

O/0897/26

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION NUMBER 3970474
IN THE NAME OF GLOBAL FULFILLMENT LIMITED
FOR THE TRADE MARK:**

PHOERA

IN CLASS 21

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NUMBER 507648
BY AQUA PURITY LIMITED**

BACKGROUND AND PLEADINGS

1. Trade mark registration number UK00003970474 (“the contested mark”), shown on the cover page of this decision, stands registered in the name of Global Fulfillment Limited (“the Proprietor”). The contested mark was filed on 22 October 2023 and registered on 12 January 2024 for *brushes* in class 21.

2. On 7 August 2024, Aqua Purity Limited (“the Cancellation Applicant”) filed an application for a declaration of invalidity of the contested mark in full. The application is based upon sections 5(2)(a) and 5(4)(a), under the provisions of section 47(2), of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(a), the Cancellation Applicant relies upon the following trade mark (“the earlier mark”):

UK trade mark number 3355455

Representation: PHOERA

Filing date: 22 November 2018

Registration date: 22 February 2019

Goods relied upon: *cosmetics* in class 3.

4. Given its respective filing and registration dates, the Cancellation Applicant’s mark qualifies as an earlier mark under section 6(1)(a) of the Act but was not, at the filing date of the contested mark, subject to the use provisions at sections 47 (2A) – (2F) of the Act. For the purposes of these proceedings, the Cancellation Applicant may rely upon its earlier mark for the goods listed in the previous paragraph without proving use.

5. Under section 5(2)(a), the Cancellation Applicant claims that there is a likelihood of confusion (including a likelihood of association) between the earlier mark and the contested mark on the basis that the marks are identical and the goods are highly similar.

6. Under section 5(4)(a), the Cancellation Applicant relies upon the unregistered sign, PHOERA, which it claims to have used throughout the UK in relation to *cosmetics* since 2017 and in relation to *cosmetic brushes* since 2021. The Cancellation Applicant claims to have generated a substantial goodwill in the sign and that use of the contested mark would constitute a misrepresentation to the public that would damage the Cancellation Applicant's goodwill. Therefore, use of the contested mark would be contrary to the law of passing off.

7. The Proprietor filed a counterstatement denying the entirety of the Cancellation Applicant's claims and putting the Cancellation Applicant to proof of its alleged goodwill.

8. Neither party is professionally represented. Only the Cancellation Applicant filed evidence. No hearing was requested and neither party filed written submissions in lieu of a hearing. This decision is taken following a careful consideration of all the papers filed.

EVIDENCE

9. The Cancellation Applicant filed evidence in the form of the witness statement of Bushra Farid ("BF WS") dated 27 May 2025 and its corresponding exhibits (labelled BF1 – BF17A). Bushra Farid is the director of the Cancellation Applicant and the evidence has been filed mainly to demonstrate the claimed goodwill in its sign and instances of actual confusion.

10. I do not intend to summarise the evidence but have taken it into account and will refer to it throughout this decision, where relevant.

DECISION

Relevance of EU law

11. 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.

Section 5(2)(a)

Statutory provisions

12. Sections 5(2)(a) and 5A of the Act state:

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

(a) it is identical to an earlier trade mark and is to be registered for goods or services 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.”

And

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13. Section 5(2)(a) has application in invalidation proceedings by virtue of section 47 of the Act, the relevant parts of which state as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, [...]

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Relevant case law

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

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(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 marks

15. Whilst the Proprietor denies that the contested mark and the earlier mark are “identical or similar [...] in a way that creates confusion”, it is self-evident that they are identical, both being the word mark “PHOERA”.

Comparison of goods

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the Court of Justice of the European Union (“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.”

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

18. Further, in *Kurt Hesse v OHIM*,¹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,² the General Court 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.”

19. The goods to be compared are the Cancellation Applicant’s *cosmetics* in class 3 and the Proprietor’s *brushes* in class 21.

20. The Cancellation Applicant attests to a high degree of similarity between the goods on the basis that the Proprietor’s goods include cosmetic brushes which, when compared to *cosmetics*, serve the same purpose, are complementary, are provided through the same distribution channels and have the same relevant public.

21. The Proprietor disagrees and submits that the goods are “fundamentally different”.

22. Cosmetic and make up brushes are proper to class 21 of the Nice classification. As such, the Proprietor’s *brushes* would encompass cosmetic brushes. To this extent, the parties’ goods will overlap in users and have a similar purpose where they are both used as part of improving the appearance of the user’s face or body, although the method of use differs as the Proprietor’s goods are the tools used to apply the Cancellation Applicant’s goods. The goods are typically used together and are, therefore, complementary in that they are important to one another and consumers would expect the same undertaking to provide cosmetics and brushes to apply cosmetics. Such goods will reach the market through shared trade channels and will be located in close proximity in retail stores and under the same categories online. However, the goods have very different physical natures and are not in competition

¹ Case C-50/15 P.

² Case T-325/06.

with one another. Taking all of the above into consideration, I find a low to medium degree of similarity between the parties' goods.

The average consumer and the purchasing act

23. 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.

24. 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.

25. The average consumer of the parties' goods will be a member of the general public. Various factors will be taken into account during the selection process, such as the ingredients of the cosmetics, the materials used in the brushes, and the general suitability for the users' requirements. An average degree of attention will be paid when selecting the goods. Consumers will make a selection usually upon perusing the shelves of physical outlets, or their online or catalogue equivalents. Word of mouth recommendations and conversations with retail assistants will also take place. As such, the purchase is predominantly visual, though I do not discount an aural element.

Distinctive character of the earlier mark

26. 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)."

27. 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, 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.

28. I will assess the inherent position first. PHOERA is not an ordinary dictionary word: it will be seen as invented by the average consumer. It is neither descriptive of, nor allusive for the goods. I consider the earlier mark to have a high degree of inherent distinctiveness.

29. Turning to whether the distinctiveness of the earlier mark has been enhanced through use, I consider the Cancellation Applicant's evidence of use.

30. There is evidence of use of the earlier mark in relation to sales of PHOERA cosmetics (for example, nail gel, brow pencil, lipliner, mascara, highlighter cream and eyeshadow),³ uncontested narrative evidence that the Cancellation Applicant generated over £1.4 million in sales between 2019 and 2023⁴ - including over £359,000 from October 2020 to September 2021⁵ (the remaining financial statements

³ BF13.

⁴ BF WS at paragraph 8.

⁵ BF8.

are not easily discernible,⁶ though the total aforementioned turnover is uncontested regardless) - and evidence of the earlier mark used in relation to cosmetics on TikTok,⁷ Instagram⁸ and Facebook.⁹

31. The social media evidence is not persuasive; firstly, it is undated and secondly, the follower numbers are low (55 on TikTok, 430 on Instagram and 1,300 on Facebook). The only evidence relating to the amount spent on advertising the mark is £5,272.63 on Amazon campaigns, with no overall figure provided. Neither has the Cancellation Applicant provided details of the market share held by the mark, and although £1.4 million is not an insignificant turnover, with no evidence of the size of the cosmetics market, it is impossible to estimate the market share. Whilst the Cancellation Applicant has clearly created and maintained a market, given that account should be taken of the market share, promotional spend and intensity of use,¹⁰ I am not satisfied that the level of use supports a finding of enhanced distinctiveness in the earlier mark which, in any case, remains at a high degree inherently.

Likelihood of confusion

32. 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 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the

⁶ BF9.

⁷ BF3.

⁸ BF4.

⁹ BF5.

¹⁰ As per *Lloyd Schuhfabrik Meyer*, cited above.

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he/she has retained in his/her mind.

33. I have found the earlier mark and the contested mark to be identical. I have found the earlier mark to have a high degree of inherent distinctive character. I have found the goods to be similar to between a low and medium degree. I have identified the average consumer to be a member of the general public who would pay an average degree of attention to the purchase of the goods and selects them predominantly by visual means, though I do not discount the aural consideration.

34. Given the identity between the competing marks, it is my view that the average consumer will be directly confused, despite the similarity between the goods being low to medium, due to the interdependency principle. There is a likelihood of direct confusion.

Actual confusion

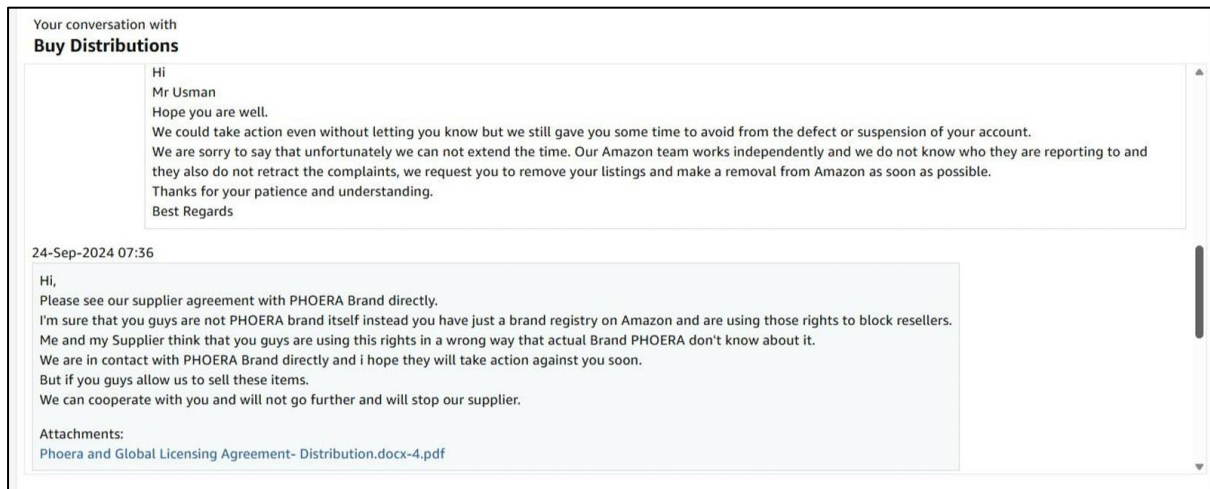
35. For completeness, though it has no bearing on my finding in the previous paragraph, I will address the evidence of alleged actual confusion by the Cancellation Applicant. On this point, I note the comments of Kitchin LJ (as he then was) in the case of *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220. While the relevant discussion in that case surrounded the lack of confusion in the marketplace, he did state that:

“80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion.” (My emphasis)

36. Bushra Farid’s witness statement includes the following:

“6. We discovered Amazon sellers selling under our brand name, we reported them to Amazon. Subsequently informed us that they had bought Phoera Cosmetics from Global Fulfilment, believing they were the official UK distributors (Exhibit, BF17, BF17a). This misleading conduct has caused **market confusion**, as evidenced in an emails from of their customers (Exhibit BF14, BF14), stating they believed Global Fulfillment are the brand owner. They provided invoices for Cosmetics purchased from Global Fullfillment (Exhibit BF14a). (Sic)” [Original emphasis]

37. The evidence referred to consists of two conversations; neither set of circumstances is particularly clear but I reproduce the evidence below:¹¹



¹¹ BF15 and BF17.

38. Even if I were satisfied that the above circumstances constitute instances of actual confusion, two examples is not what I would consider a powerful factor pointing towards confusion, and I place very little weight on it. Regardless, I have found a likelihood of confusion in the absence of evidence of actual confusion.

Outcome

39. The section 5(2)(a) ground has succeeded.

Section 5(4)(a)

Statutory provisions

40. 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.”

41. Section 5(4)(a) has application in invalidation proceedings by virtue of section 47 of the Act, the relevant parts of which state as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

[...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Relevant case law

42. 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

43. 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 *SWORDERS 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.’”

44. The Proprietor has not provided any evidence of use and, therefore, the relevant date for the section 5(4)(a) assessment is the filing date of the contested mark: 22 October 2023.

Goodwill

45. 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.”

46. The evidence of advertising of the sign is limited: as discussed in my enhanced distinctiveness assessment, the only figure provided is £5,272.63 in relation to Amazon campaigns between June 2019 and October 2021; the social media accounts have a low number of followers and this evidence is undated. However, the uncontested turnover figure of over £1.4 million is not insignificant and there is evidence of a large number of sales of different cosmetics (such as nail gel, brow pencil, lipliner, mascara, highlighter cream and eyeshadow, for example) in the years leading up to the relevant date. Even though I have no evidence of the market share held by the Cancellation Applicant in relation to cosmetics, I remind myself that small businesses are capable of generating a protectable goodwill so long as it is more than trivial.¹² The sales figures and turnover I have referred to do not strike me as trivial. Accordingly, I am satisfied that the Cancellation Applicant has generated a modest, but protectable, goodwill. Whilst the Cancellation Applicant relies upon *cosmetics* and *cosmetic brushes* under this ground, the only evidence of actual sales of *cosmetic brushes* includes four sales of lip brushes, one sale of eyelash brushes and one make up brush set, all in June 2023.¹³ In my view, this is not sufficient for a finding of goodwill and so the protectable goodwill extends only to *cosmetics*.

¹² *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

¹³ BF13.

Misrepresentation and damage

47. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ 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.”

And later in the same judgment:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

48. *Halsbury's Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attached importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

49. In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a *substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal’s later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.¹⁴ This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

50. I have already found that there is a likelihood of confusion between the earlier mark and the contested mark. The sign relied upon under this ground is identical to the earlier mark relied upon under section 5(2)(a). All other factors being equal, I find that a substantial number of members of the public will be deceived into believing that the goods provided under the contested mark and the Cancellation Applicant’s sign are offered by the same or connected undertakings: the mark and the sign are identical and the goods fall within the same or very closely related fields of activity.¹⁵ Therefore, misrepresentation is made out. In such circumstances, I consider that damage through diversion of sales is entirely foreseeable.

Outcome

51. The section 5(4)(a) ground has succeeded.

¹⁴ Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

¹⁵ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA).

CONCLUSION

52. The application has been successful and the contested mark will be declared invalid in its entirety.

COSTS

53. The Cancellation Applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the Cancellation Applicant is unrepresented, at the conclusion of the evidence rounds, the Tribunal, by way of a letter dated 27 October 2025, invited the Cancellation Applicant to indicate whether it wished to make a request for an award of costs and, if so, to complete the attached pro-forma including a breakdown of its costs. The Cancellation Applicant failed to return the pro-forma. As such, I make no award of costs other than the official fee of £200.

54. I therefore order Global Fulfillment Limited to pay Aqua Purity Limited the sum of £200. 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 30th September 2026

MRS E FISHER

For the Registrar