

O/0851/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004219081

IN THE NAME OF JIANG LI

TO REGISTER THE FOLLOWING TRADE MARK:

CHARM ELEPHANT

IN CLASSES 3 & 21

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000456359

BY LA BROSSE & DUPONT MAISON

Background and pleadings

1. On 15 June 2025, JIANG LI (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 04 July 2025 in respect of the following goods:

Class 3: Soap; Soaps; Bars of soap; Bar soap; Loofah soaps.

Class 21: Loofahs; Scrub sponges; Scouring pads; Household scouring pads; Scrubbing pads; Abrasive pads for kitchen purposes; Household utensils; Household or kitchen utensils; Bottle cleaning brushes; Bath sponges; Abrasive sponges for scrubbing the skin; Skin cleansing brushes; Foot exfoliating pads; Cleaning sponges; Abrasive sponges for kitchen [cleaning] use; Brushes for cleaning.

2. On 29 August 2025, LA BROSSE & DUPONT MAISON (“the Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all goods in the application. The Opponent relies upon the following mark:

ELEPHANT

UK Registration no. UK00910859767

Filing date: 04 May 2012

Date of registration: 28 September 2012

Relying upon the following goods:

Class 21: Small household utensils and containers (not in precious metals or coated therewith), brushes (except paint brushes), sponges, feather-dusters, brooms, short-handled brushes, hand-operated cleaning instruments and equipment, scoops (cleaning instruments), buckets, saucepan scourers, cloth for washing floors, gloves for household purposes, mats for household purposes for sinks, brushes, sponges and

cloths for polishing, draining mats, furniture dusters, dishcloths (for household purposes), cloths for cleaning, clothes pegs, wiper covers, mop wringers, fly swatters, scrapers (for household purposes), suction pads for household purposes, sink plungers, non-electric hot water bottles.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the Opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.¹
4. The Opponent submits that the marks are similar and that the goods at issue are identical or similar.
5. The Applicant filed a counterstatement denying the grounds of opposition and requesting that the Opponent provide proof of use of the earlier mark in respect of all the goods relied upon.
6. The Applicant is self-represented; the Opponent is represented by DOLLEYMORES.
7. The Opponent filed evidence and the Applicant filed written submissions during proceedings. Neither party requested a hearing, however, the Opponent filed submissions in lieu of the same. This decision is taken following careful consideration of the papers.

¹ See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

Evidence and Submissions

8. The Opponent's evidence is in the form of the witness statement of François Carayol dated 30 December 2025, accompanied by four exhibits (FC1-FC4). Mr Carayol is the CEO at LA BROSSE & DUPONT MAISON (the Opponent), a position held since 2004.
9. The main purpose of Mr Carayol's evidence is to demonstrate that the earlier mark has been put to genuine use in the relevant territories during the relevant period in relation to the goods relied upon.
10. The Applicant filed written submissions on 10 February 2026.
11. The Opponent filed written submissions in lieu of a Hearing on 19 March 2026.

Relevance of EU Law

12. 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 caselaw. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Proof of Use

13. The registration procedure for the earlier mark was completed more than five years prior to the filing date of the contested application. Therefore, it is subject to proof of use pursuant to section 6A of the Act. In its notice of opposition, the Opponent made a statement of use in relation to the class 21 goods relied upon. Accordingly, I will begin by assessing whether there has been genuine use of the earlier mark.
14. The relevant statutory provisions are as follows:

“6(1) This section applies where:

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

15. Section 100 of the Act reads:

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

16. The relevant period during which genuine use must be shown is the five years ending with the filing date of the contested application, being 15 June 2025. Therefore, the relevant period is 16 June 2020 to 15 June 2025. As the Opponent’s earlier mark is a comparable mark, the territory in which use of the mark must be shown is the EU (including the United Kingdom)² prior to IP completion day, being 31 December 2020,³ and the United Kingdom only thereafter.

17. Consequently, the onus is upon the Opponent to prove that genuine use of the earlier mark was made within the relevant territories, during the relevant period, and in respect of the relevant goods as registered.

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

“105. The principles applicable to determining whether there has been genuine

² *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraphs 36, 50 and 55.

³ See paragraph 7 of Part 1, Schedule 2A of the Act.

use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v 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. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods, 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

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

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

to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

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

19. Before assessing the Opponent’s evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, (as he then was) sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, where he stated that:⁴

“22. The burden lies on the registered proprietor to prove use [...]. However, 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

⁴ Case BL O/230/13.

tribunal (which in many cases will be the Hearing Officer in the first instance) 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.”

20. I also note Mr Alexander QC’s (as he then was) comments in *Guccio Gucci SPA v Gerry Weber International AG*.⁵ Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

21. The comments of Mr Geoffrey Hobbs QC (as he then was) in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, where he sat as the Appointed Person, are also relevant.⁶ He stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As *Mann J. observed in Matsushita Electric Industrial Co. v. Comptroller General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

⁵ Case BL O/424/14.

⁶ Case BL O/404/13.

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

22. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and, whether on this basis, I can reasonably be satisfied that there has been genuine use of the mark.

Form of the mark

23. Before I move on to assess if the Opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered or acceptable variants.

24. Section 6A(4)(a) of the Act states:

“...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).”

25. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

26. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

27. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue

to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

28. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.
29. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)."
30. The Opponent's registration is for the word mark 'ELEPHANT'. Where the Opponent has used its earlier mark as registered, that will clearly be use on which the Opponent can rely. However, it is noted from the evidence that the Opponent's mark has also been used in the following way:



31. I bear in mind that where a registered mark is used as part of another mark or with additional matter, this may still constitute acceptable use of the mark as registered, where this element continues to act independently as an indicator of origin.^[1]
32. To my mind, use of the mark with a figurative device depicting a silhouette of an elephant and a house makes no material difference to the distinctive character of the mark itself. While the wording at the bottom of the mark is not entirely clear, it

^[1] *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

appears to include a year, suggestive of it being an incorporation date for the company. Regardless of the exact nature of this additional wording, I consider that the word 'ELEPHANT' remains clearly identifiable within the sign as used and continues to indicate origin. Consequently, it is use upon which the Opponent can rely.

Evidence of use

33. Whether the use shown of the earlier mark is sufficient to establish genuine use will depend on whether there has been real commercial exploitation of the same, in the course of trade, sufficient to create or maintain a market for the goods at issue, in the relevant territories, during the relevant five-year period.
34. 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.⁷ As indicated in the caselaw above, use does not need to be quantitatively significant to be genuine.
35. The Opponent claims to have used its earlier mark 'Elephant' during the relevant period, in relation to all goods relied upon.⁸
36. With regards to use of the earlier mark, the following has been deduced from Mr Carayol's witness statement and exhibits:
37. The Opponent is based in France and sells to a single client in the UK, namely B&Q, which has over 300 physical stores in the UK and Ireland and also sells via the websites www.diy.com and www.diy.ie.
38. UK sales figures between the years 2020 and 2024 are provided, as shown below:

⁷ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09.

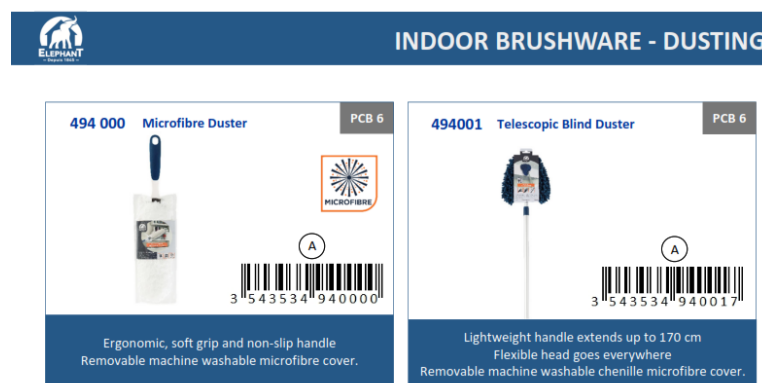
⁸ As set out in paragraph 2.

Year	Value (Euros)	Number of units
2020	44,099.52	12440
2021	48,852.00	12930
2022	37,764.96	8340
2023	31,732.56	5328
2024	31,881.12	6456

39. From these figures, I can discern that annual sales in the relevant period are between 31,881.12 and 48,852.00 euros – no conversion is provided for these figures in GB pounds. I also note that between 5,328 and 12,930 units were sold annually within the relevant period, although the figures are not broken down by specific products.

40. Exhibit FC1 provides 29 invoices showing sales of ELEPHANT products to B&Q Distribution Centre Swindon and B&Q DC Redhouse, in Doncaster. I note that the first of these invoices is dated 15 June 2020, one day prior to the relevant period commencing. The total unit sales and values shown on the invoices are equal to the figures provided in the above table from the witness statement of Mr Carayol. In view of this, it is apparent that the invoices represent all sales of Elephant products within the relevant period.

41. The relevant codes shown in these invoices correspond to products shown in exhibit FC2, an example of which is shown below:



42. The 'Elephant' mark is shown on the top corner of the Opponent's product catalogue. While the individual product images are small, I am satisfied that the Elephant mark is displayed on at least some of the products and/or their packaging. Examples of this are shown below:



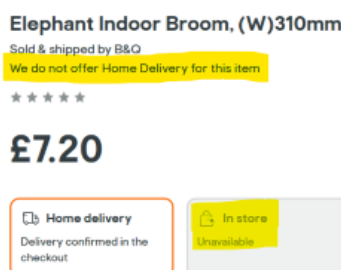
43. When viewed together, exhibits FC1 and FC2 provide information regarding the breakdown of products sold under the Elephant mark during the relevant period. I am able to discern from these exhibits that the Opponent's total unit sales within the relevant period are comprised of the following goods:

- 11,952 brooms
- 4,116 dustpan and brush sets
- 960 mop buckets
- 9,000 dusters
- 9,744 telescopic blind dusters
- 6,210 mops
- 2,880 mop refills
- 632 mop wringers

44. Exhibit FC3 provides extracts of the website of retailer B&Q (www.diy.com). While several of the extracts are undated, I note that four have been retrieved from the Wayback Machine (pages 53, 60, 69 and 76) dated 07 December 2020, 02 December 2022, 21 July 2021 and 20 November 2020. These pages show that Elephant dustpan and brush sets, Elephant microfibre dusting brushes and Elephant flat mop wringers were on sale via the B&Q website during the relevant

period. The prices range from £2.72 and £5.97 per unit. No details have been provided of visitor figures, geographical reach of the website, or the number of sales made via the website.

45. The undated extracts within exhibit FC3 show dustpan and brush sets, brooms, dusting brushes, mop heads, mops and mop wringers with prices in UK pounds (with unit prices ranging from £1.50 to £11). Further to this, I note that these products are showing as 'unavailable' in store, and that the website states 'we do not offer home delivery for this item'. An example of this can be seen below (I have added highlighting to the image to demonstrate the relevant points):



46. In view of the above, I am unable to confirm with any certainty whether the products were available for purchase via the website during the relevant period.
47. Exhibit FC4 provides extracts from the websites B&Q, Homebase, Tesco and Morrisons, showing a range of household cleaning products on sale. The extracts do not show the Elephant mark, however, Mr Carayol states that they are intended to demonstrate that the Opponent's goods and the Applicant's goods are sold within the same section of the websites of general retailers.

Genuine use

Assessment of Evidence

48. Whether the use shown in the evidence is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in

the relevant territories, during the relevant five-year period. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

49. 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. It is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof: see *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T- 415/09, paragraph 53. However, where there is no use of the mark in respect of the goods as registered, it follows there has been no genuine use of the mark: *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, paragraph 22.

50. I acknowledge that, as per the principles outlined under paragraph 18 of this decision, use of the mark must be more than token, although that use need not always be quantitatively significant for it to be deemed genuine.⁹ I also bear in mind that it is not the task of this tribunal to assess economic success or large-scale commercial use, and that there is no de minimis rule - even minimal use may qualify as genuine use if it is use warranted, in the economic sector concerned, to maintain or create market shares for the relevant goods.¹⁰

51. Caselaw does not specify particular types of documentation that must be adduced in evidence. When considering the evidence, I am 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”: (see *PLYMOUTH LIFE CENTRE*, BL O/236/13, paragraph 22). However, I remind myself that I must

⁹ *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

¹⁰ *Naazneen Investments Ltd v OHIM*, Case T-250/13 at [49].

evaluate all the evidence submitted in an overall assessment, and that although pieces of evidence may be insufficient by themselves, they may contribute to proving use in combination.

52. With regard to the evidence of use submitted, I must now consider if it sufficiently demonstrates genuine use. The burden is on the Opponent to prove that it has used its mark within the relevant period. Therefore, it was the Opponent's responsibility to provide proof that the mark was used in the relevant territories during the five-year relevant period.
53. I bear in mind that use in the EU is relevant prior to IP completion day and that only use in the UK will be relevant after this date.¹¹ However, Mr Carayol's witness statement and exhibits are focused on the UK. No evidence, beyond a statement that B&Q has stores in Ireland, has been presented regarding use in the EU prior to IP completion day.
54. Having considered the overall picture presented by the evidence, even when discounting those parts of the evidence which are undated, it is clear to me that it does demonstrate use of the Opponent's mark during the relevant period.
55. While the evidence provided shows that goods bearing the Elephant mark were only sold to one client, namely B&Q, this alone does not rule out the possibility of finding genuine use. I note that B&Q has 300 physical stores in the UK and Ireland and an online retail platform targeting UK consumers. On this point, I bear in mind the Opponent submits that "selling goods to an established retailer has a clear commercial rationale as it allows the Opponent's products to be advertised and sold to a broad customer base throughout the country".¹²
56. Whilst no information has been provided to show the distribution of sales to end consumers across B&Q stores, the fact that the products were delivered to distribution centres in Swindon and Doncaster suggests to me that they were intended for further distribution within the UK. It is likely such distribution could be

¹¹ Namely 16 June 2020 to 31 December 2020.

¹² Opponent's written submissions in lieu, paragraph 7.

both to stores and to fulfil orders purchased via B&Q's online retail platform, however, no evidence has been adduced on this point.

57. There are shortcomings in the Opponent's evidence, including the fact that no details of market share are provided and that the invoice values are only provided in Euros. However, the unit sales demonstrate a total of 45,494 units were sold during the relevant period. I consider this figure to be not insignificant and clearly beyond mere token use.
58. On balance, taking all the above into account and bearing in mind not only section 100 of the Act but also the comments of Mr Alexander QC (as he then was) and Mr Hobbs QC (as he then was) in *Plymouth Life and Dosenbach*, I consider that the Opponent's evidence is sufficient to demonstrate commercial exploitation of its mark in relation to some of the goods at issue in the UK during the relevant period. However, from the evidence I have before me, I can only ascertain that the Opponent's mark has been used on dusters, dustpan and brush sets, telescopic blind dusters, brooms, mops, mop refills, mop buckets, and mop wringers. There is no evidence to suggest that the Opponent's mark has been used on goods outside of these goods.

Fair specification

59. I must now consider whether, or the extent to which, the evidence shows use of the registered mark in relation to the goods relied upon. I must bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use, but, rather, the particular categories of goods they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the goods concerned.¹³ In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods shown in evidence; the task is not to describe the use made of the registered mark in the narrowest possible terms, unless that is what an average consumer would do. I

¹³ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

remind myself that the Opponent cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods covered by the registration.¹⁴

60. The Opponent has claimed use of the mark on the following goods:

Class 21: Small household utensils and containers (not in precious metals or coated therewith), brushes (except paint brushes), sponges, feather-dusters, brooms, short-handled brushes, hand-operated cleaning instruments and equipment, scoops (cleaning instruments), buckets, saucepan scourers, cloth for washing floors, gloves for household purposes, mats for household purposes for sinks, brushes, sponges and cloths for polishing, draining mats, furniture dusters, dishcloths (for household purposes), cloths for cleaning, clothes pegs, wiper covers, mop wringers, fly swatters, scrapers (for household purposes), suction pads for household purposes, sink plungers, non-electric hot water bottles.

61. On the matter of a fair specification, the Opponent submits that their evidence establishes genuine use for the following goods:

“Small household utensils and containers (not in precious metals or coated therewith), brushes (except paint brushes), brooms, short-handled brushes, hand-operated cleaning instruments and equipment, scoops (cleaning instruments), buckets, cloth for washing floors, brushes, cloths for polishing, furniture dusters, cloths for cleaning, wiper covers, mop wringers, dusters, mops, mop heads, mop replacement pads, dustpans.”¹⁵

62. Taking the evidence as a whole, I am satisfied that it demonstrates use of the Opponent’s mark during the relevant period in relation to some of the goods relied upon. I bear in mind that it is not necessary to describe the use made by the trade

¹⁴ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

¹⁵ Opponent’s written submissions in lieu, paragraph 12.

mark proprietor in the narrowest possible terms unless that is what the average consumer would do.¹⁶

63. Accordingly, keeping in mind the guidance provided by the relevant caselaw, I consider the following to be a fair specification of the Opponent's goods for which sufficient evidence of use has been provided:

Class 21: Hand-operated cleaning instruments and equipment, namely brushes (except paint brushes), brooms, short-handled brushes, mops, mop refills, dustpans, dustpan and brush sets, telescopic blind dusters, mop buckets, mop wringers, furniture dusters.

64. The Opponent may therefore rely upon these goods for the purposes of these opposition proceedings.

Decision

Section 5(2)(b)

65. The opposition is based upon Section 5(2)(b) of the Act, which reads as follows:

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

(a) ...

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

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

¹⁶ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

66. Section 5A of the Act reads as follows:

“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.”

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

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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

68. The goods for comparison are as follows:

Opponent's goods	Applicant's goods
<u>Class 21:</u> Hand-operated cleaning instruments and equipment, namely brushes (except paint brushes), brooms, short-handled brushes, mops, mop refills, dustpans, dustpan and brush sets, telescopic blind dusters, mop buckets, mop wringers, furniture dusters.	<u>Class 3:</u> Soap; Soaps; Bars of soap; Bar soap; Loofah soaps. <u>Class 21:</u> Loofahs; Scrub sponges; Scouring pads; Household scouring pads; Scrubbing pads; Abrasive pads for kitchen purposes; Household utensils; Household or kitchen utensils; Bottle cleaning brushes; Bath sponges;

	Abrasive sponges for scrubbing the skin; Skin cleansing brushes; Foot exfoliating pads; Cleaning sponges; Abrasive sponges for kitchen [cleaning] use; Brushes for cleaning.
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69. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

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

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

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

- i. The respective uses of the respective goods or services;

- ii. The respective users of the respective goods or services;
- iii. The physical nature of the goods or acts of service;
- iv. The respective trade channels through which the goods or services reach the market;
- v. 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;
- vi. 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.

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

“82. ...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”.

73. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information*

Ltd [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

74. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.¹⁷
75. I also note that section 60A(1)(a) of the Act provides that goods are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.
76. The Applicant submits that while certain goods fall within the same trade mark classifications, they are nevertheless differentiated in concept, market positioning and consumer expectation. They state that the Opponent’s evidence “indicates that its goods consist primarily of functional household items, including mass-market plastic cleaning and utility products sold through large retail chains” which differs to their own environmentally-focused goods, “marketed with a clear ethical and aesthetic positioning”.¹⁸
77. However, differences between the manner in which goods are currently provided by the parties are irrelevant, except to the extent that those differences are apparent from each party’s specification. It is the goods relied upon by the Opponent, and

¹⁷ *Separode Trade Mark* (BL O/399/10), per Mr Geoffrey Hobbs QC, sitting as the Appointed Person; and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35, at paragraphs 30 to 38).

¹⁸ Applicant’s written submissions, paragraph 5.2

the goods applied for by the Applicant that I will be comparing. The assessment I must make between the goods is a notional and objective assessment, rather than a subjective one. Furthermore, marketing strategies are temporary and may change over time.¹⁹ As such, it is not appropriate to take such factors into account in my assessment.

78. The Opponent submits that the goods at issue in class 21 are all for cleaning, are identical in their nature and method of use, are in competition and are complementary. They further submit that their evidence demonstrates the goods are sold through the same departments in general retail websites.²⁰ I bear these submissions in mind when making the comparisons below.

Class 3:

Soap; Soaps; Bars of soap; Bar soap.

79. The Opponent submits that the Applicant's above goods are all soaps for cleaning, including household cleaning.²¹ I agree that these goods are not limited to any specific purpose. I consider them to be broad enough to encompass soaps for cleaning, which overlap in purpose with the Opponent's "hand-operated cleaning instruments and equipment, namely [...] short-handled brushes [...]". There is also an overlap in user at a general level, in that the respective goods will be used by members of the general public. However, the goods clearly differ in nature and method of use. I say this because the Applicant's goods are soaps (including those in bar form), while the Opponent's goods are cleaning instruments, which comprise of a handle and bristles. Where the Applicant's soaps are for cleaning, there will be an overlap in trade channels, as the respective goods will likely be sold by the same retailers of cleaning products, or within the same cleaning aisles of general retailers. I do not consider the goods to be in competition, as a consumer is unlikely to choose to purchase a bar of soap for cleaning in place of a cleaning brush. Although the goods may be used alongside one another while cleaning, I do not consider them

¹⁹ *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

²⁰ Opponent's submissions in lieu, paragraph 17.

²¹ Opponent's written submissions in lieu, paragraph 18.

to be complementary in the way set out in caselaw. Overall, I consider them similar to a low degree.

Loofah soaps.

80. I understand loofah soaps to be soaps integrated into loofahs. In the absence of any submissions to the contrary, I understand loofahs to be a natural plant product commonly used in personal care and/or personal hygiene. In view of this, the goods differ in nature, method of use and purpose to the Opponent's goods, including "hand-operated cleaning instruments and equipment, namely [...] short-handled brushes, mops [...]", which are intended for cleaning physical environments to remove dirt or sanitise. There is an overlap in user at a general level, being members of the general public, however, this in itself is insufficient to engage a finding of similarity. While the goods may all be sold by general retailers, the Applicant's goods will be positioned within the personal care/toiletries department, while the Opponent's goods will be positioned in the cleaning or homeware departments. I do not consider the goods to be in competition, as a consumer will not purchase loofah soap in place of the Opponent's cleaning instruments/equipment. Neither do I consider the goods to be complementary in the way set out in caselaw. Overall, I consider the goods to be dissimilar.

Class 21:

Brushes for cleaning; Bottle cleaning brushes.

81. The Applicant's above goods are specific types of brushes for cleaning. I consider these to be encompassed by the Opponent's broad category "hand-operated cleaning instruments and equipment, namely brushes (except paint brushes) [...]". They are therefore identical on the principle set out in *Meric*.

Scrub sponges; Scouring pads; Household scouring pads; Scrubbing pads; Abrasive pads for kitchen purposes; Abrasive sponges for kitchen [cleaning] use; Cleaning sponges.

82. The Applicant's above goods are all types of sponges and pads for cleaning. These overlap in purpose with the Opponent's "hand-operated cleaning instruments and equipment, namely [...] short-handled brushes", as the respective goods are all used for cleaning. There is also an overlap in user to the extent that the respective goods will be used in domestic settings by members of the general public. However, they differ in nature and method of use as brushes generally comprise of a handle with bristles, while the Applicant's goods are soft or abrasive pads held directly in the hand and are more often used in the cleaning of dishes, cookware or smaller surfaces. There is an overlap in trade channels, as the respective goods will likely be sold by the same retailers of cleaning products, or within the same household cleaning aisles of general retailers. I do not consider the goods to be in competition, as a consumer is unlikely to choose to purchase a cleaning sponge or pad, in place of a short-handled brush. Although the goods may be used alongside one another while cleaning, I do not consider them to be complementary in the way set out in caselaw. Overall, I consider them similar to between a low and medium degree.

Household utensils; Household or kitchen utensils

83. I understand the Applicant's above goods to be broad categories of utensils intended for a range of household tasks. While these goods include utensils used for food preparation, serving and cooking, I consider that the term 'household utensils' may also encompass some utensils used for household cleaning tasks. In view of this, I consider there will be a degree of overlap in purpose with the Opponent's "hand-operated cleaning instruments and equipment, namely brushes (except paint brushes) [...] short-handled brushes [...]" to the extent that the respective goods are used for cleaning. However, the goods will vary in their precise nature and method of use. There is an overlap in user to the extent that the respective goods may be used in domestic settings by members of the general public. There is an overlap in trade channels, as the goods will likely be sold by the same retailers of household products, or within the same household cleaning or homeware departments of general retailers. I do not consider the goods to be in competition. While the goods may be used alongside one another while cleaning, I do not consider them to be complementary in the way set out in caselaw. Overall, I consider the goods to be similar to a low degree.

Skin cleansing brushes.

84. The Applicant's above skin cleansing brushes are intended for use in personal hygiene/care to cleanse the skin. While the Opponent's goods include the term "hand-operated cleaning instruments and equipment, namely brushes (except paint brushes), [...] short-handled brushes [...]", I consider the core and natural meaning of this term to be brushes intended for cleaning physical environments to remove dirt or sanitise. In view of this, the goods differ in purpose and method of use, however there is a degree of overlap in nature in that the goods are both brushes. There is also an overlap in user at a very general level, being members of the general public. While the goods may all be sold by general retailers, the Applicant's goods will be positioned within the personal care/toiletries department, while the Opponent's goods will be positioned in the cleaning or homeware departments. I do not consider the goods to be in competition, as a consumer will not choose the Opponent's cleaning goods in place of a cleansing brush for use on skin. Neither do I consider the goods to be complementary in the way set out in caselaw. Overall, I consider the goods to be similar to a very low degree.

Bath sponges; Loofahs; Abrasive sponges for scrubbing the skin; Foot exfoliating pads.

85. The Applicant's above goods are sponges, loofahs and exfoliating pads for personal hygiene and personal care. These goods differ in nature, method of use and purpose to the Opponent's goods, including "hand-operated cleaning instruments and equipment, namely [...] short-handled brushes, mops [...]", which are intended for cleaning physical environments to remove dirt or sanitise. There is an overlap in user at a general level, being members of the general public, however, this in itself is insufficient to engage a finding of similarity. While the goods may all be sold by general retailers, the Applicant's goods will be positioned within the personal care/toiletries department, while the Opponent's goods will be positioned in the cleaning or homeware departments. I do not consider the goods to be in competition, as a consumer will not choose the Opponent's cleaning goods in place of a sponge or pad for personal use. Neither do I consider the goods to be

complementary in the way set out in caselaw. Overall, I consider the goods to be dissimilar.

86. It is a prerequisite of section 5(2)(b) of the Act that the goods be identical or at least similar. As per *eSure*,²² in relation to the goods which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b) of the Act, I will take no further account of such goods, with the opposition failing to that extent. The opposition under section 5(2)(b) of the Act, therefore, fails at this juncture for the following goods:

Class 3: Loofah soaps.

Class 21: Bath sponges; Loofahs; Abrasive sponges for scrubbing the skin; Foot exfoliating pads.

Average consumer and the purchasing act

87. As the caselaw above indicates, it is necessary to determine who the average consumer is for the goods at issue. I must then determine the manner in which the goods are likely to be selected by the average consumer.

88. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

89. In *Iconix* (cited above) the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

²² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

90. Both parties submit that the average consumer for the goods at issue will be members of the general public, paying around an average degree of attention during the purchasing process.²³

²³ Applicant's written submission in lieu, paragraph 5.3 & Opponent's written submissions in lieu, paragraphs 20-21.

91. I agree with the parties that the average consumer of the goods at issue will be members of the general public. The goods are likely to be purchased frequently, at low cost. Various factors are likely to be taken into consideration during the purchasing process, including the durability, price and suitability for the consumer's needs. Accordingly, I find that the average consumer will pay no more than a medium degree of attention during the purchasing process.
92. The goods will likely be self-selected from the shelves of retail outlets or their online equivalents. Given the process of selection, the visual impact of the marks is likely to play the greater role, though I do not discount the opportunity for aural recommendations to be made, for example, by word-of-mouth or from a sales person, etc.

Comparison of the marks

93. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
ELEPHANT	CHARM ELEPHANT

94. The Opponent's mark consists of the word 'ELEPHANT'. There are no other elements to contribute to the overall impression, which lies in the word itself.
95. The Applicant's mark consists of the words 'CHARM ELEPHANT' with no other elements to contribute to the overall impression. Both parties submit that the word 'CHARM' qualifies the word 'ELEPHANT' within the mark. I agree that the word 'CHARM' qualifies the word "ELEPHANT". Bearing this in mind, I consider that the overall impression lies in the mark as a whole.
96. Visually, the marks coincide in the word 'ELEPHANT' which appears in both marks. The word 'CHARM' at the beginning of the Applicant's mark acts as a point of visual

difference, a position to which the average consumer tends to pay more attention.²⁴ Overall, I consider that the marks are visually similar to between a low and medium degree.

97. Aurally, the Opponent's mark 'ELEPHANT' is reproduced in its entirety at the end of the Applicant's mark. This element will be pronounced identically in both marks. A point of aural difference is the additional word 'CHARM' at the beginning of the Applicant's mark, which will be pronounced in the ordinary way. Overall, bearing in mind the identical pronunciation of the longer shared element, I consider the marks to be aurally similar to a medium degree.

98. Conceptually, the ordinary dictionary word 'ELEPHANT' appears in both marks, which I consider the average consumer will recognise as referring to the large land-based animal with a flexible trunk.

99. The Opponent submits that the word 'CHARM' will be assigned the dictionary definition of an 'object that is believed to have magic power'. They further submit that the word 'CHARM' is laudatory, as cleaning products are often advertised as having 'magical cleaning powers'.²⁵

100. The Applicant submits that the word 'CHARM' "suggests attractiveness, appeal, or a positive emotional quality, thereby creating a composite concept that goes beyond the mere reference to an animal".²⁶

101. The parties appear to agree insofar as the word 'CHARM' in the Applicant's mark qualifies or describes the word 'ELEPHANT'. While the word 'CHARM' can have several defined meanings, I consider that a significant proportion of average consumers will understand it as referring to a small object worn or kept for luck or protection.

102. When viewed as a whole, although the order of the words in the Applicant's "CHARM ELEPHANT" mark is slightly unusual, I consider it alludes to a charm in

²⁴ *El Corte Ingles, S4 v OHIM*, Cases T-183/02 and T-184/02.

²⁵ Opponent's written submissions in lieu, paragraph 23.

²⁶ Applicant's written submissions in lieu, paragraph 4.4.

the shape of an elephant. This meaning introduces a point of conceptual difference which moves the Applicant's mark away from being purely a reference to an elephant.

103. Overall, I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

104. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

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

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

105. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are suggestive or allusive of a characteristic of the goods,

to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

106. Dealing first with the inherent distinctiveness of the Opponent's mark. The dictionary defined word 'ELEPHANT', will be assigned its ordinary meaning. The Applicant submits that while the mark is not directly descriptive of household goods in classes 3 and 21, it is "readily understood by consumers as a generic animal name rather than an indicator of specific commercial origin".²⁷

107. While I note the Applicant's comments, I consider that the word 'ELEPHANT' has no obvious descriptive or allusive qualities in relation to the goods at issue. Accordingly, I find the earlier mark to be inherently distinctive to a medium degree.

108. Turning now to the question of whether the Opponent's mark has acquired enhanced distinctiveness through its use. In this regard, the Opponent submits that their use of the ELEPHANT mark has enhanced its level of distinctive character.²⁸

109. While I found the Opponent's evidence sufficient to demonstrate proof of use, I must now consider whether it meets the threshold required to demonstrate the mark's distinctiveness has been enhanced through use.

110. The Opponent's evidence demonstrates sales were made to UK based retailer B&Q's distribution centres consistently throughout the relevant period. However, I consider the Opponent's evidence to have various shortcomings. While I have evidence of products bearing the ELEPHANT mark being present on B&Q's online retail platform, I have no evidence before me relating to how the goods are presented to consumers in stores, nor the geographic reach of onward sales to the relevant public. I have not been provided with information regarding the size of the corresponding cleaning product market in the UK or the market share enjoyed by the Opponent under the mark for the goods relied upon. In addition, no information

²⁷ Applicant's written submissions in lieu, paragraph 3.1

²⁸ Opponent's written submissions in lieu of a Hearing, paragraph 25.

has been provided regarding marketing spend, or how the goods provided under the ELEPHANT mark have been promoted.

111. When considering the evidence in full, I find that it does not establish that the Opponent's mark has acquired an enhanced degree of distinctiveness in relation to the goods at issue. I am therefore of the view that the Opponent's evidence falls short of what would be required to show that the distinctiveness of the mark has been enhanced through use.

Likelihood of confusion

112. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

113. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

114. Earlier in this decision, I found that:

- The goods range from identical to similar to a very low degree.
- The average consumer for the goods is the general public who will pay no more than a medium degree of attention during the purchasing process. They

will select the goods primarily by visual means, although I do not discount an aural component.

- The marks are visually similar to between a low and medium degree and aurally similar to a medium degree. The marks are conceptually similar to a medium degree.
- The earlier mark is inherently distinctive to a medium degree, and the evidence of use provided was insufficient for me to find that the degree of distinctiveness had been enhanced through use of the mark.

115. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistaken for one another. Despite the shared 'ELEPHANT' element, I do not consider this word plays an independent distinctive role in the Applicant's mark. The Applicant's mark starts with the word 'CHARM', creating a point of visual, aural and conceptual difference between the parties' marks. I do not consider this word will go unnoticed by the average consumer, particularly given its position at the beginning of the mark. In my view, the word 'CHARM' qualifies the word 'ELEPHANT', so that the Applicant's mark will be perceived as a whole, rather than as 'ELEPHANT' with an additional word. I consider that the words 'CHARM ELEPHANT', taken together, create a different overall impression which will assist the average consumer in distinguishing one mark from the other. Consequently, I consider there to be no likelihood of direct confusion between the marks.

116. I now proceed to consider whether there exists a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

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

117. Furthermore, in *Liverpool Gin*,²⁹ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis"

²⁹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

118. Having recognised the differences between the marks, I consider it unlikely that the average consumer will conclude that they originate from the same or economically linked undertakings. I do not consider the word 'ELEPHANT' to be so strikingly distinctive that consumers would assume only one undertaking would use it in a trade mark. Further, I see no reason why the average consumer would see the use of the word "CHARM" at the beginning of the Applicant's mark as a logical indicator of a sub-brand or brand extension of the Opponent's mark. I consider that the average consumer would simply put the presence of the common element 'ELEPHANT' in both marks down to coincidence rather than as an indication that there is an economic connection between the undertakings. Consequently, I do not consider that there exists a likelihood of indirect confusion.

Conclusion

119. The opposition based upon 5(2)(b) is unsuccessful. Therefore, subject to any successful appeal against my decision, the application may proceed to registration.

Costs

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

121. The Applicant did not file a completed Pro Forma and as the Applicant paid no official fees arising from the action, I make no award of costs.

Dated this 23rd day of September 2026

Emma Rees
For the Registrar