O/0998/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3770602
BY WAKEFUL LTD

TO REGISTER:

Wakeful

wakeful

WAKEFUL

AS A SERIES OF TRADE MARKS IN CLASSES 5, 29 & 32

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 434840 BY
MINTOLOGY LIMITED

BACKGROUND AND PLEADINGS

1. On 28 March 2022, WAKEFUL LTD ("the applicant") applied to register the series of three trade marks shown on the front cover of this decision. Nothing turns on the differences between the marks in the series and so I shall refer to them in the singular throughout this decision. Following amendments to the specification, the goods and services for which registration is sought are as follows:

> *Class 5*
> *Vitamins and vitamin preparations; Vitamin supplements; Vitamin drinks; Chewable vitamins; Effervescent vitamin tablets; Multi-vitamin preparations; Vitamin supplement patches; Vitamin and mineral food supplements.*
>
> *Class 29*
> *Milk drinks; Yogurt drinks; Flavoured milk drinks; Lactic acid drinks; Yoghurt based drinks; Milk drinks containing fruits; Lactic acid bacteria drinks; Milk substitutes; Soya milk [milk substitute]; Rice milk [milk substitute]; Non-dairy milk substitutes; Plant-based milk substitutes; Oat milk; Milk-based beverages; Milk-based beverages flavoured with chocolate; Oat-based beverages [milk substitute].*
>
> *Class 32*
> *Waters [beverages]; Isotonic beverages; Beverages containing vitamins; Fruit-flavoured beverages; Non-alcoholic beverages; Beverages (Non-alcoholic -); Mineral waters [beverages]; Nutritionally fortified beverages; Flavoured carbonated beverages; Syrups for making beverages; Effervescing beverages (Powders for -); Functional water-based beverages; Mineral enriched water [beverages]; Energy drinks; Energy drinks containing caffeine; Soft drinks for energy supply; Isotonic drinks; Carbohydrate drinks; Protein drinks; Sports drinks; Carbonated soft drinks; Bottled drinking water; Non-alcoholic drinks; Distilled drinking water; Isotonic non-alcoholic drinks; Low calorie soft drinks; Non-carbonated soft drinks.*

2. On 7 July 2022, the application was partially opposed by Mintology Limited ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and concerns the goods in Class 5 of the specification.

3. Under section 5(2)(b), the opponent is relying on the following marks and all the goods and services listed:

UKTM No. 3380309 ("the 309 mark")

WAKEN

Application date: 4 March 2019
Registration date: 24 May 2019

Class 3
Toothpaste; oral rinses; mouthwash; breath sprays; whitening strips; dentifrices.

Class 5
Medicated mouthwash; medicated oral care dissolving strips; medicated oral care products; medicated oral care products, namely medicated toothpaste; medicated oral care preparations; medicines for dental purposes; medicated dental rinses; medicated mouth spray; medicated dentifrices; material for stopping teeth, dental wax.

Class 21
Toothbrushes (manual and electric); dental floss; interdental brushes and floss.

Class 35
Retail services relating to the sale of toothpaste, oral rinses, mouthwash, breath sprays, whitening strips, dentifrices, medicated mouthwash, medicated oral care dissolving strips, medicated oral care products, medicated oral care products, namely medicated toothpaste, medicated oral care preparations, medicines for dental purposes, medicated dental rinses, medicated mouth spray, medicated dentifrices, material for stopping teeth, dental wax, toothbrushes (manual and electric), dental floss, interdental brushes and floss.

UKTM No. 3491514 (“the 514 mark”)

WAKEN

Application date: 19 May 2020

Registration date: 16 October 2020

Class 3

Lip preparations; lip care preparations; non-medicated lip care preparations; lip balm; lip masks; lip conditioners; lip scrubs; lip serum; toothpaste; oral rinses; mouthwash; breath sprays; whitening strips; dentifrices; cosmetic tooth gloss; cosmetic chewing gum; essential oils; air fragrance reed diffusers; none of the aforesaid including lip make-up, lip stick and products sold primarily as lip colouring products and lip gloss.

Class 35

Advertising and promotion of lip preparations, lip care preparations, non-medicated lip care preparations, lip balm, lip masks, lip conditioners, lip scrubs, lip serum, toothpaste, oral rinses, mouthwash, breath sprays, whitening strips, dentifrices, cosmetic tooth gloss, cosmetic chewing gum; none of the aforesaid including lip make-up, lip stick and products sold primarily as lip colouring products and lip gloss, medicated lip balm; conducting, arranging and organising trade fairs related to lip preparations, lip care preparations, non-medicated lip care preparations, lip balm, lip masks, lip conditioners, lip scrubs, lip serum, toothpaste, oral rinses, mouthwash, breath sprays, whitening strips, dentifrices, cosmetic tooth gloss, cosmetic chewing gum; none of the aforesaid including lip make-up, lip stick and products sold primarily as lip colouring products and lip gloss, medicated lip balm.

UKTM No. 3528739 (“the 739 mark”)

Application date: 1 September 2020

Registration date: 3 December 2021

Class 3

Lip preparations; lip care preparations; non-medicated lip care preparations; lip balm; lip masks; lip conditioners; lip scrubs; lip serum; toothpaste; oral rinses; mouthwash; breath sprays; whitening strips; dentifrices; cosmetic tooth gloss; cosmetic chewing gum; essential oils; air fragrance reed diffusers; none of the aforesaid including lip make-up, lip stick and products sold primarily as lip colouring products and lip gloss.

Class 5

Chewing gum for medical purposes; medicated dentifrices; medical diagnostic test strips; dietetic substances for medical use; vitamin and mineral preparations; food supplements; medicines for dental purposes; medicated lip care preparations; pharmaceutical preparations for lip care; medicated mouthwash; medicated oral care dissolving strips; medicated oral care products; medicated toothpaste; medicated lip balm; medicated lip masks; medicated lip scrub; medicated lip serum; medicines for dental purposes; medicated dental rinses; medicated mouth spray; medicated dentifrices; material for stopping teeth; dental wax.

Class 21

Toothbrushes (manual and electric); dental floss; interdental brushes and floss.

UKTM No. 3428462 ("the 462 mark")

Application date: 13 September 2019

Registration date: 6 December 2019

Class 3

Toothpaste; oral rinses; mouthwash; breath sprays; whitening strips; dentifrices.

Class 5

Medicated mouthwash; medicated oral care dissolving strips; medicated oral care products; medicated oral care products, namely medicated toothpaste; medicated oral care preparations; medicines for dental purposes; medicated dental rinses; medicated mouth spray; medicated dentifrices; material for stopping teeth, dental wax.

Class 21

Toothbrushes (manual and electric); dental floss; interdental brushes and floss.

Class 35

Retail services relating to the sale of toothpaste, oral rinses, mouthwash, breath sprays, whitening strips, dentifrices, medicated mouthwash, medicated oral care dissolving strips, medicated oral care products, medicated oral care products, namely medicated toothpaste, medicated oral care preparations, medicines for dental purposes, medicated dental rinses, medicated mouth spray, medicated dentifrices, material for stopping teeth, dental wax, toothbrushes (manual and electric), dental floss, interdental brushes and floss.

4. These marks qualify as earlier marks under section 6(1) of the Act. As they were all registered less than five years before the application date of the contested mark, they are not subject to the proof of use provisions in section 6A of the Act and the opponent may rely on all the goods and services listed above.

5. The opponent claims that the marks are highly similar and that the contested goods are identical to *Vitamin … preparations* and *Food supplements* covered by the 739 mark, and similar to the remaining goods and services relied on. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. Under section 5(3), the opponent relies on all four earlier marks and claims that they have a reputation for all the goods and services listed. It further claims that the relevant public will make a link between the marks and that damage would occur in one or more of the following ways:

- the applicant would gain an unfair advantage by using the earlier marks to generate consumer interest without having to invest in the promotion and advertising of its own goods;
- the opponent's goods are known for their high quality and this image would be transferred to the applicant's goods without it having to have incurred the same marketing costs as the opponent;
- the opponent's reputation would be damaged if the applicant's goods were of lower quality or if its brand image were inferior; and/or
- the opponent's marks would no longer be capable of arousing immediate association with the goods and services for which they are registered.

7. Under section 5(4)(a), the opponent claims to have established goodwill through the use since 2019 of the signs registered as the earlier marks for the following goods and services: *Lip care preparations; lip balm; toothpaste; oral rinses; mouthwash; breath sprays; whitening strips; dentifrices; toothpaste; mouthwash; toothbrushes; oral care products; dental floss; retail services relating to lip care preparations, lip balm, toothpaste, oral rinses, mouthwash, breath sprays, whitening strips, dentifrices, toothpaste, mouthwash, toothbrushes, oral care products and dental floss*. According to the opponent, use of the contested mark would constitute a misrepresentation to the public that would damage the goodwill in its business, for instance by the loss or diversion of trade. Consequently, use of the contested marks for the contested goods would be contrary to the law of passing off.

8. The applicant filed a defence and counterstatement denying the claims made and arguing that the parties operate in different market sectors. Its counterstatement contains detailed submissions on the claims, and I will refer to them where appropriate during the course of my decision.

9. Only the opponent filed evidence in these proceedings. The witness statement comes from Rhodri Ferrier, Company Director and co-founder of Mintology Limited, and is dated 13 January 2023. Mr Ferrier's evidence goes to the use and reputation of the earlier marks and signs.

10. Neither side requested a hearing and the opponent filed final written submissions dated 2 May 2023.

11. In these proceedings, the opponent is represented by Lane IP Limited, and the applicant is unrepresented.

DECISION

Section 5(2)(b)

12. Section 5(2) of the Act is as follows:

> "A trade mark shall not be registered if because–
>
> …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

13. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):[1]

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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;

[1] Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the trade mark case-law of EU courts, although the UK has left the EU.

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 goods and services

14. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

> "… there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."[2]

[2] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

15. The contested goods are as follows:

> *Class 5*
> *Vitamins and vitamin preparations; Vitamin supplements; Vitamin drinks; Chewable vitamins; Effervescent vitamin tablets; Multi-vitamin preparations; Vitamin supplement patches; Vitamin and mineral food supplements.*

16. At this point, I consider it would be helpful to clarify that, as the opponent is not required to prove it has used the earlier marks, I must base my assessment of this ground on the contents of the respective specifications alone, rather than any previous patterns of trade. The exception to this is the question of whether the distinctive character of the earlier marks have been enhanced, and I shall come to this later. The same point also applies to the contested goods. The applicant states that it proposes to use the mark for *"goods related to the market niche of healthy nootropics"*.[3] I am, however, required to consider the terms for which registration is sought, rather than any submissions about marketing intentions.

17. The applicant admits that the contested goods are identical or similar to *Vitamin and mineral preparations* and *Food supplements* covered by the opponent's 739 mark (one of the figurative marks). Where goods (or services) in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. All the contested goods are included in the opponent's broader *Vitamin and mineral preparations* and so I find them to be identical. The goods and services covered by the 462 mark (the other figurative mark) put the opponent in no better a position.

18. I shall also consider whether there is any identity or similarity between the contested goods and any of the goods and services covered by the 309 and 514 marks (the plain word **WAKEN**). The opponent submits that the applicant's goods are identical to the 309 mark's *Medicated mouthwash; medicated oral care dissolving strips; medicated oral care products; medicated oral care products, namely medicated*

[3] Counterstatement, paragraph 6.

toothpaste; medicated oral care preparations; medicines for dental purposes; medicated dental rinses; medicated mouth spray; medicated dentifrices. This is because, in its view, *"The term 'medicated' means a good that is impregnated with a medical substance, which would include vitamins. 'Medicines for dental purposes' clearly includes vitamins."*[4]

19. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "12. … Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

20. In my view, the average consumer would understand the core meaning of the term *Medicine* to be a drug or other therapeutic substance used to treat or prevent a disease or its symptoms and the term *Vitamin* to mean a substance occurring naturally, usually in food, which is essential for the healthy functioning of the body. I consider that it would be a straining of the language to treat them as identical. However, I accept that the users will be the same and the contested goods are likely to reach the market through the same trade channels as the opponent's *Medicated oral care products*, *Medicated oral care preparations* and *Medicines for dental purposes* which can all be found in the specification of the 309 mark. They are likely to be stocked in fairly close

[4] Written submissions in lieu of a hearing, paragraph 10(a).

proximity in supermarkets. There will be an overlap in nature and method of use. I consider that there will also be a degree of competition, as a consumer could choose to buy a medicated oral care product or dental medicine or vitamin supplements and preparations to improve their dental and oral health. The goods are not complementary. Taking all these factors into account, I find that there is a medium degree of similarity between them.

21. The opponent submits that its Class 5 goods represent its best case. I agree and cannot see that any of the other goods or services are closer to the contested goods. In the analysis that follows, I shall refer to the 309 and 739 marks as these are the ones with the closest specifications and the 514 and 462 marks are identical to them.

Average consumer and the purchasing process

22. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes 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 and services in question: *Lloyd Schuhfabrik*, paragraph 26.

23. The average consumer would, in my view, be a member of the general public. The opponent submits that the goods in question would be low in cost and sold as everyday items, and that the average consumer would therefore be paying a low degree of attention when making their purchase. The applicant, on the other hand, submits that the level of attention would be greater than average as the goods at issue would be expected to have an impact on the user's health, would be relatively expensive and would be bought in quantities that are intended to last for a month. I agree with the applicant that the consumer would be buying the goods for health reasons, and so I do not accept the opponent's submission that they will be paying a low degree of attention. I consider that the level of attention would be between medium and high.

24. The goods are likely to be selected by the consumer from the shelves of a retailer or from a website. It follows that the purchasing process will be largely visual. However,

I accept that they may also seek advice from sales staff or receive word-of-mouth recommendations, and so the aural aspects of the mark cannot be ignored.

Comparison of marks

25. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

26. The respective marks are shown below:

Contested mark	**Earlier marks**
Wakeful wakeful WAKEFUL	The 309 mark: WAKEN The 739 mark: 

27. The contested mark consists of a single word. In paragraph 39 of *LA Superquimica v European Union Intellectual Property Office*, Case T-24/17, the General Court held that such plain word marks protected the word or words contained in the mark in whatever form, colour or typeface. The overall impression of the mark lies in the word.

28. The 309 mark also consists of a single word and I find that the overall impression of that mark lies in the word alone.

29. The 739 mark is a composite mark, consisting of a verbal and figurative element. The verbal element is the single word "WAKEN", presented in capital letters in a slightly stylised typeface. Above the verbal element is a circle containing a pattern of four curved lines in the bottom half of the circle. The courts have held that in principle the verbal element of a composite mark should be considered to be more distinctive than the figurative element: see *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37. In my view, this would be the case with the 739 mark. I find that the dominant and more distinctive element of the 739 mark is the word "WAKEN", with the stylisation and the device making lesser contributions to the overall impression of the mark. However, I consider it important to be clear at this point that the role of the device is not insignificant, particularly given its size and position. The verbal element, in my view, plays an independent distinctive role in the mark.

Comparison with the 309 mark

30. The initial four letters of each of the marks are the same. The only difference comes from the endings: "-N" and "-FUL". The beginnings of words tend to have more visual and aural impact than the ends: see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraphs 81 and 82. I find that the marks are visually highly similar.

31. Both marks are common English words and will be pronounced in the usual way. As both are the same length and have identical first syllables, I find them to be aurally similar to a high degree.

32. I turn now to the conceptual comparison. The word "WAKEN" is likely to be understood by the average consumer as meaning the action of rousing someone from sleep. The applicant submits that "WAKEFUL" in the contested mark means *"not able to sleep, or used to describe a period of time when you are not able to sleep"*. This definition is taken from the Cambridge Online Dictionary.[5] The applicant argues that

[5] Counterstatement, paragraph 78.

the meanings of the marks are different: that the opponent's refer to the act of waking someone up from sleep, while the contested mark relates to being unable to fall asleep. The opponent submits that the applicant's mark refers to a period of not being asleep, but that both are connected to sleep states and are therefore conceptually highly similar. I agree with the opponent. It must be recalled that the average consumer will not analyse the marks in minute detail. Taking into account the shared concept of being awake, I find that the differences between the action of rousing someone and the state of being awake for some period of time are quite subtle. I find that marks are conceptually similar to a high degree.

Comparison with the 739 mark

33. The contested mark shares the same first four letters with the verbal element of the 739 mark. The ends of the words and the device in the 739 mark are points of visual difference. Taking account of the marks as a whole, and the dominant and more distinctive role played by the verbal element of the 739 mark, I find that they are visually similar to a low to medium degree.

34. The verbal element of the 739 mark is the only element that will be articulated. I therefore adopt my findings on the aural comparison in paragraph 31 above.

35. I have already found that the device in the 739 mark would not be perceived as representing anything and so any conceptual message conveyed by this mark comes from the verbal element. I therefore adopt my findings on the conceptual comparison in paragraph 32 above.

Distinctive character of the earlier mark

36. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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)."

37. Registered trade marks possess varying degrees of inherent distinctive character from the low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

38. The applicant submits that the average consumer would understand the word "WAKEN" to be *"associated, allusive and descriptive"* of vitamins and supplements, and so the mark has a very low level of inherent distinctiveness.[6] It also submits that the use the opponent has made of its marks in the oral and dental care market has reduced the mark's distinctiveness in the context of vitamins and supplements, as it has become more associated with the former market. Whether the opponent's mark is known for goods or services in another sector has no relevance to my consideration of this ground.

Distinctive character of the 739 mark

39. I have already found that "WAKEN" is a commonly used English word, which means the act of rousing someone from sleep. I accept that one of the reasons people take vitamin and mineral preparations is to increase their energy levels and combat feelings of tiredness. I therefore consider that the word is weakly allusive for these goods. I disagree with the opponent that allusive marks have at least an ordinary or

[6] Counterstatement, paragraph 51.

medium level of inherent distinctive character. Such marks tend to have a lower level of inherent distinctiveness. The device increases the inherent distinctive character of the 739 mark to a medium level.

40. In his witness statement for the opponent, Mr Ferrier says that the earlier marks have been used in relation to mouthcare products and accessories and lip balms.[7] The opponent has not claimed to have used the 739 mark for *Vitamin and mineral preparations* and these goods do not feature in the evidence. I find that the inherent distinctive character of the 739 mark has not been enhanced for *Vitamin and mineral preparations*.

Distinctive character of the 309 mark

41. The applicant submits that the word "WAKEN" is allusive of dental and oral care goods, as people usually brush their teeth in the morning and will feel more awake by the time that they have finished doing so. In my view, identifying such an allusion requires a number of mental steps that I am not persuaded the average consumer will make. Consequently, I consider that the 309 mark has a medium degree of inherent distinctive character for *Medicated oral care products*, *Medicated oral care preparations* and *Medicines for dental purposes*.

42. Mr Ferrier states that his company launched a range of oral care products under the earlier marks in October 2019. The goods are marketed as containing natural mints and other botanical extracts, but I cannot see any evidence that they are medicated. I find that the inherent distinctive character of the 309 mark has not been enhanced for *Medicated oral care products, Medicated oral care preparations* and *Medicines for dental purposes*.

Conclusions on likelihood of confusion

43. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to

[7] Paragraph 4.

be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind 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 they have in their mind.

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

45. I shall begin by considering the likelihood of confusion with the 309 mark, as I found the marks to be highly similar and the distinctive character of the 309 mark to be at a medium level. I also found a medium degree of similarity between the goods. Even with the average consumer paying a level of attention between medium and high during the purchasing process, it is my view that, given their high degree of similarity, the marks will be imperfectly recollected and one is likely to be mistaken for the other. I find that there is a likelihood of direct confusion between the contested mark and the 309 mark.

46. The partial opposition based on the 309 mark is successful under section 5(2)(b) of the Act.

Section 5(3)

47. Section 5(3) of the Act is as follows:

> "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."

48. The conditions of section 5(3) are cumulative. First, the application must be similar to the earlier mark(s). Secondly, the opponent must satisfy me that the earlier mark has 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 earlier mark being brought to mind by the application. 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 and/or 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.

49. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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 Salomon*, 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

50. I have already found that the contested mark is similar to the earlier marks.

Reputation

51. In *General Motors*, the CJEU held that:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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."

52. The relevant date on which the opponent must show that the earlier marks have a reputation is the application date of the contested mark, i.e. 28 March 2022.

53. The goods and services are, for the most part, targeted towards the general public, although I note that some, such as *Material for stopping teeth*, would be bought by dental surgeons.

54. Exhibit RF1 shows the opponent's products as toothpaste, toothpaste tablets, mouthwashes, mouthwash cups, dental floss, lip balm, candles, toothbrushes, toothpaste squeezer keys. The earlier marks can be seen on the packaging. As the 309 and 514 marks are plain word marks, I consider that the use shown below is use of those marks also: see *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, paragraphs 31-35.[8]

[8] The image is taken from page 26 of Exhibit RF1.

55. The images in Exhibit RF1 are taken from the opponent's website but are undated. What I can take from the evidence is that mouthwashes were being sold from the beginning and the packaging was as shown above. This can be seen from an article dated 30 October 2019 from the website of the Culina Group, which appears to be a logistics company that worked with the opponent on the launch of the brand.[9] The first two pages of Exhibit RF2 also show some press articles in national publications such as *Harper's Bazaar, Elle, GQ* and *The Sunday Telegraph* covering the launch of the mouthwashes. While not all of these are dated, those that are come from 2019. The peppermint version was awarded Best Mouthwash in the Beauty Shortlist Wellbeing Awards 2020 and the spearmint version won Gold for best natural dental product in the Global Green Beauty Awards 2020 and Bronze in the Pure Beauty Awards 2020.[10] In 2021, the opponent won Best Dental Hygiene Range for its mouthwashes at the Glamour Wellness Awards.[11] Mr Ferrier states that five new mouthwash flavours were launched in February 2022.[12]

56. It is not clear when the other products came onto the market, although I note that an article from a beauty and lifestyle blog, We Were Raised by Wolves, dated 18 January 2022, describes the opponent as selling toothpaste, lip balms *"and associated eco-friendly accessories"* as well as mouthwash. The article itself is a

[9] Exhibit RF2, pages 55-57.
[10] *Ibid*, pages 94 and 108.
[11] *Ibid*, page 125.
[12] Witness statement, paragraph 8.

review of what is described as *"one of their 'hero' products, the Apple & Mint Mouthwash"*.[13]

57. By the relevant date, the opponent's goods were being sold in Boots, Sainsbury's, Amazon, Ocado, Waitrose and Wilko: all retailers with a national presence. Mr Ferrier lists other retailers in paragraph 9 but has not given any dates in relation to them.

58. He states that since the launch of the brand, retail sales have amounted to £4 million and that substantial sums have been invested in advertising and marketing: £800k on digital advertising, £40k on photography, £53k on the production of in-store displays, £1.2m on retailer marketing, space promotions and advertising. It is not clear from the wording of the witness statement if this last figure includes all promotional expenditure or is in addition to the previously given figures.[14] The witness statement is dated 13 January 2023. There is no indication that the figures for sales and marketing spend cover the period up to the relevant date of 28 March 2022 or the period up to the date of the witness statement. There may have been sales of £4 million over a period of 2 years and 5 months or a period of 3 years and 2 months, or somewhere in between. The same applies in respect of the marketing expenditure, but there is the added uncertainty of whether the total spending was £1.2m or nearly £3m.

59. While I accept that the opponent's mouthwashes have won awards during the period leading up to the relevant date, there is nothing to tell me the impact these may have had upon the relevant public. I can see that there was some coverage in the national press at the launch, but later articles are taken from blogs and the UK readership of these is not clear. I note that the We Were Raised by Wolves blogpost claims to have had 9,407,055 page views, but as this information appears to be in a sidebar it is not clear whether this refers to the particular review or the blog as a whole. It is also likely to be a figure that was current at the time of retrieving the post (11 January 2023, almost a year after publication).

[13] Exhibit RF2, pages 84-88.
[14] Witness statement, paragraphs 5-7.

60. In my view, the evidence falls short of demonstrating that the earlier marks had a reputation by the relevant date.

61. The partial opposition under section 5(3) fails.

Section 5(4)(a)

62. Section 5(4)(a) of the Act states that:

> "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 or 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 4(A) is met
>
> …"

63. Subsection 4(A) is as follows:

> "The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

64. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

> "First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the

public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."[15]

65. *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:

[15] Page 406.

(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 are likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches 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."

66. The relevant date for assessing a claim of passing off is the date of commencement of the conduct complained of: see *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429. In opposition proceedings, this is the date of the application for registration or, if relevant, a priority date. Where the applicant has used the mark before the application it is also necessary to consider the position at the point of first use. The applicant states that it wishes to develop a range of vitamins and supplements, and has provided no evidence to show that it has already used the mark for these goods.[16] Consequently, the relevant date is 28 March 2022.

[16] Counterstatement, paragraph 3.

Goodwill

67. The opponent must show that it had goodwill in a business at the relevant date and that the signs relied upon were associated with, or distinctive of, that business. I remind myself that it claims to have used the signs covered by the registered marks for the following goods and services:

> *Lip care preparations; lip balm; toothpaste; oral rinses; mouthwash; breath sprays; whitening strips; dentifrices; toothpaste; mouthwash; toothbrushes; oral care products; dental floss; retail services relating to lip care preparations, lip balm, toothpaste, oral rinses, mouthwash, breath sprays, whitening strips, dentifrices, toothpaste, mouthwash, toothbrushes, oral care products and dental floss*.

68. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

69. I shall not repeat the analysis I have already made of the opponent's evidence. I found that it was insufficient to show that the earlier marks had a reputation, but the law of passing off may protect a small level of goodwill, provided this is more than nominal. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31,

paragraph 52; *Reckitt & Colman*, and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

> "34. … a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

70. On the basis of the opponent's evidence, I am satisfied that it is likely to have established a modest level of goodwill associated with the sale of mouthwashes by the relevant date, and that the earlier marks were distinctive of its business.

Misrepresentation

71. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

> "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] RPC 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 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

72. I have already said at several points in this decision that I accept that the parties' goods will be sold through some of the same retailers. They are both concerned with the health of the user. To the extent that the vitamin preparations of the applicant's specification are focused on oral and dental health, I consider that it is likely, given the high degree of similarity between the word sign and the contested mark that the public would be misled into purchasing the applicant's goods in the belief that they are the responsibility of the opponent.

Damage

73. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, 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."

74. I do not think it likely that the consumer will buy the applicant's vitamin preparations instead of mouthwashes. I recall that my finding of a degree of competition under section 5(2)(b) was based on a comparison between different goods. I shall therefore consider whether there is likely to be a damage to the reputation of the opponent. Mr Ferrier's evidence shows that the environmental impact of the products is important to its image, with the company being certified 100% carbon neutral in December

2020.[17] In my view, there is a risk of damage through injurious association and so the section 5(4)(a) ground is successful.

OUTCOME

75. The partial opposition has succeeded and Application No. 3770602 may, subject to a successful appeal, proceed to registration for the following goods, that were unopposed:

> *Class 29*
> *Milk drinks; Yogurt drinks; Flavoured milk drinks; Lactic acid drinks; Yoghurt based drinks; Milk drinks containing fruits; Lactic acid bacteria drinks; Milk substitutes; Soya milk [milk substitute]; Rice milk [milk substitute]; Non-dairy milk substitutes; Plant-based milk substitutes; Oat milk; Milk-based beverages; Milk-based beverages flavoured with chocolate; Oat-based beverages [milk substitute].*
>
> *Class 32*
> *Waters [beverages]; Isotonic beverages; Beverages containing vitamins; Fruit-flavoured beverages; Non-alcoholic beverages; Beverages (Non-alcoholic -); Mineral waters [beverages]; Nutritionally fortified beverages; Flavoured carbonated beverages; Syrups for making beverages; Effervescing beverages (Powders for -); Functional water-based beverages; Mineral enriched water [beverages]; Energy drinks; Energy drinks containing caffeine; Soft drinks for energy supply; Isotonic drinks; Carbohydrate drinks; Protein drinks; Sports drinks; Carbonated soft drinks; Bottled drinking water; Non-alcoholic drinks; Distilled drinking water; Isotonic non-alcoholic drinks; Low calorie soft drinks; Non-carbonated soft drinks.*

[17] Witness statement, paragraph 8.

COSTS

76. The opponent has been successful and is entitled to a contribution towards the costs of the proceedings in line with the scale set out in Tribunal Practice Notice No. 2/2016. In the circumstances, I award the opponent the sum of £1700 which has been calculated as follows:

Preparing a statement and considering the other side's statement: £400
Preparing evidence: £700
Preparing submissions in lieu of a hearing: £400
Official fees: £200
TOTAL: £1700

77. I therefore order WAKEFUL LTD to pay Mintology Limited the sum of £1700. 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 conclusion of the appeal proceedings.

Dated this 25th day of October 2023

Clare Boucher,
For the Registrar,
Comptroller-General