

BL O/0837/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 4053606  
BY MAYO INTERNATIONAL PTY LTD  
FOR THE FOLLOWING TRADE MARK:

**REVITAFOAM**

IN CLASS 3

-AND-

THE OPPOSITION THERETO UNDER No. 449673  
BY MEDITAGO HOLDINGS LLC A DELAWARE LIMITED LIABILITY COMPANY

## **Background and pleadings**

1. On 20 May 2024, Mayo International Pty Ltd (“**the Applicant**”) applied to register the trade mark REVITAFOAM in the UK in respect of the Class 3 goods set out below. The application was accepted and published in the Trade Marks Journal on 14 June 2024.

### **Class 3:**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, cosmetics, hair lotions; products in this class for use in hairdressing salons, namely, hair conditioners, hair foams, and hair moisturisers; all the foregoing being either in the form of a foam or in form capable of producing foam.

2. On 16 September 2024, MediTago Holdings LLC a Delaware limited liability company (“**the Opponent**”), opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”).<sup>1</sup> The opposition is based on its two UK comparable trade marks (EU)<sup>2</sup> detailed below. The Opponent relies on all of the goods for which its marks are registered.

### **Mark 1**

|                                    |                                                                                                                                                                                                                                                                                                                                                                                              |
|------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Representation of the mark:</b> |  The logo for REVITA High-Performance Hair-Growth-Stimulating Shampoo. It features the word "REVITA" in a large, bold, sans-serif font with a crown icon above the letter "V". Below "REVITA" are the words "HIGH-PERFORMANCE" and "HAIR-GROWTH-STIMULATING SHAMPOO" in smaller, bold, sans-serif fonts. |
| <b>Disclaimer:</b>                 | “HIGH-PERFORMANCE HAIR-GROWTH-STIMULATING SHAMPOO”                                                                                                                                                                                                                                                                                                                                           |
| <b>Registration Number:</b>        | 915065212                                                                                                                                                                                                                                                                                                                                                                                    |
| <b>Filing date:</b>                | 30 May 2006                                                                                                                                                                                                                                                                                                                                                                                  |
| <b>Registration date:</b>          | 11 July 2016                                                                                                                                                                                                                                                                                                                                                                                 |

<sup>1</sup> 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.

<sup>2</sup> 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.

|               |                                                                                  |
|---------------|----------------------------------------------------------------------------------|
| <b>Goods:</b> | <u>Class 3:</u> Hair lotion.<br><u>Class 5:</u> Capillary lotions (Medicated -). |
|---------------|----------------------------------------------------------------------------------|

## Mark 2

|                                    |                                                                                    |
|------------------------------------|------------------------------------------------------------------------------------|
| <b>Representation of the mark:</b> |  |
| <b>Disclaimer:</b>                 | "HIGH-PERFORMANCE HAIR-GROWTH-STIMULATING CONDITIONER"                             |
| <b>Registration Number:</b>        | 913856505                                                                          |
| <b>Filing date:</b>                | 20 March 2015                                                                      |
| <b>Registration date:</b>          | 31 August 2015                                                                     |
| <b>Goods:</b>                      | <u>Class 3:</u> Hair lotion.<br><u>Class 5:</u> Capillary lotions (Medicated -).   |

3. The trade marks upon which the Opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As they had been registered for more than five years at the filing date of the contested mark, they are subject to the use conditions pursuant to section 6A of the Act. As they are comparable trade marks (EU), they are additionally subject to the provisions set out in Schedule 2A, Part 1, paragraph 7 of the Act. Accordingly, the Opponent made a statement that it has used its marks in relation to the goods on which it relies.

4. The Opponent claims that the competing marks are similar and that the respective goods are similar or identical, giving rise to a likelihood of confusion.

5. The Applicant filed a defence and counterstatement. It admitted that its applied-for "*hair lotions*" is found identically in the Opponent's specifications. It denied all other claims made. It also requested that the Opponent prove use of the earlier marks in relation to the goods on which the Opponent relies.

6. Following the filing of the defence, the sequential evidence rounds were set, during which the Opponent filed its evidence in chief, which goes to provide proof of use of the earlier mark; it elected not to file any submissions during the evidence rounds. The Applicant did not file any evidence nor did it file any submissions during the evidence

rounds. A hearing was not requested, instead, both parties elected to file final written submissions in lieu of a hearing, both of which were filed on 12 March 2026.

7. In its submissions in lieu, the Opponent resiled its claim in relation to the applied for *“bleaching preparations and other substances for laundry use”*, submitting that upon further review, they are dissimilar.<sup>3</sup> Accordingly, regardless of the outcome of this opposition, these goods will proceed to registration.

8. In its submissions in lieu, in addition to its previously admitted identity between the competing *“hair lotions”*, the Applicant conceded that *“there is, at most, a low degree of similarity”* between the Opponent’s *“hair lotions”* and *“capillary lotions”* and the Applicant’s following goods:<sup>4</sup>

*“products in this class for use in hairdressing salons, namely, hair conditioners, hair foams, and hair moisturisers; all the foregoing being either in the form of a foam or in form capable of producing foam.”*

9. The Applicant maintained that the remainder of its applied for goods are dissimilar to the Opponent’s.<sup>5</sup>

10. In its submissions in lieu, the Applicant also, for the first time, criticised the Opponent’s evidence of use and questioned its reliability. I address that matter further in my decision.

11. I make this decision following a careful consideration of the papers before me.

12. The Opponent is represented by Potter Clarkson LLP and the Applicant is represented by Bates Wells & Braithwaite London LLP.

### **EVIDENCE FILED**

13. The Opponent’s evidence is provided in the witness statement of Fernando Támez Gutierrez, dated 17 September 2025. It includes four exhibits labelled FG01 – FG04 and is accompanied by a signed statement of truth. Mr Gutierrez states he is the Chief Executive Officer of DS Healthcare Group Inc., a position he has held since 2019. He

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<sup>3</sup> Opponent’s submissions in lieu, dated 12 March 2026, paragraph 31.

<sup>4</sup> Applicant’s submissions in lieu, filed 12 March 2026, paragraph 47.

<sup>5</sup> Ibid., paragraph 46.

states that his company uses the earlier marks under exclusive licence from the Opponent. The purpose of his evidence is to show genuine use of the marks by his company during the relevant period.

14. Mr Gutierrez confirms that:

“The statements contained in this witness statement are made from my own knowledge, from records to which I have free and full access or from enquiries and research I have made, or from information shown to me by the Opponent's legal representatives. I am authorised to make this statement on behalf of the Opponent.”

## **DECISION**

### **PROOF OF USE**

#### **Approach**

15. Where an earlier mark has been registered for five years or more at the relevant date, it may only be relied on if it has been put to genuine use. I therefore begin by assessing the evidence for proof of use.

16. Whilst both earlier marks contain the word REVITA, Mark 2 contains the additional word element ‘.COR’, which serves only to increase the differences between the competing marks. Given that the specifications of the two earlier marks are identical, Mark 1 represents the Opponent's strongest case. I shall therefore assess whether the evidence establishes genuine use of Mark 1 and, if so, proceed with the opposition on that basis.

#### **Proof of use legislation**

17. The relevant provisions of the Act are as follows:

##### **Section 6A**

#### **Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where—

(a) an application for registration of a trade mark has been published,

- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
    - (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
  - (1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
  - (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
  - (3) The use conditions are met if—
    - (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
    - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
  - (4) For these purposes—
    - (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
    - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- [...]
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

**Raising of relative grounds in opposition proceedings in case of non-use**

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

Section 100<sup>6</sup>

**Burden of proving use of trade mark**

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.”

**Proof of use case law**

18. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*<sup>7</sup> as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] in a considerable number of cases, the principal decisions being

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<sup>6</sup> Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark. In this regard see *Ferrari SpA v DU*, C–721/18, at paragraphs 73 to 83.

<sup>7</sup> [2023] EWCA Civ 1247.

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 Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno 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. [...] the principles may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional

items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

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

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

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

19. In *Walton International*,<sup>8</sup> Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight

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<sup>8</sup> *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

principles he subsequently set out in *easyGroup Ltd*, detailed above),<sup>9</sup> added the further three principles when assessing genuine use in the EU:

“118. *The law with respect to genuine use in the Union*. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark “in the Union”. In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].”

20. The genuine use provision is not there to assess economic success or large-scale commercial use.<sup>10</sup> An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>11</sup>

### **The relevant dates**

21. The relevant five-year period for proof of use, ending on the filing date of the contested application, is **21 May 2019 to 20 May 2024**. As Mark 1 is a comparable

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<sup>9</sup> Ibid., paragraphs 114 and 115.

<sup>10</sup> *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

<sup>11</sup> *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

mark (EU), and part of the relevant five-year period falls before IP Completion Day, EU use (including use in the UK) remains relevant up to IP Completion Day, i.e. 31 December 2020. From 1 January 2021, any use must relate solely to the UK. Accordingly, **EU use is relevant from 21 May 2019 to 31 December 2020**, and use from **1 January 2021 to 20 May 2024 must relate solely to the UK**.

### **Opponent's evidence**

22. Mr Gutierrez's narrative evidence is that his company, DS Healthcare Group Inc., of which he has been CEO since 2019 *"manufactures, sells and distributes haircare, skincare, and cosmetic products (the "Products") out of its South Florida headquarters, under exclusive license from [the] Opponent to commercialize the Opponent's trade marks throughout various territories around the globe, including the UK,"*<sup>12</sup> and that he understands that the Opponent has been requested to provide proof of use of the earlier trade marks relied on.<sup>13</sup>

23. As regards sales during the relevant period, he states:

"I confirm that for the years 2020-2024, sales of goods branded with the REVITA trade mark have been approximately \$500,000 per annum."

24. He states that his company *"has a UK website, dslaboratories.uk, for directly selling and promoting REVITA branded goods to UK consumers. This domain was first registered in 2019 ... [and] recently [his company has] transitioned to using its Amazon store, as its primary sales outlet in the UK."*<sup>14</sup>

25. Extracts from the internet archive site WayBack Machine are in evidence. They consist of webpages from the 'dslaboratories.uk' website dated within the relevant period, from the years 2020-2024. The archive webpages include images and information relating to shampoos, conditioners and hair styling gels to prevent and treat hair loss. These hair products are formulated with specific active ingredients to fortify hair, support and stimulate hair growth and combat hair thinning. The products are marketed as innovative hair care products, recommended by dermatologists, said to have been clinically proven following extensive studies and testing, and suitable for

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<sup>12</sup> Witness statement, paragraph 3.

<sup>13</sup> Witness statement, paragraph 4.

<sup>14</sup> Witness statement, paragraphs 6 and 9.

use by hair transplant patients post procedure, to stimulate hair growth; and for use by people suffering from pattern baldness. They are marketed as having an “*Advanced Nonosome Delivery System*” which “*encapsulates key active ingredients and delivers them to the scalp and skin for a prolonged release and higher efficacy*”.<sup>15</sup>

26. The UK website evidence features the following products and the prices are listed in pounds sterling:

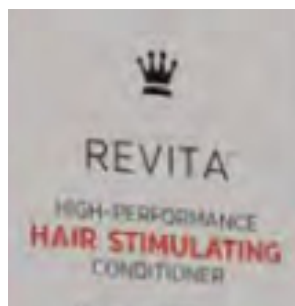
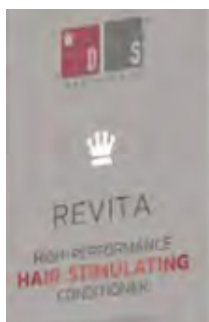
- REVITA.CBD High-Performance Hair Stimulating Shampoo  
(a product which contains CBD as an active ingredient)



- REVITA High-Performance Hair Stimulating Shampoo



- REVITA High-Performance Hair Stimulating Conditioner



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<sup>15</sup> See for example page 20 and 28 of Exhibit FG01.

- REVITA High Performance Hair DENSITY Conditioner<sup>16</sup>



- REVITA High-Performance Styling Gel



27. The website states this in relation to the “REVITA High Performance Hair Stimulating Conditioner”:<sup>17</sup>

# REVITA

## HIGH PERFORMANCE HAIR STIMULATING CONDITIONER

**293 sold**  
in last 17 hours

**205 mL / 7 FL OZ**

Revita® Conditioner delivers state-of-the-art hair growth technology that builds on the legendary success of Revita Shampoo. This conditioner establishes a new benchmark for the comprehensive synthesis of hair stimulating compounds. Unlike conventional conditioners, Revita Conditioner contains powerful ingredients known to stimulate the scalp and promote hair growth. This conditioner was formulated to work synergically with Revita Shampoo.

<sup>16</sup> Exhibit FG01, page 47, dated 1 March 2024. The product image however is undated, and is shown on page 53 of the same exhibit.

<sup>17</sup> Exhibit FG01, page 24.

28. The website pages highlight that their products “have over 10,000 5-star reviews”.<sup>18</sup> In particular I note that the “REVITA High Performance Hair Stimulating Conditioner” had gained a 4.7 out of 5 star rating based on 2,806 verified buyer reviews;<sup>19</sup> and the “REVITA High Performance Hair Stimulating Shampoo” gained a 4.6 out of 5 star rating based on 3,430 verified buyer reviews.<sup>20</sup>

29. Mr Gutierrez states that *“on numerous of the archived [website] extracts it can be seen that these particular products were selling well, as indicated by a flame symbol and the number of products in the given number of hours”*. The top right-hand corner of the image reproduced at paragraph 27 is an example of what Mr Gutierrez is describing.

30. Extracts from the UK Amazon store of ‘DS Laboratories’ are in evidence.<sup>21</sup> Mr Gutierrez states that these *“current extracts also reflect that my company has recently transitioned to using its Amazon store, as its primary sales outlet in the UK. Whilst the goods are listed as out of stock on our website, customers are redirected to our Amazon Store, where the goods are available with next day delivery.”* He goes on to state that *“the availability of the branded goods in the UK, extends beyond my company’s website and its Amazon store. The branded goods have been retailed by many 3<sup>rd</sup> parties over the years. Included as Exhibit FG03 are archived extracts from some 3<sup>rd</sup> party retailer websites.”*

31. Whilst the extracts from the UK third party retailers “hairgivers” and “PharmacyClub” are undated, they nonetheless contain customer reviews which are dated within the relevant period. These two website extracts feature “Revita hair growth shampoo”; marketed as *“one of the most known and effective shampoos to stimulate hair growth and reduce hair loss”*; the pharmacy website markets the shampoo as a *“hair loss treatment”*.<sup>22</sup>

32. Mr Gutierrez states that *“My company’s products have been reviewed by some of the most globally recognised publications including Forbes, Marie Claire, Cosmopolitan and the Telegraph. [...] enclosed as Exhibit FG04 are [...] extracts of*

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<sup>18</sup> See for example FG01 page 26.

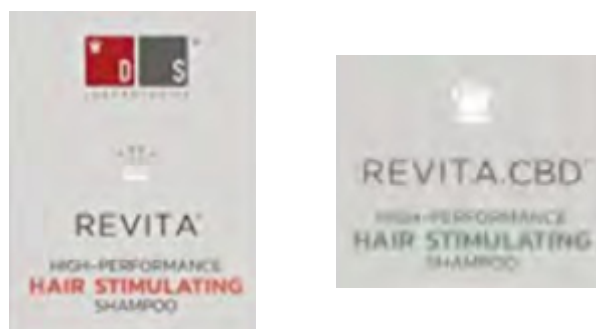
<sup>19</sup> Exhibit FG01, pages 43-44.

<sup>20</sup> Exhibit FG01, pages 106-107.

<sup>21</sup> Exhibit FG02.

<sup>22</sup> Exhibit FG03, page 177.

*the Telegraph and Marie Claire Articles.*” The Telegraph article is dated before the relevant period. The Marie Claire article is titled “*The 25 Best Hair Growth Shampoos of 2022, According to Experts*” and features “*Revita Shampoo For Thinning Hair by DS Laboratories*” (product label image below on the left) and “*Revita.CBD Super Antioxidant Hair Stimulating CBD Shampoo*” (product label image below on the right):



33. I have set out the various signs used at paragraph 26 of this decision. For ease of reference, a representative example of such use is reproduced below on the right; and an image of Mark 1 as registered is shown below on the left.



34. The purpose of the statutory provision on ‘variant form’ under section 46(2) of the Act is to avoid imposing strict conformity between the form in which the trade mark is used and the form in which it was registered. Where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the provision envisages that the obligation to use the registered trade mark may be fulfilled by furnishing proof of use of the sign in the form in which it is used in trade.<sup>23</sup>

35. I bear in mind the Applicant’s submissions that the signs shown in the evidence are not acceptable variants of the earlier registrations. It points out that the disclaimed

<sup>23</sup> See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

wording in the earlier registrations does not match the product descriptor wording shown in the evidence; the fonts used differ; and the size, placement and colour of the crown device differ.<sup>24</sup>

36. However, where a mark is composed of a number of elements and one or more of them is not distinctive, the alteration or omission of those elements does not alter the distinctive character of the trade mark as a whole.<sup>25</sup> The differences identified by the Applicant do not alter the distinctive character of Mark 1, which resides principally in the dominant word REVITA. The disclaimed wording does not form part of the protection conferred by the registration and is, in any event, descriptive and non-distinctive. The differences in that wording and in the font are therefore immaterial, as are the differences in the crown device,<sup>26</sup> which is a small decorative element and remains subordinate to the word REVITA. The addition of the descriptive element “.CBD” is similarly immaterial. Furthermore, although the REVITA sign is used in conjunction with the ‘DS Laboratories’ brand, it continues to denote trade origin.<sup>27</sup> The various forms of use shown are therefore acceptable variants of Mark 1 as registered.

37. Earlier I noted that in its submissions in lieu, the Applicant, for the first time, criticised the Opponent’s evidence of use and questioned its reliability. Those criticisms and challenges are summarised by the Applicant as follows:

“29. The party providing the Witness Statement, and which is using the REVITA marks, has not provided evidence that it is doing so with the consent of the owner of the registered rights upon which the Opposition is based.

30. None of the marks that are presented within Exhibits FG01, FG02, FG03 and FG04 are sufficiently close to the marks as registered that they support their registration, and/or show genuine use of the Registered Marks.

31. In addition, for the reasons outlined above, the goods upon which these marks are being used do not fall within the scope of the registered rights.

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<sup>24</sup> See the table included in paragraph 28 of the Applicant’s submissions in lieu.

<sup>25</sup> *Hyphen GmbH v EUIPO*, Case T-146/15, at [30]. Also see by way of analogy, ‘NUDE’ trade mark, BL O/1155/25, at [46]-[49].

<sup>26</sup> Bearing in mind that Mark 1 is registered in black and white, therefore the fact that it appears in silver in some examples of use is immaterial, since registration of a mark in black and white covers its use in colour. See *Specsavers* [2014] EWCA Civ 1294 at [5]; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at [47].

<sup>27</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, at [32] and [35].

32. Overall, we submit that the Opponent has not provided evidence of its use of the marks within the relevant period and the Opposition should therefore be rejected in its entirety.”

38. Mr Gutierrez’s narrative evidence is that: his company, DS Healthcare Group Inc., uses the earlier marks under an exclusive licence for the purpose of commercialising the Opponent’s trade marks in various territories, including the UK; and that for the years 2020-2024, sales of goods branded with the REVITA trade mark were approximately \$500,000 per annum. The Applicant questions whether the use was with the Opponent’s consent because the licence has not been exhibited;<sup>28</sup> and notes that the sales figures are not substantiated in documentary evidence, submitting that *“in the absence of any supporting evidence it is difficult to take [the sales figures] seriously”*.<sup>29</sup>

39. However, the Applicant did not challenge the truthfulness or reliability of this evidence during the evidence rounds, nor did it request cross-examination.<sup>30</sup> Had the Applicant raised these matters during the evidence rounds, the Opponent would have had an opportunity to address them.<sup>31</sup> Consequently, it is not now appropriate for the Applicant to raise such challenges for the first time in its submissions in lieu and invite me to disregard this evidence. I have no reason to disbelieve Mr Gutierrez merely because the licence and documentary support for the approximate sales figures have not been exhibited, particularly bearing in mind that Mr Gutierrez’s statement is signed with a statement of truth and given his confirmation that he has access to his company’s records and that his evidence is based on those records.<sup>32</sup> Mr Gutierrez

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<sup>28</sup> Applicant’s submissions in lieu, paragraphs 10, 11, 13 and 15.

<sup>29</sup> Applicant’s submissions in lieu, paragraphs 16 – 18.

<sup>30</sup> In *TUI UK Ltd v Griffiths* [2023] UKSC 48, the Supreme Court reaffirmed the general rule of evidence that, if a party wishes to challenge a witness’s evidence on a material point, fairness generally requires that the challenge be put to the witness rather than first appearing in final submissions. This is because a witness should have an opportunity to explain or clarify the evidence being challenged. At [42] the Court reaffirmed the established rule of evidence set out in *Phipson on Evidence* 20<sup>th</sup> ed (2022), namely that if a party has decided not to challenge the evidence when presented with the opportunity, it *“will be in difficulty in submitting that the evidence should be rejected”*.

<sup>31</sup> The Applicant was notified in the Registry’s official letter dated 14 December 2025: “If you reserve specific criticisms of the other party’s evidence until final written submissions or at the hearing, and the hearing officer considers that this will cause unfairness to the other side, your submissions may be given reduced or no weight, or the proceedings may be delayed with consequences for costs.”

<sup>32</sup> As Mr Arnold pointed out in paragraph 31 of his decision in *Extreme TM* [2008] RPC 2, “A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not [...] constitute bare assertion.”

gave his evidence as CEO of the licensee company and was in a position to have first-hand knowledge of the facts given in his statement.

40. Furthermore, his statement is consistent with the exhibited documents, and whilst the exhibits do not include sales invoices, they nevertheless demonstrate that sales took place, for example, by showing the number of products sold within a given number of hours and through the thousands of customer reviews from UK-based “verified buyers” of the REVITA products. Whilst I have no evidence on market share, I nonetheless consider that the sales figures provided are not insignificant amounts.

41. Taking the evidence into account, it seems to me that there has plainly been genuine use of Mark 1 in relation to products for the hair and that the use demonstrated was use with the Opponent’s consent.

42. As regards the goods for which use must be shown, the Applicant submits that the evidence, which it characterises as showing use in relation to shampoos and conditioners, is not evidence of use for the goods covered by the registrations. It submits that (my emphasis for clarity):

“23. [...] The terms ‘hair lotion’ and ‘capillary lotion’ are **broad**. The term ‘hair lotion’ generally refers to a type of hair care product in a lotion form that is used to stimulate hair growth. It is not a common term use by consumers when referring to hair products such as shampoos and conditioners, or even styling products.

24. It is **not clear** that a shampoo or conditioner, or hair styling product, would fall within the definition and scope of the goods in either class 3 or class 5 of these registrations.”

43. Consequently, it submits that “hair lotion” and “capillary lotion” should be given their ordinary English meaning and, on that basis, do not naturally describe shampoos, conditioners or styling products. It further submits that “capillary lotion” in Class 5 denotes a medicated product for promoting hair growth, whereas the goods shown in the evidence are not presented as medicated.

44. The Applicant’s challenge was reserved until final submissions. If the Applicant’s case was that shampoos and conditioners cannot fall within the scope of the registered

terms, that point should have been raised during the evidence rounds, so that the Opponent had an opportunity to respond and, if necessary, file evidence addressing it. In any event, the submission is put cautiously: the Applicant acknowledges that “hair lotion” and “capillary lotion” are “*broad*” and says that it is “*not clear*” whether shampoos and conditioners fall within the scope of the registered terms.

45. The proof of use requirement does not require a proprietor to prove use in relation to all possible variations of the goods covered by the registration.<sup>33</sup> It is enough to show use in relation to goods which are sufficiently distinct to constitute coherent categories or subcategories of the goods covered by the registration. While specifications must be given their ordinary meaning, I do not consider that the evidence should be treated as incapable of showing use for the registered goods simply because the goods are described in the evidence as shampoos and conditioners, particularly where the registered terms are broad and capable of encompassing a range of products.

46. In considering the ordinary meaning of “hair lotion”, I have regard to the Collins English Dictionary definition of “lotion” as “a liquid that you use to clean, improve, or protect your skin or hair”.<sup>34</sup>

47. Although the evidence shows use in relation to shampoos and conditioners, the goods are not presented as ordinary cleansing or conditioning products. Rather, they are presented throughout as hair-stimulating and hair-loss treatment products containing active ingredients directed at promoting hair growth and scalp health, with compounds and delivery systems intended to provide prolonged release of those active ingredients to the scalp. Their purpose therefore extends beyond the mere cleansing or conditioning functions typically associated with conventional shampoos and conditioners. In substance, the defining purpose of the goods is the treatment of the hair and scalp; “shampoo” and “conditioner” identify the form in which that treatment is supplied and applied. I am fortified in that conclusion by the fact that

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<sup>33</sup> As explained by Carr J in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47(vi)], applying the principles set out in *Maier v ASOS Plc* [2015] EWCA Civ 220 at [56] and [60], a principle later affirmed in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 at [247].

<sup>34</sup> See the definition of “lotion” in the online version of Collins English Dictionary, current as at the date of this decision.

‘PharmacyClub’, a third-party retailer, identifies the shampoo as a “*hair loss treatment*”.

48. In conclusion, having regard to the nature, purpose and intended use of the goods shown in the evidence, I am satisfied that the use shown falls within the scope of “*hair lotion*” in Class 3 on the basis that I consider the goods to constitute a coherent and independently viewable sub-category of “hair lotions”.

49. Taking all the foregoing into account, I consider that the evidence supports genuine use of Mark 1 for the following fair specification, on which the Opponent may rely:<sup>35</sup>

### Class 3

“hair treatment lotions in the form of shampoos and conditioners”

50. I consider the above fair specification adequately limits the specification to reflect the proven use, while still covering goods that are essentially the same, striking a balance between avoiding unjustifiably broad protection and ensuring closely related goods are not excluded.

51. As for “*capillary lotions (medicated -)*” in Class 5, this denotes a medicated product. Although the evidence refers to products suitable for, or directed at, hair-loss concerns and scalp treatment, including use by those who have undergone a medical hair transplant, the goods are not clearly presented or marketed as medicated products. I therefore do not consider it necessary to make a broader finding under Class 5, given my finding that the use supports the Class 3 fair specification identified above.

52. For the reasons given above, genuine use has been established for Mark 1, limited to the above fair specification. I therefore proceed on this basis.

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<sup>35</sup> In making that assessment, I have regard to the principles laid down by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, at [245] to [249], per Kitchin LJ (as he then was). That approach was subsequently approved by the Supreme Court in *SkyKick UK Ltd v Sky Ltd* [2024] UKSC 36. At [261], Lord Kitchin (as he had by then become) explained that the approach he had set out in *Merck* must be read in light of later CJEU authority, which establishes that the essential criterion for identifying a coherent and independently viewable sub-category of goods or services is their purpose and intended use (see, for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at [36]–[53]). Also see related case law in relation to ‘fair specification’: *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10; *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47].

## **CLAIM UNDER SECTION 5(2)(b)**

### **Legislation and Case Law**

53. Section 5(2)(b) of the Act states:

“5(2) 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”.

54. I am guided by the principles applicable to the assessment of the likelihood of confusion, as cited with approval by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25. These 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 Office for Harmonisation in the Internal Market (“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:

(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 greater 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**

55. In *Gérard Meric v OHIM*,<sup>36</sup> (“*Meric*”), the General Court held to the effect that 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 and vice versa.

56. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. According to the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,<sup>37</sup> and the guidance from Jacob J. (as he then was) in the *Treat* case,<sup>38</sup> those factors include, *inter alia*:

- (1) the physical nature of the goods;
  - (2) their intended purpose;
  - (3) their method of use;
  - (4) who the users of the goods are;
  - (5) the trade channels through which the goods reach the market;
  - (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
  - (7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
- or
- (8) whether they are complementary to each other.

57. Complementary means that “*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*”.<sup>39</sup> Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,<sup>40</sup> and it can be clearly distinguished from ‘use in combination’ – the latter being where goods are merely used together, whether by

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<sup>36</sup> Case T- 133/05

<sup>37</sup> Case C-39/97, paragraph 23.

<sup>38</sup> *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case.

<sup>39</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

<sup>40</sup> *Kurt Hesse v OHIM*, Case C-50/15 P

choice or convenience (e.g. wine and wine glasses<sup>41</sup>), this means that they are not essential for each other.

58. When interpreting the terms in a specification I bear in mind:

- (a) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”, although “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 [and services] in question”,*<sup>42</sup>
- (b) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], 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 and services”,*<sup>43</sup>
- (c) the following applicable principles of interpretation:
  - “(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*
  - (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*
  - (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*
  - (4) A term which cannot be interpreted is to be disregarded.”*<sup>44</sup>

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<sup>41</sup> As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/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.”*

<sup>42</sup> *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

<sup>43</sup> *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

<sup>44</sup> See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

59. I have already made a finding that the Applicant's "*bleaching preparations and other substances for laundry use*" can proceed to registration. Therefore the remainder of the contested goods are set out in the table below, alongside the Opponent's fair specification:

| Opponent's fair specification                                                          | Applicant's goods                                                                                                                                                                                                                                                                                                                                |
|----------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <u>Class 3</u><br><br>Hair treatment lotions in the form of shampoos and conditioners. | <u>Class 3</u><br><br>Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, cosmetics, hair lotions; products in this class for use in hairdressing salons, namely, hair conditioners, hair foams, and hair moisturisers; <i>all the foregoing being either in the form of a foam or in form capable of producing foam.</i> |

Cleaning, polishing, scouring and abrasive preparations; *all the foregoing being either in the form of a foam or in form capable of producing foam.*

60. The above are cleaning products intended for the removal of dirt, stains and other unwanted matter from surfaces. They are not items for personal care. I consider them analogous to "*bleaching preparations and other substances for laundry use*", in relation to which the Opponent no longer pursues a claim of similarity. I therefore find them dissimilar to the Opponent's goods.

Soaps; *all the foregoing being either in the form of a foam or in form capable of producing foam.*

61. On account of the limitation, these goods are foaming liquid soaps rather than solid soaps. Although a hair treatment lotion in the form of a shampoo will have cleansing properties, it is not equivalent to soap, even in liquid form. Soap is primarily a cleansing product, whereas the Opponent's goods are hair treatment products. The goods therefore differ in nature, purpose and intended use. However, there is likely to be

some overlap in users and trade channels, as manufacturers of soaps may also produce hair treatment lotions in the form of shampoos. I therefore find the goods similar to a low degree.

Perfumery, cosmetics; *all the foregoing being either in the form of a foam or in form capable of producing foam.*

62. Perfumery and cosmetics are personal care products, but they are not hair treatment products. Perfumery is intended to fragrance the body, while cosmetics are generally intended to beautify. The goods therefore differ in nature, purpose and method of use from the Opponent's hair treatment products. However, there is likely to be some overlap in users and trade channels, as manufacturers of perfumery and cosmetics may also produce other personal care products such as hair treatment lotions. I therefore find the goods similar to a low degree.

Hair lotions; *all the foregoing being either in the form of a foam or in form capable of producing foam.*

63. Although the Opponent's reliance on its registered term "*hair lotion*" has been limited to the fair specification identified above, the goods covered by that fair specification remain encompassed by the broader registered term "*hair lotion*". I therefore continue to proceed on the basis of the Applicant's concession that there is identity between the respective goods.

Products in this class for use in hairdressing salons, namely, hair conditioners, hair foams, and hair moisturisers; *all the foregoing being either in the form of a foam or in form capable of producing foam.*

64. The Applicant conceded that the above goods are similar to the Opponent's "*hair lotion*" to, at most, a low degree. As the Opponent's fair specification remains within the scope of that broader term, the concession is unaffected. I therefore proceed on the basis of that concession, namely that the respective goods are similar to a low degree.

65. Since some similarity between the goods is required for the purposes of a section 5(2)(b) claim, the opposition must fail in respect of the goods I have found to be dissimilar.<sup>45</sup> Accordingly, the goods listed below will proceed to registration.

### Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; all the foregoing being either in the form of a foam or in form capable of producing foam.

66. I will therefore proceed to consider a likelihood of confusion only in relation to the identical and similar goods identified above.

### **The average consumer and the nature of the purchasing process**

67. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. 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, at [15]-[20], where he pointed out the following in relation to the average consumer:

- (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

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<sup>45</sup> See *Waterford Wedgwood plc v OHIM* – C-398/07 P (case of the CJEU); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

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.

68. The average consumer of the relevant goods will be a member of the general public. Although the goods will vary in price, they are, for the most part, likely to be relatively inexpensive and purchased on a regular basis. They will typically be selected visually in retail outlets, catalogues and online. While I do not discount the possibility of oral selection by requests to staff, consumers are still likely to have viewed the goods before purchase. The selection process will therefore be predominantly visual.

69. The purchasing process for the goods is likely to be more casual than careful and will not involve an overly considered thought process. Overall, the average consumer will not typically demonstrate more than a medium level of attention when selecting the goods.

### **Comparison of marks**

70. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*,<sup>46</sup> that:

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<sup>46</sup> Case C-591/12P, at paragraph 34.

“[...] 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.”

71. It would be wrong, therefore, to dissect the trade marks artificially, 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.

72. The marks being compared are shown below.

| Opponent's Mark 1                                                                   | Applicant's mark |
|-------------------------------------------------------------------------------------|------------------|
|  | REVITAFOAM       |

#### Overall impression

73. The Opponent's mark is a figurative mark registered in black and white. It consists of the word REVITA, presented in a large stylised font, together with a small crown device above the letter 'V' and the wording 'HIGH-PERFORMANCE HAIR-GROWTH-STIMULATING SHAMPOO' (which has been disclaimed) positioned below REVITA in a smaller, capitalised font.

74. In accordance with Tribunal Practice Notice ("TPN") 1/2020, whilst I am required to take disclaimed elements into account in assessing the likelihood of confusion under section 5 of the Act, the TPN makes clear that *"elements of trade marks which are in fact descriptive and/or non-distinctive will continue to be given less weight than distinctive features in assessments made under section 5 of the Act."* As I have already found, that wording is descriptive and non-distinctive in relation to the goods. The

average consumer is therefore unlikely to attribute any trade mark significance to it. Its smaller and less prominent position below REVITA also means that it is likely to attract less attention. It consequently carries little weight in the overall impression of the mark.

75. The crown device plays only a minor decorative role such that it too carries less weight in the overall impression of the mark.

76. The word REVITA is the largest and most prominent element of the mark. It has no apparent descriptive meaning in relation to the goods and is therefore both a distinctive and dominant element, such that the overall impression of the mark is dominated by that word.

77. The Applicant's mark is a word-only mark, comprising the joined elements REVITA and FOAM. As regards the ordinary word FOAM, it is likely to be perceived as describing the form of the goods i.e. that they are in the form of a 'foam'. As such the average consumer may attribute no trade mark significance to the word FOAM and it will therefore attract less attention than the initial element REVITA, and will play little or no part in the overall impression conveyed by the mark.

#### Visual comparison

78. Both marks have the word REVITA in common. The Applicant's mark is a word mark and its fair and notional use is not limited to any particular font or presentation. The fact that REVITA appears in a stylised font in the Opponent's mark is therefore not a point of notable visual distinction in the comparison of the shared REVITA element. These competing elements are therefore visually highly similar.

79. The crown device and the wording HIGH-PERFORMANCE HAIR-GROWTH-STIMULATING SHAMPOO in the Opponent's mark represent points of visual difference. However, bearing in mind the limited weight those elements have in the overall impression of the mark, those differences have limited significance.

80. The additional element FOAM in the Applicant's mark is also a point of visual difference, but it appears at the end of the mark and has a descriptive nature.

81. Bearing in mind that the marks coincide in the distinctive and dominant word REVITA, which appears at the beginning of the Applicant's mark,<sup>47</sup> and dominates the Opponent's mark, I consider them visually similar overall to a medium to high degree.

#### Aural comparison

82. REVITA in both marks will be pronounced identically. I do not consider that the addition of FOAM in the Applicant's mark alters the pronunciation of REVITA, as the average consumer is likely to perceive the natural break in REVITAFOAM and pronounce it as two separate words, namely, REVITA-FOAM.

83. I bear in mind that secondary (or even descriptive) elements in a mark may not always be spoken by the average consumer. This is because in everyday life people often say things in a simplified or shortened form (even though they may be aware of the entire mark).<sup>48</sup> Given the limited weight played by HIGH-PERFORMANCE HAIR-GROWTH-STIMULATING SHAMPOO and FOAM in the overall impressions of the marks, I do not rule out the possibility that a proportion of average consumers may simply shorten both marks to REVITA. In those circumstances, the marks would be aurally identical.

84. That said, even though the word FOAM carries limited weight in the overall impression of the Applicant's mark, I do not discount that a proportion of average consumers will still verbalise that word. However, I think it less likely that the average consumer will verbalise the entirety of the wording HIGH-PERFORMANCE HAIR-GROWTH-STIMULATING SHAMPOO; they may simply shorten it to SHAMPOO or HAIR-GROWTH SHAMPOO for example. In either case, those elements represent points of aural difference. However, given the limited weight those descriptive elements play in the overall impressions of the competing marks, and bearing in mind that REVITA will be pronounced first when the marks are verbalised with the additional wording, I consider that the marks are aurally similar to a medium degree, even in those circumstances.

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<sup>47</sup> Taking into account the general rule of thumb that the beginnings of marks tend to make a stronger impression on consumers – see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81.

<sup>48</sup> See the decision of the Appointed Person in *ENRICH LEARNING*, BL O/1141/25, [16] – [18].

### Conceptual comparison

85. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>49</sup> I do not consider either mark conveys an immediately discernible concept in respect of the word REVITA, which appears to be an invented word.

86. The other elements which make up the respective marks represent points of conceptual difference. However, given their descriptive, decorative or otherwise limited role in the overall impressions of the marks, those differences have limited weight.

### Distinctive character of the earlier trade mark

87. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be.<sup>50</sup>

88. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>51</sup> 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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

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<sup>49</sup> This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

<sup>50</sup> *Sabel v Puma*.

<sup>51</sup> Case C-342/97.

contain an element descriptive of the goods or services for which it has been registered; [...].”

89. Whilst distinctiveness is assessed by reference to the mark as a whole, simply stating the overall level of distinctiveness of the earlier mark is not sufficient, it is the distinctive character of the component or components that are similar between the marks that is of particular relevance. In this regard, the Appointed Person in *Kurt Geiger v A-List Corporate Limited*<sup>52</sup> stated:

“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.

40. To take a simple example, a device mark for the word ‘SOAP’ presented with each letter intertwined with barbed wire would have considerable distinctive character even if registered for soap. However, this distinctiveness is provided entirely by the barbed wire element in the device, not by the word SOAP which is entirely descriptive. The high distinctive character of the device would not therefore increase the likelihood of confusion in the event of someone else using the word SOAP in a trade mark for soap but presenting the letters in the form of a fish.”

90. In other words, it is necessary to determine in what the distinctive character of the earlier mark lies, so that the analysis can focus on those components that are common to, or similar between, the marks at issue. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

91. Registered trade marks possess varying degrees of inherent distinctive character, ranging from low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words.

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<sup>52</sup> BL O-075-13

92. For the reasons already stated, it is the distinctiveness of the word REVITA which is particularly relevant, since it is that word which the competing marks have in common, and it is the dominant element of the earlier mark.

93. The average consumer will perceive REVITA as an invented word with no clear or allusive meaning in relation to the goods. It therefore possesses a high degree of inherent distinctive character, which arises from the word itself rather than its stylisation.

94. Although the distinctive character of a mark can be enhanced by virtue of the use that has been made of it, and the Opponent has filed evidence of use, I do not consider it necessary to evaluate the evidence for enhanced distinctiveness since I have already assessed the inherent distinctiveness of the word REVITA as high.

### **Conclusions on Likelihood of Confusion**

95. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>53</sup> I must also consider the average consumer of the goods, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.<sup>54</sup>

96. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.<sup>55</sup> The relative weight of the factors is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.<sup>56</sup>

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<sup>53</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

<sup>54</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

<sup>55</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

<sup>56</sup> See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

97. It is well established that direct confusion arises where the consumer mistakes one mark for the other; whereas indirect confusion arises where the consumer recognises that the marks are different, but because of their similarities, believes that the goods or services bearing the later mark come from the same undertaking, or from an economically linked undertaking.<sup>57</sup> For example, the consumer concludes that the later mark is another brand of the owner of the earlier mark because the marks share a common element.<sup>58</sup> In *L.A. Sugar Limited v By Back Beat Inc*,<sup>59</sup> Mr Iain Purvis Q.C., as the Appointed Person, explained that instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:<sup>60</sup>

- “(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).”

98. I summarise my findings as follows:

- (1) the relevant goods remaining under consideration are either identical or similar to the Opponent’s fair specification;

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<sup>57</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

<sup>58</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion. In *Liverpool Gin Distillery* Arnold LJ approved Mr Purvis’s formulation but added at [12] that it is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

<sup>59</sup> *Ibid.*

<sup>60</sup> In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added at [12] that it is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

- (2) the average consumer is a member of the general public who will predominantly select the goods visually, paying a medium degree of attention during the selection process;
- (3) the overall impression of both marks is dominated by the word REVITA which is the component the competing marks have in common;
- (4) comparing the common component in the marks, I have found that it is visually highly similar; aurally the common component is identical; and it has no discernible concept;
- (5) overall the marks are visually similar to a medium to high degree;
- (6) if the respective marks are pronounced in a shortened form such that only REVITA is verbalised, they are aurally identical; in circumstances where the other word elements are verbalised then they are aurally similar overall to a medium degree;
- (7) the non-coinciding elements represent points of conceptual difference, however those differences carry limited weight;
- (8) in assessing the distinctive character of the earlier mark I have found that REVITA is inherently distinctive to a high degree.

99. I bear in mind that although both marks contain other elements, their overall impressions are dominated by REVITA. That is the highly distinctive element common to both marks. The remaining elements are either descriptive or decorative and play only a lesser role.

100. Taking account of all the relevant factors, I find that the average consumer will simply mistake one mark for the other, and will therefore be directly confused as to the origin of the goods as a result.

101. Alternatively, even if the average consumer recognises the differences between the marks, they would still be indirectly confused. They are likely to recognise the common REVITA element and regard the word FOAM and the wording HIGH-PERFORMANCE HAIR-GROWTH-STIMULATING SHAMPOO as identifying a different line or range of REVITA goods, with the crown device seen as a decorative

marketing choice. The differences would therefore be attributed to sub-branding or range segmentation rather than to different undertakings.

### **OUTCOME**

102. The opposition under section 5(2)(b) of the Act is partially successful. Subject to any appeal, contested trade mark application number 4053606 shall:

- (1) be **refused registration** in respect of the following goods:

#### **Class 3**

Soaps; perfumery, cosmetics, hair lotions; products in this class for use in hairdressing salons, namely, hair conditioners, hair foams, and hair moisturisers; all the foregoing being either in the form of a foam or in form capable of producing foam.

- (2) **proceed to registration** in respect of the following goods:

#### **Class 3**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; all the foregoing being either in the form of a foam or in form capable of producing foam.

### **COSTS**

103. As both parties have been partially successful, I order that each party bear its own costs.

**Dated this 16<sup>th</sup> day of September 2026**

**Daniela Ferrari**  
**For the Registrar**