O-0855-23

TRADE MARKS ACT 1994

IN THE MATTER OF
UK DESIGNATION OF INTERNATIONAL REGISTRATION NO. 1581221
IN THE NAME OF LLC CRYSTAL MANAGEMENT COMPANY FOR

RAD

IN CLASSES 3, 5, 8, 18, 20, 21, 26 AND 35

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 427905
BY ENVIRON SKIN CARE (PROPRIETARY) LIMITED

BACKGROUND AND PLEADINGS

1. On 21 September 2020 LLC Crystal Management company ("**the Holder**") applied to designate for protection in the UK, International Registration No. 1581221 (the "**Designation**") for the (figurative) trade mark shown on the cover of this decision (the **"Contested Mark**") – essentially the word RAD - in relation to goods and services in Classes 3, 5, 8, 18, 20, 21, 26 and 35.

2. Environ Skin Care (Proprietary) Limited (the "**Opponent**") is the registered proprietor of:

   (i) EUTM Registration No. 2480879 (the "**First Earlier Registration**"),[1] for the word mark RAD (the "**Opponent's RAD Mark**") in respect of the following goods specified in Class 3:

   Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

   Filing date: 22 November 2001
   Registration date: 2 May 2003

   and

   (ii) EUTM Registration No. 13517636 (the "**Second Earlier Registration**"),[2] for the word mark RAD SHIELD (the "**Opponent's RAD SHIELD Mark**") in respect of the following goods specified in Class 3:

   Sunscreen preparations; sunscreens.

   Filing date: 1 December 2014
   Registration date: 30 March 2015

3. On 2 November 2021 the Opponent filed a notice of opposition against the Designation, but the opposition is directed only against the goods specified in Class 3 (the "**Contested**

1 The First Earlier Registration is mirrored in the comparable UK trade mark registration No. 902480879.
2 The Second Earlier Registration is mirrored in the comparable UK trade mark registration No. 913517636.

Goods"). Those Contested Goods are set out in the part of this decision that considers the extent to which the goods at issue are identical or similar. The opposition is based on the following grounds under the Trade Marks Act 1994, as amended ("**the Act**"):

(i) **Section 5(1)** – a claim of double identity between the First Earlier Registration and the Designation (in Class 3);

(ii) **Sections 5(2)(a)** and **5(2)(b)** – a claim that there exists a likelihood of confusion between the Designation (in Class 3) and both of the Opponent's Earlier Registrations;

(iii) **Section 5(3)** – a claim that the First Earlier Registration has a reputation in respect of "*Cosmetics, namely suncream and sunscreen*", and that use of the Contested Mark in relation to the Contested Goods would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or the repute of the First Earlier Registration.

(iv) **Section 5(4)(a)** - that the Opponent has used the sign RAD in respect of "*Cosmetics, namely suncream and sunscreen*" throughout the UK since at least 1993, generating goodwill and that use of the Contested Mark in relation to the Contested Goods would be contrary to the law of passing off.

4. The Applicant submitted a notice of defence, including a counterstatement denying all of the grounds. It put the Opponent to proof of use of its RAD Mark in relation to "cosmetics, namely sun cream and sunscreen" (which is how the Opponent described the goods used under its First Earlier Registration), and of its RAD SHIELD Mark in relation to all of the goods covered by the Second Earlier Registration (i.e. *sunscreen preparations; sunscreens*). It also requested proof of the claimed reputation and goodwill under the mark RAD for "cosmetics, namely sun cream and sunscreen".

5. The Holder is represented in these proceedings by AA Thornton IP LLP; the Opponent by Potter Clarkson LLP. During the evidence rounds, only the Opponent filed evidence. Beyond the defence form and counterstatement, no further papers were filed on behalf of the Holder. No oral hearing was requested, and only the Opponent filed submissions in lieu of a hearing. This decision is taken based on my close reading of the papers filed.

STATUTORY PROVISIONS

6. Sections of the Act applicable to this decision are set out below:

Section 5 Relative grounds for refusal of registration.

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

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

(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".

(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

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

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

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

….

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

(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.

5A Grounds for refusal relating to only some of the goods or services

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.

7. **Section 6** of the Act defines what is meant by an "earlier trade mark" for the purposes of section 5. Since the Holder applied for the contested UK Designation on 21 September 2020, which is before IP completion day (31 December 2020),[3] the EU trade marks that are the Opponent's Earlier Registrations (which have filing dates from 2001 and 2014) continue to qualify as earlier trade marks for the purposes of these opposition proceedings.

8. Under **section 6A** of the Act, since the Opponent's Earlier Registrations had been registered for more than five years when the Holder applied for the contested UK Designation, the Opponent may rely on its Earlier Registrations only to the extent that the use conditions are met. Section 6A provides that the use conditions are met if—

- 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,[4] or
- the earlier trade mark has not been so used, but there are proper reasons for non-use.

For these purposes—

- use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

3 IP completion day is an abbreviation for 'Implementation Period' completion day, the ending of the 11-month period from 31 January 2020 during which the UK continued to be subject to EU rules.

4 Since the earlier marks are European Union trade marks the reference to the United Kingdom may be construed as a reference to the European Community.

- 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.

9. The Holder has requested that the Opponent prove its claimed use of the Earlier Registrations. Section 100 of the Act makes it clear that the onus lies on the Opponent to provide evidence to support its claimed use during the relevant period and in the relevant territory. The relevant period is the period of 5 years ending with the filing date of the contested Designation,[5] i.e. from **22 September 2015 to 21 September 2020**. Since the Earlier Registrations are EU trade marks, and since the whole of the relevant 5-year period falls before IP completion day, the relevant territory is the European Union. It was therefore open to the Opponent to rely on evidence of genuine use relating to the EU, including the UK, though in the event, the Opponent focused its evidence only on the UK.

MY APPROACH TO THE EVIDENCE AND CLAIMS

10. The substance of the grounds under sections 5(1) and 5(2) may only be considered if the Opponent's evidence demonstrates satisfaction of the use provisions under section 6A of the Act. For the section 5(3) ground, the evidence of use must additionally bear out the Opponent's claimed reputation. The section 5(4)(a) ground requires evidence of relevant actionable goodwill associated with the unregistered sign RAD in relation to the same goods for which it claims reputation. The evidence of use therefore serves three discrete, related purposes – genuine use, reputation, and goodwill. In the circumstances, I find it convenient to summarise the evidence filed and to draw conclusions and make findings at relevant points in dealing with the subsequent grounds.

THE EVIDENCE

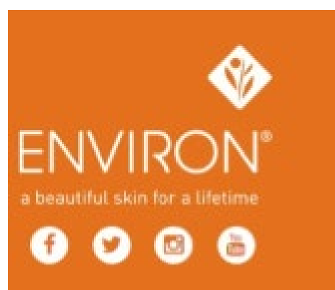
11. The Opponent's evidence of use comes from a witness statement of Gareth Dunn dated 7 November 2022, which introduces ten exhibits.[6] Mr Dunn has been CEO of the opponent company since March 2022 and he makes his statement from his own knowledge and records to which he has access or from enquiries he has made. I note the following from his evidence:

5 Section 6A(1A) of the Act.
6 (The exhibits to Gareth Dunn's witness statement are indeed referenced numerically by GB, not GD.)

i. He states that the Opponent "is a globally recognised professional skin care brand" [sic] "that utilises science to provide skin care" and that "the Environ brand was founded in 1990".

ii. Mr Dunn states that the Opponent's "website and social media pages operate on a geo-location basis" and that he therefore encloses extracts of these at **Exhibit GB1** "as accessed in the UK". As I explain in my following two paragraphs, I found this to be an exhibit, which of itself, furnished little or no evidential support for the Opponent's claims based on use of RAD and RAD SHIELD.

iii. Website - **Exhibit GB1** shows a couple of pages from the Opponent's website, but since those pages are not dated, it is not possible to discern whether they relate to the relevant period. It is not even apparent that this is a website targeted at the UK (or the EU) – for instance, there are no prices in pounds sterling, or references to the UK, such as in a URL, a contact address or telephone number or list of stockists (though the exhibit includes links to "Find a Stockist" and "Contact Us"). Exhibit GB1 contains no reference at all either to RAD or RAD SHIELD; the website pages shown include the following trade mark:

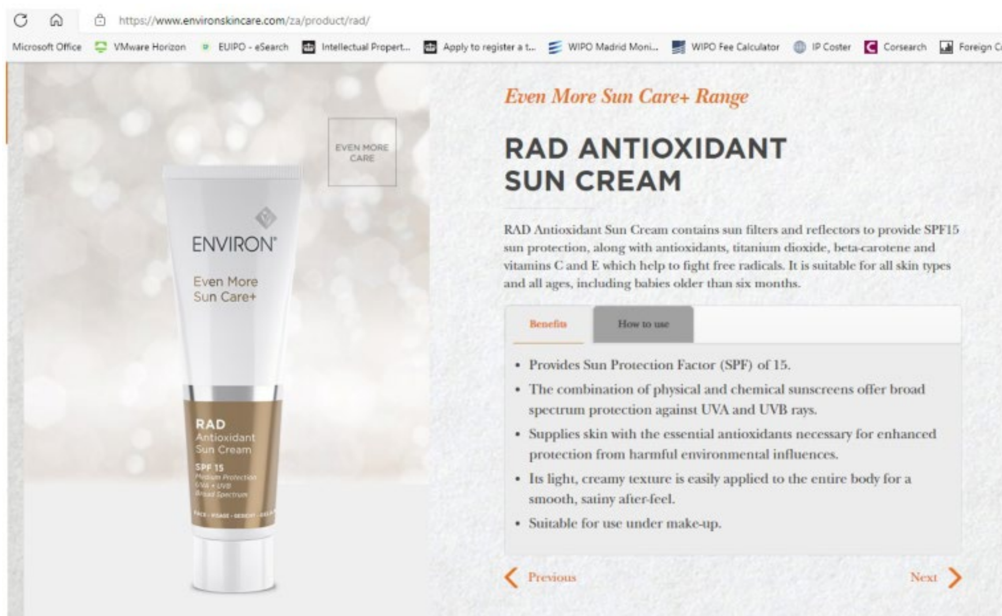


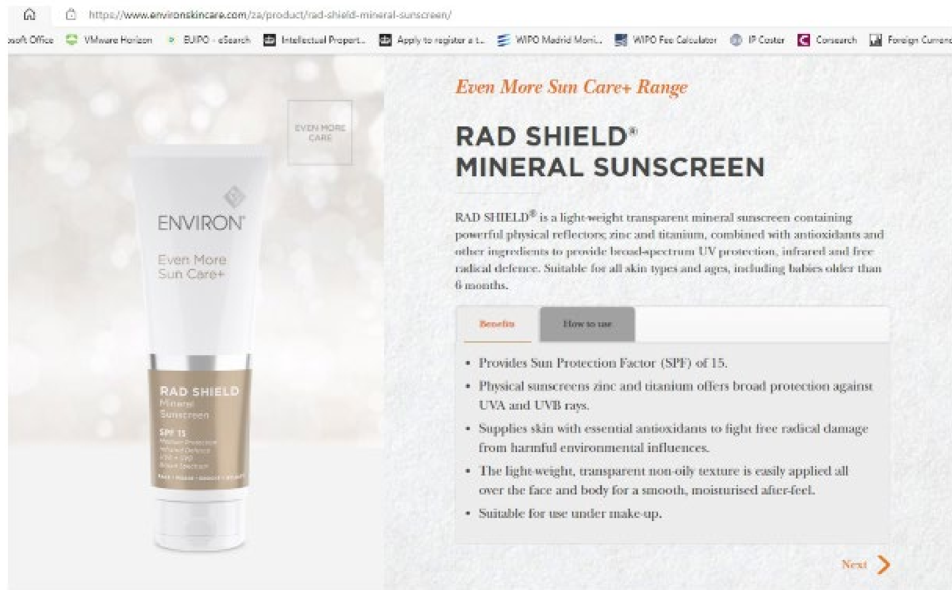
The web page shown appears to offer a link from the website to the Opponent's products, as can be seen below, yet the website exhibit does not show any products offered by reference to either of the marks:

PRODUCTS	SCIENCE OF ENVIRON
Essential Care	Aging Skin
Focused Care	Acne
Even More Care	Dry Skin
Skin Care Professionals	Results
Find a Stockist	Vitamin A
	Vitamin STEP-UP SYSTEM™

iv. Social media - The submissions in lieu on behalf of the Opponent noted "in particular that the Opponent's Instagram page has amassed nearly 100,000 "followers"" and that "the Opponent's Twitter page, which has the handle "@EnvironUK", was founded in October 2014". I accept those points, but the Instagram evidence is undated and it is not apparent where in the world its followers may be or how many may be in the UK or EU. The Instagram extract shows that there have been 745 posts, but although the exhibit shows references to ENVIRON, environskincare and www.environskincare.com, there are no references to or images of goods under either RAD or RAD SHIELD. The Twitter evidence shows only a few tweets, dated August 2019 and January 2020, and none mentioning either RAD or RAD SHIELD.

v. Mr Dunn states that **Exhibit GB2** comprises "extracts reproduced from the Opponent's website showing product specimens for the Opponent's RAD and RAD SHIELD suncreams and sunscreens." The images of RAD and RAD SHIELD goods shown are these:





vi. The images are undated and Mr Dunn does not say which territory this evidence relates to. Again, there is no reference to the UK or the EU or to pounds sterling or Euros. In fact, the URL in each of the examples is shown to include the component “za”:

As I understand it, “za” is the Internet country code top-level domain (ccTLD) for South Africa. If the RAD or RAD SHIELD suncreams were offered for sale in the EU or UK, it would have been sensible to have shown their presence on a website directed to consumers in those territories.

vii. **Exhibit GB3** shows copies of certificates from “Biorius”, which Mr Dunn states is a company offering regulatory consulting services. The exhibit shows two “Compliance Certificates”- addressed to “Environ” at an address in South Africa, one dated 20 August 2019 and the other 2 October 2019, attesting that “Even More Sun Care + RAD Antioxidant Sun Cream” and “Even More Sun Care + RAD Shield Mineral Sunscreen” “are compliant under Regulation (EC) No 1223/2009 and may be placed on the European market.” These descriptions match the images shown under Exhibit GB2, but the Exhibit GB3 certificates still fail to establish that those goods were in fact sold in the EU in the relevant period (which ended on 21 September 2020). They simply indicate that as from August and October 2019 the goods appear to have been compliant under the Regulation such that they might potentially have been marketed in the EU. This evidence

does not show actual sales in the 12 - 13 months between the date of the certificates and the end of the relevant period.

viii. Mr Dunn states that “in the UK, the RAD and RAD shield brands are sold via a distributor … iiaa (International Institute for Anti-ageing)”.[7] **Exhibit GB4** is a copy of the distributorship agreement between the Opponent (identified in the document as “the Exporter”) and iiaa Limited (identified in the document as “the Distributor”). Large parts of the 25-page document are redacted, which Mr Dunn states is for reasons of confidentiality. The distribution agreement is signed and dated 17 **December 2013**. Clause 7 of the agreement at Exhibit GB4 identifies, amongst the intellectual property covered by the agreement various trade marks including ENVIRON and RAD. It states that it shall be the responsibility of iiaa Limited “to determine the particulars of all trade marks which form the subject-matter of this clause 7 and which may be registered in the name of the Exporter or Environ or Vivida (as the case may be) from time to time." Clause 8 of the agreement places on the distributor a duty to use its best endeavours to promote and extend sales of the “Products” throughout the “Territory” and to clearly indicate that it is acting as the appointed distributor of the Products in the Territory. The First Schedule defines “Products” as including “cosmetic or medical products within the ENVIRON range of products manufactured by the Exporter in the sole discretion of the Exporter …”.[8] The Second Schedule defines the “Territory” as “United Kingdom of Great Britain and Northern Ireland” and “Republic of Ireland.”

ix. **Exhibit GB5** is stated to comprise extracts reproduced from the Opponent’s UK distributor website showing the Opponent’s RAD products and product description. There is no reference to RAD SHIELD in the exhibit. The product description of the RAD suncream is shown below, along with an image of the product, which differs from the images in Exhibit GB2, but where the brand RAD is clearly visible.

7 Paragraph 9 of his witness statement

8 In addition to such goods under that (fairly loose) description, the “Products” also cover “dietary supplements” and “all other products” in respect of which the Exporter has distributorship right in relation to the Territory.

ENVIRON® +

RAD SPF 15

Environ RAD sunscreen is a sun protection cream. The sun filters and sun reflectants contained in this product provide a SPF 15 while natural antioxidant vitamins increase sun protection and assist in fighting free-radicals.

- Contains organic sun filters, namely Butyl Methoxydibenzoylmethane (UV-A) and, Octyl Methoxycinnamate (UV-B)
- Contains antioxidants, beta-carotene and vitamins C and E.
- Contains Titanium Dioxide

iiaa

The exhibit does not show the date on which the image appeared on the iiaa website, so it is not possible to know whether it was there during the relevant period. Nor is it apparent how the product is targeted to the UK,[9] still less that it was available for sale in relevant period. The exhibit includes a link to "Find a Stockist" and "Become a Stockist" – but this exhibit shows no stockists offering the product during the relevant period.

x. Mr Dunn states that sales of RAD-branded products within the UK for the relevant period totalled nearly £725,000 from the sale of over 82,000 units.[10] **Exhibit GB6** is said to be a sample of invoices from the Opponent's UK distributor (iiaa) over the period 2015 - 2020, showing "actual sales" of the Opponent's RAD and RAD SHIELD products in the relevant territory. The values shown on the invoices are in pounds sterling, addressed to businesses in the UK and the invoices include explicit reference to the RAD and to RAD SHIELD.

xi. However, I have some reservations about the corroborative strength of what is shown in Exhibit GB6. The exhibit shows around 140 invoices spanning 8 January 2015 - 11

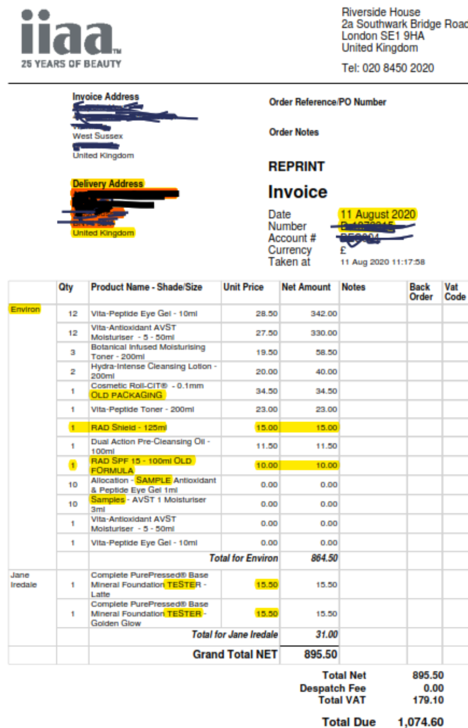
9 (Nor EU – except to the extent that beneath the image above is an EU-formulated web address: "iiaa.eu".)

10 At paragraph 11 of his witness statement.

August 2020. More or less every one of the invoices is addressed to a different company in the UK - there is virtually no evidence of any repeat orders. Each of the invoices across the five years is in respect of very small quantities – indeed most of the invoices the quantity is indicated as just 1 x 100 ml "RAD SPF 15 - 100ml OLD FORMULA Code: 3304990000", though some invoices show quantities of 2, 3, 4, 5 or so, and a few show the quantity as 12.[11] All of the invoices that mention RAD SPF 15 are identified as "OLD FORMULA" and/or "VOID".[12]

xii. The impression I take from the invoices in this exhibit is that insofar as they relate to RAD products they are essentially samples of products, though I accept that the invoices generally show a unit price (of £10) for each of the 100 ml products, whereas other goods that are explicitly listed as "SAMPLE" show no unit price and are thus free samples.

xiii. Of the 140+ invoices exhibited, only 20 include reference to "RAD SHIELD". All of those 20 invoices are dated between 3 – 11 August 2020 (right at the end of the relevant period). Most were again for small quantities – typically 1 x 125 ml for £15, though several were for 5 x 125 ml and one was for 10.[13] An example invoice is shown below (where, cautious of data protection, I've attempted to redact the recipient details):



iiaa
25 YEARS OF BEAUTY

Riverside House
2a Southwark Bridge Road
London SE1 9HA
United Kingdom

Tel: 020 8450 2020

Invoice Address
West Sussex
United Kingdom

Order Reference/PO Number

Order Notes

REPRINT

Invoice

Delivery Address
United Kingdom

Date 11 August 2020
Number
Account #
Currency £
Taken at 11 Aug 2020 11:17:58

	Qty	Product Name - Shade/Size	Unit Price	Net Amount	Notes	Back Order	Vat Code
Environ	12	Vita-Peptide Eye Gel - 10ml	28.50	342.00			
	12	Vita-Antioxidant AVST Moisturiser - 5 - 50ml	27.50	330.00			
	3	Botanical Infused Moisturising Toner - 200ml	19.50	58.50			
	2	Hydra-Intense Cleansing Lotion - 200ml	20.00	40.00			
	1	Cosmetic Roll-CIT® - 0.1mm OLD PACKAGING	34.50	34.50			
	1	Vita-Peptide Toner - 200ml	23.00	23.00			
	1	RAD Shield - 125ml	15.00	15.00			
	1	Dual Action Pre-Cleansing Oil - 100ml	11.50	11.50			
	1	RAD SPF 15 - 100ml OLD FORMULA	10.00	10.00			
	10	Allocation - SAMPLE Antioxidant & Peptide Eye Gel 1ml	0.00	0.00			
	10	Samples - AVST 1 Moisturiser 3ml	0.00	0.00			
	1	Vita-Antioxidant AVST Moisturiser - 5 - 50ml	0.00	0.00			
	1	Vita-Peptide Eye Gel - 10ml	0.00	0.00			
			Total for Environ	*864.50*			
Jane Iredale	1	Complete PurePressed® Base Mineral Foundation TESTER - Latte	15.50	15.50			
	1	Complete PurePressed® Base Mineral Foundation TESTER - Golden Glow	15.50	15.50			
			Total for Jane Iredale	*31.00*			
			Grand Total NET	**895.50**			

Total Net 895.50
Despatch Fee 0.00
Total VAT 179.10

Total Due 1,074.60

11 For instance pages 131 and 192 of 224.

12 There are also numerous references to "VOID" and/or "DISCONTINUED" e.g. page 47; and page 79 lists 10 x 10ml RAD SPF 15 but with the words "DO NOT USE".

13 Pages 197, 199, 200 for instance and page 208.

xiv. Mr Dunn states that RAD and RAD SHIELD products are sold through several stockists in the UK and that extracts from stockists' websites are shown in **Exhibit GB7**. Mr Dunn names nine stockists, reflected in the websites shown in Exhibit GB7. Each of those website extracts shows offers for sale of 100ml tubes of "ENVIRON RAD ANTIOXIDANT SUN CREAM SPF 15" – no reference is shown to RAD SHIELD at all. I accept that the websites appear to target the UK (e.g. with co.uk suffix and prices in pounds), but it is not clear that the goods shown were offered during the relevant period, since Mr Dunn uses the present tense in his statement ("are sold") and no dates are shown in the exhibit, except insofar as page 5 of the exhibit shows the copyright for the SkinAddict page as 2021, which is after the relevant period. I also note that only two of those nine named by Mr Dunn seem to feature among the invoices shown in Exhibit GB6, namely: The DermaCompany, which was invoiced for 4 units of "old formula" RAD SPF (total £40) on 22 June 2015 and for 5 units of RAD SHIELD (total £75) on 5 August 2020; and Chelleon, which on 2 October 2015 was invoiced for 12 units of "old formula" RAD SPF (total £120). It is not clear how the 2015 invoices square with the certification of RAD SPF products for marketing in the EU only from August 2019 indicated by Exhibit GB3.

xv. Mr Dunn states that he encloses print outs from iiaa's Facebook page and Instagram accounts to demonstrate "advertisements relating to RAD products within the relevant period". **Exhibit GB8** is an extract from iiaa facebook and is dated 22 July 2016, though it is not clear that it is directed to the UK or EU since the accompanying symbol looks like a globe and the reference to "festival" is unexplained:

We've got you covered from head to toe with our top festival products!

26

In any event the page garnered only 26 "likes" and the RAD product is not especially prominent in the accompanying image, which I reproduce below:

Contrary to Mr Dunn's statement, Exhibit GB8 did not appear to include any Instagram evidence from iiaa.

xvi. **Exhibit GB9** shows Instagram posts from eight third parties, with dates ranging from January 2018 – August 2020, showing images of a tube of Environ's RAD SPF, in various settings – e.g. on a tennis racquet at Wimbledon time, on a shelf in an unnamed store, on a garden table, or backed by snow-capped slopes. I accept that the eight third-party Instagram posts date from within the relevant period and they appear directed at the UK since they contain references to various UK cities such as Leeds, Oxford and Edinburgh and the hashtags include #skincareuk #environuk, #environoxfordshire as well as #iiaa and #environrad. However, there is generally no explanation of the context for the posts and only two of the posts contain any reference to the product price or where it may be purchased. Each of the posts is shown to have garnered some "likes", but number only between 7 – 35.

xvii. The final piece of evidence is **Exhibit GB10**, which, as Mr Dunn states, is a product review article from *Women Stuff*, dated 4 August 2020, entitled "Review: Environ launches new RAD Shield mineral sunscreen." While this article dates from the month just before the end of the relevant period, its evidential value towards establishing use, reputation or goodwill in the UK or EU is virtually nil, since the article is one that appeared on a South Africa website – as discernible from the "za" domain code. The article makes no reference to the UK or EU and there is no evidence of whether customers in the relevant territory would have encountered the article.

ASSESSMENT OF GENUINE USE

12. I have previously set out the legislative provisions under section 6A of the Act relating to proof of use, and the evidential burden on the opponent under section 100. In determining what conclusions I may draw from the evidence filed, I bear in mind the principles of the law relating to genuine use of a registered trade mark summarised by Arnold J (as he then was), in *Walton International Ltd & Anor v Verweij Fashion BV.*[14] This summary includes, inter alia, that genuine use means actual use of the trade mark by the proprietor or a third party acting with consent to use the mark, and that such use must be by way of real commercial exploitation of the mark on the market, for the relevant goods or services, sufficient to create or maintain a market share for those goods or services.[15] The use must be more than merely token, although there is no *de minimis* rule in relation to genuine use, and it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use. The use must be consistent with the essential function of a trade mark which includes for example, affixing the mark to the relevant goods in order to guarantee to the consumer that the goods come from a single undertaking which controls the manufacture of those goods, and which is responsible for their quality.

13. In determining whether there is real commercial exploitation of the mark, all the relevant facts and circumstances must be taken into account, which include: (1) 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; (2) the nature of the goods or services; (3) the characteristics of the market concerned; (4) the scale and frequency of use of the mark; (5) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (6) the evidence that the proprietor is able to provide; and (7) the territorial extent of the use.

14. A finding of genuine use does not depend on economic success or large-scale commercial use;[16] rather, it is concerned with the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods and services.

15. While the onus is on the Opponent to have filed evidence of genuine use of its mark, I must consider what the evidential picture as a whole shows me, not whether each piece of

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14 [2018] EWHC 1608 (Ch), paragraphs 114 and 115 detail the summary in full.
15 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.
16 *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

evidence shows use by itself.[17] Whilst there is no requirement for the Opponent to produce any specific form of evidence, in *Awareness Limited v Plymouth City Council,*[18] the Appointed Person stated that:

> *22.* […] *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 (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.*
>
> […]
>
> *28.* […] *Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered* […]*."*

16. My account of the evidence earlier in this decision made clear that I found there to be significant shortcomings in the evidence. The question is whether I consider the evidence taken *as a whole* convinces me that there has been genuine use of the earlier registrations in the UK (since there is no evidence at all bearing out use in the European Union). There are various factors that weigh unfavourably for the Opponent, including the sometimes-loose statements from Mr Dunn, and an impression that the evidence strains to establish its premises, which raises the question as to why, if it exists, more convincing evidence was not filed.

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[17] *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.
[18] Case BL O/236/13, paragraph 22 and 28.

17. Some of the criticisms that I have made of the individual exhibits are such that those exhibits carry little or no weight even in a cumulative overview of the whole and may fairly be discounted in this assessment of genuine use. These include the website and social media content of Exhibits GB1 and GB2. I accept, in light of Exhibit GB3, that the suncreams under the marks appear to have met regulatory requirements for use in the EU as from August and October 2019 - the evidence is silent as to the position before those dates; I accept that the Opponent had an agreement covering distribution of RAD products in the UK.[19] The evidence contains no direct account from iiaa Limited, which is the Opponent's UK distributor, as to the extent of relevant branded goods sold during the relevant period in the UK (nor from any distributor covering the EU) and the undated website extracts at Exhibit GB5 do not assist. The stockists' website extracts at Exhibit GB7 show no use during the relevant period. The published article at Exhibit GB10, shows no relevant use, and tends to indicate that sunscreen under the RAD SHIELD mark was launched as late as the month before the end of the relevant period.

18. However, I do not overlook that Mr Dunn's witness statement provides narrative evidence as to sales of RAD-branded products within the UK for the relevant period specifying a total "value in sales" of nearly £725,000 from the sale of over 82,000 units.[20] This evidence has not been challenged, and while I have made some critical observations about the invoices at **Exhibit GB6**, they do tend to support that there were sales of the Opponent's RAD suncream in the UK across the relevant period and of the RAD SHIELD sunscreen in the final weeks of the relevant period. The marks RAD or RAD SHIELD have been used in conjunction with the ENVIRON house-brand, which is acceptable for the purposes of establishing genuine use.[21] Mr Dunn gives no account of any relationship between the Opponent (or iiaa) and the third parties whose posts on Instagram posts are shown at Exhibit GB9, so it is not clear that this is use with the consent of the Opponent (as the legislation requires), and even if it may be said that the Opponent would likely consent to any promotion of the marks by third parties, the reach of the posts is shown to have been negligible (in their number of likes). However, the third-party posts (with their various UK references) do at least support the position that Environ's RAD SPF 15 sunscreen had some presence in the UK market during the relevant period.

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19 Exhibit GB4

20 At paragraph 11 of his witness statement.

21 See ruling in Colloseum Holding AG v Levi Strauss & Co [2013] C–12/12 WLR (D) 14332, where paragraph 32 confirms that use may be in conjunction with another mark.

19. I bear in mind relevant factors from the case law: the suncream market in the EU and UK is undoubtedly very large; suncreams are used by the general public at large, with some variation in price between the lower- and higher-end offerings; the territorial evidence is limited to the UK, since there is no evidence of use elsewhere in the EU, but use in the UK is sufficient for the present purposes. The scale of the use of the two earlier registrations in the UK over the five-year period is stated to be in excess of 82,000 units, which strikes me as relatively modest, but the Opponent's goods are not at the lowest end of the market (seemingly retailing at around £20 for 100ml)[22] and those numbers certainly appear more than token.

20. The Opponent's evidence does not make clear which goods sold under which marks make up that total of 82,000 units, but the evidence clearly majors on the RAD mark. Since the goods in evidence covered by the two marks are essentially equivalent (both being sunscreens in the form of skin creams) the smaller portion of sales attributable to the RAD SHIELD mark offers no advantage to the Opponent. This is because the Opponent's RAD mark is clearly identical to the Contested Mark, whereas the additional word SHIELD differs from the Contested Mark. Moreover, the evidence of use of RAD SHIELD is very limited indeed and catches only the very last month of the relevant period, such that I am dubious that the use shown satisfies the requirements for genuine use, especially given the total absence of evidence of use of that EU registration elsewhere in the relevant territory (other than the UK).

21. In the circumstances, my approach shall be to proceed in this decision on the basis that I find the evidence succeeds in establishing use warranted in the economic sector concerned to maintain or create a share in the market under the Opponent's RAD Mark for a sun-protection skin cream. It follows that it will be unnecessary to consider the section 5(2)(b) claim (which is based on the First Earlier Registration) since it will offer no prospect of greater success than may be achieved by the section 5(2)(a) ground.

22. I note that the Opponent's the First Earlier Registration for the word mark RAD specifies the term "cosmetics". The Opponent's claim is framed on the basis of its use of the mark for "cosmetics, namely sun cream and sunscreen". The average consumer would understand

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22 Exhibit GB9 includes an Instagram post by skinroom_uk, dated July 2020 which refers to a gift of "RAD SPF15, worth £19.95.

the term “cosmetics" to refer to a product meant to be applied to the human body, especially the face, for the purpose of beautifying or cleansing. I accept that the Opponent’s registration for “cosmetics” is apt to cover skin-care creams formulated to guard against the harmful effects of the sun.

23. Where proof of use of an earlier mark is validly requested and the submitted evidence is sufficient only for part of the goods listed, the earlier mark is deemed registered for only those goods and any analysis as part of an opposition action is consequently restricted. In *Euro Gida,*[23] Geoffrey Hobbs (then QC) sitting as the Appointed Person explained that “*… fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned*.” In the present case, I am content to frame a fair specification that partly mirrors the terms claimed by the Opponent itself, namely “*sun cream and sunscreen*”.

DECISION ON THE SECTION 5(1) CLAIM

24. As set out in the statutory provisions at my paragraph 6 above, a contested mark shall be refused registration where it is identical to an earlier mark and the goods are identical. The Contested Mark is shown here:

Although the Contested Mark is characterised in the register as a figurative mark, I find it will be seen as essentially a word comprised of the letters R A D and it is identical to the Opponent’s RAD Mark, which is registered as a plain word mark and may therefore fairly be used in precisely the font, style and colour of the Contested Mark.

25. For the Opponent to succeed under this ground, the only other matter to determine is the extent to which the goods are identical. Based on the fair specification given above, the

23 *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10. See also 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).*

goods on which the Opponent is able to rely under the First Earlier Registration are "*sun cream and sunscreen*". The Contested Goods are those of the Holder in Class 3, namely:

Abrasives; breath freshening sprays; balms, other than for medical purposes; lip glosses; petroleum jelly for cosmetic purposes; cotton wool for cosmetic purposes; adhesives for cosmetic purposes; scented water; lavender water; toilet water; depilatory wax; mustache wax; creams for leather; massage gels, other than for medical purposes; dental bleaching gels; make-up; deodorants; depilatories; perfumes; perfumery; decorative transfers for cosmetic purposes; eyebrow pencils; cosmetic pencils; adhesives for affixing false eyelashes; adhesives for affixing false hair; hair conditioners; cosmetic creams; skin whitening creams; hair sprays; nail polish; hair lotions; lotions for cosmetic purposes; aftershave lotions; cosmetic masks; perfume oils; cosmetic oils; oils for toilet purposes; essential oils; oils for cleaning purposes; cleansing milk for toilet purposes; soaps, except soaps for babies; cosmetic kits; nail art stickers; artificial nails; pumice stone; lipstick cases; hydrogen peroxide for cosmetic purposes; breath freshening strips; teeth whitening strips; abrasive cloth; glass cloth (abrasive cloth); lipstick; pomades for cosmetic purposes; shaving preparations; cosmetic preparations for baths; bath preparations, not for medical purposes; hair straightening preparations; hair waving preparations; color-removing preparations; denture polishes; mouthwashes, not for medical purposes; nail polish removers; make-up removers; nail care preparations; denture cleaning preparations; aloe vera preparations for cosmetic purposes; sunscreen preparations; breath freshening preparations for personal hygiene; make-up powder; nail varnish removers; artificial eyelashes; bath salts, not for medical purposes; eyebrow cosmetics; make-up products; sun-tanning preparations (cosmetics); hair dyes; neutralizers for permanent waving; cosmetic preparations for eyelashes; cosmetic preparations for skin care; cosmetics; cosmetics for children; mascara; toiletry preparations; phytocosmetic preparations; talcum powder, for toilet use; cotton swabs for cosmetic purposes; henna [cosmetic dye]; dry shampoos; shampoos; herbal extracts for cosmetic purposes; extracts of flowers (perfumes); ethereal essences; all of the above-mentioned goods, except for babies.

26. As the Opponent submitted, it is settled case law that there is identity between the respective goods not only where the terms coincide or have the same meaning, but also where the goods covered by the earlier mark are included in the more general category covered by the

trade mark application or vice versa.[24] The submissions in lieu argued that the following from the Contested Goods are therefore identical to the Opponent's *sun cream and sunscreen*.

i. *balms, other than for medical purposes*;
ii. *cosmetic creams*;
iii. *lotions for cosmetic purposes*;
iv. *cosmetic kits*;
v. *aloe vera preparations for cosmetic purposes*;
vi. *sunscreen preparations*;
vii. *sun-tanning preparations (cosmetics*);
viii. *cosmetic preparations for skin care*;
ix. *cosmetics*;
x. *toiletry preparations*;
xi. *phytocosmetic preparations*

27. I find that I accept the Opponent's submissions in that regard.

28. The Opponent's *sun cream and sunscreen* clearly have the same meaning as the terms *sunscreen preparations* and *sun-tanning preparations (cosmetics)* among within the Contested Goods.

29. The fair specification of *sun cream* and *sunscreen* derives from the wider term "cosmetics" specified under the Opponent's First Earlier Registration; I have therefore concluded that *sun cream* and *sunscreen* are goods that may fall within the scope of the wider term "cosmetics". In view of the case law principle that goods designated under an earlier mark may be considered as identical where they are included in a more general category designated by a trade mark application, I find that *sun cream* and *sunscreen* are covered by, and therefore identical to, the following Contested Goods: *cosmetic creams*; *lotions for cosmetic purposes*; *cosmetic preparations for skin care*; *cosmetics*. By the same token, I find *cosmetics for children* also identical.

30. The Holder's *phytocosmetic preparations* are cosmetic preparations derived from plants, as of course are *aloe vera preparations for cosmetic purposes* – both terms could include *sun cream* and *sunscreen,* which are thus identical goods.

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24 (see *Case T-133/05 Gérard Meric v Office for Harmonisation in the Internal Market* and *Case T-522/10 Hell v OHIM*)

31. Are *balms, other than for medical purposes* identical to *sun cream* and *sunscreen*? It seems to me a balm and a cream are essentially the same species of goods, and a lip balm may include a sunscreen. I am therefore content to find these Contested Goods also identical.

32. The Holder's *cosmetic kits* could be curated to comprise various versions of *sun cream* and *sunscreen* and I am therefore again content to find these Contested Goods identical.

33. That just leaves *toiletry preparations*. As I understand it, toiletries are articles used in washing and taking care of one's body, such as soap, shampoo, antiperspirant, toothpaste and face creams. The Nice Classification heading for Class 3 includes "Non-medicated cosmetics and toiletry preparations", thus listing toiletry preparations separately from, but together with cosmetics; I find this offers no great assistance in interpretation of the scope of the term *toiletry preparations.*[25] It is a term whose scope does not seem to me sharply delineated, nor does it seem an undue stretch to include a suncream or sunscreen among those goods for taking care of body or face. I am therefore again content to find these Contested Goods also identical.

34. **OUTCOME UNDER SECTION 5(1):** The opposition succeeds under section 5(1) in relation to the goods listed (i) – (xi) at my paragraph 26 above (as well as *cosmetics for children*). It fails in respect of the other Contested Goods, which are not identical.

DECISION ON THE SECTION 5(2)(a) CLAIM

35. I turn next to consider whether the opposition succeeds further based on the claim that the marks are identical and the goods are similar such that there is a likelihood of confusion. An assessment under section 5(2)(a) is multi factorial and the claim must be determined in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

25 While classification is primarily an administrative convenience, case law has acknowledged the potential for classification considerations to assist in interpretation in some instances – see for instance *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited),* [2018] EWHC 3608 (Ch), paragraph 94.

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.[26] The relevant principles are:

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

(e) 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;

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

(g) 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;

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

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26 Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to retained EU trade mark case law.

Comparison of the goods

36. Section 60A(1)(a) of the Act provides that for the purpose of the Act goods and services 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.

37. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[27]

i. the physical nature of the goods;

ii. their intended purpose;

iii. their method of use / uses;

iv. who the users of the goods and services are;

v. the trade channels through which the goods reach the market;

vi. 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

vii. 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);

viii. whether they are complementary to each other. Complementary has been described as meaning 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"*.[28] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[29] Complementarity should be distinguished from 'use in combination', where goods are merely used together, whether by choice or convenience

[27] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

28 *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82

29 *Kurt Hesse v OHIM, Case C-50/15 P*

(e.g. bread and butter; or wine and wine glasses[30]) but are not essential or important to one another's use such that they would be assumed to share source.

38. I bear in mind too that when interpreting terms in a specification 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"*.[31]

39. For the purposes of making a comparison, goods can be grouped together where the same reasoning applies.[32]

40. Before I consider the Contested Goods beyond those that I have earlier found to be identical for the purpose of section 5(1), I should say that if I am wrong in any of my findings of identical goods under section 5(1), then I would consider those goods at least sufficiently similar to the Opponent's fair specification goods to give rise to a likelihood of confusion under section 5(2(a), based on factors for instance of potentially shared purpose, nature and method of use.

41. The Opponent's submissions in lieu referred to an earlier decision by the EUIPO that had found goods that comprised various oral hygiene preparations, perfumery and body cleaning and beauty care preparations to be "at least similar to a low degree to the opponent's sun screen preparations".[33] The reasoning for similarity given in that first instance EUIPO decision was that "[those] goods may coincide in their producers and end users with the opponent's sun care preparations and they are offered usually via the same distribution channels. Furthermore, they may have the same purpose."

42. The goods in that case included most of the remaining Contested Goods such as *abrasives; massage gels, other than for medical purposes; bath preparations, not for medical purposes;*

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30 As Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL-0-255-13 - *"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."*

31 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

32 *Separode Trade Mark* BL O/399/10, paragraph 5

33 EUIPO's decision in Opposition No. B3124042 dated 1 February 2022.

lipstick; cosmetic masks; skin whitening creams; mouthwashes, not for medical purposes; nail polish; hair dye; hair-waving preparations; cosmetics for eye-lashes; cosmetic pencils; lavender water; toilet water; depilatory preparations; mascara; cleansing milk for toilet purposes; hair spray; breath freshening sprays; soaps; deodorants for human beings; after-shave preparations; cotton wool for cosmetic purposes; tissues impregnated with make-up removing preparations.

43. The decision highlighted by the Opponent is of course not binding on a tribunal in the UK. The Opponent argued further that the similarity between the goods was greater than that estimated by EUIPO Opposition Division.[34] The Opponent submitted that the goods "are sold in close proximity with each other (e.g. beauty shops or the same sections of department stores), so have the same distributions channels; they share the same relevant consumer (e.g. consumers who wish to enhance or maintain their appearance and personal hygiene); and are usually provided by the same types of undertakings (e.g. cosmetics / beauty / self-care companies). The Opponent submitted that "the respective goods in the present proceedings are similar to at least an average degree, if not to a high degree, in view of the shared relevant consumer, distribution channels and usual origin (the latter, in particular, being considered a "strong factor" in the assessment of the similarity between goods, due to its strong impact on likelihood of confusion)."

44. In my view, most of the remaining Contested Goods have only a low degree of similarity with suncreams/sunscreens. The Opponent has filed no evidence to make good its submission as to usual origin, and it does not seem to me obvious that those who produce sun creams typically also produce the other goods such as: hair spray; mascara; cotton wool; deodorants; hair dyes; depilatory wax; adhesives for affixing false eyelashes; adhesives for affixing false hair; hair conditioners - and so on. I accept that the goods may all be purchased from say a chemist's shop and may be located in the same approximate section of a supermarket, but lots of diverse goods are found in such places. Here the nature and method of use of the goods tends to differ and the central difference of the goods having different purposes leads to my lower estimation of the degree of similarity. The goods are not in competition, nor complementary. Since suncreams / sunscreens are bought by the general public at large, I find the significance of any overlap in consumer to be very limited.

34 See paragraphs 41 – 43 of Opponent's submissions in lieu.

Therefore, except as otherwise indicated below, I consider the Contested Goods that I have not previously found to be identical to be similar only to a low degree.

45. A few of the non-identical Contested Goods warrant particular mention. I recall that earlier in this decision I found that *balms, other than for medical purposes* may be considered identical to *sun cream* and *sunscreen*, since a balm may include a cream and a lip balm may include a sunscreen. I have also alternatively found *balms, other than for medical purposes* sufficiently similar to succeed under section 5(2)(a). I now therefore consider the extent to which similar reasoning should carry across to *cosmetic oils; oils for toilet purposes*. In my view, ***cosmetic oils*** and ***oils for toilet purposes*** may contain sunscreen, so may have the same purpose and be in competition with suncreams. They may also be similar in nature and method of use to *sun cream* and *sunscreen*. I consider those goods similar to a medium degree.

46. Petroleum jelly may be an ingredient in lip (and other) balms, and such balms may offer relief or protection from the effects of the sun. A good that is an ingredient in another good does not of itself make it similar to that good. However, I recognise that ***petroleum jelly for cosmetic purposes*** may be used to soothe and improve the appearance of sun-chapped lips, as an alternative to a suncream, and the degree of similarity is thereby raised, such that I consider those goods similar to a medium degree. I do not, however, make the same finding in respect of the Holder's ***lip glosses****;* though similar in method of use to lip balms, it is my understanding that the purpose of lip gloss is decorative, rather than remedial or preventative – its purpose is to make lips (or lipstick) shiny – not to soothe chapped lips or prevent sun damage. I consider lip gloss to be closer to lipsticks and nail polish as product applied for decoration. Consequently, the degree of simiilarity I accord to lip glosses is not elevated to medium.

47. Earlier in this decision I have accepted that *suncream* and *sunscreen* fall within, and, on the evidence filed, constitute a fair specification of the Opponent's registration for "*cosmetics".* I have also found terms such as *cosmetics*; *lotions for cosmetic purposes; cosmetic kits* under the Holder's Designation are more general categories that may include the Opponent's *suncream and sunscreen* and may therefore be considered identical on the basis of the principle from Meric. With regard to the Contested Goods ***make-up****;* ***make-up products*** and ***make-up preparations***, I find that they are at least very similar, if not identical

to cosmetics,[35] and may be considered similar to a medium degree to *suncream and sunscreen* taking account of factors such as nature, method of use, user, channels of trade, purpose and complementarity. "*Make-up*" includes a foundation cream, which may include a sun protection, and thus may also be in competition with the Opponent's goods.

The average consumer and the nature of the purchasing act

48. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. The word "average" here denotes that the person is typical.[36] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.

49. It is therefore necessary to determine who the average consumer of the respective goods is, and how the consumer is likely to select those goods. 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.[37]

50. The average consumer of the goods at issue will be a member of the general public. The goods are likely to be sold through a range of retail outlets (and their online equivalents) such as chemist's, beauty shops, supermarkets or department stores and via catalogues. The goods are likely to be displayed on shelves where they will be viewed and self-selected by the consumer. A similar process will apply online and with catalogues where the consumer will select the goods having viewed an image displayed on a webpage/page. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants or other consumers. Even where the goods are selected by making requests to staff, the selection process prior to purchase would be visual in nature such that visual considerations accordingly dominate.

51. Whilst the parties' Class 3 goods may range in price, they are not particularly costly goods. They may be bought regularly as part of a daily skin care regime or particularly if the consumer is going to be somewhere sunny. When purchasing the goods, the average

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35 In my view, to find otherwise may, in my view, be "straining the language unnaturally to produce a narrow meaning" - to borrow the phrasing of Daniel Alexander KC in the *YouView TV Ltd* case cited earlier.

36 *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

37 *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV*, Case C-342/97

consumer is likely to consider such things as how it smells or feels - its ease of absorption or oiliness – its SPF factor, whether the ingredients suit their skin type and so on. Still, the goods are affordable consumer items and the selection and purchasing of the goods will not, on average, require an overly considered thought process – no more than a medium level of attention.

Comparison of marks

52. I have found the Opponent's RAD Mark to be identical to the Contested Mark.

Distinctive character of the Opponent's RAD Mark

53. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.[38]

54. In *Lloyd Schuhfabrik*, the Court of Justice of the European Union ("**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-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 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)".

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38 *Sabel* at [24]

55. The Opponent submits that “the word RAD can mean extremely exciting or good.” I accept that that may be so, in which case the mark would be somewhat laudatory, which may tend to lower its distinctive character. However, in the context of the goods under the Opponent’s fair specification - *suncream* and *sunscreen* – it seems likely that the average consumer may also perceive the RAD Mark as a reference or allusion to the goods’ purpose in shielding from rays radiating from the sun.[39] In my view, that three-letter word is not especially distinctive on an inherent basis. The distinctive character of a trade mark may be enhanced through its use, but having regard to the factors from case law identified in my previous paragraph, the extent of use shown in the evidence is not in my view enough to have enhanced the distinctiveness of the mark among the UK public. In reaching that conclusion, I note the great size of the UK market for suncream and sunscreens, the lack evidence of active promotion by the Opponent or iiaa and the relatively modest annual sales. I find the distinctive character of the Opponent’s RAD Mark in respect of suncream and sunscreens to be lower than medium.

Conclusion as to likelihood of confusion

56. I turn now to make a global assessment of likelihood of confusion if the parties’ marks were used concurrently in respect of their respective goods. This assessment takes account of my findings set out in the foregoing sections of this decision and of all of the various principles from case law outlined in my paragraph 35 above.

57. It requires a realistic appraisal of the net effect of the similarities and differences between the marks and the goods in issue, giving the similarities and differences as much or as little significance as the relevant average consumer would attach to them, noting that such a consumer is taken to be reasonably well-informed and reasonably observant and circumspect. The average consumer is a hypothetical person - a legal construct - created to strike the right balance between the various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market.[40]

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39 This certainly strikes me as the more likely interpretation in the context of the RAD SHIELD mark; and even without the SHIELD, the letters may still may be allusive of radiation in the context of sunscreen.

40 *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ, particularly paragraph 34.

58. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

59. The assessment of likelihood of confusion involves factoring in the potential for a greater degree of similarity (or identity) between marks to offset a lesser degree of similarity between the goods. Another favourable factor is that the average consumer will typically exercise no more than a medium level of attention in the purchasing process. I find that given that the marks are identical, **the Opponent's claim under section 5(2)(a) should succeed where I have found the respective goods similar to a medium degree or more**.[41] This is because those goods may potentially share the sun shielding purposes of the Opponent's goods as framed in my fair specification.

60. However, I also take into account that I have found the inherent distinctive character of the Opponent's RAD Mark in respect of suncream and sunscreens to be lower than medium (based on the laudatory and/or allusive possibilities of the word), and its use (alongside the ENVIRON house mark, and extending only to those limited goods) is not of sufficient scale to have enhanced its distinctiveness from the perspective of the relevant average consumer. I therefore find that in respect of any of the goods that I have found to be similar to less than a medium degree, no likelihood of confusion arises, whether direct or indirect. Despite the mark being identical, there will no more than mere association.

61. **OUTCOME UNDER SECTION 5(2)(a):** The opposition under section 5(2)(a) succeeds in respect of the following goods:

    i. *cosmetic oils*
    ii. *oils for toilet purposes*
    iii. *petroleum jelly for cosmetic purposes*
    iv. *make-up products*
    v. *make-up preparations*
    vi. *make-up*

41 The section 5(2)(a) claim would, as I indicated earlier, alternatively succeed for any of the goods that are I have found, if not identical in the alternative, similar.

I reiterate that if any of the goods under section 5(1) are not identical, but merely similar, then those goods - identified at my paragraph 34 above – are alternatively successfully opposed under section 5(2)(a).

THE SECTION 5(3) CLAIM

62. This ground is also directed against all of the Contested Goods. The statutory provision is set out at my paragraph 6 above. The Opponent claims that when the Holder applied for the Designation (21 September 2020 – "**the relevant date**"), the Opponent's RAD Mark had a reputation in respect of *Cosmetics, namely suncream and sunscreen*.

63. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: General Motors, C-375/97, EU:C:1999:408; Intel Corporation Inc. v CPM United Kingdom Ltd, C252/07, EU:C:2008:655; Adidas-Salomon & Anor v Fitnessworld Trading Ltd, C-408/01, Page 34 of 61 EU:C:2003:582; L'Oréal v Bellure, C-487/07, EU:C:2009:378); and Marks and Spencer v Interflora, C-323/09, EU:C:2011:604.. The law appears to be as follows:

    (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

    (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

    (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

    (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

    (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious

likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oréal v Bellure).*

64. The function and value of a trade mark are not confined to its being an indicator of origin of goods or services (which section 5(2)(b) safeguards); a trade mark can also convey messages, such as a promise or reassurance of quality or a certain image of, for example,

lifestyle or exclusivity ('advertising function').[42] Section 5(3) aims at protecting this advertising function and the investment made in creating a certain brand image by granting protection to reputed trade marks, irrespective of the similarity of the goods or services or of a likelihood of confusion, provided that it can be demonstrated that the use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

Reputation

65. In *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC (IPEC), Judge Hacon considered whether an EU trade mark registered for restaurant services had a reputation under article 9(2)(c) of the EU Trade Mark Regulation (which is equivalent to s.10(3) of the Trade Marks Act). The judge summarised the law as follows:[43]

> "69. I draw the following from the judgments of the Court in *PAGO* and *Iron & Smith* and from the opinion of Advocate General Wahl in *Iron & Smith*:
>
> (1) An EU trade mark has a reputation within the meaning of art.9(2)(c) if it was known to a significant part of the relevant public at the relevant date.
> (2) The relevant public are those concerned by the products or services covered by the trade mark.
> (3) The relevant date is the date on which the defendant first started to use the accused sign.
> (4) From a geographical perspective, the trade mark must have been known in a substantial part of the EU at the relevant date.
> (5) There is no fixed percentage threshold which can be used to assess what constitutes a significant part of the public; it is proportion rather than absolute numbers that matters.
> (6) Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria.
> (7) All relevant facts are to be taken into consideration when making the assessment, in particular the market share held by the trade mark, the intensity, geographical

42 (judgment of 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378)
43 See also the CJEU judgment in General Motors, particularly at paragraphs 25, 27 and 28.

extent and duration of its use, and the size of the investment made by undertaking in promoting it.

(8) The market for the goods or services in question, and from this the identity of the relevant public, ought to assume a paramount role in the assessment.

(9) The territory of a single Member State (large or small) may constitute a substantial part of the EU, but the assessment must be conducted without consideration of geographical borders."

66. I note the Opponent's submission that it (presumably Environ) – "is a globally recognised professional skin care brand". If that is so, it is not made out in the evidence. The evidence contains a couple of references to a presence in South Africa, but that is not relevant for the purposes of this decision, which is concerned with the territory of the EU. As I have noted previously, the evidence focuses almost exclusively on the UK, though case law permits that evidence relating only to the UK may be capable of satisfying the requirement for a reputation in a substantial part of the EU.[44]

67. Although the evidence of Mr Dunn's witness statement contains figures relating to sales in the UK over the five-year period up to the relevant date, the Opponent does not break those figures down between the two Earlier Registrations, so it cannot be said with any certainty what proportion of those figures may relate to the Opponent's RAD SHIELD Mark (which the Opponent does not claim as a basis for the present ground).

68. Even taking the stated figures in full - where the "value in sales" within the UK totalled nearly £725,000 over 5 years, from the sale of over 82,000 units - these are not figures that indicate that the Opponent's RAD Mark was known to a significant part of the relevant public in the territory, even if limited to the UK. The claimed goods are bought by the general public. The UK population is somewhere in excess of 65 million people; even discounting heavily from that population total to take into account that many of those constituting the UK general public will lack either the capacity or interest to buy the relevant goods, and even proceeding on the (unlikely) basis that each of those 82,000 sales was to a different individual, that is, in my view, still an insufficiently significant proportion of the relevant public to establish a

44 See Geoffrey Hobbs QC, as a Deputy Judge of the High Court in *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), at paragraph 76.

reputation. I also particularly note the negligible evidence of promotion of the goods (via social media) and total lack of evidence of expenditure on advertising.

69. My conclusion in this regard seems in step with case law. For example, in *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of section 10(3) of the Act, which is the infringement provision that mirrors the terms of the relative ground objection under section 5(3). The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. There had been some awards and press coverage, though only seven such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the geographical aspect of the test but not the economic one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

70. Since I find that the Opponent's evidence has not established the claimed reputation, which is a required component of section 5(3), it follows that the claim must fail. In the circumstances it is not necessary for me to consider whether the necessary mental link would arise, nor the claimed bases of damage.

71. **OUTCOME UNDER SECTION 5(3):** The claim under section 5(3) fails.

THE SECTION 5(4)(A) CLAIM

72. This ground is again directed against all of the Contested Goods. The statutory provision is set out at my paragraph 6 above, and the onus is on the Opponent to satisfy the Tribunal that its unregistered sign would have been protectable by virtue of the law of passing off at **the relevant date** – which again is the date of filing the application, 26 September 2021. The Opponent claims to have used the sign RAD in respect of "*Cosmetics, namely suncream and sunscreen*" throughout the UK since at least 1993.

73. *Requirements for passing off:* The criteria for a passing off claim have been well established through UK case law. As set out in the decision by the House of Lords in *Reckitt & Colman Ltd v Borden Inc*,[45] the following three points must be established in order to claim passing off successfully:

(a) First, the plaintiff must establish a **goodwill** or reputation attached to the goods or services which it supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which its particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiffs goods or services.

(b) Second, the plaintiff must demonstrate a **misrepresentation** by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are the goods or services of the plaintiff.

(c) Third, the plaintiff must demonstrate that it suffers or that it is likely to suffer **damage** by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

Goodwill

74. The first element described in *Reckitt & Colman* refers to "goodwill or reputation", although case law has developed so as to distinguish between goodwill and "mere reputation" – the latter being insufficient alone to sustain a claim of passing off. To satisfy the first element of the tort, the Opponent is required to show that it has goodwill among UK consumers.

75. In *Hart v Relentless Records*, Jacob J. (as he then was) stated his view that "the law of passing off does not protect a goodwill of trivial extent. …. one is looking for more than a minimal reputation."[46] This does not mean that a small business is incapable of establishing goodwill - even though its goodwill may be modest, a business can protect signs which are distinctive of that business under the law of passing off. Thus in Lumos Skincare Ltd v Sweet Squared Ltd,[47] the Court of Appeal upheld a claim for passing off based on the

45 [1990] 1 All E.R. 873
46 Hart & Anor v Relentless Records [2002] EWHC 1984 (Ch) [62]
47 [2013] EWCA Civ 590

claimant's use of the mark "LUMOS" for around three years before the defendant's use of the same mark, even though sales volumes and turnover were modest. In that case, the Claimant sold skincare products under the name LUMOS and alleged passing off by the Defendants' sale of nail care products under the same name. Both parties sold their products to beauty salons whose technicians used the products on their customers. The claimant's products sold for between £40 and £100 each and between early 2008 and September 2009, the claimant had achieved a turnover of around £2,000 for quarter. From the latter date up until the relevant date in October 2010, the claimant's turnover increased to around £10k per quarter and had repeat custom from over 25 retail clients. Even so, the claimant remained a very small business with a modest number of sales, yet the court was prepared to protect the goodwill in that business under the law of passing off. It is also the case that a relatively short period of time may sometimes be sufficient to build up goodwill.[48] Each case turns on the individual facts found in the evidence.

76. As will be clear from my earlier summary of the evidence, the claimed extent of use throughout the UK since at least 1993 is not substantiated. However, just as I have found the evidence sufficient to permit a finding of genuine use of the RAD Mark in respect of *Cosmetics, namely suncream and sunscreen*, based on the sales figures in the five years leading up to the relevant date, so too am I content to find the Opponent to have had actionable goodwill under the RAD sign in respect of the same.

Misrepresentation and damage

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

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

48 The notorious outlier example in this regard being Stannard v Reay [1967] F.S.R. 140, 144

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

79. Having considered a likelihood of confusion under section 5(2)(a), there is in my view no factor in the present case that would lead me to reach a different conclusion on the reach of misrepresentation and consequent damage. The opposition under section 5(4)(a) claim succeeds no further than does the claim based on registered rights under section 5(2)(a).

OVERALL OUTCOME OF OPPOSITION

80. In view of my earlier conclusions under each of the claimed grounds, the Contested Goods of the Holder may proceed to registration in respect of all of the goods in Class 3, except for the 17 specified goods that are marked with strike-through below:

Abrasives; breath freshening sprays; ~~balms, other than for medical purposes~~; lip glosses; ~~petroleum jelly for cosmetic purposes;~~ cotton wool for cosmetic purposes; adhesives for cosmetic purposes; scented water; lavender water; toilet water; depilatory wax; mustache wax; creams for leather; massage gels, other than for medical purposes; dental bleaching gels; ~~make-up~~; deodorants; depilatories; perfumes; perfumery; decorative transfers for cosmetic purposes; eyebrow pencils; cosmetic pencils; adhesives for affixing false eyelashes; adhesives for affixing false hair; hair conditioners; ~~cosmetic creams~~; skin whitening creams; hair sprays; nail polish; hair lotions; ~~lotions for cosmetic purposes~~; aftershave lotions; cosmetic masks; perfume oils; ~~cosmetic oils; oils for toilet purposes;~~ essential oils; oils for cleaning purposes; cleansing milk for toilet purposes; soaps, except soaps for babies; ~~cosmetic kits;~~ nail art stickers; artificial nails; pumice stone; lipstick cases; hydrogen peroxide for cosmetic purposes; breath freshening strips; teeth whitening strips;

abrasive cloth; glass cloth (abrasive cloth); lipstick; pomades for cosmetic purposes; shaving preparations; cosmetic preparations for baths; bath preparations, not for medical purposes; hair straightening preparations; hair waving preparations; color-removing preparations; denture polishes; mouthwashes, not for medical purposes; nail polish removers; make-up removers; nail care preparations; denture cleaning preparations~~; aloe vera preparations for cosmetic purposes; sunscreen preparations;~~ breath freshening preparations for personal hygiene; make-up powder; nail varnish removers; artificial eyelashes; bath salts, not for medical purposes; eyebrow cosmetics; ~~make-up products;~~ ~~sun-tanning preparations (cosmetics);~~ hair dyes; neutralizers for permanent waving; cosmetic preparations for eyelashes; ~~cosmetic preparations for skin care; cosmetics; cosmetics for children~~; mascara; ~~toiletry preparations; phytocosmetic preparations;~~ talcum powder, for toilet use; cotton swabs for cosmetic purposes; henna [cosmetic dye]; dry shampoos; shampoos; herbal extracts for cosmetic purposes; extracts of flowers (perfumes); ethereal essences; all of the above-mentioned goods, except for babies.

81. The Designation of International Registration No. 1581221 may of course proceed to registration in relation to the goods and services that were not opposed, namely those designated in Classes 5, 8, 18, 20, 21, 26 and 35.

COSTS

82. Both parties have achieved a degree of success in this opposition, but the greater proportion of the Contested Goods were not successfully opposed. In the circumstances, I award a proportionate contribution towards the Holder's costs in reviewing the statement of grounds, preparing the brief counterstatement and considering the other side's evidence, estimated in line with the scale set out in Tribunal Practice Notice 2/2016.

83. I order Environ Skin Care (Proprietary) Limited to pay LLC Crystal Management company the sum of £300, to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 11th day of September 2023

Matthew Williams
For the Registrar