O/0762/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3764104 BY

GLORYAL LTD

TO REGISTER THE TRADE MARK:

ENLIVENLIFT

IN CLASS 3

AND

OPPOSITION THERETO

UNDER NO. 434459

BY

DCS GROUP (UK) LTD

BACKGROUND & PLEADINGS

1. On 10 March 2022 Gloryal Ltd ("**the applicant**"), applied to register the trade mark shown on the front page of this decision in the United Kingdom. It was accepted and published in the Trade Marks Journal on 25 March 2022. Following the filing of a Form TM21B, the goods were reduced in scope and they now read as follows:

   Class 3: Masks (Beauty -); Beauty lotions; Beauty milks; Beauty gels; Beauty creams; Beauty serums; Beauty milk; Beauty soap; Beauty masks; Beauty balm creams; Beauty care preparations; Facial beauty masks; Beauty care cosmetics; Non-medicated beauty preparations; Beauty masks for hands; Beauty creams for body care; Distilled oils for beauty care; Beauty preparations for the hair; Body cleaning and beauty care preparations; Beauty serums with anti-ageing properties; Beauty tonics for application to the body; Beauty tonics for application to the face.

2. DCS Group Ltd ("**the opponent**") opposes all of the application on the basis of Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("**the Act**"). The opposition is based upon the opponent's comparable UK trade mark (EU)[1]. Pertinent details of the "earlier marks" are as follows:

   Mark: ENLIVEN
   UK TM No: 906980361
   Relied upon goods: *Class 3 – Toiletries; hair care products; shampoos; conditioners; hairsprays; hand washes; nail varnish removers; skin cleansers; mouth washes for oral hygiene; preparations for the care and treatment of body, face, skin, nails and hair.*
   Filing date: 11 June 2008
   Date of registration: 4 February 2009

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") 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)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives

3. The grounds of opposition are directed against all of the applied for goods. In summary the claims are as follows:

    a) For the s.5(2)(b) claim the opponent relies only upon its class 3 goods and that they enjoyed an enhanced degree of distinctive character. The opponent contends that there is a likelihood of confusion and/or "consumers will believe that there is an economic connection with the Opponent in the sense that ENLIVENLIFT is a sub-brand of ENLIVEN or ENLIVENLIFT products originate from a company economically linked to the Opponent".

    b) For the s.5(4)(a) claim the opponent claims to have acquired goodwill through the provision of the following goods, "Toiletries; hair care products; shampoos; conditioners; hairsprays; hand washes; nail varnish removers; skin cleansers; mouth washes for oral hygiene; preparations for the care and treatment of body, face, skin, nails and hair.", under the sign "ENLIVEN" since 1996, throughout the UK. The opponent claims that use of the applied for mark would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

4. The applicant filed a counterstatement denying the claims made. Whilst the earlier relied upon mark is sufficiently old for it to be the subject of proof of use, the opponent decided to not request evidence demonstrating use.

5. Both sides filed evidence in these proceedings. Neither party requested a hearing, but the opponent did file written submissions in lieu. Therefore, this decision is taken following a careful perusal of the papers.

6. In these proceedings, the opponent is represented by Wynne-Jones IP Limited. The applicant is represented by Janina White.

Preliminary issue

7. On 18 November 2022 a Case Management Conference ("CMC") took place to discuss the granting of the opponent's extension of time request.

8. One week prior to the CMC, the opponent filed its evidence. It totalled 419 pages which is above the 300-page limit[2]. For the reasons set out in the post-CMC letter of 22 November 2022 it was directed that the extension of

[2] TPN 1/2015

time be granted and the evidence reduced to 300 pages. This was duly complied with.

Evidence

Opponent's evidence

9. The opponent's evidence consists of a witness statement from Charles Shortt who is the Director and Chief Marketing Officer and shareholder for the opponent.

10. Mr Shortt states that the objectives of the witness statement are to, 1) establish that the registered mark has been used for the goods on which it relies upon, 2) demonstrate that it has acquired an enhanced distinctive character, and 3) show that the opponent owns goodwill in its business carried out under the relied-upon registration and unregistered sign.

11. He states that the opponent was incorporated on 7 February 1991 and is a seller and distributor of health, beauty, toiletries and household brands and by the year ending 31 December 2020 it had an annual turnover of £267m.

12. A breakdown of the sales has been presented as follows:

	Mar '17 – Feb '18	**Mar '18 – Feb '19**	**Mar '19 – Feb '20**	**Mar '20 – Feb '21**	**Mar '21 – Feb '22**
HAIR GEL	£675k	£584,470	£585,570	£474,800	£595,425
MENS					
Deodorants	£195,100	£160,860	£109,530	£78,495	£54,050
Shower and shampoo	£44,140	£58,400	£33,180	£10,225	-
Shave	£69,590	£66,360	£46,980	-	£21,755
FRUIT NATURALS					
Shower gel	£104,720	£104,055	£75,660	£62,380	£67,105
HAND GELS	£274,750	£285,210	£402,040	£2,340,605	£270,200
NAIL POLISH REMOVER	£179,810	£180,820	£201,375	£159,235	£305,215
MOUTHWASH	£265,440	£271,260	£311,615	£412,975	£462,090
HAIRCARE	£256,100	£401,800	£350,680	£346,260	£329,880
HANDWASH	£179,770	£221,320	£306,430	£1,341,580	£375,675
LUXURY RANGE	£153,410	£183,895	£209,130	£156,545	£91,385
SKINCARE	-	-	-	£3,930	£11,275
FRUITS	-	-	-	-	£255,060

13. It is stated that these goods can be purchased through the following UK retailers: B&M, Homebase, The Range, Boots, Nisa, Matalan, Charlies, Poundstretcher, QD, B&Q, Getir, Viking Direct, Bestway Wholesale and online via Amazon. All of the goods also appear on the opponent's website.

14. Exhibit CS4 consists of a number of images of how the goods appear on the shelves of the stores listed above and how the marks appear on the goods. Some examples are duplicated below:

Matalan – Instore Display

15. In terms of marketing and advertising, the opponent has a social media presence through Facebook, TikTok and Instagram starting in February 2012, February 2022 and November 2016 respectively. The number of followers has not been provided.

16. Mr Shortt also states that the opponent regularly attends trade shows at the Spring and Autumn exhibitions at the Birmingham NEC. He provides various invoices[3] which demonstrate attendance in Autumn 2021 and a brochure for the 2022 Spring and Autumn fairs.

17. That concludes my summary of the opponent's evidence.

Applicant's evidence

18. The applicant's evidence consists of a witness statement of Janina White who is the in-house counsel for the applicant. The witness statement does not include any exhibits.

19. Miss White's witness statement largely consists of submissions rather than evidence. I shall refer to the relevant parts in this decision. However, Miss White does argue that as the applicant is a "small family business…we are

[3] Exhibit CS16

of no competition to the Opponent"[4]. Whilst Miss White may consider this to be the case, this is not relevant to this decision. A UK trade mark grants a nationwide monopoly over the trade mark for the goods and/or services it covers. Therefore, should the business expand, it could prove to be that the brands (if found to be confusingly similar) may be confused by one another. Conversely, even if the applicant does not grow that does not mean that the modest sales, if confusion arises, may adversely affect the opponent – which is effectively what the opponent claims will happen.

20. Miss White also argues that the applicant's goods are high end covering a niche audience, and therefore "there are completely separate and distinct channels of distributions". When assessing whether there is a likelihood of confusion, I must assess the goods and services as applied for against the earlier relied upon goods and/or services. It is a notional assessment. In other words, it is a paper exercise whereby I assess one set of goods against another, not based on the actual usage or proposed use.

21. That concludes my summary of the applicant's evidence.

Section 5(2)(b)

22. The relevant law is as follows:

> "A trade mark shall not be registered if because –
>
> 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.""

23. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

[4] Para. 10

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.

(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

24. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

> "23. In assessing the similarity of the goods or services concerned […] 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 complementary."

25. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(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."

26. The competing goods to be compared are shown in the following table:

Applied for goods	**Opponent's goods**
Class 3: Masks (Beauty-); Beauty lotions; Beauty milks; Beauty gels; Beauty creams; Beauty serums; Beauty milk; Beauty soap; Beauty masks; Beauty balm creams; Beauty care preparations; Facial beauty masks;	Class 3: Toiletries; hair care products; shampoos; conditioners; hairsprays; hand washes; nail varnish removers; skin cleansers; mouth washes

Beauty care cosmetics; Non-medicated beauty preparations; Beauty masks for hands; Beauty creams for body care; Distilled oils for beauty care; Beauty preparations for the hair; Body cleaning and beauty care preparations; Beauty serums with anti-ageing properties; Beauty tonics for application to the body; Beauty tonics for application to the face.	for oral hygiene; preparations for the care and treatment of body, face, skin, nails and hair.

27. In the opponent's statement of case[5] it produced the following table which it claims to illustrate which goods are identical:

Opponent's goods	**Applicant's goods**
Toiletries	Masks (Beauty-); Beauty lotions; Beauty milks; Beauty gels; Beauty creams; Beauty serums; Beauty milk; Beauty soap; Beauty masks; Beauty balm creams; Beauty care preparations;
Hair care products; shampoos; conditioner; hairsprays	Beauty preparations for the hair;
Preparations for the care and treatment of body, face, skin, nails and hair	All of the applied for goods
Skin cleansers	Beauty soap

28. Paragraph 12 of the applicant's counterstatement states that:

> "The Applicant agrees with the Opponent's statement in paragraph 9. As per the presented comparison table, there are clear distinction between subclasses of goods."

29. I take the above statement to be in agreement that all of the applied for goods are identical to those of the opponent, as set out. This is a useful and sensible concession, and even if it was not the applicant's intention to have conceded that point, I would have reached the conclusion that they are identical anyway.

Average Consumer and the Purchasing Act

[5] Para. 9

30. The average consumer is deemed to be reasonably well informed, 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 and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

> "The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

31. The goods at issue are Class 3 beauty products. The average consumer of the goods will be a member of the general public. The goods and services are unlikely to be particularly expensive and are likely to be reasonably frequent purchases. However, various factors will still be taken into account such as fragrance, ingredients and suitability for skin type (for the goods) and ease of use and speed of service (for the services). Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

32. The goods are likely to be self-selected from the shelves of a retail outlet or their online or catalogue equivalents. Visual considerations are, therefore, likely to dominate the selection process[6]. However, I do not discount aural considerations such as aural recommendations.

Comparison of Trade Marks

33. 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 Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

[6] *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 at [50].

> "[…] 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."

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

Applied for mark	Earlier mark
ENLIVENLIFT	

Overall impression

35. The applied for mark consists of the word ENLIVENLIFT, presented in upper case. I agree that consumers would view the applied for mark as being a combination of ENLIVEN and LIFT, notwithstanding the two words are conjoined, however I disagree with the opponent that ENLIVEN is dominant. Therefore, I consider the overall impression resides in the mark as a whole.

36. The earlier mark comprises of the word "ENLIVEN" which is underlined and in thick mildly stylised font. The word is also underlined.

37. Despite being conjoined, the opponent argues that the applied for mark consists of two elements with "ENLIVEN" dominating the overall impression.

38. The opponent argues that the marks are visually similar to a high degree. This appears to be based on its argument that "ENLIVEN" is "the most dominant and distinctive part of the mark". For the reasons set out above,

I do not consider this to be the case. The marks do overlap in that they both contain the word “ENLIVEN”, which are the first seven letters of the applied for mark and the only word of the earlier mark. The applied for mark also includes “LIFT” which is not present in the earlier mark. Taking this into account, along with the earlier mark being underlined, I find that they are visually similar to a degree above medium but not high.

39. Aurally, the opponent argues that they are similar to a high degree. Naturally the applicant disagrees. The “ENLIVEN” element will be pronounced in the same manner in each mark. The marks differ insofar that “LIFT” will be pronounced in the applied for mark, which is not present in the earlier mark. Therefore, I find that they are aurally similar to a degree above medium but not high.

40. The word “ENLIVEN” is a dictionary defined verb which means “to make something more interesting, entertaining or appealing”. In other words, it is to liven something or someone up. The applied for mark has no dictionary definition. However, I find that the average consumer would identify two separate words – ENLIVEN and LIFT. The first element would have the same meaning as the earlier mark and therefore there is a conceptual overlap. The presence of the word LIFT does not alter this concept, but merely qualifies ENLIVEN.

41. In view of the above, I find the respective marks to be conceptually similar to a medium degree.

Distinctive Character of The Earlier Trade Mark

42. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> “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).
>
> 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)."

Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.

43. From an inherent distinctive character perspective, being underlined does not contribute any distinctive character *per se* to the earlier mark. The word itself does not describe the goods or a characteristic thereof. However, the word enliven is to liven someone or something up. This has a laudatory connotation insofar that it could be perceived that the goods will enliven one's skin, body, etc. and therefore I find it to have a low to medium degree of distinctive character.

44. The opponent claims that there "is an enhanced distinctive character in the Earlier Trade Mark due to the unusual mark in relation to the goods listed". In order to have an enhanced distinctive character it must demonstrate, through evidence, that the use made of the mark results in the distinctive character being enhanced.

45. The date I am required to assess whether the distinctive character of the earlier mark has become enhanced due to the use made of it is the application date – 10 March 2022.

46. The opponent states that for the year ending 31 December 2020 it had an annual turnover of £267m. However, the breakdown of sales for the various goods (see my paragraph 12) shows sales in the tens of thousands rather than millions. The evidence does demonstrate that the goods are sold in multiple nationwide outlets, and the marketing and advertising is widespread. However, the evidence does not support a claim to the earlier mark having an enhanced degree of distinctive character by virtue of the use made of it. The sales are not high enough to support such a claim, particularly when there is no indication of market share which I should imagine to be in the billions of pounds for this sector.

Likelihood of confusion

47. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, i.e., that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.[7] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[8]

48. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. I shall begin by considering a likelihood of direct confusion.

49. I have found the respective goods to be identical. I have also found the respective marks to be aurally and visually similar to a degree above medium but not high, and conceptually similar to a medium degree.

50. I have also found the distinctive character of the earlier mark to have a low to medium degree of inherent distinctive character, which has not been enhanced by virtue of the use made of it. In terms of the average consumer, I concluded that it will primarily be a visual purchase with a medium degree of attention paid.

51. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

[7] See *Canon Kabushiki Kaisha*, paragraph 17.

[8] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

52. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

53. I am mindful that I have found the inherent distinctive character of the earlier mark to be low to medium, but nevertheless, when taking into account imperfect recollection, I consider a consumer being faced with the applied for mark would be mistaken into believing it came from the same or economically linked undertaking as that of the earlier mark.

54. In view of the above, the s.5(2)(b) ground succeeds in full.

Section 5(4)(a)

55. For the sake of completeness, I now turn to the s.5(4)(a) claim. The relevant law states that:

> "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 or 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 4(A) is met…"

Subsection 4(A) is as follows:

> "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."

56. 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).”

57. The relevant date is the filing date of the application, namely 10 March 2022.

Goodwill

58. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine* [1901] AC 217:

> “What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

59. Whilst the opponent’s exhibit CS1 does include pictures of new bottles of conditioner, these are after the relevant date. Further, there is no specific reference in the evidence to skin cleansers. Whilst it could be argued that these goods would be covered by the terms “haircare” and “skincare”, when there are specific references to shampoo, shower gel and hand gels, handwash etc then it is reasonable to conclude that no sales were made for these goods. This is corroborated by there not being any pictures or references to these goods in the evidence.

60. With regard to the remaining goods, I am satisfied that at the relevant date the opponent had goodwill in a business selling, “Toiletries; hair care products; shampoos; conditioners; hairsprays; hand washes; nail varnish removers; skin cleansers; mouth washes for oral hygiene; preparations for the care and

treatment of body, face, skin, nails and hair", and that the sign "ENLIVEN" was distinctive of that goodwill.

61. The test for whether misrepresentation occurs is whether, on the balance of probabilities, a substantial number of the relevant public will be misled into purchasing the other side's goods[9].

62. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

> "… if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

63. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce a different outcome. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

64. As outlined above, whilst the tests for a likelihood of confusion and passing off differ, in this instance the outcome is the same. I am satisfied that the applied for mark and the relied upon sign are sufficiently similar for goods which are also similar.

65. The s.5(4)(a) claim succeeds.

OVERALL CONCLUSION

66. The opposition succeeds in its entirety. The application, subject to appeal, will be refused for all of the applied for goods.

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[9] *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC Morritt L.J.

COSTS

67. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I have detailed a CMC which took place relating to excessive evidence. I am satisfied that there are no cost implications for the extension of time and subsequent reduction in evidence. Therefore, I award costs to the opponent as a contribution towards the cost of the proceedings on the following basis:

Official fee	£200
Preparing a statement of case and considering the other side's counterstatement	£250
Preparing evidence and considering the applicant's evidence; written submissions	£800
TOTAL	**£1250**

68. I, therefore, order Gloryal Ltd to pay DCS Group (UK) Ltd the sum of £1250. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of August 2023

Mark King
For the Registrar,
The Comptroller General