

O/0542/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3886448

IN THE NAME OF SIENNA NATURALS INC.

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 3:

SIENNA NATURALS

AND

OPPOSITIONS THERETO UNDER NOS. 442188 AND 442189

**BY SIENNA X LTD AND THE SPRAY TAN CUBICLE COMPANY LTD,
RESPECTIVELY**

AND

IN THE MATTER OF

TRADE MARK REGISTRATION NO. 914572895

IN THE NAME OF SIENNA X LTD FOR THE FOLLOWING TRADE MARK IN

CLASSES 3, 7, 22, 35, 41 AND 44:

SIENNA X

AND

AN APPLICATION FOR REVOCATION ON THE GROUNDS OF NON-USE

UNDER NO. 506648

BY SIENNA NATURALS INC.

BACKGROUND

1) These proceedings concern three consolidated cases: two cases are oppositions and one case is an application for revocation on the grounds of non-use. The parties to the dispute are Sienna Naturals Inc. ('SN Inc.') on the one hand, and Sienna X Ltd ('SX Ltd') and The Spray Tan Cubicle Company Ltd ('STCC Ltd') on the other. The latter two companies are under common ownership.

The oppositions

2) On 8 March 2023, SN Inc. applied to register the trade mark SIENNA NATURALS in the UK, in respect of the following goods:

Class 3: Non-medicated cosmetics and toiletry preparations; hair care preparations; hair conditioners; hair creams; hair oils; hair shampoo; hair styling preparations.

3) The application claims a priority date of 23 September 2022 from the United States of America. It was published in the Trade Marks Journal on 19 May 2023. Two oppositions were then filed against the application: one by SX Ltd and the other by STCC Ltd.

SX Ltd's opposition (under no. 442188)

4) SX Ltd claims that the trade mark application offends under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 ('the Act'). In support of the two former grounds the following trade mark registration is relied upon:

- **UKTM 914572895**

SIENNA X

Goods and services in classes 3, 7, 22, 35, 41 and 44¹

Filing date: 18 September 2015

Date of entry in register: 21 August 2016

5) Under section 5(2)(b) of the Act, only the goods in class 3 and the services in classes 35 and 44 are relied upon. It is claimed that the respective goods and services are identical or, at least, similar and that the respective marks are similar, such that there exists a likelihood of confusion under section 5(2)(b) of the Act.

6) Under section 5(3) of the Act, it is claimed that the earlier mark has a reputation in relation to the goods and services in classes 3 and 35. It is said that the contested mark will 'ride on the coat tails' of the earlier mark because it will benefit from the power of attraction, prestige and reputation of the same. As such, it is claimed that use of the contested mark will lead to unfair advantage being taken of the earlier mark. It is also claimed that it can be inferred that SN Inc. intended to take such unfair advantage. It is further claimed that use of the contested mark will cause detriment to the reputation of the earlier mark if the goods provided under the same are deficient in standard. Lastly, it is claimed that the distinctive character of the earlier mark would be diluted, thereby undermining its core function.

7) The trade mark relied upon by SX Ltd is a 'comparable trade mark (EU)' which is an earlier mark, in accordance with section 6 of the Act.² As it had been registered for at least five years at the priority date of the contested mark, it is subject to the proof of use conditions, as per section 6A of the Act. SX Ltd made a statement of use for all the goods and services relied upon.

¹ See Annex for the full list of goods and services.

² Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs and IR (EU) TMs registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register and, as a consequence, have the same legal status as if they had been applied for and registered under UK law. A 'comparable trade mark (EU)/IR(EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM/EU(IR)TM from which it derives.

8) Under section 5(4)(a) of the Act, SX Ltd relies upon use of the sign SIENNA X throughout the UK since 2006 in relation to 'cosmetic and beauty care products and services'. It is claimed that it has generated goodwill, of which that sign is distinctive, and that use of the contested mark will result in misrepresentation and damage to that goodwill.

9) SN Inc. filed a counterstatement in which it put SX Ltd to proof of use. It also denied all the grounds of opposition. It did not deny or admit the claimed identity or similarity between the respective goods and services, instead reserving its position until it had received the opponent's 'proof of use' evidence.

STCC Ltd's opposition (under no. 442189)

10) STCC Ltd claims that the trade mark application offends under section 5(4)(a) of the Act. It relies upon use of the sign SIENNA X throughout the UK since 2006 in relation to 'cosmetic and beauty care products and services'. It is claimed that it has generated goodwill, of which that sign is distinctive, and that use of the contested mark will result in misrepresentation and damage to that goodwill.

11) SN Inc. filed a counterstatement denying the ground of opposition.

The application for revocation on grounds of non-use (No. 506648)

12) SN Inc. seeks revocation of SX Ltd's trade mark registration no. 914572895, in its entirety, on the grounds of non-use under Section 46(1)(a) or (b) of the Trade Marks Act 1994 ('the Act').

13) The section 46(1)(a) claim is based upon the five-year period following registration, namely, 22 August 2016 to 21 August 2021, with a claimed date of revocation of 22 August 2021.

14) The section 46(1)(b) claim is based on five-year period of 22 September 2017 to 21 September 2022 with a claimed date of revocation of 22 September 2022.

15) SX Ltd filed a counterstatement, opposing the application for revocation. It states that the registered mark has been put to genuine use in relation to all the goods and services covered by its registration for an uninterrupted period of over ten years.

Consolidation and evidence

16) Upon receipt of the counterstatements, SX Ltd and STCC Ltd confirmed joint and several liability³ and the three proceedings were consolidated under rule 62(1)(g) of The Trade Marks Rules 2008.

17) SN Inc. has filed no evidence. The evidence on behalf of SX Ltd and STCC Ltd consists of i) a witness statement from Nicola Jane Matthews⁴ with Exhibits NM01 – NM14, and ii) a witness statement from Heidi Van Ocken⁵ with Exhibits HV01 – HV02. No hearing was requested. The parties filed written submissions in lieu.⁶ I note that the submissions filed on behalf of SX Ltd and STCC Ltd refer to, and attach, an ‘Annex A’ containing evidential material. As no request was made to file this additional evidence outside of the normal evidence rounds, and it is not, in any event, properly deposited in a witness statement, it will have no bearing on my decision. I now make this decision based upon all the other papers before me.

Representation

18) SN Inc. is represented by Kilburn & Strode LLP. SX Ltd and STCC Ltd are both represented by JP Mitchell Solicitors.

Relevance of EU Law

19) 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

³ As per JP Mitchell Solicitors email of 15 January 2024

⁴ Dated 15 April 2024

⁵ Dated 12 April 2024

⁶ Both sets of submissions are dated 12 September 2024

European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Approach

20) The dates of revocation sought by SN Inc. are earlier than the priority date of its own mark. As such, the success or otherwise of the application for revocation will affect the extent to which SX Ltd can rely upon its mark in the opposition to SN Inc's mark (if at all). It therefore makes sense to decide the application for revocation first.

21) The two periods of non-use which have been claimed in the revocation substantially overlap. If genuine use is satisfied in one of those periods, it will suffice to satisfy genuine use in the other. It is, therefore, appropriate to consider both periods together in the same assessment.

22) I also note that the period in which proof of use must be shown in the opposition⁷ is almost identical to the period claimed under section 46(1)(b) in the revocation. It follows that my findings as regards genuine use in the revocation will also determine whether proof of use has been satisfied, and to what extent, for the purposes of the opposition. I proceed accordingly.

THE REVOCATION

23) The relevant provisions of section 46 of the Act are as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds –

⁷ As per Section 6A and Schedule 2A of the Act the relevant period for proof of use in the opposition is 24 September 2017 to 23 September 2022.

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

24) Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

25) As the contested mark is a comparable mark, SX Ltd can rely upon use of that mark in the EU for the part of the relevant period which falls prior to IP Completion Day (31 December 2020).⁸ After that date only use in the UK is relevant.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-

⁸ As per paragraph 8 of Part 1, Schedule 2A of the Act.

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken 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]; *Silberquell* 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].”

Ms Matthews' evidence

27) Ms Matthews explains that she is the managing director of both SX Ltd and STCC Ltd and that she owns all shares in both companies. It is said that SX Ltd owns certain important rights in relation to the business, including the trade mark registration for SIENNA X. These rights are held separate from day-to-day trading activities which are carried out by STCC Ltd, trading as SIENNA X.

Evidence described as 'supply on our own account'

28) **Exhibit NM3** contains dated screenshots from the website www.sienna-x.co.uk. These consist, inter alia, of the following:

- A screenshot dated 17 July 2018 shows the following stylised mark ('the first stylised mark'):



There is an option to 'shop products'. The following goods and services are listed on the page: 'kit packages' for spray tanning and waxing, spray tan solution, hot and warm wax, guns, cubicles and equipment for self-tanning. The relevant tab which is open on the page is aimed at 'professionals' and there is an option to 'book training' although it is not clear from the page what the training relates to. Another screenshot, from what appears to be a different section of the website, states: 'Self-Tan – Tan like a pro with Sienna X's self-tan range. We've taken the expertise learnt from our Professional range and applied it to our consumer range.'

- A screenshot dated 17 December 2018 shows various self-tan products such as 'tan primer', 'tinted mousse', 'tinted mist' and 'self-tan lotion' for sale in British pounds, all bearing the following stylised mark ('the second stylised mark'):



The word mark SIENNA X is also used on the page in the 'Finer details' section, where it states that 'Sienna X self-tan is packed full of natural ingredients...' A 'Tan Finder tool' provides the option to '...find the right tan for your skin type.'

- A screenshot dated 15 September 2019 shows the first stylised mark. The ribbon at the top of the page lists the various sections of the website. These are: 'Tan', 'Brows', 'Skincare', 'Find a therapist', 'Tips', 'Social' and 'Professionals'. Under the 'Professionals' tab, there is the option to purchase self-tanning kits, solution, guns, cubicles and equipment and wax. There is also a 'brows' section offering kits, eyebrow wax, tints, developers/removers, pencils and a 'professional skincare' section offering 'The skincare collection' and skincare sample sachets. There is also an option on the website to 'shop products' and 'book training'.
- A screenshot dated 23 June 2020 shows the following mark ('the third stylised mark'). The word below 'sienna' is not particularly clear in the version reproduced below, but it reads 'PROFESSIONAL':



The goods on the page are described as 'professional spray tan equipment' and include spray guns/machines, pop-up cubicles and replacement hoses and guns, all for sale in British pounds. The word mark is also present on the page in the following statement: 'Explore the range of Spray Tanning Equipment from The Professional Spray Tanning Collection by Sienna X...'.

- A screenshot dated 29 April 2020 shows depilatory wax, professional wax kits and waxing training. The word mark appears in the following statement: 'The Luxurious Wax range by Sienna X has everything you need to offer premium waxing treatments to your clients...' The first stylised mark is also visible on the products themselves.
- A screenshot dated 08 August 2020 is entitled 'Professional Skincare collection'. The third stylised mark is present on the page and on products themselves. Those products include cleansing lotion, cleansing balm, facial polish, chemical peel, clay mask, miracle mask, facial oil, retinol serum and priming day cream. The first stylised mark is also present at the bottom of the web page.
- A screenshot dated 10 May 2020 is entitled 'Self tan: prep, prolong and remove'. The page states: 'Prepare your skin for tanning using the Sienna X prep. Everything you need to create a beautiful, flawless tan from primers to balms, body scrubs to tan removers.' The first stylised mark is present at the top of the page. That mark or the third stylised mark is also present on the following products, for sale in British pounds: self-tanning mitts, self-tan primer, self-tan remover, self-tan extending balm, exfoliating-priming scrub, body balm, body scrub.
- A screenshot dated 28 September 2021 shows a 'Silver Professional Spray tan kit' for sale. The kit is said to include the following: spray tan machine, cubicle, spray tan courses, self-tanning solution, full size treatment essentials, expert business support, free ongoing social marketing collateral. The first stylised mark is present at the bottom of the page.
- A screenshot dated 23 October 2021 is entitled 'Sienna X Training Course Locator'. Under the heading 'Search by month' the following courses are listed: spray tan training, beginners wax training, brows professional training.
- A screenshot dated 03 July 2022 shows another 'Silver spray tan business kit' for sale containing the same goods and services as those in the kit described above from September 2021.

- A screenshot dated 21 May 2022 is entitled 'Professional Skincare collection' and is described as 'The Skincare collection by Sienna X'. There are samples available to purchase of facial oil and miracle mask. There is also a Deluxe Professional Skincare collection available to purchase for £249 plus VAT. It is not clear what goods are in this collection as no images are present.
- A further screenshot dated 21 May 2022 shows various skincare products 'by Sienna X' including sachets of retinol serum, miracle mask, priming day cream and eye cream.

29) **Exhibit NM4** contains examples of social media coverage. It is said that this consists of various posts on Facebook and Instagram between 2017 and 2022 (there are also posts from 2023, but these are outside of the relevant period), details of which are as follows:

- The goods and services promoted in these posts are all referred to either by the words Sienna X and/or by the first, second or third stylised marks. These are depilatory wax, invitations to 'start your own mobile spray tanning business', training in brow treatments, waxing and self-tanning, professional waxing kits, spray tanning kits, self-tanning creams, lotions and mists and self-tan remover solution.
- A screenshot from Facebook dated 2018 shows posts entitled 'budget & schedule', 'audience definition', 'budget scheduling' and 'estimated daily results'. Ms Matthews gives no explanation in her statement to explain what this post is intended to show.
- A post from 14 January 2019 on the Sienna X Professional page states: 'Visit the Sienna X Worcester HQ on Monday 28th Jan for live Brow, Spray Tanning and Waxing demos, plus advice and exciting product news...'
- A post from 15 November 2019 refers to the 'NEW Premium skincare range' and an opportunity to attend a workshop about the same. The goods pictured in the post are facial oil, day cream, miracle mask, eye cream and retinol serum.

- A post from 7 August 2020 states: ‘discover our top tips...’ and ‘How do you convert your calls into business?’
- A post from 13 January 2021 promotes the ‘Sienna X training academy’.
- A post from 27 June 2022 states: ‘Be your own beauty boss’ and ‘spray tanning, skincare, waxing and brows’.

30) **Exhibit NM5** contains ‘sample’ invoices. All of them bear the first stylised mark in the top right-hand corner. The word-only mark Sienna X is also used in the description of some of the goods. The name of the customer has been redacted in many of the invoices. However, there is sufficient information to show that all have been issued to UK addresses. The net price of the goods and services and the total prices are also redacted in all the invoices. Those which are dated within the relevant periods list the following goods and services:

- 2018: tanning kits, training courses, exfoliating spritz, tan remover wipes, barrier cream, machines and guns, tanning solution, waxing kits, hot wax, warm wax, spatulas, waxing strips, cooling cream, soothing oil, cleansing gel, brow and lash tints, micellar make up remover.
- 2019 and 2020: Tanning kits/packages, including training course, machine and gun, tanning solution, cubicle, marketing material (leaflets, business flyers, branded poster etc.), exfoliating spritz, barrier cream, tan removal wipes, balm sachet (pack of 12), scrub sachet (pack of 12), wax kits, hot wax, warm wax, spatulas, waxing strips, cooling cream, soothing oil, cleansing gel, brow and lash tints, eye masks, micellar make up remover, brow training courses.
- 2020: Skincare products, namely chemical exfoliator, cleansing milk/balm, day cream, eye cream, facial oil, facial scrub, clay mask, miracle mask, retinol serum, toner, cleansing lotion. There are also brow kits, including brow tints, pencils, fixing serum, eye masks and self-tanning kits and training courses.
- 2021: skincare kit, waxing kits, brow kits, brow and lash tints, cleansing gels, cooling cremes, micellar make-up remover.

Evidence described as 'Third party sales/supply'

31) Ms Matthews states that 'we' supply goods and services under the Sienna X mark to a wide range of third-party retailers and distributors. Evidence of sales to such customers, and onward sales by the same to end consumers, is provided at **Exhibits NM6 – NM13**, as follows:

- **Exhibit NM6:** This consists of screenshots from the Sally Beauty and Salon Services websites for the period of 2018 – 2020. The goods listed on these pages include Sienna X tanning solution/mists and lotions, tanning mitts, spatulas, paper strips, hot wax, tanning kits, tan-removal oil.
- **Exhibit NM7:** This consists of sample invoices issued to Sally Salon Services Ltd for the period of 2018 – 2020. All bear the first stylised mark in the top right-hand corner and some of the goods in the description are referred to by the words Sienna X. The goods in these invoices are self-tan solutions, removal wipes, depilatory waxes, body scrub, body balm, cleansing gel, soothing oil, waxing strips, spatulas, barrier cream, machines and guns, exfoliating spritz, skincare miracle mask, cleansing lotion, retinol serum, facial oil, facial polish, eye cream.
- **Exhibit NM8:** This consists of screenshots from the website of Capital Hair & Beauty. Relevant screenshots from between 2017 and 2022 show the following goods for sale under the SIENNA X mark and/or one of the stylised marks: barrier cream, buffing mitt, self-tan solution.
- **Exhibit NM9:** This consists of sample invoices issued to Capital Hair & Beauty. Relevant invoices from the period of 2018 – 2020 all bear the first stylised mark in the top right-hand corner and some of the goods in the description are referred to by the words Sienna X. The goods in these invoices are 'Sienna X business kits' (consisting of self-tanning solution, cubicle, machine and gun, exfoliating spritz, tan removal wipes, body scrub, barrier cream)
- **Exhibit NM10:** This consists of screenshots from the website of Superdrug. Relevant pages, dated from 2019 – 2022, show the following goods for sale

under the word mark Sienna X or and/or one of the stylised marks: self-tanning mitts, self-tanning lotions, mousse and drops.

- **Exhibit NM11:** This consists of screenshots from the website of Ashton & Fincher from 2018 and 2020. The goods on these pages are Sienna X spray tan, tan machine and gun, buffing mitt, self-tan lotion, self-tan primer, body scrub.
- **Exhibit NM12:** This consists of a screenshot from the website of Alan Howard, dated 2020. The goods on the page include Sienna X self-tan.
- **Exhibit NM13:** This consists of screenshots from the website of Lookfantastic from 2018 – 2020. The goods for sale on these pages include Sienna X self-tan lotion. The exhibit also contains invoices issued to The Hut Group (which trades as LookFantastic) dated 2018 – 2020. All bear the first stylised mark at the top. The goods listed in the invoices are self-tan lotions, mists and mousse, tan primer, body balm, body scrub, face and body wash and self-tanning mitts.

Turnover and marketing

32) Relevant annual business turnover for the period from 2016 to 2022 is provided, as follows:⁹

Fiscal Year	Revenue (£)
2016 - 17	£2,999,734.85
2017 - 18	£2,776,332.41
2018 - 19	£2,932,091.86
2019 - 20	£3,336,405.36
2020 - 21	£1,564,544.92
2021 - 22	£2,678,752.99

⁹ Ms Matthews' witness statement, [15]

33) Marketing spend for the period from April 2018 to the date of Ms Matthews' statement (15 April 2024) was £2,003,633.48 which, she states, averages out at approximately £350,000 per annum. This is broken down, as follows:¹⁰

- Promotional costs, campaigns, advertising, collateral costs brochures, flyers, stands, point of sale materials - £85,000 (22.4%)
- Amazon - £36,000 per annum (9.4%)
- PR company - £36,000 per annum (9.4%)
- Facebook paid advertising - £33,000 per annum (8.7%)
- SEO agency - £30,000 per annum (7.9%)
- Paid influencers for social media - £26,000 per annum (6.8%)
- Web agency, Klavio emailer, AWIN and other support tools - £26,000 per annum (6.8%)
- Events, product launches, awards - £24,000 (6.3%)
- Google Ads PPC - £23,000 per annum (6%)
- Trustpilot Reviews - £12,900 (3.4%)
- Tik Tok Ads - £11,000 per annum (2.6%)
- Prizes - £5,000 per annum (1.3%)
- Gifting - £4,000 per annum (1.1%)

Awards

34) Ms Matthews states that Sienna X has won 'Best Tanning Supplier' every year between 2010 – 2020 and has also won 'Best Use of Social Media' in 2019. It is said

¹⁰ Ms Matthews' witness statement, [18]

that these awards are given by Guild, which is one of the leading awards bodies in the relevant industry. Evidence of these awards is at **Exhibit NM14**.

35) Ms Matthews also states that Sienna X has been the most popular stocked spray tan brand in UK beauty salons for the last ten years, with an average of approximately 33% market share over the last seven years (which would date back to 2017 from the date of her witness statement). It is also said that, in the most recent survey conducted by Guild in 2022, Sienna X was reported by 43% of survey respondents.

Ms Ocken's evidence

36) Ms Ocken is a director of Sally Europe and Sally Salon Services Ltd (together, 'Sallys'). She explains that Sallys is a major retailer and distributor of beauty care products and services in the UK and the EU.

37) Ms Ocken explains that the UK division of Sallys operates two businesses, (i) Sally Beauty UK which retails beauty care products and services to UK consumers and (ii) Sally Salon Services which distributes and sells beauty care products and services to trade professionals, such as beauty salons and therapists. Sallys has over 244 stores in the UK.

38) It is stated that Sally's has sold a wide range of Sienna X products and services in the UK consistently since February 2016, including the following:

- **To consumers:** Tanning products and solutions, skin care products, bath & body products, skincare gift sets
- **To trade/professional customers:** tanning starter kits/tanning machines, tanning equipment, including 'pop-up' tanning tents, spray tan solution, promotional materials, spray tan training services, warm & hot waxing products, pre & post-waxing products, heaters & waxing equipment, treatment products, waxing accessories, waxing starter kits, waxing training, skin care products, skincare gift sets.

39) **Exhibit HV01** is said to show evidence of Sally's UK sales. This consists of screenshots from the websites of Sallys. Those dated within the relevant period of

2017 – 2022 show use of the word mark Sienna X in relation to spatulas (including for eyebrows), paper strips, self-tanning solution, mousse and mist, tan primer, depilatory wax, cleansing gel, soothing oil, self-tanning mitts, spray tan business kits, self-tan removal oil, miracle mask, post-wax soothing cream, facial oil, facial polish, cleansing balm, toning solution, eye cream, day cream, cleansing lotion and clay masks.

40) **Exhibit HV02** contains sample invoices which are said to show some of the purchases made by Sallys of Sienna X products. These all bear the first stylised mark at the top and some of the products on the invoices are referred to by the words Sienna X. I note that some of these invoices are duplicates of those provided in exhibit NM7 which I will not summarise again here. An additional invoice (not present in exhibit NM7) is dated 31 May 2019 and lists the following goods, all described by the words ‘Sienna X Skincare’: Toner, cleansing milk, retinol serum, facial oil, facial scrub, miracle mask, cleansing balm, chemical exfoliator, day cream, eye cream, clay mask. A similar invoice, dated 01 August 2022, lists the same skincare products, along with depilatory waxes, waxing strips, tanning lotions, mitts and machines/guns.

Assessment of the evidence

Form of the mark shown in use

41) Insofar as the evidence shows use of the plain words SIENNA X, that is plainly use upon which SX Ltd may rely.

42) The evidence also shows use of the marks in a differing form to which it is registered, as follows:

i) The First Stylised mark



ii) The Second stylised mark



iii) The Third stylised mark



43) In assessing whether the above three examples of use are those upon which SX Ltd may rely, I bear in mind that it is settled law that use of a trade mark includes its independent use and its use as part of a composite mark, provided that it continues to be indicative of the origin of the product.¹¹ Further, in *Lactalis McLelland Limited v Arla Foods AMBA*,¹² Mr Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable just use and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a

¹¹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

¹² BL O/265/22

figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

44) In respect of mark i), the stylisation of the letter ‘X’ and its placement within the circular device element does not, in my view, alter the distinctiveness of the mark, as registered. The mark can still clearly be read as SIENNA X which dominates the mark. As regards mark ii), similar reasoning applies. Further, whilst the stylised ‘X’ in that mark is placed below the word ‘SIENNA’, the mark will still be read through as SIENNA X, which dominates the mark; mark ii) is also use upon which SX Ltd may rely. Turning to mark iii), again similar considerations apply as those made in relation to mark i). Further, the addition of the entirely descriptive and non-distinctive word ‘professional’ obviously does not alter the distinctiveness of the mark, as registered.

45) I find that the differences between the mark, as registered, and all of the marks at i) – iii) above are ones which do not alter the distinctiveness of the registered mark and they are all acceptable variants upon which SX Ltd may rely.

Sufficiency of use and a fair specification

46) I will now determine the sufficiency of use and a fair specification for each class within the registration. As regards determining the latter, I bear in mind that In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) 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.”

47) 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.”

Class 3

48) This class, as registered, reads as follows (my emphasis):

Class 3: Soaps; essential oils; cosmetics; hair lotions; hair preparations; shampoos; exfoliants; dentifrices; toothpastes; sun tanning preparations; self-tanning preparations, lotions and creams; perfumes; glitter for cosmetics purposes; sun screen preparations; sun tan accelerator products and preparations; anti-perspirants and deodorants for personal use; creams, lotions and balms for the skin and for the body; hand creams; face creams; dermatological preparations and substances; all of the aforementioned for use by women only.

49) I can see no evidence before me showing any use for the underlined goods.

50) Insofar as the remaining non-underlined terms are concerned, I have no hesitation in accepting that there has been genuine use for 'self-tanning preparations, lotions and creams'. The evidence clearly paints a picture of longstanding and substantial use for those kinds of goods.

51) I also find that there has been genuine use, since 2019, for certain other kinds of cosmetics and skincare preparations, namely, cleansing balms, lotions and milks, body balms, face masks (clay/cream), facial polishes, oils and scrubs, cleansing gels for the skin, face creams, barrier creams, eye cream, facial toners, chemical peels, retinol serum, make-up remover, post-waxing soothing creams and oils, wipes for applying and removing self-tan, eyebrow pencils, eyebrow and lash colourants and tints, skin exfoliants, depilatory waxes and strips. Whilst the evidence before me for such goods is not as substantial as for self-tanning preparations, and the turnover and marketing figures are not broken down to show the extent of sales or promotion for such goods, I am satisfied that, when viewing the evidence collectively, there has been real commercial exploitation of the mark for those kinds of goods within the relevant period with the aim of creating and maintaining a market for them. In reaching this view, I have borne in mind, in particular, the content of all of the invoices before me spanning the relevant periods listing those kinds of goods, the presence of such goods on the opponent's website over the relevant period and the sales made by Sally's UK of those kinds of goods (obtained from SX Ltd) during the relevant periods.

52) The term 'soaps' is a broad one covering soap for use on the person and for the purpose of household cleaning. The use before me shows use for cleansing balms, gels and lotions for the skin but it does not show use for any soap per se. I find no genuine use for soaps.

53) Turning to 'essential oils', I accept that use has been made for 'facial oils' which may contain essential oils. However, the use before me is unclear as to whether those facial oils are comprised solely of essential oils. I find no genuine use for 'essential oils' per se.

54) Bearing all the above in mind, I must now determine a fair specification in class 3.

55) I do not consider that the breadth of use shown is sufficient to warrant retention of the term 'cosmetics'. This is a broad term covering various sub-categories such as make-up and haircare products, for example. The use shown is limited to only certain kinds of cosmetics such as waxing preparations/strips, cosmetics for eyebrows and skincare preparations.

56) The term 'exfoliants' is also a broad one which covers, not only skin exfoliants such as the facial scrubs/polishes shown in the evidence, but all kinds of exfoliants, including those for household cleaning purposes for which no use has been shown; retention of that broad term is, therefore, also not warranted.

57) Turning to the term 'dermatological preparations and substances', this is a broad term covering all preparations and substances that may be applied to the skin which fall in class 3. I do not consider that this term accords with the perception of the average consumer or how they would fairly describe the nature of the use shown in the evidence. Rather, the average consumer is likely to fairly describe the use shown as being for 'skincare preparations'.

58) Bearing all of the above in mind, I find that a fair specification in class 3 is, as follows:

Class 3: Skincare preparations; eyebrow cosmetics; eyebrow and lash tints/colourants; depilatory wax; wax strips for removing body hair; exfoliants for the skin; self-tanning preparations, lotions and creams; wipes for applying and removing self-tan; creams, lotions and balms for the skin and for the body; face creams; all of the aforementioned for use by women only.

Class 7

59) This class, as registered, reads as follows:

Class 7: Sprayers (machines) for applying artificial sun tanning preparations.

The evidence before me shows regular sales of these kinds of goods within the relevant periods sufficient to create and maintain a share in the relevant market. This is borne out by the various invoices listing such goods, the presence of such goods on

SX Ltd's own website and sales to Sally's UK. I find that the specification, as registered, reflects a fair specification in class 7.

Class 22

60) This class, as registered, reads as follows (my emphasis):

Class 22: Tents, awnings, booths and unfitted coverings; tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations.

The evidence shows regular sales of 'tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations' over the relevant periods. This is clear from the various invoices and the presence of these goods on the websites in evidence. There is no evidence for any other kinds of tents, awnings, booths and unfitted coverings. I find a fair specification in class 22 is, as follows:

Class 22: Tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations.

Class 35

61) This class, as registered, reads as follows (my emphasis):

Class 35: Retail services in connection with the sale of soaps, essential oils, cosmetics, hair lotions, hair preparations, shampoos, exfoliants, dentifrices, toothpastes, sun tanning preparations, perfumes, self-tanning preparations, lotions and creams, glitter for cosmetics purposes; retail services in connection with the sale of sun screen preparations, sun tan accelerator products and preparations, anti-perspirants and deodorants for personal use, creams, lotions and balms for the skin and for the body, hand creams, face creams, dermatological preparations and substances, medicated cosmetic preparations and substances, dermatological preparations and substances without prescription; retail services in connection with the sale of sprayers (machines) for applying artificial sun tanning preparations, equipment and supplies connected with spray-tanning and self-tanning, tents, awnings,

booths and unfitted coverings, tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations;
advertising, marketing and promotional services; marketing consultancy;
marketing agency services; business marketing services; direct marketing
services; public relations services and consultancy; business assistance;
management and administrative services; business analysis, research and
information services.

I bear in mind my earlier findings of genuine use and a fair specification for the goods in classes 3, 7 and 22. All of those goods appear to have been regularly offered for sale through the website of SX Ltd over the relevant periods. That website appears to be one which provides a retail service i.e. the bringing together of various goods in class 3, 7 and 22 (of the kind for which genuine use has been shown) for consumers to browse and purchase. I find genuine use in respect of retail services connected with the sale of those goods. There is no evidence of retail services connected with the sale of any other kinds of goods such as hair lotions, dentifrices, toothpastes, soaps, essential oils etc.

62) I find no genuine use for ‘advertising, marketing and promotional services; marketing consultancy; marketing agency services; business marketing services; direct marketing services; public relations services and consultancy; business assistance; management and administrative services; business analysis, research and information services’ (my emphasis). The evidence of the provision of these services is either non-existent or very thin.

63) I find that a fair specification in class 35 is, as follows:

Class 35: Retail services in connection with the sale of skincare preparations, eyebrow cosmetics, eyebrow and lash tints/colourants, depilatory wax, wax strips for removing body hair, self-tanning preparations, lotions and creams, wipes for applying and removing self-tan, exfoliants for the skin, creams, lotions and balms for the skin and for the body, face creams; retail services in connection with the sale of sprayers (machines) for applying artificial sun tanning preparations and equipment and supplies connected with spray-tanning and self-tanning; retail services in connection with the sale of tents,

awnings, booths and unfitted coverings, all for use in the application of fake tan and self-tanning preparations.

Class 41

64) This class, as registered, reads as follows:

Class 41: Education and training; education and training in relation to hygiene and beauty care; education and training in relation to cosmetics, tanning, self-tanning and haircare; education and training in relation to marketing, advertising, business development and business administration.

The evidence shows that SX Ltd has regularly provided training services in relation to self-tanning, depilatory waxing and eyebrow treatments over the relevant periods. This is evidenced by such services being offered on the website of SX Ltd, the sample invoices listing such services and the social media posts advertising the same. There is either no evidence, or insufficient evidence, of the provision of any other kinds of education or training services.

65) I find that a fair specification in class 41 is, as follows:

Class 41: Training in relation to conducting beauty treatments, namely self-tanning, depilatory waxing and eyebrow treatments.

Class 44

66) This class, as registered, reads as follows:

Class 44: Medical, hygienic and beauty care services; skin care salons; beauty salons; sun tanning salons; skin care services; sun tanning services; self-tanning services and salons; consultancy and advisory services relating to all the aforesaid.

The evidence pertaining to these services is either non-existent or very thin. I find no genuine use for any of these services.

CONCLUSION ON REVOCATION

67) With effect from 22 August 2021, the contested mark is partially revoked. It shall remain registered for the following goods and services:

Class 3: Skincare preparations; eyebrow cosmetics; eyebrow and lash tints/colourants; depilatory wax; wax strips for removing body hair; exfoliants for the skin; self-tanning preparations, lotions and creams; wipes for applying and removing self-tan; creams, lotions and balms for the skin and for the body; face creams; all of the aforementioned for use by women only.

Class 7: Sprayers (machines) for applying artificial sun tanning preparations.

Class 22: Tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations.

Class 35: Retail services in connection with the sale of skincare preparations, eyebrow cosmetics, eyebrow and lash tints/colourants, depilatory wax, wax strips for removing body hair, self-tanning preparations, lotions and creams, wipes for applying and removing self-tan, exfoliants for the skin, creams, lotions and balms for the skin and for the body, face creams; retail services in connection with the sale of sprayers (machines) for applying artificial sun tanning preparations and equipment and supplies connected with spray-tanning and self-tanning; retail services in connection with the sale of tents, awnings, booths and unfitted coverings, all for use in the application of fake tan and self-tanning preparations.

Class 41: Training in relation to conducting beauty treatments, namely self-tanning, depilatory waxing and eyebrow treatments.

OPPOSITION 442188

Proof of Use

68) I remind myself that, for the purposes of its opposition under section 5(2)(b) of the Act, SX Ltd relies on its goods in class 3 and services in classes 35 and 44. Under section 5(3) of the Act, it relies only upon its goods in class 3 and 35.

69) Bearing in mind my earlier comments at paragraph 22, SX Ltd may only rely, under section 5(2)(b) and 5(3) of the Act, upon the goods and services in classes 3 and 35 which have survived the revocation.

Section 5(2)(b)

70) This section of the Act states:

“5. - (2) A trade mark shall not be registered if because –

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

5A. 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.”

71) The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

72) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment that:

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

73) Guidance on this issue has also come from Jacob J, where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

74) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking..”

75) In *Sanco SA v OHIM* Case T-249/11, the General Court (‘GC’) found that goods and services may be regarded as ‘complementary’ and therefore similar to a degree

in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

76) I also bear in mind that in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch) (*'YouView'*), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

77) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05), where the GC held that:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

78) The goods and services to be compared are:

SX Ltd's goods and services	SN Inc's goods
Class 3: Skincare preparations; eyebrow cosmetics; eyebrow and lash tints/colourants; depilatory wax; wax strips for removing body hair; exfoliants for the skin; self-tanning preparations, lotions and creams; wipes for applying and removing self-tan; creams, lotions and balms for the skin and for the body; face creams; all of the aforementioned for use by women only. Class 35: Retail services in connection with the sale of skincare preparations, eyebrow cosmetics, eyebrow and lash	Class 3: Non-medicated cosmetics and toiletry preparations; hair care preparations; hair conditioners; hair creams; hair oils; hair shampoo; hair styling preparations.

tints/colourants, depilatory wax, wax strips for removing body hair, self-tanning preparations, lotions and creams, wipes for applying and removing self-tan, exfoliants for the skin, creams, lotions and balms for the skin and for the body, face creams; retail services in connection with the sale of sprayers (machines) for applying artificial sun tanning preparations and equipment and supplies connected with spray-tanning and self-tanning; retail services in connection with the sale of tents, awnings, booths and unfitted coverings, all for use in the application of fake tan and self-tanning preparations.	
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79) It seems to me that SX Ltd's strongest case obviously lies with its 'skincare preparations' and its next best case lies with its 'self-tanning preparations, lotions and creams'. I proceed accordingly.

Non-medicated cosmetics and toiletry preparations

80) To my mind, the earlier 'skincare preparations; all of the aforementioned for use by women only' falls within the contested goods. They are, therefore, identical in accordance with *Meric*. If that is not right, 'non-medicated cosmetics and toiletry preparations' are nevertheless, obviously, highly similar to the aforementioned earlier goods due to the users being the same (the restriction of the earlier goods to use by women only is not a point of distinction for reasons given below at paragraph 86), the nature and methods of use of the goods being the same or highly similar and the trade channels being the same. There may also be a competitive and/or complementary relationship in play.

81) I will now also consider the similarity between the contested 'non-medicated cosmetics and toiletry preparations' and the earlier 'self-tanning preparations, lotions and creams; all of the aforementioned for use by women only'.

82) The earlier 'self-tanning preparations, lotions and creams' are a type of non-medicated cosmetic because they are used for a cosmetic purpose (to enhance/beautify the appearance of the skin by providing a fake tan) and they are non-medicated. The earlier 'self-tanning preparations, lotions and creams' are therefore identical to the contested 'non-medicated cosmetics'.

83) Turning to the contested 'toiletry preparations', I understand these goods to be for the purpose of cleaning and grooming the body and hair. The earlier 'self-tanning preparations, lotions and creams all of the aforementioned for use by women only' will not be used for cleaning the body or hair. However, there is some shared purpose and method of use with toiletries because both will be applied to the skin to enhance its appearance. The users will be the same. The nature of the goods is highly similar to the extent both may be comprised of lotions or creams or other preparations for application to the skin. The trade channels will be the same with both being stocked in the same stores. I would also expect them to be stocked in the same general area within retail outlets given their shared nature, purpose and method of use and there is no evidence before me to suggest otherwise. I find that the earlier 'self-tanning preparations, lotions and creams all of the aforementioned for use by women only' are highly similar to the contested 'toiletry preparations'.

hair care preparations; hair conditioners; hair creams; hair oils; hair shampoo; hair styling preparations.

84) I will first compare the above contested goods to the earlier 'skincare preparations all of the aforementioned for use by women only'. The applicant makes no submissions on the similarity between those goods. The respective nature is highly similar as both parties' goods may be comprised of lotions, creams, oils or other liquid-type preparations for application to the body/hair. The purpose and method of use is also the same or highly similar as they will all be used to either cleanse or enhance the appearance, albeit that the earlier goods are for enhancing the skin whereas the

contested goods are for enhancing hair. The trade channels and users will also be the same. I find that the contested goods are highly similar to the earlier 'skincare preparations; all of the aforementioned for use by women only'.

85) I will now also consider the similarity between the various contested hair care products and the earlier 'self-tanning preparations, lotions and creams; all of the aforementioned for use by women only'. The applicant contends that these goods are dissimilar.¹³ Its reasons for this are that:

- i) The respective purpose differs because its goods are for cleaning, conditioning, colouring or styling hair whereas the earlier 'self-tanning preparations, lotions and creams' are for providing a tanned look without exposure to radiation,
- ii) The goods are applied differently. The earlier goods are applied directly to the skin and are used periodically, depending on the desired level of tan and its maintenance whereas the contested goods are applied to the hair and scalp with specific instruction for use depending on the product type (leave-in conditioners, rinse out shampoos etc.) and usage can be daily (shampoo) or less frequent (e.g. hair dyes),
- iii) The respective users are said to be different because the earlier goods will be purchased by those seeking a tanned appearance without exposure to the sun whereas the contested hair products will be purchased by consumers seeking to maintain or change their hair's appearance or health. It is also pointed out that the earlier goods are limited to use by women whereas the contested goods could be used by men and women, providing further distinction between them.
- iv) The position in stores will differ because the contested goods will be stocked in the hair care aisle whereas the earlier goods will be stocked in the sun care section.
- v) It is said that the earlier goods are subject to specific regulations regarding the concentration of DHA (dihydroxyacetone) and other ingredients to ensure safety and efficacy.

¹³ Submissions in lieu, [21]-[29]

86) I accept that the contested goods are for application to the hair rather than to the skin and that the former will be used for cleansing, conditioning and colouring the hair whereas the earlier goods are purely for providing a tanned look to the skin. However, there is overlap in purpose to the extent that both parties' goods will be used to enhance a person's appearance. There is also an overlap in nature and method of use to the extent that all the respective goods may consist of creams/lotions/liquids/mousse/sprays and will be applied to the human person, albeit to the hair and scalp, on the one hand, as opposed to being applied to the skin, on the other. Both parties' goods will be purchased by members of the general public and/or businesses/professionals such as salons. In this connection, whilst I note the applicant's comments about the earlier goods being restricted to use by women, as SX Ltd points out, its goods will also be used by women and therefore this is not a point of distinction.

87) Turning to trade channels, I accept that the respective goods may not be stocked on the same shelves and may be stocked in different aisles. However, I would still expect the goods to be found in the same general area of a retail store given their overlap in nature, purpose and method of use, as described in the preceding paragraph. In relation to SN Inc's argument at point v) above, I do not consider that this is a factor which affects my assessment of the similarity between the goods. The goods are not in competition or complementary.

88) Overall, I find the earlier 'self-tanning preparations, lotions and creams; all of the aforementioned for use by women only' to be similar to 'hair care preparations; hair conditioners; hair creams; hair oils; hair shampoo; hair styling preparations' to a medium degree.

Average consumer and the purchasing process

89) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary

according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

91) The average consumer for the relevant goods includes members of the general public (as noted above, the restriction in the earlier specification to use solely by women is not a point of distinction between the goods) and professionals/businesses such as salons. The purchasing act will be primarily visual as all the goods are likely to be sought out by eye in bricks and mortar establishments or on Internet websites, for example. That is not to say, though, that the aural aspect should be ignored because the goods may sometimes be the subject of discussions, such as with sales representatives or salon workers. The cost of the goods is likely to vary. However, even those at the higher end of the cost scale can generally be described as low-cost. The average consumer may consider factors such as scent, physical nature (cream, lotion or mousse etc.) and suitability for hair or skin type. I find that the level of attention paid during the purchase for the relevant goods is likely to be of a medium degree.

Comparison of marks

92) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to dissect the marks artificially, although it is necessary to take account of their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

93) The marks to be compared are:

Earlier mark	Contested mark
SIENNA X	SIENNA NATURALS

94) The earlier mark consists of the word SIENNA followed the letter X. Both of those elements are distinctive. However, SIENNA is prominently positioned at the beginning of the mark and takes up a much greater proportion of the mark than the letter X. I find that the word SIENNA dominates the overall impression of the mark with the letter X playing a lesser role.

95) The contested mark consists of the words SIENNA NATURALS. The word NATURALS has little, if any, distinctiveness given that it is likely be perceived as indicating that the relevant goods are derived from natural ingredients and/or give a natural look. The word SIENNA enjoys a prominent position at the beginning of the mark and has greater distinctiveness than the word NATURALS. I find that the word SIENNA dominates the overall impression of the mark with the word NATURALS playing a lesser role.

96) Visually, both marks begin with the identical word SIENNA. The visual difference arises due to that word being followed by the letter X in the earlier mark as opposed to the word NATURALS in the contested mark. Owing to the dominance of the word SIENNA in both marks, it is that element which is likely to have the greater impact on the perception Overall, I find an above-medium degree of visual similarity between the marks.

97) Aurally, the word SIENNA is likely to be pronounced as SEE-EN-AH. Both marks share these identical three syllables at the beginning. The earlier mark contains one additional syllable in the form of the letter 'X'; contrastingly, the contested mark contains three additional syllables in the form of the word NAT-UR-ALS. Bearing in mind the dominance of the word SIENNA in both marks, it is that element which is

likely to have the greater impact on the perception. I find an above-medium degree of aural similarity between the marks.

98) The word SIENNA is likely to be recognised as a female forename. Both marks share this identical concept. The X element in the earlier mark will instantly be understood as the well-known letter of the alphabet. However, beyond being recognised as a letter, that element does not evoke any immediately graspable concept, as such. I do not, therefore, consider that the letter X creates any real conceptual difference between the marks; it is, effectively, conceptually neutral. The word NATURALS in the contested mark will be understood as a plural of the well-known word NATURAL. It is likely that this will immediately be perceived as an indication that the goods are derived from natural ingredients and/or give a natural look. That being so, that word has little, if any, distinctiveness for obvious reasons in the relevant context and, therefore, has little role to play in distinguishing the marks from a conceptual perspective. Overall, I find a very high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

99) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion between it and the contested mark (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

100) I have already explained that the earlier mark is likely to be recognised as a female forename followed by the well-known letter of the alphabet, X. Neither element is descriptive or allusive in relation to the relevant earlier goods. I find that the word SIENNA, of itself, has a medium degree of distinctiveness. Single letters are typically regarded as being relatively low in inherent distinctiveness.¹⁴ In my view, the letter X, of itself, is relatively low in distinctiveness in relation to the relevant earlier goods. Overall, the mark as whole has a medium degree of inherent distinctiveness.

101) I now turn to the question of whether the inherent distinctiveness of the earlier mark has been enhanced through use for the relevant earlier goods.

102) I have reviewed all the evidence before me from Mses. Matthews and Ocken. Having done so, I bear in mind the following: i) the apparent longevity of use in the UK for 'self-tanning preparations, lotions and creams; all of the aforementioned for use by women only', ii) the fact that those goods have regularly been stocked in major retailers such as LookFantastic and Superdrug, iii) the number of invoices before me showing the sale of such goods, iv) the number of awards for 'best tanning supplier' year-on-year since 2010, and v) Ms Matthews' statement that SIENNA X has been the most popular stocked spray tan brand in UK beauty salons for the ten year period dating back from her statement, with an average of approximately 33% market share over the last seven years (dating back to 2017 from the date of the witness statement).

¹⁴ *BORCO-Marken-Import Matthiesen GmbH & Co. KG v OHIM* Case C-265/09 P.

103) As regards point v) above, I note that SN Inc observes, in its submissions in lieu, that Ms Matthews' statement about the market share held by SIENNA X has not been corroborated by any other evidence. However, I am mindful that no such criticism was made during the normal evidence rounds. Had it been made at that time, Ms Matthews would have had the opportunity to reply with further evidence to dispel any doubts held by SN Inc as regards the accuracy of the market share data. Leaving that criticism until filing submissions in lieu means that Ms Matthews has not had that chance. Bearing this in mind, viewing the evidence as a whole, and noting that Ms Matthews has made a 'statement of truth', I see no reason to doubt the accuracy of the market share information she has given.

104) Bearing in mind points i) – v) above, it also seems likely to me that, although the marketing and turnover figures are not broken down by product type, a large proportion of the same are likely to relate to the promotion and sale of 'self-tanning preparations, lotions and creams; all of the aforementioned for use by women only'. I find that the distinctiveness of the earlier mark for those goods has been elevated to an above-medium degree.

105) I find that there is insufficient evidence before me to show that the earlier mark enjoyed enhanced distinctiveness at the relevant date in relation to the wider category of 'skincare preparations; all of the aforementioned for use by women only'. Whilst I am satisfied that there has been genuine use for that wider category, the scale of use for the same appears does not appear to have been particularly significant and there is nothing else in the evidence such as awards, market share evidence or significant promotion for those goods to persuade me otherwise. I will, therefore, proceed on the basis of the mark's inherent distinctiveness for those goods which is of a medium degree.

Likelihood of confusion

106)) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a

greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

The likelihood of confusion between the earlier 'skincare preparations; all of the aforementioned for use by women only' and the contested goods.

107) I will first consider the likelihood of direct confusion. The respective goods are highly similar. The most dominant element of both marks is the identical word SIENNA and the marks are visually and aurally similar to an above-medium degree. Further, the marks are very highly similar from a conceptual perspective. All these factors clearly weigh heavily in SX Ltd's favour. Furthermore, the earlier mark, as a whole, has a medium degree of distinctiveness, and the 'SIENNA' element, of itself, (being the point of coincidence between the marks) has a medium degree of distinctiveness. Weighing all these factors, and bearing in mind the principle of imperfect recollection, I find that there is a likelihood of direct confusion between the marks, on the part of an average consumer, paying a medium degree of attention during a mainly visual purchase.

108) I will now also consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later

mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

109) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

110) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

111) I find that, in the event the average consumer recognises that the respective marks are not the same, they are still likely to believe that the respective goods come from the same or linked undertaking(s). I make this finding bearing in mind that the respective marks both contain, as their dominant element, the identical word SIENNA, and that the other differing elements, being the letter X on the one hand, and the word NATURALS, on the other, are both relatively less distinctive than the SIENNA element. In my view, the change of X to NATURALS is one which the average consumer may expect to see in a brand variant or brand extension.

112) Additionally, and in the alternative, there is also a likelihood of a substantial proportion of consumers simply misremembering the earlier mark as the word SIENNA alone. In such circumstances, those consumers are even more likely to consider that the mark SIENNA NATURALS is a logical brand extension of the earlier mark. This is because, the only perceived difference would be the addition of a word which has little, if any, distinctiveness, given that it will be perceived as indicating or that the goods are derived from natural ingredients and/or give a natural look. Bearing this in mind together with the high degree of similarity between the goods, I find that there is also a likelihood of indirect confusion. **The opposition under Section 5(2)(b) of the Act succeeds based upon 'skincare preparations; all of the aforementioned for use by women only'.**

The likelihood of confusion between the earlier 'self-tanning preparations, lotions and creams; all of the aforementioned for use by women only' and the contested goods.

113) I will, again, first consider the likelihood of direct confusion. The respective goods are either identical, highly similar or similar to a medium degree. The most dominant element of both marks is the identical word SIENNA and the marks are visually and aurally similar to an above-medium degree. Further, the marks are very highly similar from a conceptual perspective. All these factors weigh heavily in SX Ltd's favour. Furthermore, the earlier mark, as a whole, has an above-medium degree of enhanced distinctiveness, and the 'SIENNA' element, of itself, (being the point of coincidence

between the marks) has a medium degree of distinctiveness. Weighing all these factors, and bearing in mind the principle of imperfect recollection, I find that there is a likelihood of direct confusion between the marks, on the part of an average consumer, paying a medium degree of attention during a mainly visual purchase. I would have reached the same conclusion even if I had based my assessment on the medium degree of inherent distinctiveness of the earlier mark.

114) I will now also consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

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

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

115) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

116) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

117) I find that, in the event the average consumer recognises that the respective marks are not the same, they are still likely to believe that the respective goods come from the same or linked undertaking(s). I make this finding bearing in mind that the respective marks both contain, as their dominant element, the identical word SIENNA, and that the other differing elements, being the letter X on the one hand, and the word NATURALS, on the other, are both relatively less distinctive than the SIENNA element. In my view, the change of X to NATURALS is one which the average consumer may expect to see in a brand variant or brand extension.

118) Additionally, and in the alternative, there is also a likelihood of a substantial proportion of consumers simply misremembering the earlier mark as the word SIENNA alone. In such circumstances, those consumers are even more likely to consider that

the mark SIENNA NATURALS is a logical brand extension of the earlier mark. This is because, the only perceived difference would be the addition of a word which has little, if any, distinctiveness, given that it will be perceived as indicating that the goods are derived from natural ingredients and/or give a natural look. Bearing this in mind together with the degree of similarity between the goods ranging from at least medium to identical, I find that there is also a likelihood of indirect confusion. **The opposition under Section 5(2)(b) of the Act succeeds based upon ‘self-tanning preparations, lotions and creams; all of the aforementioned for use by women only’.**

Section 5(3)

119) Section 5(3) of the Act provides, as follows:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

120) The relevant case law can be found in the following judgments of the CJEU: *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited*, 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.*, C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L’Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. The law appears to be 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'Oréal 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'Oréal 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'Oréal 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'Oréal v Bellure*).

Reputation

121) The first hurdle that SX Ltd must overcome under this section of the Act is to show that its mark had a reputation in the UK on the priority date of the contested mark. The relevant date in these proceedings is, therefore, **23 September 2022**.

122) In *General Motors*, the CJEU gave guidance on what is required to establish the necessary reputation:

“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.”

123) I have already summarised the evidence before me when I considered whether the distinctiveness of the earlier mark had been enhanced through use from the perspective of the average UK consumer; I found that it had been enhanced to an above-medium degree in respect of ‘self-tanning preparations, lotions and creams; all of the aforementioned for use by women only’. Bearing in mind my earlier comments in that regard I find that the earlier mark also had a reasonable reputation for those goods at the relevant date. I do not consider that the evidence establishes that the earlier mark had a reputation for any of the other goods and services relied upon.

Link

124) Whether the public will make the required mental ‘link’ between the contested mark and the earlier mark must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

- i) *The degree of similarity between the conflicting marks*

The marks are visually and aurally similar to an above-medium degree and conceptually very highly similar.

- ii) *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

The relevant section of the public is members of the general public and businesses/professionals such as salons. The respective goods range from being identical to highly similar to similar to a medium degree.

- iii) *The strength of the earlier mark's reputation*

The earlier mark had a reasonable reputation at the relevant date for 'self-tanning preparations, lotions and creams; all of the aforementioned for use by women only'.

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

The earlier mark has a medium degree of inherent distinctiveness and had acquired an above-medium degree of enhanced distinctiveness at the relevant date.

- V) *Whether there is a likelihood of confusion*

I have found there to be a likelihood of direct and indirect confusion.

Conclusions on link

125) It is implicit in my finding of a likelihood of confusion that a link will be made. Further, even if I am wrong to have found a likelihood of confusion, I find that the earlier

mark will be brought to mind upon encountering the contested mark. In reaching this view, I have borne in mind the similarities between the marks, the degree of similarity/identity between the goods, the reasonable reputation enjoyed by the earlier mark and its above-medium degree of enhanced distinctiveness. The requisite link is established.

Damage

Unfair advantage

126) To the extent that the relevant public believe that the goods of SN Inc are the goods of SX Ltd, there will plainly be unfair advantage.

127) In the event that I am wrong to have found a likelihood of confusion, I will also assess whether the mere bringing to mind of the earlier mark is likely to lead to unfair advantage. I note that SX Ltd has claimed that it can be inferred that SN Inc intended to take unfair advantage of its reputation. There is nothing in the evidence to suggest there was any such subjective intention. Nevertheless, SX Ltd's evidence shows that its annual marketing expenditure is not insignificant and that its products appear to be highly regarded for their quality given the annual awards that it has received and the significant market share it has enjoyed. Bearing these factors in mind, I find that there is, objectively, and even in the absence of confusion, a non-hypothetical risk that the link that is made between the contested mark and the earlier mark will result in the aforementioned positive image associated with the earlier mark transferring to SN Inc's mark. This association with the earlier reputed mark would make the contested mark more attractive to the relevant public and give SN Inc more custom than it otherwise would have enjoyed and make its job of marketing its goods easier. As this would come without paying any compensation to SX Ltd, and without SN Inc expending the money necessary to create a market for its own goods in the UK, I find that this constitutes unfair advantage.

Other heads of damage

128) I do not consider that either of the other claimed heads of damage put SX Ltd in any stronger position. As such, I decline to deal with them.

129) **The opposition under section 5(3) of the Act succeeds.**

Section 5(4)(a)

130) SX Ltd claims to have established a passing off right under the sign SIENNA X at the relevant date, in relation to 'cosmetics and beauty care products and services'. The evidence pertaining to this ground is the same as that already considered under section 5(2)(b). I cannot see how this claim adds to, or improves upon, that claim bearing in mind the scope of goods and services for which use has been shown. As such, I decline to deal with this ground.

OPPOSITION 442189

131) STCC Ltd also claims to have established a passing off right under the sign SIENNA X at the relevant date, in relation to 'cosmetics and beauty care products and services'. Bearing in mind my comments in the preceding paragraph, and the success of opposition 442188, I cannot see how this opposition improves upon the other. As such, I decline to deal with the claim made under section 5(4)(a) of the Act in this opposition.

OVERALL OUTCOME

132) **Opposition 442188 succeeds in full. Application 3886448 is refused registration.**

133) **Revocation 506648 is partially successful. With effect from 22 August 2021, the mark 914572895 is partially revoked. It shall remain registered for the following goods and services:**

Class 3: Skincare preparations; eyebrow cosmetics; eyebrow and lash tints/colourants; depilatory wax; wax strips for removing body hair; exfoliants for the skin; self-tanning preparations, lotions and creams; wipes for applying and removing self-tan; creams, lotions and balms for the skin and for the body; face creams; all of the aforementioned for use by women only.

Class 7: Sprayers (machines) for applying artificial sun tanning preparations.

Class 22: Tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations.

Class 35: Retail services in connection with the sale of skincare preparations, eyebrow cosmetics, eyebrow and lash tints/colourants, depilatory wax, wax strips for removing body hair, self-tanning preparations, lotions and creams, wipes for applying and removing self-tan, exfoliants for the skin, creams, lotions and balms for the skin and for the body, face creams; retail services in connection with the sale of sprayers (machines) for applying artificial sun tanning preparations and equipment and supplies connected with spray-tanning and self-tanning; retail services in connection with the sale of tents, awnings, booths and unfitted coverings, all for use in the application of fake tan and self-tanning preparations.

Class 41: Training in relation to conducting beauty treatments, namely self-tanning, depilatory waxing and eyebrow treatments.

COSTS

134) SX Ltd has been entirely successful in its opposition and partially successful in the revocation. It has, therefore, had the greater degree of success and is entitled to an award of costs. I will apply an appropriate reduction to account for the only partial success in the revocation. I have not considered it necessary to consider STCC Ltd's opposition under section 5(4)(a) as it appeared to add nothing beyond the other opposition. As such, I do not consider it appropriate to award anything for the official fee for that opposition or the preparation of the relevant statement of grounds. Bearing

these factors in mind, together with the consolidation of the three cases, and using the guidance in Tribunal Practice Notice 1/2023, I award costs on the following basis:

Official fee	£200
Preparing a statement and considering the other side's statement	£500
Preparing and filing evidence	£600
Written submissions in lieu	£300
Total:	£1600

135) I order Sienna Naturals, Inc. to pay Sienna X Ltd and The Spray Tan Cubicle Company Ltd the sum of **£1600**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of June 2026

Beverley Hedley
For the Registrar

ANNEX

Goods and services covered by mark 914572895:

Class 3: Soaps; essential oils; cosmetics; hair lotions; hair preparations; shampoos; exfoliants; dentifrices; toothpastes; sun tanning preparations; self-tanning preparations, lotions and creams; perfumes; glitter for cosmetics purposes; sun screen preparations; sun tan accelerator products and preparations; anti-perspirants and deodorants for personal use; creams, lotions and balms for the skin and for the body; hand creams; face creams; dermatological preparations and substances; all of the aforementioned for use by women only.

Class 7: Sprayers (machines) for applying artificial sun tanning preparations.

Class 22: Tents, awnings, booths and unfitted coverings; tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations.

Class 35: Retail services in connection with the sale of soaps, essential oils, cosmetics, hair lotions, hair preparations, shampoos, exfoliants, dentifrices, toothpastes, sun tanning preparations, perfumes, self-tanning preparations, lotions and creams, glitter for cosmetics purposes; retail services in connection with the sale of sun screen preparations, sun tan accelerator products and preparations, anti-perspirants and deodorants for personal use, creams, lotions and balms for the skin and for the body, hand creams, face creams, dermatological preparations and substances, medicated cosmetic preparations and substances, dermatological preparations and substances without prescription; retail services in connection with the sale of sprayers (machines) for applying artificial sun tanning preparations, equipment and supplies connected with spray-tanning and self-tanning, tents, awnings, booths and unfitted coverings, tents, awnings, booths and unfitted coverings for use in the application of fake tan and self-tanning preparations; advertising, marketing and promotional services; marketing consultancy; marketing agency services; business marketing services; direct marketing services; public relations services and consultancy; business assistance; management and administrative services; business analysis, research and information services.

Class 41: Education and training; education and training in relation to hygiene and beauty care; education and training in relation to cosmetics, tanning, self-tanning and haircare; education and training in relation to marketing, advertising, business development and business administration.

Class 44: Medical, hygienic and beauty care services; skin care salons; beauty salons; sun tanning salons; skin care services; sun tanning services; self-tanning services and salons; consultancy and advisory services relating to all the aforesaid.