conversations, as it is with the press and media examples mentioned earlier, that ORIGINS needs no introduction. It is assumed by the contributors that, in the context of beauty and skincare, a reference to ORIGINS will be understood as meaning our products".

73. Mumsnet was founded in 2000 and is now the biggest network for parents, with around 7 million unique visitors per month, clocking up around 100 million page views.¹⁷

74. What follows is a list of the titles of relevant posts (underlined), followed by the date each was posted, with relevant comments below:

MAC, Bobbi Brown, Origins – your recommendations? - 21/10/2011

"Big fan of Origins. Erase the years moisturiser, lavender shower gel and the body scrub. Hand cream".

Origins skin care 2 - 25/03/2012

"Omg I am so converted to their skin [c]are after having a free facial, so many products I want to buy...How come I didn't know about their combination skin products?"

"I think they are great. I have combination skin and use Checks and balances, United state toner and Starting over oil free moisturiser. Modern friction scrub is also amazing."

¹⁶ See exhibit LE15

¹⁷ See exhibit LE15, page 10

“Have been using it for nearly two years now, and LOVE it. I use their cream cleanser (can't remember the name), Brighter by Nature serum (feels amazing on skin and helps smooth and gets rid of pigmentation/scarring) and Brighter by Nature moisturiser. Second that modern friction scrub is excellent too. GinZing under eye cream is also amazing.”

Origins? What would you recommend? - 29/11/2013

“about to order something from origins as a present for someone else but I may be tempted to treat myself! is it any good? what would be nice?”

“The 'Never A Dull Moment' exfoliator is an absolute must. It works wonders and smells incredible. Agree about the ginger range too!”.

“I love origins, their ginger range is fab, also some lovely cleansers and moisturisers. I really like Never a Dull Moment cleanser and GinZing moisturiser and eye cream, also their Drink Up overnight hydration mask works miracles!”

“The Andrew Weil mushroom range is quite nice. Smells divine and good for anti-redness, calming etc. Whenever I wear it (not often), it reminds me of having a beauty treatment - all those lovely smells!”

Origins Perfect World SPF35 – discontinued – 26/07/2014

“Why do they discontinue things I love? (and according to the Origins lady, I'm not the only one)”

“Still raging that they discontinued Youthtopia eyecream - the only thing that has ever worked for me. If you are reading this Origins -please bring it back !!!”

Dermalogica or Origins? – 15/04/2015

“I love Origins, and Dermalogica, but I find Origins nicer to use (texture, smell etc).

“Have A Nice Day has been discontinued (sob) some years ago, I used to love it for a light summer moisturiser. Perfect World is much heavier and thicker so probably more what you're after.

But I love Night A Mins so you may disagree. (My skin is combination oily, with occasional dehydration but mostly under control).

I use the Perfect World or Plantscription serums too (currently on PW serum and Plantscription moisturiser, which is another nice thick one). My skin definitely feels better when I use the serum before moisturising.”

Origins skin care 5 – 29/01/2016

“I remember using Origins years ago and wondered how people rated them these days? I'm 39 and have pretty good skin, but two small boys that aren't the greatest sleepers do leave me a bit knackered looking...Budget isn't unlimited by any means, but [I seem] to remember Origins being fairly midrange and that's about right”.

“I use the Origins Drink up mask and I think it's one of the most hydrating”.

Hit me with your fave masks from Origins please - 13/02/2019

“I'm thinking of treating myself to a nice moisturiser and might try Origins. I've used Night-Mins before and liked it. Thinking about a day cream, has anyone any experience of A Perfect World, Plantscription or Make a Difference?”

75. Before assessing the opponent's reputation, I find it convenient to address two issues in the applicant's submissions.

The opponent's turnover figures

76. The applicant does not dispute the opponent's turnover figures but submits that the Opponent's sales figures 'in excess of £20 million' are not significant, "...within the enormous beauty and personal care products market". It says:

"The value of the UK skincare market was \$17.98 in 2022 (https://growthmarketreports.com/report/skincare_market-united-kingdom-industry-analysis). The Opponent's proportion of the overall UK market amounts to about 0.1%".

77. There are three problems with this submission. The first is that the UK skin care market is likely to be worth more than seventeen dollars and ninety-eight cents, this is clearly a typographical error. Secondly, the skeleton argument is the first time this point has been raised by the applicant and thirdly, the supporting evidence is a hyperlink to a report that has not been provided.

78. The applicant is professionally represented and must know it is not appropriate to use the skeleton argument to raise new points and file new evidence. It must also be aware that the tribunal does not accept evidence in the form of hyperlinks, in the absence of evidence of what lay behind them at the relevant date. This is because the content behind the link may have changed.

79. Accordingly, I give no weight to this submission, beyond noting that 0.1% of what is no doubt a very large and valuable market is still likely to be a significant volume of sales.

The opponent has no reputation in the ORIGINS word marks

80. The applicant submits in its skeleton argument that the opponent has not shown any examples in evidence of use of the word ORIGINS on packaging, without the tree device. It concludes that given the low level of distinctiveness of the word ORIGINS any 'public reputation in the earlier marks is held in the tree device or a combination of the word ORIGINS and the tree device'.¹⁸

¹⁸ I will return to the issue of distinctiveness of the word ORIGINS later in this decision

81. Mr Bartlett (for the opponent), submits, in his skeleton argument, that use of the word ORIGINS with the tree device is also use of the word ORIGINS and supports the word mark registrations. He says the same of the slightly stylised word mark ORIGINS.

82. In *Colloseum Holdings AG v Levi Strauss & Co.*,¹⁹ the court held that 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. This is the case regardless of whether or not separate protection has been sought for the other combinations. I find that to be the case here.

My conclusions on reputation

83. The opponent’s evidence shows that ORIGINS began in the 1990s and since its launch, has established itself as a well-known brand, primarily in the skincare market. Its products have been reviewed and reported in the press and magazines, for example, The Guardian, The Daily Express, Evening Standard, Cosmopolitan, Marie Claire and British Vogue. It sells its goods through stores such as Boots, Harrods, John Lewis and Selfridges, as well as ASOS, Next and Marks and Spencer. Online sales of ORIGINS goods in the UK in 2016 through the Look Fantastic website amounted to £1m+. A 2015 beauty power list in Marie Claire showed that Origins Plantscription anti-ageing power serum, priced at £48, sold at a rate of one bottle every 30 seconds. ORIGINS has won numerous awards, a list of 83 is provided in evidence and includes awards from Women’s Health, Tatler and Vogue, among many others. This is supported by the evidence from Mumsnet, which I agree with Mr Evans, shows an awareness of the ORIGINS brand amongst consumers, which is such that each person posting on the blog refers to ORIGINS without the need for further explanation.

84. ORIGINS goods are promoted as being environmentally responsible, for example, being paraben free, using wind and hydro power in the production processes and taking part in the Re-leaf campaign where a tree is planted for every tub of Plantscription anti-ageing cream sold. ORIGINS goods are shown to be made of natural ingredients, for

¹⁹ Case C-12/12, paragraph 32. See also *Castellblanch SA v OHIM, Champagne Louis Roederer SA* [2006] ETMR 61

example, ginger, raspberry stem cells, mimosa, mushrooms and mango seed butter. The words 'Powered by Nature, Proven by Science' sit below the tree logo and the word ORIGINS on website pages and have done since at least October 2008.

85. The earlier ORIGINS marks are used alone in press reports, advertising and marketing materials, in products descriptions and on its own website. It is also used with variations of tree devices, including, inter alia, a small tree device to the left of the word and a large tree device above the words. In some examples, the bottom of the two-tree device terminates in a straight horizontal line and in other versions there are two distinct curved lines, one at the bottom of each of the two trees.

86. The UK turnover for ORIGINS is £20m+ per year from 2012-2020.

87. Having considered the evidence in detail, I cannot find that the opponent has a reputation under the ORIGINS marks for perfume. This is because the opponent's evidence relating to perfume is not sufficient to establish a reputation in those goods. Turnover figures are not broken down into categories of goods and whilst this is not necessarily a deciding factor, I have very little other evidence that shows sales or advertising of perfumes. In total, there are two undated pictures of a ginger perfume provided by Mr Evans and there are tabs headed 'Fragrances' on historic web pages, but no evidence has been provided to show what lies behind the 'Fragrance' tab, if a customer were to click on it. There is one example of a sale of Ginger Essence on an invoice dated 6 January 2020, priced £19.98.

88. That said, it is clear from the evidence that the fragrance of some of the opponent's goods is an important part of their attraction. For example, the Mumsnet blog post, dated 29 November 2013, includes comments such as, 'smells incredible' and 'all those lovely smells'.

89. Overall, the opponent's evidence shows it to have a substantial reputation in the ORIGINS brand for skincare (and to a lesser extent) cosmetics. The reputation is such that the opponent's goods are associated with natural, particularly plant-based ingredients.

Link

90. In addition to the earlier marks having a reputation, a link must be made between the mark applied for and the earlier marks. In *Intel Corporation Inc v CPM (UK) Ltd*²⁰ (“*Intel*”) the CJEU provided guidance on the factors to consider when assessing whether a link has been established. It stated:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

91. Those factors include:

The degree of similarity between the conflicting marks

92. In *Intra-Press SAS v OHIM*,²¹ the CJEU stated that:

“72...The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

²⁰ C-252-07

²¹ Joined cases C-581/13P & C-582/13P

93. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.

94. The similarity of signs under sections 5(2) and 5(3) of the Act is assessed in the same way.²²

95. The application is made for the term 'CRISTIANO RONALDO ORIGINS'. The opponent relies on four earlier marks. Two are plain word marks, for the word ORIGINS; one is a slightly stylised word mark ORIGINS and the fourth is a device of two trees and the slightly stylised word ORIGINS.

96. For the purposes of the remaining assessment under the 5(3) ground of opposition, I will compare the opponent's word marks to the contested mark. In doing so, I take account of the fact that the word ORIGINS is used alone and with a number of two-tree devices, all of which constitute use of the word mark and contributed to my conclusion that the opponent has the requisite reputation.

97. In terms of the visual and aural comparison between the contested mark and the earlier marks, the applicant says:

17. The Earlier Marks share the word ORIGINS with the contested sign but do not include the forename CRISTIANO and surname RONALDO of the contested sign. It is well established that similarities located at the beginning of a mark will be noticed with greater emphasis by the average consumer. In this case, it is submitted that CRISTIANO RONALDO is the dominant visual feature of the marks.

²² See the principles established in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P

18. Additionally, the inclusion of the figurative element of the Tree Device in the 2540 Mark, which is the prominent feature of that mark, creates further differentiation between that mark and then contested sign.

19. The Origin Marks and the Contested Sign are not visually similar.

20. As with the visual comparison, the inclusion of the forename and surname Cristiano Ronaldo in the Contested sign creates a marked difference between the pronunciation of the Earlier Marks and Contested sign. Aurally, the Earlier Marks and the Contested sign are not similar.

98. Both parties' marks are presented in block capitals. The application and the plain word earlier marks have no additional stylisation. The third word mark has a small degree of stylisation, which contributes very little, if anything to the overall impression of the mark. The overall impression of both parties' marks rests in the words.

99. Each of the opponent's word marks is the word ORIGINS. The third word of the contested application is the word ORIGINS. Clearly, there must be some degree of visual and aural similarity, given both marks contain the identical word ORIGINS. The application includes the words CRISTIANO RONALDO before the word ORIGINS. All three words will be noticed and articulated. Accordingly, I find the competing marks visually and aurally similar to a fairly low degree.

100. In terms of conceptual similarity, the applicant says:

"8. The composite sign CRISTIANO RONALDO ORIGINS forms such a unit as having a different meaning compared with the meaning of the components CRISTIANO RONALDO and ORIGINS taken separately. The word ORIGINS has no independent distinctive role in the composite sign.

9. This is due to the fact that when viewing the Contested Sign as a whole the relevant public will come to the conclusion that the marketed product originates from a producer associated with Cristiano Ronaldo".

101. Further, the applicant says:

“14. In this instance the level of fame of the individual whose name is contained in the Contested Sign is so significant that it is totally implausible to suggest that the relevant public would perceive an independent conceptual meaning in any additional element to a composite mark unless the additional element was highly distinctive. Cristiano Ronaldo is a world-renowned footballer and as mentioned in paragraph 8 of the witness statement of Nayan Thakrar, has a total social media following in excess of 900 million. From a google search, we have gathered that this number now approaches 1 billion, the largest following in the world (<https://explodingtopics.com/blog/social-media-following>)”.

102. The opponent submits:

“30... relation to class 3 goods ORIGINS, whether alone or in the form CRISTIANO RONALDO ORIGINS, has no clear meaning and the two elements do not "hang together" in relation to those goods.

31. Accordingly, the marks overall must be found to have some degree of similarity. That degree of similarity is at least moderate”.

103. I accept that Cristiano Ronaldo is a famous footballer and that the presence of his name in the mark gives a clear conceptual message relating to the footballer himself. However, this is not linked to the word ORIGINS in the same mark. I agree with the opponent that the applicant’s conclusion that the concept of its mark relates to the origin story of Cristiano Ronaldo is unlikely. If the goods were documentary films or books, then it is a plausible argument, but in the context of goods in class 3, being skincare, cosmetics and perfume, which is the context in which this assessment must be made, I do not accept it.

104. The word ORIGINS applied to goods in class 3 is more likely to be seen as an allusive reference to the source of the goods themselves, especially in a market where

the goods are, in my experience, often sold based on their naturally derived or scientifically approved ingredients.

105. In terms of the conceptual comparison, clearly the inclusion of Cristiano Ronaldo in the application is a significant point of conceptual difference, but the word ORIGINS does not sit with the words CRISTIANO RONALDO in a way that forms a new meaning, as claimed by the applicant. ORIGINS is the only word in the opponent's earlier word marks and is the third word in the applied-for mark, it will be given its plain and ordinary meaning. I find the conceptual similarity between the competing marks to be low to medium, based on the inclusion of the word ORIGINS in both, which is the totality of the earlier word marks and an independent element in the application.

The strength of the earlier mark's reputation

106. For the reasons I have already given, at the relevant date, the opponent's marks had a substantial reputation in the skin care market and to a lesser extent in respect of cosmetics.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

107. The opponent submits:

25. The word ORIGINS for beauty products is inherently distinctive. The word has no descriptive meaning for such products and it is not laudatory or otherwise non-distinctive.

26. Further, as a result of [the opponent's] extensive and longstanding use of the mark, ORIGINS has acquired enhanced distinctiveness.

108. The opponent cites the evidence from the Mumsnet blog that shows the way in which "...unprompted, ordinary consumers discuss the ORIGINS brand".

109. The applicant relies on *Whyte and Mackay Limited v Origin Wine Limited*,²³ to show that ORIGIN holds the minimum degree of distinctive character. The applicant has not provided the paragraph, so I provide it below:

“28. In my judgment there is an error of principle in the hearing officer's approach. The root problem with his analysis is that he failed at the outset to consider how the average consumer would understand the word ORIGIN in the context of the relevant goods. For this purpose, it makes no difference whether one is considering the Respondents' goods (wine in the case of the Word Mark) or the Appellant's goods (Scotch whisky and whisky-based liqueurs). Either way, in my judgment the average consumer would understand the word ORIGIN as referring to the origin of the goods, whether their geographical origin or their trade origin. This would be true in relation to most goods and services, but it is particularly true of both wine and Scotch whisky, where geographical origin is both an important factor in quality and frequently intimately associated with trade origin. It follows that the word ORIGIN is inherently descriptive, or at least non-distinctive, for the goods in issue. As counsel for the Appellant rightly conceded, *Formula One* establishes that, since its validity has not been challenged, the Word Mark must nevertheless be deemed to have the minimum degree of distinctive character for it to be validly registered; but no more than that”.

110. The applicant concludes, “Many elements of this case are directly analogous to this matter”.²⁴

111. That case was decided on the facts and evidence before the judge. The marks are not the same as those at issue in this case and nor are the goods. Clearly, in the case of whisky and wines, which were the relevant goods in the *Whyte Mackay* decision, there is a very clear relationship between the goods and their origin. In fact, the origin may be a significant factor taken into account when purchasing such goods. This is not so clearly the case with regard to class 3 goods of the type at issue in this case.

²³ 2015 EWHC 1271 (Ch)

²⁴ See the applicant's skeleton argument, paragraph 6

112. The applicant submits:²⁵

“11. Furthermore, in JURA ORIGIN V ORIGIN at paragraph 28, the judge held that the ORIGIN word mark holds the minimum degree of distinctive character for it to be validly registered, but no more than that. This was in alignment with the Formula One Licensing BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2012:314] principle.

113. Again, the words in the marks before me are not the same, but even if I were to accept that the ORIGINS marks were, prima facie, very low in inherent distinctive character, there is sufficient evidence to show that by the relevant date, the opponent had established a significant reputation in its ORIGINS brand, through the use made of its marks. That reputation is in skincare and to a lesser extent cosmetics, meaning that the distinctive character of the ORIGINS marks, for those goods, has been enhanced substantially.

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

114. The first sentence of the applicant’s skeleton argument reads: *“The Applicant accepts that the goods are identical or similar”*. In accordance with the decision in BEAK,²⁶ I will proceed on that basis.

Whether there is a likelihood of confusion

115. The earlier marks have a significant reputation for skin care goods and to a lesser extent for cosmetics. I found no evidence of use/reputation for perfumes. Given the level of similarity between the respective marks and the enhanced distinctive character of the opponent’s marks, due to the use made of them, I find it likely that there is a likelihood of confusion in the mind of the average consumer, (being a member of the general public, making a primarily visual purchase), for, at least, identical goods.

²⁵ See the applicant’s skeleton argument, paragraph 11

²⁶ O/0096/25

116. The opponent submits that:

“41. It should first be noted that even when, as here, the goods are identical or closely similar, a finding there is no risk of confusion does not rule out the possibility of an opposition succeeding on the basis of the same marks under Section 5(3). In particular, the degree of ‘similarity’ required to create the necessary ‘link’ under section 5(3) is self-evidently lower than would be required for a finding of likelihood of confusion. See for instance Specsavers v Asda [2012] EWCA Civ 24 at [120] where Kitchin LJ, as he then was, said as follows:

‘Infringement under this provision requires a certain degree of similarity between the registered mark and the sign, such that the average consumer makes a connection between them. It is not necessary that the degree of similarity is such as to create a likelihood of confusion, but it must be such that the average consumer establishes a link between the registered mark and the sign; and this is to be assessed having regard to all the circumstances of the case, as the Court of Justice explained in Adidas Salomon AG [2003] ECR I-2537 at [29]-[30].’

117. I agree. The existence or not of a likelihood of confusion is one of a number of factors that must be taken into account. What is important is to establish which goods in the applicant’s specification will, when sold under the CRISTIANO RONALDO ORIGINS mark, create a link with the opponent’s ORIGINS marks in the mind of the consumer.

118. Throughout its pleadings the applicant takes the view that the fame of Cristiano Ronaldo removes any possibility of a link being made between the opponent’s ORIGINS brand and the application. The submission seems to be that Cristiano Ronaldo’s fame as footballer is far greater than the following of the ORIGINS brand.

119. Mr Bartlett, a partner at the opponent’s representative, provides a witness statement, dated 28 December 2023, in which he submits evidence to demonstrate the

popularity of brand tie-ups and of tie-ups with celebrities with fragrance and make-up brands.²⁷ These include:

- Fashion house Nina Ricci and pastry maker Ladurée – 29 May 2014, The Branding Journal
- Pat McGrath cosmetics and Supreme clothing, Vogue (date not clear)
- Odell Beckham Jnr (US football star) and BYREDO (fragrance), 2 July 2022, Harpers Bazaar
- Angelina Jolie and Guerlain, 19 March 2018, The Sun
- Natalie Portman and Dior, 1 September 2021, Mail Online
- Kirsten Dunst and Bulgari, 7 March 2011, parentonline
- Jon Bon Jovi and Avon, 3 July 2012, trendhunter.com
- Poppy Delavigne and Jo Malone, The Standard (date not clear)
- Alex Pettyfer and Diesel, 18 January 2018, beautypackaging.com
- Adam Levine and Yves Saint Laurent, 5 March 2019, Mail Online

120. I agree with the opponent that it is not uncommon for celebrities to engage in tie-ups with beauty brands and this includes celebrities in fields other than the beauty industry. I also note that the opponent has already created ranges of goods with third parties, including Dr Weil and Madeline Shaw. Taking account of all the preceding factors, in particular, the opponent's strong position in the skincare market in respect of its ORIGINS brand, I find that the use of CRISTIANO RONALDO ORIGINS for goods in class 3, (that include identical goods and some similar goods) will result in a link being made between the contested application and the opponent's ORIGINS brand.

Damage

121. The opponent has claimed that the applicant's trade mark will take unfair advantage of its earlier rights. It also pleads that there will be a detriment to its reputation and that the distinctive character of its earlier rights will be diluted. I will deal first with unfair advantage.

²⁷ See exhibits IB2 and IB3

122. In *Jack Wills Limited v House of Fraser (Stores) Limited*²⁸ Arnold J. (as he then was) considered the earlier case law and concluded that:

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

123. The opponent submits:

“47. By using the mark in the Application, for the goods claimed, [the applicant] would free ride (and does in fact do so in relation to perfumes) on the reputation attaching to [the opponent's] mark. [The applicant] would unfairly utilise the marketing effort made by [the opponent] in the promotion of its ORIGINS brand over more than two decades of trading. As [the opponent's] evidence shows (Evans [21]) that expenditure has been substantial. Such an advantage is almost always "unfair" unless there is due cause.”

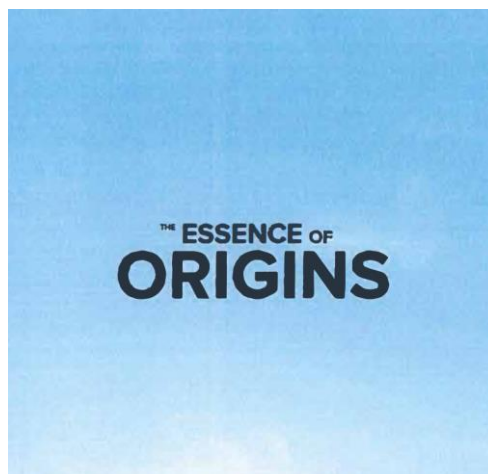
124. It is fairly unusual in cases before this tribunal that there is evidence of the intended/actual use of an application when we come to make an assessment on the likelihood of damage. However, in Mr Bartlett's witness statement he submits evidence

²⁸ [2014] EWHC 110 (Ch)

to demonstrate the way in which the applicant is using the applied for mark,²⁹ for example, the following is taken from the applicant's Cristiano Ronaldo website:³⁰



125. The images below are taken from the applicant's CR7cristianoronaldo Instagram page:



²⁹ See exhibit IB1

³⁰ These images are taken from the applicant's website and its social media pages

126. The opponent concludes that its position is supported by the actual use that the applicant has made of its mark, “...with frequent and prominent use of the ORIGINS component of the mark”.

127. I agree. The success of the earlier ORIGINS marks and the opponent’s reputation in the field of skin care (and to a lesser extent cosmetics), make it easier for the attraction of the earlier mark to be projected on to the applicant’s mark. The fact that the application contains an additional element, being the name of the footballer Cristiano Ronaldo, before the word ORIGINS, does not remove the likelihood of damage in the way the applicant suggests. I find that there is a risk, which is not hypothetical, that use of the contested mark will make it easier for the applicant to offer its goods and services to a section of the relevant public. I find the applicant’s actual use of the applied for mark to reinforce my finding, especially where the ORIGINS element is separated from the Cristiano Ronaldo element or made considerably larger than the rest of the mark. This unfair advantage will extend to the goods for which I have found a link to made, which is all of the goods in the application.

128. As I have found for the opponent under the first head of damage, I do not consider it necessary to go on to consider the other heads of damage pleaded.

129. Having found the 5(3) ground to have been made out the only defence left for the applicant is to show that it has due cause to use the mark applied for. No pleadings have been advanced by the applicant on this point, so I do not need to consider it.

The remaining grounds and marks

130. The opponent has succeeded in full under the 5(3) ground, based on its word marks. I do not intend to make a separate assessment based on the earlier figurative mark, as it cannot put the opponent in a better position.

131. Although I have considered whether there is a likelihood of confusion, as far as it is necessary to do so whilst considering the Intel factors required to establish a link under section 5(3), I do not intend to give separate consideration to the 5(2)(b) and 5(4)(a)

grounds. This is because the way in which link is assessed under 5(3) gives the opponent a greater reach in terms of its penumbra of protection for its goods in class 3. The remaining grounds can take it no further.

COSTS

132. Origins Natural Resources, Inc. has been successful and is entitled to a contribution towards its costs. I award the following:

Official fees	£200
Preparing evidence and considering and commenting on the other side's evidence	£800
Preparing for and attending a hearing	£700
Total	£1700

133. I order Eden Parfums Limited to pay Origins Natural Resources, Inc. the sum of £1700. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of April 2026

Al Skilton
For the Registrar,
the Comptroller General