O/0387/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4100894

IN THE NAME OF LAI SONG

TO REGISTER THE FOLLOWING TRADE MARK:

ZENEMENT

IN CLASS 10

AND

THE OPPOSITION THERETO UNDER NUMBER 452736

BY BITIO PROJECT SL

Background and pleadings

1. On 18 September 2024, Lai Song ("the applicant") applied to register the trade mark "Zenement" in the UK. The mark was accepted and published in the Trade Marks Journal on 29 November 2024. The following goods were filed under the mark:

> *Class 10: Clinical thermometers; Devices for measuring blood sugar; Electric esthetic massage apparatus; Electrocardiographic recorders; Electronic hearing aids; Hematimeters; Lighting for medical use; Massage apparatus; Medical apparatus and devices; Medical apparatus and instruments; Medical ultrasound apparatus; Moxibustion apparatus; Nebulisers; Pulse measuring devices; Stethoscopes.*

2. On 27 February 2025, Bitio Project SL ("the opponent") opposed the trade mark based upon Section 5(2)(a) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK trade mark:[1]

Zenement

UK registration number: UK00917449489
Filing date: 8 November 2017
Registration date: 20 December 2018

Relying on all goods, namely:

> *Class 5: Dietary supplements and dietetic preparations; Pharmaceuticals and natural remedies; Sandalwood oil for medical, pharmaceutical and veterinary purposes; Castor oil as a coating for pharmaceuticals; Medicated baby oils; Medicated additives for animal foods; Cooling sprays for medical purposes; Drug delivery agents in the form of dissolvable films that facilitate the delivery of pharmaceutical*

1 The earlier mark is a comparable mark. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the contested mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

preparations; Sea water for medicinal bathing; Cellular function activating agents for medical purposes; Radiation sickness treating agents; Chlorine detoxification agents for medical purposes; Benzol detoxification agents for medical purposes; Arsenic detoxification agents for medical purposes; Drug delivery agents in the form of coatings for tablets that facilitate the delivery of pharmaceutical preparations; Pest control preparations and articles; Medical dressings, coverings and applicators; Diagnostic preparations and materials; Cardiovascular agents for medical purposes; Drug delivery agents in the form of edible wafers for wrapping powdered pharmaceuticals; Hydrogen peroxide for medical purposes; Fodder additives for medical purposes; Adhesives for affixing prostheses; Medical adhesives for binding wounds; Medical adhesives for binding internal tissue; Surgical glues; Live organs and tissues for surgical purpose; none of the above-captioned goods for the use as dental preparations, dental article or dental care product.

3. By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance with section 6 of the Act. As the opponent's earlier registration had been registered for more than five years before the filing date of the applicant's mark, it is subject to the use provisions set out in section 6A of the Act. The opponent states that it has used the mark for all of the registered goods.

4. In its pleadings, the opponent claims that the marks are identical and the goods are similar. As such, the opponent submits there will be a likelihood of confusion between the marks.

5. The applicant filed a counterstatement in which it acknowledges that the marks are identical but denies that the goods are identical or similar to such a degree that would give rise to the likelihood of confusion. The applicant requested the opponent to file proof of use for the opponent's earlier registration relied upon.

6. Only the opponent filed evidence. No hearing was requested. Neither party filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

7. The opponent is represented by Dynham Limited. The applicant is represented by Pablo Albert Catala.

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

Evidence

9. The opponent's evidence was filed in the form of a witness statement, dated 15 July 2025, by Goncal Pagan, who is the Director and CEO of the opponent. The witness statement introduces thirteen exhibits, labelled GP1 to GP13. The purpose of the evidence is to address the applicant's request for the opponent to show proof of use for the opponent's earlier registration.

10. I confirm that I have taken all filed documents into account and refer to them to the extent that I deem necessary below.

Decision

Relevant period

11. The opponent's earlier mark was registered on 20 December 2018, which is more than five years before the filing date of the contested application. Section 6A of the Act states:

> "(1) This Section applies where–
>
> > (a) an application for registration of a trade mark has been published,
> >
> > (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

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

> "7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—
>
> > (a) the references in section 6A(3) and (6) t the earlier trade mark are to be treated as references to the corresponding EUTM; and
> >
> > (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
>
> (3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —
>
> > (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
> >
> > (b) the references in section 6A to the United Kingdom include the European Union".

13. The relevant period for proof of use of the opponent's mark is from 19 September 2019 to 18 September 2024. I note that the relevant territory will be considered the EU (including the UK) from 19 September 2019 to 31 December 2020, and the UK only from 1 January 2021 to 18 September 2024.

PROOF OF USE

Relevant case law

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky’[2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: Ansul at [35] and [37].
>
> (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at[36]; Sunrider at [70]; Verein at [13]; Centrotherm at [71]; Leno at [29]; Ferrari at [32].
>
> (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Centrotherm at [71]; Leno at [29]; Gözze at [37], [40]; Ferrari at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial

justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and Ferrari at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. Lidl at [33]. In Awareness Ltd v Plymouth City Council [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. […]

22. […] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal […] comes to take its final decision, the evidence must be sufficiently solid and specific

to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

15. Proven use of a mark which fails to establish that "the commercial exploitation of the marks is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

Genuine use

16. In his witness statement, Mr Pagan states that 'Zenement' is the primary food supplement brand sold by the opponent. The brand was established in 2017 and the name is derived from the fusion of the words 'zen' and 'supplement'.

17. The opponent owns the domain 'zenement.com', which was purchased in 2017, as shown in Exhibit GP1. Mr Pagan states that the website was in use from 2019 to 2024, which is demonstrated by screenshots from the Wayback Machine in Exhibit GP2. The screenshots show supplements for sale, with the products priced in euros. A wide range of supplement tablets and powders are shown, their bottles labelled with the following logos:

18. Mr Pagan states that the products sold under the Zenement brand are a range of food supplements which target key areas such as anti-aging, stress relief, relaxation, improved sleep quality, increased energy levels, overall vitality, maintenance of healthy bones and joints, proper digestive function and cardiovascular health. The range of products sold are shown in screenshots of the opponent's website in Exhibit GP3. The products are listed in euros.

19. Despite the opponent's website being directed towards EU consumers, Mr Pagan states that the goods are also sold to UK consumers through this website, as well as via third-party distributors and online marketplaces. Exhibit GP4 includes a screenshot

from naturitas.co.uk, showing supplements for sale under the Zenement brand. The above signs (stylised versions of the word mark) are used on the packaging and at the top of the page, but the word mark registered (i.e. in standard, uniform font) is used in the description of the page and the titles of the products listed. (For the sake of completeness, I am anyway prepared to accept that the stylised signs are use of the word mark in an acceptable variant form, since, despite the atypical font differentiation, the word "Zenement" is undisturbed and the differing elements do not alter the distinctive character of the mark in the form in which it was registered.)[2] The products in Exhibit GP4 are priced in GBP.

20. Exhibit GP5 shows a screenshot of mifarma.co.uk, another third-party website selling Zenement supplements. In this website, the title of the page and the description of the goods lists the brand as 'ZENement'. The products are listed in GBP.

21. Mr Pagan states that the biggest channel for the opponent's presence in the UK is Amazon. Exhibit GP6 contains screenshots from the sales dashboard of the opponent's Amazon account for the second half of 2023 and the entire of 2024. From 16 July 2023 to 31 December 2023, 11,869 items were sold at a total of £246,035.89. In 2024, 25,564 items were sold at a total of £519,201.94. I note that the relevant period ends on 18 September 2024, so not all of these sales are relevant. However, the relevant sales figures are significant.

22. Mr Pagan also provides Amazon unit orders, Amazon UK sales and global sales for the years 2019 to 2024. The sales figures are provided in both GBP and EUR. I have only listed GBP below for clarity. Amazon UK and global sales figures are not provided for 2019.

Year	Amazon Unit Orders	Amazon UK Sales	Global Sales
2019	1,140	-	-
2020	11,883	£196,375.15	£2,321,089.14

2 In *LA Superquimica v EUIPO2*, the General Court confirmed that the protection for a word mark relates to the words appearing in the application, not the specific figurative or stylistic aspects, including the font.

2021	8,472	£111,847.20	£3,968,294.78
2022	12,031	£200,673.52	£5,157,840.48
2023	23,951	£355,514.63	£7,633,455.33
2024	19,584	£519,201.94	£10,479,496.53

23. I note that the global sales are not divided into UK sales, although Mr Pagan stated that Amazon is where the majority of UK sales are made, so it is reasonable to conclude that the Amazon UK sales figures above make up most of the UK portion of the global sales. It is also not clear what proportion of the global sales relates to the EU for the portion of the relevant period before IP Completion Day.

24. The opponent's Amazon UK page is shown in Exhibit GP7. The ZENement logo is shown at the top of the page and on the products themselves. The Zenement word-only mark is shown as the page title and brand name. A range of supplements are shown for sale under the Zenement brand, mostly priced between £10 and £20 per item. Mr Pagan states that products under the Zenement brand have been available for purchase on Amazon UK since 18 October 2017. Mr Pagan further states that some of the products sold under the mark have ratings as high as 4.7 out of 5.

25. Links are provided to individual products. The tribunal does not accept hyperlinks as proper forms of evidence, not least because the content to which a hyperlink connects is subject to change and is therefore lacks the stability and reliability required of evidence. I note that a large number of products are listed, dated from 18 October 2017 to 14 September 2024. Mr Pagan states that the pages for each product could not be provided due to evidence limitations. Instead, five listings per year have been provided in Exhibit GP8. In these screenshots, the brand is clearly listed as 'Zenement', and the store as the Zenement Store. Additionally, the Zenement word-only mark is also included at the end of the product title. The products themselves have the 'ZENement' stylised sign on them. All of the products shown were available during the relevant period.

26. I note that these screenshots state that the supplements provided under the Zenement brand offer a range of health benefits, including boosting cardiovascular health, aiding in regulating cellular aging and function, and acting as antioxidants.

27. Invoices to UK customers for sales of products under the Zenement brand through Amazon are provided in Exhibit GP9. The invoices are dated between 5 January 2020 and 1 August 2024. The products listed on the invoice contain the Zenement mark within the product name. The invoices show that sales were widely geographically spread across the UK during the relevant period.

28. Mr Pagan states that, during the relevant period, the Zenement mark appeared frequently on the opponent's social media accounts. Exhibit GP10 shows examples of posts published on Facebook and TikTok featuring the Zenement brand. I note that the products shown use the ZENement logo, but the name of the social media accounts contains the word-only mark. I also note that a number of Facebook posts have captions written in Spanish, indicating that they are not targeted towards UK consumers. Other Facebook posts have captions translated into four different languages, including English. The TikTok posts have captions written in English; however, as social media has a global audience, I cannot determine how many of these posts reached UK consumers. The social media posts show a range of supplements and the benefits of taking them.

29. Mr Pagan states that the opponent has actively participated in trade fairs and industry events to promote the Zenement brand. Exhibit GP11 shows an article published by Barcelona Health Hub about Zenement's debut at INFARMA, one of the leading pharmaceutical trade fairs in Spain. It is not clear when the trade fair took place; however, I note that the article was published on 4 April 2025, over six months after the end of the relevant period. Without a date of the trade fair being provided and considering the date of the article, I consider it likely that the trade fair took place after the end of the relevant period.

30. A screenshot of Zenement's Amazon brand campaign data is provided in Exhibit GP12. This shows that, from October 2017 to February 2025, the marketing expenditure on Amazon advertising was £116,811.76. This period is longer than the relevant period. I note that the graph shows that expenditure steadily increased over

time, being particularly high from approximately February 2023 to February 2025. Although the expenditure is shown for a period of time longer than the relevant period, it is clear that a reasonable proportion of this expenditure took place within the relevant period. Mr Pagan notes that the opponent's advertisements were displayed to UK consumers a total of 91,735,658 times. In addition to 'Amazon Sponsored Ads', Mr Pagan states that the opponent also paid for Amazon Demand-Side Platform (DSP), in which advertisements are displayed both on and off the Amazon site. Exhibit GP13 shows an example of an Amazon DSP advertisement.

31. The evidence is not without shortcomings, but an assessment of genuine use is a global assessment, which includes looking at the evidence as a whole.[3] The evidence presented demonstrates that supplements bearing the opponent's mark were sold across the UK during the relevant period. I have not been provided evidence or submissions relating to the size of the supplement market, so I cannot determine the level of use of the opponent's mark in the context of the market. However, use need not be quantitatively great in order for it to be deemed genuine; the evidence before me need only demonstrate that the opponent has made a genuine attempt to create or preserve a market share for these goods in the relevant territory. Taking all of the evidence into account, I am satisfied that the opponent has shown genuine use of its mark in relation to dietary supplements.

<u>Form of the mark</u>

32. I have considered above that the opponent's earlier registered mark is a word-only mark consisting of the word Zenement and that the distinctive character of this mark lies in the word itself. I note that the additional capitalisation in the stylised sign shown in the evidence results in the word 'ZEN' being emphasised. While it could be argued that this emphasis alters the consumer's perception of the mark, it remains my view that the distinctive character of the mark is not altered, not least because "ement" is meaningless and it naturally coheres with the 'zen' element to form a whole (if invented) word.[4] However, even if I am wrong, the bulk of the opponent's evidence

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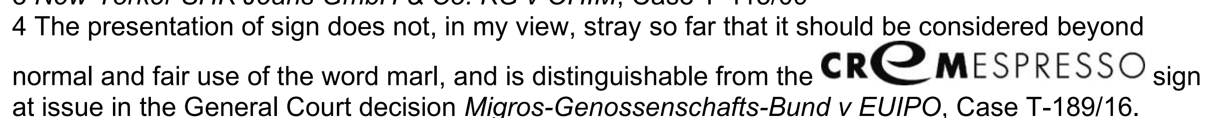
3 *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09
4 The presentation of sign does not, in my view, stray so far that it should be considered beyond normal and fair use of the word marl, and is distinguishable from the 

sign at issue in the General Court decision *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16.

includes the use of both the word-only mark and the additional form shown above. Therefore, even if the additional form were not considered an acceptable variant form of the mark, the bulk of the opponent's evidence would still be relevant and the outcome of genuine use would not be altered.

Fair specification

33. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated.

34. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

35. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods

or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

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

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

36. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

37. Having reviewed the evidence, I am satisfied that genuine use of the mark has been established for dietary supplements.

38. The opponent's specification includes 'pharmaceuticals and natural remedies'. The opponent's evidence shows food supplements that may be considered to fall within the scope of pharmaceuticals or natural remedies. However, I have not been shown evidence to cover the full breadth of this term. I consider that the goods for

which genuine use has been shown within this term are adequately covered by the term ‘dietary supplements’. As such, I find no genuine use for ‘pharmaceuticals and natural remedies’ as a broad term.

39. I have not been shown any evidence of the opponent’s *‘Dietetic preparations; Pharmaceuticals and natural remedies; Sandalwood oil for medical, pharmaceutical and veterinary purposes; Castor oil as a coating for pharmaceuticals; Medicated baby oils; Medicated additives for animal foods; Cooling sprays for medical purposes; Drug delivery agents in the form of dissolvable films that facilitate the delivery of pharmaceutical preparations; Sea water for medicinal bathing; Cellular function activating agents for medical purposes; Radiation sickness treating agents; Chlorine detoxification agents for medical purposes; Benzol detoxification agents for medical purposes; Arsenic detoxification agents for medical purposes; Drug delivery agents in the form of coatings for tablets that facilitate the delivery of pharmaceutical preparations; Pest control preparations and articles; Medical dressings, coverings and applicators; Diagnostic preparations and materials; Cardiovascular agents for medical purposes; Drug delivery agents in the form of edible wafers for wrapping powdered pharmaceuticals; Hydrogen peroxide for medical purposes; Fodder additives for medical purposes; Adhesives for affixing prostheses; Medical adhesives for binding wounds; Medical adhesives for binding internal tissue; Surgical glues; Live organs and tissues for surgical purpose; none of the above-captioned goods for the use as dental preparations, dental article or dental care product’.*

40. As such, a fair specification for the earlier mark is as follows:

Zenement

Class 5: *Dietary supplements.*

(It is not clear that the original limitation could be pertinent, but if I am wrong, then the fair specification should be understood as limited as ‘not for the use as dental preparations, dental article or dental care product’.)

Section 5(2)(a)

41. Section 5(2)(a) of the Act provides that "A trade mark shall not be registered if because it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

42. Section 5A of the Act provides that "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

The principles

43. I note the following parts from the standard summary of the principles applicable to the assessment of the likelihood of confusion insofar as it relates to section 5(2)(a) (which requires identical marks):[5]

> (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
>
> […]
>
> (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

5 See Supreme Court judgment in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25

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

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

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

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

Identical marks

44. The parties agreed that the marks are self-evidently identical.

Comparison of the goods

45. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

46. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a. The respective uses of the respective goods or services;

b. The respective users of the respective goods or services;

c. The physical nature of the goods or acts of service;

d. The respective trade channels through which the goods or services reach the market;

e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

f. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

47. Further, in *Kurt Hesse v OHIM*,[6] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,[7] the GC stated that "complementary" means:

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

48. With this in mind, the goods for comparison are as follows:

Opponent's goods:	**Applicant's goods:**
Class 5: *Dietary supplements*	Class 10: Clinical thermometers; Devices for measuring blood sugar; Electric esthetic massage apparatus; Electrocardiographic recorders; Electronic hearing aids; Hematimeters; Lighting for medical use; Massage apparatus; Medical apparatus and

[6] Case C-50/15 P
[7] Case T-325/06

	devices; Medical apparatus and instruments; Medical ultrasound apparatus; Moxibustion apparatus; Nebulisers; Pulse measuring devices; Stethoscopes.

49. In its submissions, the opponent submits:

> "[…] the applied-for goods are similar. For example, some goods are complementary, such as "pharmaceuticals" covered by the Earlier Mark and the "medical apparatus and instruments" applied for in the Application. In this example, both goods would be used by medical professionals and the general public, and may be used alongside one another at the same time. As is well established, complementarity can be the sole basis for a finding of similarity between goods. The respective goods are both aimed at medical professionals and the general public, and, among others, will share the same end users."

50. No genuine use has been shown for the term 'pharmaceuticals'. However, I will take the opponent's submissions into account insofar as they may be applicable to dietary supplements (though this was not expressly argued by the opponent).

51. In its counterstatement, the applicant states:

> "The goods in class 10 (medical devices and instruments) differ significantly in nature, purpose, method of use, and trade channels from the goods in class 5 (pharmaceuticals and dietary supplements) covered by the opponent's earlier mark."

52. Again, I bear those submissions in mind insofar as they relate to dietary supplements.

Medical apparatus and devices; Medical apparatus and instruments

53. The purpose of the goods very broadly overlaps where both goods are intended to improve the health of a user. However, the specific purpose of the goods differs as the above goods are used to medically treat or alleviate symptoms of a disease or

condition, while the opponent’s goods are used to supplement a diet with nutrients, with the purpose of avoiding a vitamin deficiency or enhancing physical performance. The users of the goods overlap as both may be used by members of the general public, although the above goods may also be used by medical professionals. The nature of the goods differs as the above goods are apparatus, devices and instruments, while the opponent’s goods are tablets, powders and liquids for consumption. Trade channels broadly overlap as both goods will be sold in pharmacies and supermarkets, although I consider that the goods will be displayed on different shelves within these shops. There is no competition or complementarity between the goods. Overall, I find the above goods dissimilar to the opponent’s ‘dietary supplements’.

Clinical thermometers; Devices for measuring blood sugar; Electrocardiographic recorders; Pulse measuring devices; Stethoscopes; Medical ultrasound apparatus; Hematimeters

54. The above goods are all devices and apparatus for monitoring a patient. The purpose of the goods clearly differs from that of the opponent’s goods, which are used to supplement a diet with nutrients, with the purpose of avoiding a vitamin deficiency or enhancing physical performance. The users of the goods differ as the above goods will be used by medical professionals, while the opponent’s goods will be used by the general public. The nature of the goods differs as the above goods are apparatus, devices and instruments, while the opponent’s goods are tablets, powders and liquids for consumption. Trade channels differ as the above goods will be sold via medical wholesalers, while the opponent’s goods will be sold by pharmacies, health stores and supermarkets. There is no competition or complementarity between the goods. Overall, I find the above goods dissimilar to the opponent’s ‘dietary supplements’.

Electric esthetic massage apparatus; Massage apparatus; Moxibustion apparatus

55. The above goods are massage apparatus with the purpose of relaxing a patient and easing tension in muscles. This purpose clearly differs from that of the opponent’s goods, which are used to supplement a diet with nutrients, with the purpose of avoiding a vitamin deficiency or enhancing physical performance. The

users of the goods differ as the above goods will be used by massage professionals, while the opponent's goods will be used by the general public. The nature of the goods differs as the above goods are apparatus, while the opponent's goods are tablets, powders and liquids for consumption. Trade channels differ as the above goods will be sold via online retailers and electronic apparatus stores, while the opponent's goods will be sold by pharmacies, health stores and supermarkets. There is no competition or complementarity between the goods. Overall, I find the above goods dissimilar to the opponent's 'dietary supplements'.

Electronic hearing aids

56. The above goods are devices that aid in a patient's hearing. The purpose of the goods clearly differs from that of the opponent's goods, which are used to supplement a diet with nutrients, with the purpose of avoiding a vitamin deficiency or enhancing physical performance. The users of the goods overlap as both goods will be used by the general public. The nature of the goods differs as the above goods are a device, while the opponent's goods are tablets, powders and liquids for consumption. Trade channels differ as the above goods will be sold by pharmacies and other specialist stores via a prescription from an audiologist, while the opponent's goods will be sold by health stores and supermarkets; both goods may be sold in a pharmacy, but in entirely separate shelving categories. There is no competition or complementarity between the goods. Overall, I find the above goods dissimilar to the opponent's 'dietary supplements'.

Lighting for medical use

57. The purpose of the goods clearly differs as the above goods are used to provide lighting for medical purposes, while the opponent's goods are used to supplement a diet with nutrients, with the purpose of avoiding a vitamin deficiency or enhancing physical performance. The users of the goods differ as the above goods will be used by medical professionals, while the opponent's goods will be used by the general public. The nature of the goods differs as the above goods are lighting apparatus, while the opponent's goods are tablets, powders and liquids for consumption. Trade channels differ as the above goods will be sold via medical wholesalers, while the opponent's goods will be sold by pharmacies, health stores and supermarkets. There

is no competition or complementarity between the goods. Overall, I find the above goods dissimilar to the opponent's 'dietary supplements'.

Nebulisers

58. The above goods are medical devices that create a mist from liquid medicine to facilitate its use. The purpose clearly differs from that of the opponent's goods, which are used to supplement a diet with nutrients, with the purpose of avoiding a vitamin deficiency or enhancing physical performance. The users of the goods overlap as both goods will be used by the general public. The nature of the goods differs as the above goods are an apparatus that can create a mist, while the opponent's goods are tablets, powders and liquids for consumption. Trade channels broadly overlap as both goods may be sold by pharmacies, although the goods would be found on different shelves. There is no competition or complementarity between the goods. Overall, I find the above goods dissimilar to the opponent's 'dietary supplements'.

Conclusion of goods and services comparison

59. Some similarity of goods or services is a constituent requirement of a section 5(2)(a) claim. Despite the identical marks, there can be no likelihood of confusion since I have found none of the applicant's goods to be similar to the opponent's goods.[8]

60. The opposition inevitably fails in its entirety and, subject to any successful appeal, the applied-for trade mark will proceed to registration.

COSTS

61. The applicant succeeded in these proceedings in defence of its application and is therefore entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of £850 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

[8] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

Considering the TM7 and statement of grounds and preparing and filing the TM8 and counterstatement:	£250
Considering the opponent's evidence:	£600
Total:	**£850**

62. I therefore order Bitio Project SL to pay Lai Song the sum of £850. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of May 2026

K HARBACH

For the Registrar