

O/0718/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004034293

BY BLISS WATER CARE LTD

TO REGISTER THE TRADE MARK:

Bliss Spa

IN CLASS 1

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 448703

BY BLISS TRADEMARK HOLDINGS, LLC

BACKGROUND AND PLEADINGS

1. On 3 April 2024, BLISS WATER CARE LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 19 April 2024. The applicant seeks registration for the following goods under the above application:

Class 1 Water treatment chemicals for use in swimming spas; Water treatment chemicals for use in swimming pools and spas; Chlorinated chemicals; Water treatment chemicals for use in swimming pools; Water-purifying chemicals; Chemicals for the treatment of hot water systems.

2. The application was opposed in full by Bliss Trademark Holdings, LLC (“the opponent”) on 19 July 2024 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act (“the Act”).

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark:

BLISS

UK registration no. UK00003448543

Filing date 2 December 2019; Registration date 8 August 2020.

4. Under section 5(2)(b), the opponent relies upon its class 3 terms “bleaching preparations and other substances for laundry use” and “cleaning, polishing scouring and abrasive preparations”. The opponent claims that there is a likelihood of confusion because the parties’ goods are similar and the marks are visually, aurally and conceptually identical in their distinctive component “bliss”.

5. Under section 5(3), the opponent relies upon its class 3 terms “cosmetics”, “skincare preparations, moisturizers, lotions, creams, scrubs, serum, balms, masks, gels, cleansers and toners”, “shower gels and creams”, “body firming gels and lotions”, “sun block, deodorants”, and “face and body oils”. The opponent claims that the parties’

closely similar marks and goods will result in the public believing that they originate from the same or economically linked undertaking, and that the applicant will benefit from the opponent's advertising and promotion of its mark, and thus securing an advantage without any investment. The opponent also claims that the applicant will "gain sales, goodwill and enhanced status" as a result of its association with the opponent's mark, and the attractive power of the opponent's mark will be reduced, especially if the quality of the applicant's goods is poor. The opponent also claims that there will be detriment to the distinctive character and reputation of the opponent because it will no longer signify origin and "the opponent's earlier mark will be diluted by concurrent use of a similar mark".

6. Under section 5(4)(a), the opponent relies upon its **BLISS** sign which it claims to have used throughout the UK since 2006 for "cosmetics" and "skincare preparations". The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

7. The applicant filed a counterstatement denying the claims made in regard to confusion. However, the applicant did not rebut or make any submissions in relation to the opponent's section 5(3) and 5(4)(a) claims.

8. The opponent is represented by HGF Limited and the applicant is unrepresented. The opponent filed evidence in chief. Neither party requested a hearing, however, the opponent filed submissions in lieu. I make this decision having taken full account of all the papers and evidence, and I will refer to them where necessary below.

RELEVANCE OF EU LAW

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

EVIDENCE

10. The opponent's evidence consists of the witness statement of Ralph Azrak dated 18 November 2024. Mr Azrak is the co-founder of the applicant, a position he has held since February 2023. Mr Azrak's statement is accompanied by 5 exhibits (Exhibit 1-Exhibit 5).

11. Whilst I do not propose to summarise it here, I have taken all of the opponent's evidence and submissions into consideration in reaching my decision and will refer to them where necessary below.

PRELIMINARY ISSUE

12. As noted above, the applicant's counterstatement did not address the opponent's section 5(3) and 5(4)(a) claims. Therefore, on the 8 July 2026, the Registry wrote out to the parties via an official letter, noting that both parties have proceeded as if all the grounds were still in issue; for example, the opponent filed the above evidence to support its claims of a reputation and goodwill. On this basis, the letter set a deadline of two weeks for the applicant to admit or deny the section 5(3) and 5(4)(a) grounds.

13. On 9 July 2026, the applicant confirmed that they denied all the grounds of the opposition, including section 5(3) and 5(4)(a) of the Act. Consequently, on 23 July 2026, we issued an official letter confirming that it was the preliminary view of the Registry that the applicant's aforementioned email be accepted into the proceedings, and that I shall write my decision in accordance with the applicant's denial of the section 5(2), 5(3) and 5(4)(a) grounds. Neither party disagreed with the preliminary view and therefore I shall proceed as stated.

DECISION

Section 5(2)(b)

14. Section 5(2)(b) reads as follows:

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

(a)...

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

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

15. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing date of the applicant’s mark.

16. The opponent’s earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the applicant’s mark). Accordingly, the use provisions at section 6A of the Act do not apply.

17. The opponent may rely upon all of its goods without demonstrating that it has used its mark.

Section 5(2)(b) - case law

18. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater degree of similarity between the marks, and vice versa;¹

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

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

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

¹ That being the interdependency principle.

(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

19. The parties' competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 3</u> Bleaching preparations and other substances for laundry use; cleaning, polishing scouring and abrasive preparations.	<u>Class 1</u> Water treatment chemicals for use in swimming spas; Water treatment chemicals for use in swimming pools and spas; Chlorinated chemicals; Water treatment chemicals for use in swimming pools; Water-purifying chemicals; Chemicals for the treatment of hot water systems.

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 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."

21. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

22. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means “... 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 the responsibility for those goods lies with the same undertaking.”

Water treatment chemicals for use in swimming spas; Water treatment chemicals for use in swimming pools and spas; Chlorinated chemicals; Water treatment chemicals

for use in swimming pools; Water-purifying chemicals; Chemicals for the treatment of hot water systems.

24. For the purposes of this comparison, I shall be dealing with the applicant's terms as a collective. This reflects the approach taken by the opponent in its submissions in lieu, in which they group and describe all of the applicant's above goods as "chemicals for pools, spas and hot water systems (e.g. hot tubs)".²

25. In paragraph 13 of its submissions in lieu, the opponent has also bolded its terms "bleaching preparations" and "cleaning preparations". I therefore consider that the opponent wishes to focus the comparison based on these two terms.

26. In paragraph 15 of its submissions in lieu, the opponent states that its "goods are, broadly, **cleaning preparations** which include specialised cleaning preparations for pools, spas and hot water systems". Based on this description, the opponent submits that the parties' goods share the same nature and method of use³ and that the goods would be used by the "same specialist end-users". The opponent also claims that the applicant's goods are used to clean water and the opponent's goods are also used to clean, and "could well be used alongside the applicant's goods in the cleaning of the same pools, spas or hot water systems".⁴ Lastly, at paragraph 19 of its submissions in lieu, the opponent claims that the parties' goods would be sold through the same distribution channels.

27. Firstly, I bear in mind that I am entitled to treat the class number as relevant to the interpretation of the scope of application,⁵ and that the "class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods".⁶ In this instance, the applicant's chemical goods for use in treating water is registered in class 1. NICE's explanatory note of class 1 is that it "includes mainly chemical products for use in industry, science and agriculture,

² Paragraph 14 of its submissions in lieu

³ Paragraph 16 of its submissions in lieu

⁴ Paragraph 18 of its submissions in lieu

⁵ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34

⁶ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch)

including those which go to the making of products belonging to other classes". The opponent's cleaning goods are registered in class 3, and NICE's explanatory note of this class is that it "includes mainly non-medicated toiletry preparations, as well as cleaning preparations for use in the home and other environments". Therefore I find that class 3 predominantly covers cleaning goods which are found in a domestic environment i.e. kitchen and toilet cleaners. However, other examples provided by NICE of cleaning terms which appear in class 3 are "windscreen cleaning liquids", "preparations for cleaning dentures" and "baby wipes impregnated with cleaning preparations".

28. Whilst the opponent submits that its specification covers specialised cleaning preparations for pools, spas and hot water systems, I have not been provided with any evidence to show what these goods are. As noted above, the opponent submits that the applicant's class 1 goods are used to clean water, and from my own understanding, the only way to clean or disinfect pools, spas and hot water systems would be to use chemicals, such as chlorine. I also find that chlorine is a type of water treatment chemical that would be protected by class 1. Therefore without any evidence or specific submissions before me as to what class 3 "specialised cleaning preparations for pools, spas and hot water systems" are, and how they are distinct from water treatment chemicals in class 1 (which are used for cleaning purposes), I am unable to determine if such "cleaning preparations for pools, spas and hot water systems" would subsist and therefore be protected by class 3. Consequently, I find that for the purposes of my comparison, the opponent's class 3 "cleaning preparations", as directed by its class heading, will predominantly encompass cleaning goods for domestic use, such as kitchen, bathroom and toilet cleaners. The applicant's class 1 goods are chemicals which are used to treat (and by virtue disinfect and clean) pools, spas and hot water systems that would likely be found in, for example, hotels, spas or swimming facilities. However, I appreciate that households may have a pool located indoors or in their garden (whether inbuilt or freestanding).

29. Whilst all of the parties' goods are used for cleaning, it is clear that the nature and method of use of the goods are different. I also find that the trade channels will differ on the basis that the applicant's goods are likely to be sold by pool specialists, or by undertakings which specialise in water treatment chemicals. The opponent's cleaning

preparations for domestic use will be sold in general retail outlets such as supermarkets. The goods are not complementary in the way described by the case law cited above, and they are clearly not in competition, as you would not clean a bathroom with water treatment chemicals, and you would not treat swimming pools with toilet cleaners, for example. There may be an overlap in user, however, I do not consider that an overlap in user and cleaning purpose is sufficient to find similarity especially when considering that none of the other *Treat* criteria apply. Therefore, I find that the applicant's class 1 goods, and the opponent's class 3 "cleaning preparations" are dissimilar.

30. In regard to the opponent's class 3 "bleaching preparations", this term is limited to "laundry use" within the specification. Therefore, these goods clearly do not overlap in nature, method of use, purpose and user. The goods will not overlap in trade channels, and the goods are not complementary. The goods are clearly not in competition as you would not use laundry bleach to treat a swimming pool or hot tub. Whilst there may be an overlap in user, this is not enough on its own to establish similarity. Consequently, I find that the applicant's above class 1 goods, and the opponent's "bleaching preparations [...] for laundry use" are dissimilar.

31. For the sake of completeness, I do not consider that the opponent's remaining class 3 goods (which were not bolded in its submissions in lieu), that being "other substances for laundry use" and "polishing, scouring and abrasive preparations" overlap in nature, method of use, purpose, user and trade channels with the applicant's class 1 chemical goods. The goods are neither in competition nor complementary. I therefore find that the parties' goods are dissimilar.

32. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that (my emphasis):

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has

to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

33. As established in the case law above, under section 5(2)(b), for there to be a likelihood of confusion between the marks, there has to be a finding of similarity between the goods.

34. Since I have determined that the parties’ goods are not similar, the opposition under section 5(2)(b) fails here.

Section 5(3)

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

“5(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

36. Section 5(3A) of the Act states:

“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.”

37. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L’Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v*

Marks and Spencer plc & Anor (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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, 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.

(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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

38. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar. Secondly, the opponent must show that its earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponent's mark being brought to mind by the applicant's mark. Fourthly, assuming that the first, second and third conditions have been met, section

5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

39. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 3 April 2024.

Similarity of the marks

40. The respective trade marks are shown below:

Opponent's mark	Applicant's mark
BLISS	Bliss Spa

41. I note that both of the parties' marks are word marks, and therefore their registration covers use in any standard typeface, including presenting the mark in upper and lower-case, or title-case.

42. The opponent's mark consists of the word "BLISS". The applicant's mark is also composed of the word "Bliss" followed by the word "Spa". Therefore, the marks are visually, aurally and conceptually similar to a medium degree, on the basis that both marks contain the ordinary dictionary word "BLISS".

Reputation

43. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

44. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

45. Mr Azrak states that the "BLISS business and brand" was acquired by the applicant in February 2023, but the business was originally founded in 1996 in the USA. It was first used in the UK for spa services in 2001, and has been used for skincare products since 2006.

46. Mr Azrak states that in 2021, "via the business activities of the prior owner", the BLISS brand "became the first-ever skincare brand sold at mass and drug retailers to receive B Corp Certification".⁷ This was reported by third parties such as BEAUTYINC and BPX Magazine, as shown by the June 2021 articles contained in **exhibit 2**. This exhibit also contains a printout from the "Leaping Bunny Programme" dated October

⁷ Paragraphs 7 and 11 of Mr Azrak's statement

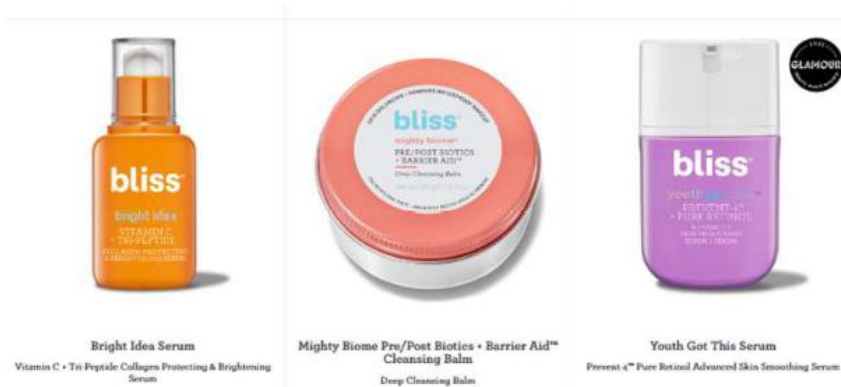
2024, showing that “BLISS” is a certified company free from animal testing. However, this printout is from after the relevant date.

47. Mr Azrak confirms that the BLISS mark has been used on the following skincare, cosmetic and toiletry products: body and face moisturizers, eye creams, face masks, body creams and lotions, facial oils and cleansers, facial cleansers and toners, body exfoliators and scrubs, soap bars, makeup wipes and hair removal kits. I note that **exhibit 3** contains screenshots from the opponent’s blissworld.co.uk website dated between 25 November 2014 to 5 May 2017, which shows BLISS skincare creams, masks and cleansers listed for sale.⁸

48. At paragraph 13 of his witness statement, Mr Azrak confirms that BLISS skincare and cosmetic goods were made available in the market through a variety of channels including UK retailers such as Boots, John Lewis, Debenhams and Marks & Spencer, as well as e-commerce platforms such as amazon.co.uk, feelunique.com and lookfantastic.com (and its blissword.co.uk website). To support this statement, **exhibit 3** contains screenshots from all of the above websites, dated between 26 March 2014 and 29 July 2023, clearly showing BLISS suncreams, serums, scrubs, moisturisers, sheet masks, clay masks, eye creams, eye gels, face wash, hand creams, body butter, toner, cleansing milk, neck cream, day creams, cleansers, skin-firming cream, lip cleanser, resurfacing pads, foot cream, soap and shampoo for sale. I also note that the goods are shown, for example, as follows:



⁸ While **exhibit 1** also contains screenshots from the opponent's blissworld.com, they are dated “Wednesday 30 October”, and therefore, without confirmation of the year, I am unable to determine if these screenshots were taken before the relevant date.



49. Whilst the branding has clearly changed over the years, as shown above, the goods have consistently been affixed with the word “bliss”.

50. In regard to the opponent’s sales made under the “bliss” mark, Mr Azrak states that since February 2023, in the UK alone, the turnover has “*been in the tens of thousands, including over USD28,000 in the last 90 days alone*”. However, I bear in mind that Mr Azrak’s statement is dated 18 November 2024, and therefore it is reasonable to infer that the “USD28,000” made in the “last 90 days” was from August 2024, which falls after the relevant date. In regard to marketing expenditure, Mr Azrak confirms that he does not have any figures for the period preceding January 2023 due to the change in the ownership of the brand. However, Mr Azrak states that the opponent’s marketing figures “*in the months since January 2023 have been in the millions of USD*”.

51. Mr Azrak states that that the opponent promotes its good in the UK via advertisements on social media pages, partnerships with influencers, and advertising

on Amazon and Google. However, I have only been provided with examples of the opponent's online advertising via social media. This is contained in **exhibit 4**, and includes the following:

- a) Screenshots of 4 Instagram posts dated between 28 April 2021 and 30 October 2022 showing BLISS branded skincare goods. I note that there are between 548 and 3,272 likes on these posts. 2 of the posts confirm that BLISS is being stocked in Boots, the third party retailer.
- b) Screenshots of 2 YouTube video reviews dated 18 September 2020 and 28 October 2023. The videos pertain to Bliss skincare and suncream, and have received 30,451 and 59,820 views.
- c) However, the Instagram and YouTube screenshots are undated and thus I am unable to determine how many likes/views were from before the relevant date.
- d) An undated screenshot of a video from the Bliss Tik Tok account regarding the Bliss Drench and Quench Moisturizer.

52. I have also been provided with examples of third party editorials which refer to the opponent's goods contained in **exhibit 5**. I note that in the Stylist Magazine article dated 29 October 2024, and the Vogue article dated 28 April 2021, they refer to the brand BLISS "disappearing from the [UK] market", on a "four-year hiatus", which made it tricky for "customers to get their hands on fan favourites like the Triple Oxygen Foaming Mask and Fabulips Lip Scrub". Nonetheless, I also note that the third party editorials also make reference to the opponent's goods as follows:

- 1) An article from theguardian.com dated 31 July 2021 which lists "The best affordable vitamin C serums", includes the "Bright Idea Vitamin C + Tri-Peptide Face Serum (£19.99 for 30ml) "from the newly resurrected Bliss spa brand (absent from the UK market for the past few years)".
- 2) An article from theguardian.com dated 3 December 2022 which recommends Retinol's under £25, including "Bliss's Youth Got this Serum (£21.99)".
- 3) An article about Bliss from glamourmagazine.co.uk dated 26 April 2021, titled "A serum from this super popular brand sells every 15 seconds in the USA and

it's finally launching here!!". It states that "you might just remember the brand from its short lived stint in the UK", and that it is loved by YouTube sensations such as Skincare by Hynam and Emma Chamberlain, with the "fan favourite" products being the foaming cleanser, waxing kit, the Block Star Daily Sunscreen and jelly cleanser.

- 4) An article from [vogue.co.uk](https://www.vogue.co.uk) dated 28 April 2021 titled "This US Spa Brand Is Back (And We Really Missed It)". The article states that Bliss is now stocked in Boots, with "an all-star lineup of old favourites" such as the foaming face wash, vitamin C serum, and hyaluronic serum.

53. The evidence above shows that I have only been provided with an approximate UK turnover figure made since February 2023, (when they obtained the brand from a previous company), that being "*in the tens of thousands*". I bear in mind that in the *PILLOW TALK* case,⁹ Thomas Mitcheson KC, sitting as the Appointed Person, upheld the Hearing Officer's decision to reject as evidence of use of a trade mark the statement: "average annual turnover of the goods in Class 28, using the 'Pillow Talk' mark, during the relevant period, was £45,000" on the basis that additional material in support of this statement (that was likely to exist) was non-existent.

54. The opponent's evidence demonstrates that multiple types of cosmetic, skincare and toiletry goods bearing the BLISS mark were available on opponent's UK website, as well as through Debenhams, Marks & Spencer, John Lewis, Feel Unique, Look Fantastic and Amazon, between 26 March 2014 and 8 July 2022. On this point, I have considered the case of *EROS BODYGLIDE* BL O/0984/25, in which Mr Phillip Johnson sitting as the Appointed Person highlighted that:

"26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B.

⁹ BL O/1160/23

The same applies where the same good is sold under trade mark A and trade mark B.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.” **(my emphasis)**

55. Whilst I appreciate that the appeal case of *EROS BODYGLIDE* explores the criticisms in relation to proof of use evidence (under section 5(2)(b)), I find that the comments can be considered and are useful when assessing reputation in the context of section 5(3) (which is a higher threshold for a party to prove). Therefore, on the basis that the “*in the tens of thousands*” approximate sales figure has not been broken down into the opponent’s different types of cosmetic, skincare and toiletry goods, it follows that this figure cannot be evidence of use for any of those BLISS goods.

56. Notwithstanding the above, I have no invoice evidence before me demonstrating sales in regard to the opponent’s own website or third party retailer websites. I have also not been provided with evidence of UK user engagement with the opponent’s website. Without evidence of actual sales and/or more comprehensive sales figures, I cannot determine the scale, frequency or territorial extent of the use of the mark, which are key factors in the assessment of reputation. The opponent has also not provided the market share held by the BLISS mark in order to show its position in the relevant markets. Nonetheless, based on the approximate sales figure provided, which was generated in just over a year,¹⁰ I find that it would likely amount to a small proportion of the cosmetic, skincare and toiletry markets (which I consider to be large sectors).

57. Mr Azrak states that the opponent’s marketing figures “in the months since January 2023 have been in the millions of USD”. Whilst he does not confirm whether this figure only pertains to UK marketing activities, the evidence has been provided under the

¹⁰ As Mr Azrak confirms that the sales were made from February 2023, and the relevant date of the proceedings is 3 April 2024.

heading of “use of BLISS in the UK” in Mr Azrak’s statement, and therefore it is reasonable to infer that this figure pertains to UK marketing only. Nevertheless, the evidence of marketing provided is limited. For example, I have no evidence of the opponent’s partnerships with influencers, and its advertising on Amazon and Google.¹¹ In regard to the social media advertisements, I have only been provided with 4 Instagram posts and 2 YouTube videos, dated between 18 September 2020 and 28 October 2022, of which the screenshots are undated. I am, therefore, unable to determine how many likes and views were from before the relevant date, and what proportion of the likes and views were made from UK consumers. I also note that without readership figures, I am unable to determine how many UK consumers were exposed to the third party editorials (some of which are from .com websites, which can therefore be accessed globally).

58. Parallel to the *PILLOW TALK* case above, I find that the absence of any useful material dated from the relevant period amounts to “a fundamental inadequacy” which allows to me to sceptical of the approximate turnover figure provided by Mr Azrak.¹² Thus, taking all of the above into account, I find that none of Mr Azrak’s evidence supports his statement on the sales made under the BLISS mark after February 2023, and I therefore reject it as it is insufficiently solid. Consequently, taking the evidence as a whole into account, I find that the opponent’s evidence is insufficient to establish a reputation in the UK. On this basis, without having found a reputation, the opposition based upon section 5(3) fails.

59. However, even if the opponent did benefit from a reputation, the opposition based upon section 5(3) would still fail. This is because, in my view, the distance between the goods relied upon by the opponent (broadly speaking, cosmetic, skincare and toiletry preparations) and the goods of the applicant (water treatment chemicals, etc.) is such that I do not consider that a link would be made by the relevant public. Even accounting for the parties’ similar ‘BLISS’ marks, the strength of reputation that would be required to bridge the gap between such different goods is at a level that the opponent’s evidence clearly falls far short of demonstrating.

¹¹ As noted in paragraph 51 above, Mr Azrak states that the opponent has promoted its goods in the UK via such methods.

¹² Paragraph 14 of *PILLOW TALK* BL O/1160/23

Section 5(4)(a)

60. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

aa)...

b) ...

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

61. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

62. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Relevant date

63. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

64. As the applicant has filed no evidence of use of its mark, I have only the prima facie relevant date to consider i.e. 3 April 2024.

Goodwill

65. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing

which distinguishes an old-established business from a new business at its first start.”

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

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

67. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in

every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

68. Goodwill arises as a result of trading activities, and whilst it is clear that BLISS cosmetic, skincare and toiletry goods were available on the opponent's website and third party retailer websites before the relevant date, there are no invoices provided demonstrating any sales and only one approximate sales figure is provided. However, I have rejected Mr Azrak's statement on the opponent's UK sales since February 2023 being "in the tens of thousands" as being insufficiently solid on the basis that there is a lack of supporting evidence. I have also been able to reject the approximate sales figure on the basis that there are multiple types of cosmetic, skincare and toiletry goods which Mr Azrak confirms the BLISS mark has been used on, and as highlighted by *EROS BODYGLIDE*, "*where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods*".¹³ Again, whilst I appreciate that the criticisms in this case are in relation to proof of use evidence (under section 5(2)(b)), I find that the comments can be considered and are useful when assessing goodwill in the context of section 5(4)(a).

69. Based on the evidence before me, I am unable to determine the scale and frequency of the opponent's sales in the UK, or if they were geographically spread. Whilst I have been provided with an approximate marketing spend post February 2023, that being in the millions of USD, the screenshot evidence of the social media advertising is undated, and therefore I am unable to determine what the user engagement was before the relevant date, and if any of those who were exposed to the posts were from the UK. I am also unable to determine how many UK consumers were exposed to the third party editorials (some of which are from .com websites, which can therefore be accessed globally).

70. I therefore find that, based on all of deficiencies above, and considering the position as at the relevant date, I find that the opponent's evidence falls short of proving

¹³ BL O/0984/25 paragraph 26

the existence of any protectable level of goodwill in their business. The section 5(4)(a) claim therefore fails at the first hurdle.

71. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

72. The opposition is unsuccessful, and the application UK00004034293 may proceed to registration.

COSTS

73. The applicant has been successful and would normally be entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

74. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 11th day of August 2026

L FAYTER

For the Registrar