

O/0871/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER UK00003907269
BY DERMO VENTURES LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**



IN CLASSES 3 AND 35

AND

**AN OPPOSITION THERETO UNDER NUMBER 442596
BY NEXT RETAIL LIMITED**

BACKGROUND

Substitution

1. On 18 August 2023, Seraphine Limited (“the former Opponent”), brought this opposition. Following the administration of the former Opponent, Next Retail Limited (“the Opponent”) was substituted into these proceedings, providing, on 20 October 2025, the necessary undertakings with regard to: (i) confirming having had sight of all papers; (ii) standing by the pleadings of the former Opponent; and (iii) accepting liability for any costs that may be awarded against it.

2. The Opponent, following effective assignment on 30 July 2025, is the owner of the marks relied upon in these proceedings.

Pleadings

3. On 2 May 2023, Dermo Ventures Limited (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the Applicant’s mark”). The application was accepted and published for opposition purposes on 19 May 2023 in respect of goods in Class 3 and services in Class 35. These will be listed later in this decision.

4. The Opponent opposes the application in full, based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3) the Opponent relies upon the following two registered trade marks:

Trade mark number UK00003174272 (“the first earlier mark”)

Representation: seraphine

Filing date: 12 July 2016

Registration date: 5 May 2017

Goods and services relied upon:

Class 3: *Soaps, perfume, cosmetics, lotions.*

Class 25: *Clothing, maternity clothes, headgear and coats.*

Class 35: Retail services connected with clothing, headgear, cosmetics, maternity garments and clothing accessories.

Trade mark number UK00908786352¹ (“the second earlier mark”)

Representation: Séraphine

Filing date: 29 December 2009

Registration date: 10 December 2010

Goods and services relied upon:

Class 9: *Downloadable electronic publications; electronic publications downloadable from a website.*

Class 25: Clothing, headgear.

Class 35: The bringing together for the benefit of others, of a variety of clothing, headgear, cosmetics, maternity garments and accessories, nursing apparel and accessories, enabling customers to conveniently view and purchase those goods in a retail store.

5. The registered marks relied upon by the Opponent are considered earlier marks in accordance with section 6(1)(a) of the Act given they were filed for registration earlier than the date of application for the Applicant's mark. Additionally, the marks had been registered for at least five years at the date of application for the Applicant's mark and so, in accordance with section 6A of the Act, the marks are subject to proof of use. The Opponent made a statement of use for both marks in relation to all the goods and services relied upon.

6. Under section 5(2)(b), the Opponent relies upon all of the goods and services listed under the respective earlier marks at paragraph 4, above. The Opponent claims that its earlier marks are similar to the contested mark and that the parties' respective goods and services are identical or similar, resulting in a likelihood of confusion.

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark (“EUTM”). As a result of the opponent having an EUTM protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

7. Under section 5(3), the Opponent relies upon the goods and services underlined at paragraph 4, above, for which it claims to have a reputation in its earlier marks in the UK. The Opponent claims that use of the Applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

8. Under section 5(4)(a), the Opponent relies upon the unregistered sign "SERAPHINE", which it claims to have used throughout the UK since March 2002 in relation to the following goods and services:

Soaps, perfume, cosmetics, lotions.

Clothing; maternity clothes; headgear, coats.

Retail services connected with clothing, headgear, maternity garments and clothing accessories.

The bringing together for the benefit of others, of a variety of clothing, headgear, maternity garments and accessories, nursery apparel and accessories, enabling customers to conveniently view and purchase those goods in a retail store.

9. The Opponent claims to have generated a goodwill in "SERAPHINE" in the UK and that use of the Applicant's mark would constitute a misrepresentation to the public that would damage the Opponent's goodwill. Therefore, use of the mark would be contrary to the law of passing off.

10. The Applicant filed a defence and counterstatement essentially denying each ground of opposition. The Applicant requested proof of use of the earlier marks in relation to their entire specifications. However, the Opponent relies only on some of the goods and services for which each earlier mark is registered; it is those, only, for which proof of use will be required. The Applicant has put the Opponent to proof of its claimed reputation and goodwill for the relevant grounds of opposition.

11. Both parties filed evidence in chief in these proceedings and the Opponent filed evidence in reply. Neither party requested a hearing but both parties filed written

submissions in lieu. The Opponent is represented by Marks & Clerk LLP;² the Applicant is unrepresented.

Preliminary issue

12. The Applicant, in its counterstatement, has made numerous submissions which, for various reasons, are not relevant to these proceedings. These submissions include, for example, the Applicant's reasons for applying for its mark, the parties' marketing strategies, the Opponent's branding and trade mark application strategies and the number of 'SERAPHINE' marks on the register, amongst others.

13. There is no obligation on me to discuss every argument raised by the parties: this was reiterated recently by Mr Phillip Johnson, sitting as the Appointed Person in the decision at BL O/0121/26. At paragraph 12, Mr Johnson cited *Eagil Trust Co Ltd v Pigott-Brown* [1985] 3 All ER 119, 122 and *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, [2014] FSR 2, in which Lewison LJ explained, at paragraph 115:

"The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted [...]."

14. Accordingly, due to the volume of irrelevant submissions, where I have not addressed any, it is as a consequence of them being immaterial to the decisions I am required to make.

² The former Opponent was represented by Fox Williams LLP.

EVIDENCE

15. The Opponent's evidence in chief is in the form of the first witness statement of Heather Wood ("HW WS1") dated 29 April 2024 and its corresponding seven exhibits (HW1-HW7). Heather Wood made the statement in her capacity as Chief Financial Officer of the former Opponent.

16. The Applicant filed evidence in chief in the form of the witness statement of Tomas Serafinavicius ("TS WS") dated 27 June 2024 and its corresponding fourteen exhibits (TS1-TS14). Tomas Serafinavicius is the director and owner of the Applicant.

17. The Opponent's evidence in reply is in the form of the second witness statement of Heather Wood ("HW WS2") dated 22 August 2024 and its corresponding five exhibits (HW8-HW12).

18. I have taken the entirety of the evidence into account in reaching this decision and will refer to it below where necessary. As there was no hearing, this decision is taken following a careful consideration of all the papers before me.

DECISION

Relevance of EU law

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

Proof of use

Statutory provisions

20. Section 6A of the Act states:

“(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.”

21. As the second earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union.”

Relevant case law

22. 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 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 Bunderversammlung 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 or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence

that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

The relevant period

23. For the purposes of these proceedings, the relevant period in which the Opponent must demonstrate genuine use of its earlier marks is the five-year period ending with the date of application for the Applicant’s mark, i.e., 3 May 2018 to 2 May 2023 (“the relevant period”). Use in the EU will be relevant for the part of the relevant period falling prior to IP completion day, i.e. 3 May 2018 to 31 December 2020.

Goods and services

24. The Opponent relies upon its first and second earlier marks for the goods and services shown below. It is these which the Opponent must demonstrate genuine use for within the relevant period.

- i. The first earlier mark –

- Class 3: *Soaps, perfume, cosmetics, lotions.*
- Class 25: *Clothing, maternity clothes, headgear and coats.*
- Class 35: *Retail services connected with clothing, headgear, cosmetics, maternity garments and clothing accessories.*

ii. The second earlier mark –

- Class 9: *Downloadable electronic publications; electronic publications downloadable from a website.*
- Class 25: *Clothing, headgear.*
- Class 35: *The bringing together for the benefit of others, of a variety of clothing, headgear, cosmetics, maternity garments and accessories, nursery apparel and accessories, enabling customers to conveniently view and purchase those goods in a retail store.*

Preliminary point

25. The differences between the first and second earlier marks (seraphine and Séraphine, respectively) are so minor – i.e., the accent on the letter ‘e’ and the capitalisation of the letter ‘s’ would not alter the distinctive character of either mark³ – that, in my view, they would be considered acceptable variant forms of one another. As such, evidence of the first earlier mark will constitute evidence of the second earlier mark and vice versa.

Evidence

26. Collectively, Heather Wood’s witness statements and the corresponding exhibits demonstrate the following:

- Seraphine began operating in 2002 and sold direct to consumers online via its own website (seraphine.com) and stores, as well as via stockists such as Next,

³ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22.

John Lewis and (historically) Zalando. HW1 demonstrates that as at the date on which the screenshot of the seraphine.com website was taken (18 April 2024) there were three Seraphine stores in the UK: two in London and one in Leeds, and two stores in Paris, France. HW1 also contains evidence of Seraphine goods on the websites of Next, John Lewis and Zalando, dated with the date the screenshots were taken (10 and 18 April 2024), though the narrative evidence is that the goods were available on Next and John Lewis online throughout the relevant period.

- Seraphine has received various awards/recognition, including: Drapers' Best Specialist E-Tailer in 2011, Drapers' Best Multichannel Retailer in 2014, the 'One to Watch' in the Sunday Times' 100 fastest growing private companies in the UK in 2014, the Queen's award for enterprise for outstanding international business growth in 2012 and 2020, and winner of the Best Maternity Wear category at the 'Absolutely Mama Awards' in 2018.⁴
- Seraphine collaborated with actress Anna Friel and singer Jamelia in 2005/6 and with singer, Sophie Ellis-Bextor in 2015 in relation to campaigns with UK pregnancy and baby charity, Tommy's.⁵ An article related to the former collaboration featured on 'prweek.com' on 26 January 2006, by which point 2,000 t-shirts had been sold (exceeding the £50,000 target) and coverage of the campaign had extended to *The Times*, *The Sun*, *London Metro*, *Mother & Baby*, *Junior Pregnancy & Birth*, *Closer*, *Practical Parenting*, *Primary Baby*, *Hello!*, *the BBC*, and *ITN*, as well as multiple local newspaper pieces.
- Seraphine's clothing products have been worn by numerous celebrities/well-known personalities including the (then) Duchess of Cambridge, Anne Hathaway, Katherine Jenkins, Jessica Alba, Myleene Klass, Sophie Ellis-Bextor, Kate Hudson, Halle Berry, Gwen Stefani, Olivia Wilde, Cat Deeley, Kim Murray, Behati Prinsloo, the character "Bridget Jones" in the film "Bridget Jones' Baby", Kimberly Walsh, Alexandra Burke, Laura Tenoudji and Millie

⁴ Supported by HW1.

⁵ HW WS1 at [8], HW1 and HW4.

Mackintosh.⁶ The relevant images appear on the Opponent's website, in numerous Instagram posts between September 2013 and May 2022,⁷ and in press articles in January 2015, August 2019 and June 2021.⁸

- The Opponent's Instagram account is in the name 'seraphinematernity', which joined the social media platform in August 2012. At the date this evidence was created (10 April 2024), the account had over 4,000 posts and 337,000 followers. The account information reads "Seraphine Maternity & Nursing [...] Clothing (brand)".⁹ The Opponent's Facebook account is in the name 'Seraphine Maternity' and was created in June 2009. At the date the pages were accessed (18 April 2024), the account had 208,000 followers and 204,000 likes. The pages include several posts showing people wearing maternity clothing.¹⁰
- Sales figures for cosmetic-related products have been provided for 2018 to 2023, broken down by season (Spring/Summer or Autumn/Winter). The total sales value for the five-year period is £91,842. Based on the product descriptions, it seems that the cosmetic products are a combination of seraphine products and those of third parties ('Storksak', 'Bloomin Lovely' and 'Lucky Legs', for example). The products are overwhelmingly body hydrators/nourishers, stretch mark creams, tummy rub creams/oils/butters and nipple balm; only stretch mark cream and nipple balm are seraphine branded and were sold from Autumn/Winter 2021 to Autumn/Winter 2023.¹¹
- A sample of invoices demonstrates sales to John Lewis totalling £138,701.98 between August 2018 and March 2023 and sales to The Sports Edit totalling £749.21 in November and December 2019.¹² The witness statement expressly describes these as examples which do not represent the total sales.¹³ Invoices showing sales to Boo's Boutique in March 2018 are irrelevant as the sales were

⁶ HW WS1 at [7], HW3 and HW5.

⁷ HW5.

⁸ HW7.

⁹ HW5.

¹⁰ HW6.

¹¹ HW WS1 at [10].

¹² HW2.

¹³ HW WS1 at [9].

made to Jersey, which is neither the UK nor the EU. Products listed on the relevant invoices include tops, dresses, shorts, bras, jeans, hoodies, leggings, vests and sweatshirts – some of which are labelled with ‘maternity’ or ‘nursing’, and some are not.

Genuine use

27. The above summary of the evidence demonstrates that the Opponent has made regular use of its earlier marks throughout the relevant period in the relevant territories. Despite not providing total sales figures, particularly for its clothing range, I am satisfied that the invoices and narrative evidence show regular sales, which I remind myself are described as a sample as opposed to the total sales. The earlier marks appear on the invoices, on the Opponent’s website, on social media and in the press, and consumers have clearly been exposed to the mark consistently throughout the relevant period. I am therefore satisfied that the Opponent has demonstrated genuine use of its earlier marks.

Fair specification

28. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs KC as the Appointed Person summed up the law as being:

“In the present state of the law, 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.”

29. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

30. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in

light of more recent guidance by the Court of Justice of the European Union (“CJEU”) that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

31. I will take each class in turn, combining the specifications of both earlier marks on the basis of my paragraph 25.

32. There is no evidence of the earlier marks used on *soaps* or *perfume* and so I disregard these terms for the purpose of these proceedings. In line with *Merck, cosmetics* is sufficiently broad to include a number of subcategories. As such, use on stretch mark cream and nipple balm alone does not demonstrate use of *cosmetics* at large but of an appropriate subcategory: creams and balms. Whilst there is no use of *lotions*, creams and balms are not in essence different from lotions and distinguishing between these goods would be arbitrary. Accordingly, a fair specification for the use shown would include *lotions*. The Opponent may rely upon the following Class 3 specification: *creams, balms and lotions*.

33. There is no evidence of use in relation to the Class 9 goods relied upon by the Opponent so I shall disregard these.

34. In Class 25, there is no evidence of use on *headgear* and so I disregard this term. Whilst there are no apparent sales of *coats* when considering the invoices, coats do feature on the Opponent’s social media pages and in the press and so I consider they were available and the mark genuinely used in relation thereto in the relevant period. For the remaining terms, the Opponent has demonstrated use in relation to a wide range of clothing items, including maternity and non-maternity clothing. As such the Opponent may rely upon the following Class 25 specification: *clothing, maternity clothes and coats*.

35. Turning to Class 35, the Opponent has demonstrated retail services relating to the above-mentioned goods. It has also shown use of a wider range of cosmetic related products when considering the third party branded goods listed in evidence. However,

whilst it has shown retail of clothing, there is no evidence of use in relation to clothing accessories nor nursery apparel. As such, I consider a fair specification to be: *retail services connected with clothing, cosmetics and maternity garments; the bringing together for the benefit of others, of a variety of clothing, cosmetics and maternity garments, enabling customers to conveniently view and purchase those goods in a retail store.*

Section 5(2)(b)

Statutory provisions

36. Section 5(2)(b) of the Act is 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.”

Relevant case law

37. The following principles are gleaned from the decisions of the CJEU 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, 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.

The principles

(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 and services

38. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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.”

39. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281 for assessing similarity between goods/services also include an assessment of the users and channels of trade of the respective goods/services.

40. Further, in *Kurt Hesse v OHIM*,¹⁴ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,¹⁵ the General Court (“GC”) stated that “complementary” means:

“...there is 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.”

41. In *Gérard Meric v OHIM*, the GC confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):¹⁶

“29. 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 fur 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.”

42. I bear in mind that it is permissible to group goods/services together for the purposes of assessment: *Separode Trade Mark*:¹⁷

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

¹⁴ Case C-50/15 P.

¹⁵ Case T-325/06.

¹⁶ Case T-133/05.

¹⁷ BL O/399/10.

43. The specifications to be compared are as follows:

The Applicant's specification

Class 3: Cosmetics; Skincare cosmetics; Perfumery products; Organic cosmetics; Cosmetics and cosmetic preparations; Multifunctional cosmetics; Perfume oils for the manufacture of cosmetic preparations; Cosmetic creams for the skin; Skin creams [cosmetic]; Skin creams [for cosmetic use]; Anti-aging creams [for cosmetic use]; Anti-aging creams; Anti-ageing creams [for cosmetic use]; Cosmetic creams and lotions; Creams for the skin; Skin creams; Cosmetic creams; Creams (Cosmetic -); Anti-ageing creams; Moisturising skin creams [cosmetic]; Sunscreen creams [for cosmetic use]; Skin care creams [cosmetic]; Cosmetic creams for skin care; Skin creams [non-medicated]; Non-medicated skin creams; Cosmetic creams for dry skin; Facial creams [cosmetics]; Cosmetic nourishing creams; Facial creams [for cosmetic use]; Facial creams [cosmetic]; Moisturizing creams; Sun creams [for cosmetic use]; Cleansing creams [cosmetic]; Moisturising creams; Exfoliating creams; Sunscreen creams; Moisturising skin lotions [cosmetic]; Creams for firming the skin; Facial creams; Toning creams [cosmetic]; Skin cream [for cosmetic use]; Skin conditioning creams for cosmetic purposes; Exfoliant creams; Moisturising creams, lotions and gels; Anti-aging moisturizers used as cosmetics; Skin moisturizers used as cosmetics; Suncare lotions [for cosmetic use]; Skin care lotions [cosmetic]; Skin balms [cosmetic]; Hydrating creams for cosmetic use; Beauty creams; Non-medicated creams; Cosmetic moisturisers; Skin lotions; Lotions for the skin; Skin cleansers [cosmetic]; Acne cleansers, cosmetic; Anti-aging moisturizers; Body and facial creams [cosmetics]; Fluid creams [cosmetics]; Night creams [cosmetics]; Cleansing creams; Cosmetics in the form of creams; Anti-aging cream; Skin toners [cosmetic]; Beauty balm creams; Skin moisturizers; Non-medicated skin lotions; Facial moisturisers [cosmetic]; Skin care creams, other than for medical use; Non-medicated cleansing creams; Eye creams; Facial lotions [cosmetic]; Cosmetic facial lotions; Skin cream; Retinol cream for cosmetic purposes; Skin moisturisers; Blemish balm creams; Perfumed creams; Non-medicated skin serums; Moisturisers [cosmetics]; Skin cleansing cream [non-medicated]; Anti-aging skincare preparations; Sun creams; Sun protecting creams [cosmetics]; Sun care lotions [for cosmetic use]; Face creams for

cosmetic use; Facial cream [for cosmetic use]; Sunscreen cream; Cream soaps; Cosmetics in the form of lotions; Cosmetic sun milk lotions; Lip cosmetics; Facial cream; Skin fresheners [cosmetics]; Milks [cosmetics]; Lip cream; Mattifying gel cream; Facial gels [cosmetics]; Skin masks [cosmetics]; Cleansing cream; Skin cleansing cream; Emollient preparations [cosmetics]; Non-medicated cosmetics; Lip stains [cosmetics]; Beauty care cosmetics; Cosmetics preparations; Natural cosmetics; Eye cosmetics; Skin care cosmetics; Non-medicated cosmetics and toiletry preparations; Cosmetics for use on the skin; Powder compacts [cosmetics]; Sunscreens [for cosmetic use]; Sun blocking lipsticks [cosmetics]; Sunscreen [for cosmetic use]; Cosmetic soaps; Cosmetics in the form of powders; Cosmetic skin fresheners; Cosmetics in the form of oils; Beauty lotions; Cosmetics containing panthenol; Smoothing emulsions [cosmetics]; Perfumed powders [for cosmetic use]; Body and facial gels [cosmetics]; Cosmetic oils; Skincare preparations; Anti-ageing moisturiser; Beauty serums; Non-medicated skincare preparations; Suncare lotions; Beauty serums with anti-ageing properties; Anti-ageing serums for cosmetic purposes; Skin moisturiser; Skin moisturizer; Moisturisers; Moisturiser; Facial cleansers [cosmetic]; Moisturizers; Skin cleansers; Anti-ageing serum; Skin moisturizer masks; Exfoliants for the care of the skin; Facial moisturizers; Exfoliants for the cleansing of the skin; Anti-aging serum for cosmetic use; Skin care oils [cosmetic]; Skin cleansing lotion; Skin cleansers [non-medicated]; Skin lotion; Skin hydrators; Cosmetics for use in the treatment of wrinkled skin; Cleansing lotions; Facial cleansers; Skin hydrators for cosmetic purposes ; Moisturising gels [cosmetic]; Cosmetic preparations for skin firming; Moisturizing preparations for the skin; Lotions for face and body care; Non-medicated face care preparations; Hand masks for skin care; Face wash; Face wash [cosmetic]; Face scrub; Facial care preparations; Cleaning masks for the face; Face masks; Skin care preparations; Face creams; Face and body masks; Face and body creams; Cleansing milks for skin care; Essences for skin care; Face and body lotions; Lip care preparations; Eye care products, non-medicated; Sun care lotions; Skin care (Cosmetic preparations for -); Cosmetic preparations for skin care; Face oils; Beauty care preparations; Exfoliating scrubs for the face; Milky lotions for skin care; Perfume oils; Perfumery, essential oils.

Class 35: Marketing research in the fields of cosmetics, perfumery and beauty products; Online retail store services relating to cosmetic and beauty products; Online

retail services relating to cosmetics; Mail order retail services for cosmetics; Advertising services relating to cosmetics; Advertising services for the promotion of e-commerce; Business consultancy services relating to product development; Providing consumer product advice relating to cosmetics; Online marketing; Online advertising; On-line advertising and marketing services; Promotion, advertising and marketing of on-line websites; Online advertising services; Advertising and marketing services provided via communications channels.

The Opponent's specification (following proof of use)

The first earlier mark

Class 3: *Creams, balms and lotions.*

Class 25: *Clothing, maternity clothes and coats.*

Class 35: *Retail services connected with clothing, cosmetics and maternity garments.*

The second earlier mark

Class 25: *Clothing.*

Class 35: *The bringing together for the benefit of others, of a variety of clothing, cosmetics and maternity garments, enabling customers to conveniently view and purchase those goods in a retail store.*

Cosmetic creams for the skin; Skin creams [cosmetic]; Skin creams [for cosmetic use]; Anti-aging creams [for cosmetic use]; Anti-aging creams; Anti-ageing creams [for cosmetic use]; Cosmetic creams and lotions; Creams for the skin; Skin creams; Cosmetic creams; Creams (Cosmetic -); Anti-ageing creams; Moisturising skin creams [cosmetic]; Sunscreen creams [for cosmetic use]; Skin care creams [cosmetic]; Cosmetic creams for skin care; Skin creams [non-medicated]; Non-medicated skin creams; Cosmetic creams for dry skin; Facial creams [cosmetics]; Cosmetic nourishing creams; Facial creams [for cosmetic use]; Facial creams [cosmetic]; Moisturizing creams; Sun creams [for cosmetic use]; Cleansing creams [cosmetic]; Moisturising creams; Exfoliating creams; Sunscreen creams; Moisturising skin lotions [cosmetic]; Creams for firming the

skin; Facial creams; Toning creams [cosmetic]; Skin cream [for cosmetic use]; Skin conditioning creams for cosmetic purposes; Exfoliant creams; Suncare lotions [for cosmetic use]; Skin care lotions [cosmetic]; Skin balms [cosmetic]; Hydrating creams for cosmetic use; Beauty creams; Non-medicated creams; Skin lotions; Lotions for the skin; Body and facial creams [cosmetics]; Fluid creams [cosmetics]; Night creams [cosmetics]; Cleansing creams; Cosmetics in the form of creams; Anti-aging cream; Beauty balm creams; Non-medicated skin lotions; Skin care creams, other than for medical use; Non-medicated cleansing creams; Eye creams; Facial lotions [cosmetic]; Cosmetic facial lotions; Skin cream; Retinol cream for cosmetic purposes; Blemish balm creams; Perfumed creams; Skin cleansing cream [non-medicated]; Sun creams; Sun protecting creams [cosmetics]; Sun care lotions [for cosmetic use]; Face creams for cosmetic use; Facial cream [for cosmetic use]; Sunscreen cream; Cream soaps; Cosmetics in the form of lotions; Cosmetic sun milk lotions; Facial cream; Lip cream; Mattifying gel cream; Cleansing cream; Skin cleansing cream; Sunscreens [for cosmetic use]; Sunscreen [for cosmetic use]; Beauty lotions; Suncare lotions; Skin cleansing lotion; Skin lotion; Cleansing lotions; Lotions for face and body care; Face creams; Face and body creams; Face and body lotions; Sun care lotions; Milky lotions for skin care.

44. The above terms are all types of *creams, balms and lotions* and so fall within the same terms in the Opponent's specification. These goods are identical in line with *Meric*.

Cosmetics; Skincare cosmetics; Organic cosmetics; Cosmetics and cosmetic preparations; Multifunctional cosmetics; Non-medicated cosmetics; Beauty care cosmetics; Cosmetics preparations; Natural cosmetics; Eye cosmetics; Skin care cosmetics; Non-medicated cosmetics and toiletry preparations; Cosmetics for use on the skin; Skincare preparations; Non-medicated skincare preparations; Non-medicated face care preparations; Skin care preparations; Eye care products, non-medicated; Skin care (Cosmetic preparations for -); Cosmetic preparations for skin care; Beauty care preparations.

45. The above terms are broad enough to encompass the Opponent's *creams, balms and lotions* on the basis that they are all cosmetics and skincare preparations. These goods are identical in line with *Meric*.

Moisturising creams, lotions and gels; Anti-aging moisturizers used as cosmetics; Skin moisturizers used as cosmetics; Cosmetic moisturisers; Anti-aging moisturizers; Skin moisturizers; Facial moisturisers [cosmetic]; Skin moisturisers; Moisturisers [cosmetics]; Anti-ageing moisturiser; Skin moisturiser; Skin moisturizer; Moisturisers; Moisturiser; Moisturizers; Facial moisturizers; Moisturizing preparations for the skin.

46. The above goods are moisturisers, which are cosmetic preparations used predominantly to prevent dryness in the skin and can come in the form of creams, balms and lotions. As such, the Applicant's goods may fall within the meaning of the Opponent's goods, or vice versa. In the alternative, where moisturisers come in a different form (such as gels, for example) or where creams, balms and lotions have a purpose other than moisturising, the goods are highly similar given their overlap in users, method of use (applied to the skin), general purpose as skincare products, their shared trade channels and that they will be found in close proximity in retail stores or online.

Skin cleansers [cosmetic]; Acne cleansers, cosmetic; Skin toners [cosmetic]; Non-medicated skin serums; Anti-aging skincare preparations; Lip cosmetics; Skin fresheners [cosmetics]; Milks [cosmetics]; Emollient preparations [cosmetics]; Sun blocking lipsticks [cosmetics]; Cosmetic soaps; Cosmetic skin fresheners; Cosmetics containing panthenol; Smoothing emulsions [cosmetics]; Facial cleansers [cosmetic]; Skin cleansers; Exfoliants for the care of the skin; Exfoliants for the cleansing of the skin; Skin cleansers [non-medicated]; Skin hydrators; Cosmetics for use in the treatment of wrinkled skin; Facial cleansers; Skin hydrators for cosmetic purposes; Cosmetic preparations for skin firming; Face wash; Face wash [cosmetic]; Face scrub; Facial care preparations; Cleansing milks for skin care; Lip care preparations; Exfoliating scrubs for the face.

47. The above goods are all cosmetic or skincare products, which may come in the form of creams, balms and lotions, save for where the term expressly says otherwise. Similarly to the assessment in the previous paragraph, the Applicant's goods may fall within the meaning of the Opponent's goods, or vice versa. In the alternative, where the Applicant's goods come in a different form (such as gels, for example) the goods are highly similar given their overlap in users, method of use (applied to the skin), general purpose as skincare products, their shared trade channels and that they will be found in close proximity in retail stores or online.

Facial gels [cosmetics]; Lip stains [cosmetics]; Powder compacts [cosmetics]; Cosmetics in the form of powders; Cosmetics in the form of oils; Perfumed powders [for cosmetic use]; Body and facial gels [cosmetics]; Cosmetic oils; Beauty serums; Beauty serums with anti-ageing properties; Anti-ageing serums for cosmetic purposes; Anti-ageing serum; Anti-aging serum for cosmetic use; Skin care oils [cosmetic]; Moisturising gels [cosmetic]; Essences for skin care; Face oils.

48. The above goods are cosmetic or skincare products in a form other than creams, balms and lotions – i.e. gels, powders, oils, serums and other liquids. Despite the physical nature differing between the Applicant's goods and the Opponent's, all have the general purpose of caring for or improving the appearance of the skin. They will overlap in users, method of use (applied to the skin) and trade channels and they will be found in close proximity in retail stores or online. I find the above goods similar to a high degree to the Opponent's *creams, balms and lotions*.

Skin masks [cosmetics]; Skin moisturizer masks; Hand masks for skin care; Cleaning masks for the face; Face masks; Face and body masks.

49. The above goods may be in the form of firstly, creams, balms and lotions, or secondly, as a sheet mask made of fabric and impregnated with a skin care preparation. In the first instance, the Applicant's goods are identical with the Opponent's *creams, balms and lotions* in line with *Meric* with the former falling into the latter, broader category. In the second instance, the Applicant's goods and the Opponent's *creams, balms and lotions* are highly similar on account of their

overlapping purpose, users, method of use, trade channels and being found in close proximity in retail stores or online.

Perfumery products; Perfume oils for the manufacture of cosmetic preparations; Perfume oils; Perfumery, essential oils.

50. The above goods are perfumes and/or oils for perfumes, the use and purpose being to give a pleasant smell to the user's body, compared to the Opponent's *creams, balms and lotions*, predominantly used as a skincare preparation to improve the appearance of the skin. Users of both sets of goods are likely to overlap and there is some similarity in the method of use given they are all applied to the body, albeit in different ways. The goods will reach the market via similar trade channels and will be found in close proximity in retail stores or online. Overall, I find a medium degree of similarity between these goods.

Online retail store services relating to cosmetic and beauty products; Online retail services relating to cosmetics; Mail order retail services for cosmetics.

51. The above services fall within the Opponent's broader terms: *retail services connected with [...] cosmetics [...] and the bringing together for the benefit of others, of a variety of [...] cosmetics [...], enabling customers to conveniently view and purchase those goods in a retail store.* They are identical in line with *Meric*.

Marketing research in the fields of cosmetics, perfumery and beauty products; Advertising services relating to cosmetics; Providing consumer product advice relating to cosmetics.

52. The above services are ones which consumers would expect to be provided by the provider of retail services connected with cosmetics. Market research, advertising and providing advice in relation to cosmetics (and similar goods, i.e. perfumery and beauty products) are important to the retail of cosmetics, and consumers would believe these services were all provided by the same undertaking. Accordingly, there is a degree of complementarity. The users will also overlap and the services will reach the market through similar trade channels. However, the purpose of the services differ and

they are not in competition with each other. Even if I am wrong in my complementarity finding, there is at least a low degree of similarity between the Applicant's services and the Opponent's *retail services connected with [...] cosmetics [...] and the bringing together for the benefit of others, of a variety of [...] cosmetics [...], enabling customers to conveniently view and purchase those goods in a retail store.*

Advertising services for the promotion of e-commerce; Business consultancy services relating to product development; Online marketing; Online advertising; On-line advertising and marketing services; Promotion, advertising and marketing of on-line websites; Online advertising services; Advertising and marketing services provided via communications channels.

53. There is no obvious similarity between the above services and any of the Opponent's goods and services. Whilst I found, in the previous paragraph, similarity between services in the field of cosmetics on the basis that consumers would expect such services to be provided by the same provider, the similarity was at a low level and the broader terms listed above are further removed. Accordingly, I find no meaningful similarity.

54. That concludes my comparison of the goods and services. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between services, there is no likelihood of confusion to be considered under section 5(2). The section 5(2)(b) ground of opposition therefore fails in relation to the following services:

Class 35: Advertising services for the promotion of e-commerce; Business consultancy services relating to product development; Online marketing; Online advertising; On-line advertising and marketing services; Promotion, advertising and marketing of on-line websites; Online advertising services; Advertising and marketing services provided via communications channels.

The average consumer and the purchasing act

55. 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

56. 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)* EWCA Civ 262, where he pointed out that:

(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.

57. The average consumer of the parties' goods and services will be a member of the general public. They will select the goods and services mainly visually, by encountering them in retail stores, catalogues, or online. There may be an aural element to the purchase where advice is sought from retail assistants or consumers share word of mouth recommendations.

58. When selecting the goods, consumers will consider factors such as the ingredients and suitability for their skin, and a medium degree of attention will be paid. For the services, consumers will consider the range of products offered by the service provider as well as the associated costs, and a medium degree of attention will be paid.

Comparison of marks

59. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

60. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

61. The trade marks to be compared are as follows:

The Opponent's earlier marks	The Applicant's mark
<u>The first earlier mark</u> seraphine <u>The second earlier mark</u> S�raphine	

Overall impression

62. The overall impression of the first earlier mark lies solely in the one word it comprises; the same applies to the second earlier mark.

63. The Applicant's figurative mark contains the stylised word 'SERAFINE', where the leg of the 'R' curves and extends to the right under the letter 'A'. Centrally above the word 'SERAFINE' is a figurative device that looks like a highly stylised letter 'S'. Below the word 'SERAFINE' is the much smaller word 'SCOTLAND'. The dominant and distinctive element of the mark is the word 'SERAFINE'. Although the word 'SCOTLAND' is not negligible in the presentation, it has less impact and carries less weight in the overall impression given its meaning as a geographical location, which I will return to below. The figurative 'S' device is merely decorative and carries a similar weight to the word 'SCOTLAND'.

Visual comparison

64. The earlier marks are word only and, as such, the case in which they are presented does not affect the comparison with the Applicant's mark. The figurative 'S' device and

the word SCOTLAND act as points of visual difference, having no counterparts in the earlier marks. The first earlier mark and the Applicant's mark share the first four letters 'SERA' and the last three letters 'INE'; the same applies to the second earlier mark, save for the acute accent on the letter 'E', which may go unnoticed. The letters in the middle of the marks' distinctive and dominant elements differ: 'PH' versus 'F'. When bearing in mind the weight the marks' elements make, I consider the Opponent's earlier marks to be visually similar to between a medium and high degree to the Applicant's mark.

Aural comparison

65. In my view, neither the stylised 'S' nor the word 'SCOTLAND' in the Applicant's mark will be articulated, thus rendering it aurally identical to the Opponent's earlier marks: all three will be pronounced as the three syllables 'SE-RA-PHINE' or 'SE-RA-FINE', the 'PH' and 'F' having no difference in sound. The marks are aurally identical. In the alternative, if the word 'SCOTLAND' is articulated, the marks are aurally similar to between a medium and high degree, given the similarity is at the beginning of the marks where consumers tend to focus.¹⁸

Conceptual comparison

66. 'SERAPHINE' and 'SERAFINE' will either be seen as female names, rendering this element conceptually identical, or as invented words, rendering them conceptually neutral. Whilst not holding much weight in the overall impression of the mark, the word 'SCOTLAND' will be seen as a geographical location and creates a conceptual difference between the marks, albeit a weak one. For consumers who see 'SERAPHINE' and 'SERAFINE' as female names, the marks are conceptually similar to a high degree overall; for those who see the aforementioned words as invented, the marks have no conceptual similarity. The position is the same for both earlier marks: the accent in the second earlier mark does not alter the impact on the consumer.

¹⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Distinctive character of the earlier mark

67. In *Lloyd Schuhfabrik Meyer* 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).”

68. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, 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.

69. For the purposes of this assessment, I shall refer to the earlier marks in the singular, given that the only differences are so minor that I do not find them to alter the distinctive character of one another.

70. I will assess the inherent distinctiveness of the earlier mark first. The word 'SERAPHINE' will either be seen as a female name or as an invented word; even in the case of the former understanding, I consider it to be an unusual, or uncommon, name, which has an effect on the distinctive character.¹⁹ As such, in either scenario I consider the mark to have a fairly high degree of inherent distinctiveness. Even where the word is seen as a female name, which may allude to the intended target market of the goods and services at issue, I consider the link to be too tenuous to materially alter the distinctiveness of the mark.

71. Turning to whether the distinctiveness of the earlier mark has been enhanced through use, I refer to the Opponent's evidence, summarised for the purpose of my genuine use assessment earlier in this decision. There is evidence of regular sales between 2018 and 2023, with over £90,000 in revenue for cosmetic related products and almost £140,000 for clothing for the same period. These figures are far from significant for the relevant markets and whilst I acknowledge that the clothing sales figures are based on a sample, I have not been provided with total sales figures for a full picture of the Opponent's revenue. I therefore cannot ascertain how extensive the use of the marks has been, even I can be satisfied that the use has been longstanding.

72. There is also no evidence of the market share held by the mark, nor the amount invested by the Opponent in promoting its goods or services. I do not ignore the awards and recognition achieved between 2011 and 2020, as well as the collaborations with celebrities from 2005 onwards, publications in the press and the Opponent's social media presence: all of this points to the use being geographically widespread. However, sales figures, market share information and advertising figures are routinely filed with the Tribunal and would be easily accessible to the Opponent, but it has not provided such evidence. With these relevant factors being unsupported by the evidence, it is difficult to make a finding that the distinctiveness of the mark has been enhanced through use and so the inherent position remains, which, in any case, is at a fairly high degree.

¹⁹ *Harman International Industries, Inc v OHIM*, Case C-51/09P.

Likelihood of confusion

73. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

74. I have found the marks to be visually and aurally similar to between a medium and high degree (or aurally identical if 'SCOTLAND' is not articulated in the Applicant's mark) and either conceptually highly similar or to have no conceptual similarity. I have found the earlier marks to possess a fairly high degree of inherent distinctive character. I have found the goods and services to vary in similarity – from identical to similar to at least a low degree. I have identified the average consumer to be a member of the general public who, when selecting the goods and services, will pay a medium degree of attention to a mainly visual purchase, though I do not discount the aural consideration.

75. I will deal with direct confusion first. Even in circumstances where consumers attribute no conceptual meaning to the common element between the marks, the extent of their visual and aural similarities leads me to conclude that consumers will misremember 'SERAPHINE' for 'SERAFINE', or vice versa. The lack of distinctiveness in the word 'SCOTLAND' and the purely decorative role of the stylised letter 'S' in the Applicant's mark means these differences are likely to be overlooked or forgotten by

the average consumer. What remains are two identical-sounding and highly visually similar words which will either portray the identical concept of a female name, or be seen as invented words with no conceptual hook for consumers to remember them by. The structure and composition of the letters S-E-R-A-I-N-E leads me to conclude that the letters 'PH' or 'F' will be misremembered. Taking all of this into account, I find a likelihood of direct confusion between the Opponent's earlier marks and the Applicant's mark. On account of the interdependency principle, I consider this applies to all of the goods and services, even those for which I have found only a low degree of similarity.

76. For completeness, I will also consider indirect confusion, which was described in the following terms by Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:²⁰

“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 recognised 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

²⁰ BL O/375/10.

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).”

77. The examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.²¹

78. In my view, if I am wrong in my finding of direct confusion on the basis of consumers not overlooking the word ‘SCOTLAND’ or the stylised letter ‘S’ in the Applicant’s mark, there is a likelihood of indirect confusion where consumers nonetheless misremember the word ‘SERAPHINE’ for ‘SERAFINE’, or vice versa and assume that the aforementioned differences, given their descriptive/non-distinctive nature or decorative role, are down to a sub-brand based in Scotland, thus believing the undertaking to be the same or related. There is a likelihood of indirect confusion for all goods and services, due to the interdependency principle.

Outcome

79. The Opponent’s claim under section 5(2)(b) succeeds and the application is refused, save for the following services:

²¹ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at [81] to [82].

Class 35: Advertising services for the promotion of e-commerce; Business consultancy services relating to product development; Online marketing; Online advertising; On-line advertising and marketing services; Promotion, advertising and marketing of on-line websites; Online advertising services; Advertising and marketing services provided via communications channels.

Section 5(3)

Statutory provisions

80. Section 5(3) states:

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark [...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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.”

81. Section 5(3A) states:

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

82. Paragraph 10 of Part 1, Schedule 2A of the Act is also relevant. It reads as follows:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to –

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom includes the European Union.”

Relevant case law

83. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(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*).

84. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the Opponent must satisfy me that its marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the Opponent's marks being brought to mind by the Applicant's mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence

of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

86. I can deal with this ground fairly swiftly. I recall that I found the Opponent’s evidence insufficient to establish that the distinctive character of its earlier marks has been enhanced through use. The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the earlier marks have a reputation and so the criticisms of the Opponent’s evidence apply equally here. Whilst there is evidence of sales, celebrity endorsement, social media presence and exposure in the press, there are clear deficiencies in the lack of total sales figures, marketing spend and market share information. Without this evidence, I cannot be satisfied of all the relevant factors (*General Motors*), nor can I say with any certainty that the Opponent’s marks have achieved any degree of reputation amongst a significant part of the public. The Opponent has failed to demonstrate the requisite reputation for this ground of opposition.

Outcome

87. The Opponent’s claim under section 5(3) fails.

Section 5(4)(a)

Statutory provisions

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

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

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

[...]

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.”

Relevant case law

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

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

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

Relevant date

90. In *Advanced Perimeter System Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander KC, as the Appointed Person, endorsed the Registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDSERS TM* O-212-06 Mr [Allan] James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

91. The Applicant has not provided evidence that it used its mark before the filing date and, therefore, the relevant date for the section 5(4)(a) assessment is 2 May 2023.

Goodwill

92. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

93. I discussed the Opponent’s evidence in relation to my assessment of genuine use earlier in this decision. The sign relied upon under section 5(4)(a) - ‘SERAPHINE’ – is identical to the first earlier mark relied upon under section 5(2)(b). The summary of the evidence earlier in my decision can therefore be repeated here.

94. The goods and services relied upon by the Opponent under this ground are as follows:

Soaps, perfume, cosmetics, lotions.

Clothing; maternity clothes; headgear, coats.

Retail services connected with clothing, headgear, maternity garments and clothing accessories.

The bringing together for the benefit of others, of a variety of clothing, headgear, maternity garments and accessories, nursery apparel and accessories, enabling customers to conveniently view and purchase those goods in a retail store.

95. All other factors being equal, there cannot be goodwill for goods and services for which I found no use. Therefore, in line with the fair specification I decided upon in the genuine use assessment, I will proceed to determine whether the Opponent has demonstrated goodwill for the following goods and services:

Creams, balms and lotions.

Clothing; maternity clothes; coats.

Retail services connected with clothing and maternity garments.

The bringing together for the benefit of others, of a variety of clothing and maternity garments, enabling customers to conveniently view and purchase those goods in a retail store.

96. The Opponent made regular use of the sign and has shown repeated sales for clothing (both maternity and non-maternity) in the five years leading up to the relevant date, as well as demonstrating retail services related thereto. Maternity and non-maternity clothing bearing the sign also featured on the Opponent's website, on social media and in the press. Despite being less of a focus in the Opponent's evidence, there are also a substantial number of sales of cosmetic-related goods, either bearing the sign relied upon or originating from third parties. Even if such goods (or retail services relating thereto) are a small part of the Opponent's business, I remind myself that small businesses are capable of generating a protectable goodwill so long as it is more than trivial.²² For these reasons, I am satisfied that the Opponent has generated a protectable goodwill in relation to the goods and services for which I found genuine use, insofar as they have been relied upon under this ground; these are listed in the previous paragraph.

²² *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

Misrepresentation

97. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

98. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely, in the light of the Court of Appeal’s decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. For the contested goods and services for which I found a likelihood of confusion, I find there to also be a misrepresentation. That leaves the remaining contested services, as follows:

Class 35: Advertising services for the promotion of e-commerce; Business consultancy services relating to product development; Online marketing; Online advertising; On-line advertising and marketing services; Promotion, advertising and marketing of on-line websites; Online advertising services; Advertising and marketing services provided via communications channels.

99. Broadly speaking, the Opponent's goodwill can be said to be in types of cosmetics, clothing, and the retail of those goods; the above services are not in the same field of activity. I remind myself that it is not necessary for the parties to operate in a common field of activity, but Millett LJ held in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) that in such circumstances the burden of establishing misrepresentation and damage is a heavy one. I also take into account that "mere wondering" is not sufficient and that consumers must be deceived: see *Phones 4U v Phone4U.co.uk Internet Ltd* [2007] RPC 5 at [16]-[17]. In my view, the differences between the fields of activity between cosmetics, clothing and the retail of the same and the advertising, consultancy, marketing, and promotion services listed above are sufficient to avoid a substantial number of the relevant public being misled into believing that the Applicant's services are the services of the Opponent.

Damage

100. In *Harrods*, Millett LJ described the requirements for damage in passing off cases at [715]:

"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

101. In my view, damage is likely to occur through diversion of sales given the same fields of activity.

Outcome

102. The section 5(4)(a) ground succeeds for the following goods and services:

Class 3: Cosmetics; Skincare cosmetics; Perfumery products; Organic cosmetics; Cosmetics and cosmetic preparations; Multifunctional cosmetics; Perfume oils for the manufacture of cosmetic preparations; Cosmetic creams for the skin; Skin creams [cosmetic]; Skin creams [for cosmetic use]; Anti-aging creams [for cosmetic use]; Anti-aging creams; Anti-ageing creams [for cosmetic use]; Cosmetic creams and lotions; Creams for the skin; Skin creams; Cosmetic creams; Creams (Cosmetic -); Anti-ageing creams; Moisturising skin creams [cosmetic]; Sunscreen creams [for cosmetic use]; Skin care creams [cosmetic]; Cosmetic creams for skin care; Skin creams [non-medicated]; Non-medicated skin creams; Cosmetic creams for dry skin; Facial creams [cosmetics]; Cosmetic nourishing creams; Facial creams [for cosmetic use]; Facial creams [cosmetic]; Moisturizing creams; Sun creams [for cosmetic use]; Cleansing creams [cosmetic]; Moisturising creams; Exfoliating creams; Sunscreen creams; Moisturising skin lotions [cosmetic]; Creams for firming the skin; Facial creams; Toning creams [cosmetic]; Skin cream [for cosmetic use]; Skin conditioning creams for cosmetic purposes; Exfoliant creams; Moisturising creams, lotions and gels; Anti-aging moisturizers used as cosmetics; Skin moisturizers used as cosmetics; Suncare lotions [for cosmetic use]; Skin care lotions [cosmetic]; Skin balms [cosmetic]; Hydrating creams for cosmetic use; Beauty creams; Non-medicated creams; Cosmetic moisturisers; Skin lotions; Lotions for the skin; Skin cleansers [cosmetic]; Acne cleansers, cosmetic; Anti-aging moisturizers; Body and facial creams [cosmetics]; Fluid creams [cosmetics]; Night creams [cosmetics]; Cleansing creams; Cosmetics in the form of creams; Anti-aging cream; Skin toners [cosmetic]; Beauty balm creams; Skin moisturizers; Non-medicated skin lotions; Facial moisturisers [cosmetic]; Skin care creams, other than for medical use; Non-medicated cleansing creams; Eye creams; Facial lotions [cosmetic]; Cosmetic facial lotions; Skin cream; Retinol cream for cosmetic purposes; Skin moisturisers; Blemish balm creams; Perfumed creams; Non-medicated skin serums; Moisturisers [cosmetics]; Skin

cleansing cream [non-medicated]; Anti-aging skincare preparations; Sun creams; Sun protecting creams [cosmetics]; Sun care lotions [for cosmetic use]; Face creams for cosmetic use; Facial cream [for cosmetic use]; Sunscreen cream; Cream soaps; Cosmetics in the form of lotions; Cosmetic sun milk lotions; Lip cosmetics; Facial cream; Skin fresheners [cosmetics]; Milks [cosmetics]; Lip cream; Mattifying gel cream; Facial gels [cosmetics]; Skin masks [cosmetics]; Cleansing cream; Skin cleansing cream; Emollient preparations [cosmetics]; Non-medicated cosmetics; Lip stains [cosmetics]; Beauty care cosmetics; Cosmetics preparations; Natural cosmetics; Eye cosmetics; Skin care cosmetics; Non-medicated cosmetics and toiletry preparations; Cosmetics for use on the skin; Powder compacts [cosmetics]; Sunscreens [for cosmetic use]; Sun blocking lipsticks [cosmetics]; Sunscreen [for cosmetic use]; Cosmetic soaps; Cosmetics in the form of powders; Cosmetic skin fresheners; Cosmetics in the form of oils; Beauty lotions; Cosmetics containing panthenol; Smoothing emulsions [cosmetics]; Perfumed powders [for cosmetic use]; Body and facial gels [cosmetics]; Cosmetic oils; Skincare preparations; Anti-ageing moisturiser; Beauty serums; Non-medicated skincare preparations; Suncare lotions; Beauty serums with anti-ageing properties; Anti-ageing serums for cosmetic purposes; Skin moisturiser; Skin moisturizer; Moisturisers; Moisturiser; Facial cleansers [cosmetic]; Moisturizers; Skin cleansers; Anti-ageing serum; Skin moisturizer masks; Exfoliants for the care of the skin; Facial moisturizers; Exfoliants for the cleansing of the skin; Anti-aging serum for cosmetic use; Skin care oils [cosmetic]; Skin cleansing lotion; Skin cleansers [non-medicated]; Skin lotion; Skin hydrators; Cosmetics for use in the treatment of wrinkled skin; Cleansing lotions; Facial cleansers; Skin hydrators for cosmetic purposes ; Moisturising gels [cosmetic]; Cosmetic preparations for skin firming; Moisturizing preparations for the skin; Lotions for face and body care; Non-medicated face care preparations; Hand masks for skin care; Face wash; Face wash [cosmetic]; Face scrub; Facial care preparations; Cleaning masks for the face; Face masks; Skin care preparations; Face creams; Face and body masks; Face and body creams; Cleansing milks for skin care; Essences for skin care; Face and body lotions; Lip care preparations; Eye care products, non-medicated; Sun care lotions; Skin care (Cosmetic preparations for -); Cosmetic preparations for skin care; Face oils; Beauty care preparations; Exfoliating scrubs for the face; Milky lotions for skin care; Perfume oils; Perfumery, essential oils.

Class 35: Marketing research in the fields of cosmetics, perfumery and beauty products; Online retail store services relating to cosmetic and beauty products; Online retail services relating to cosmetics; Mail order retail services for cosmetics; Advertising services relating to cosmetics; Providing consumer product advice relating to cosmetics.

CONCLUSION

103. The opposition has partially succeeded under section 5(2)(b) and 5(4)(a) and, subject to any successful appeal against this decision, the Applicant's mark may proceed to registration in relation only to:

Class 35: Advertising services for the promotion of e-commerce; Business consultancy services relating to product development; Online marketing; Online advertising; On-line advertising and marketing services; Promotion, advertising and marketing of on-line websites; Online advertising services; Advertising and marketing services provided via communications channels.

COSTS

104. The Opponent has been mainly successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.²³ Bearing in mind the varying degrees of length and complexity of the papers filed, I consider the following to be reasonable:

Preparing a statement of grounds and considering the counterstatement:	£600
Preparing evidence and considering and commenting on the other side's evidence:	£1100
Preparing submissions in lieu of a hearing:	£350
Official fee:	£200
Total:	£2250

²³ The proceedings commenced after 1 February 2023.

105. I therefore order Dermo Ventures Limited to pay Next Retail Limited the sum of £2250. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 25th day of September 2026

MRS E FISHER
For the Registrar