

O/1069/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003499471

IN THE NAME OF VENTURE DISTRIBUTION LTD

FOR THE FOLLOWING TRADE MARKS

Pote Plus

POTE PLUS

(SERIES OF TWO)

IN CLASSES 16, 21 & 35

AND

AN APPLICATION FOR A DECLARATION OF

INVALIDITY UNDER NO. 505402 BY

OAKSTRONG INTERNATIONAL LIMITED

BACKGROUND AND PLEADINGS

1. Venture Distribution Ltd (“the proprietor”) is the owner of the series of trade marks shown on the cover page of this decision (“the contested registration”). The contested registration was filed on 11 June 2020 and entered into the register on 2 October 2020. It stands registered for the following goods and services:

Class 16: Liners, made from plastic; disposable bags, made from plastic; Liners, made from bio-degradable materials; Disposable bags, made from bio-degradable materials.

Class 21: Potties and toilet potties; toilet seat trainers; travel potties; parts and fittings for all the aforesaid goods included in Class 21.

Class 35: Retail and wholesale services connected with the sale of potties and toilet potties, toilet seat trainers, travel potties, liners, made from plastic, disposable bags, made from plastic, Liners, made from bio-degradable materials, Disposable bags, made from bio-degradable materials. parts and fittings for all the aforesaid goods enabling customers to conveniently view and purchase those goods from a mail order catalogue, by means of telecommunication or via an internet website specialising in the aforesaid; advertising, marketing and promotional services; distribution of advertising, marketing and promotional materials; marketing campaign services; promotion of products; advertising and promotion using social media platforms; product demonstration services and advisory and consultancy services in connection with all the aforesaid services.

2. On 29 September 2022, OakStrong International Limited (“the applicant”) applied to have the contested registration declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is brought under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act and is targeted at the entirety of the proprietor’s

specification. Under the 5(2)(b) and 5(3) grounds, the applicant relies upon the following mark:

POTETTE PLUS

UK registration no. 906017016¹

Filing date 19 June 2007; registration date 3 July 2008

Relying on all goods for which the mark is registered, namely:

Class 11: Toilet seats; foldaway toilets for children.

Class 16: Liners and bags, all made of plastic.

Class 21: Chamber pots; potties for infants and children.
("the applicant's mark").

3. The applicant's position under its 5(2)(b) ground is that the marks at issue are similar and that they are registered for goods and services that are either identical or similar. As a result, the applicant claims that there exists a likelihood of confusion on the part of the public, including a likelihood of association.
4. Under the 5(3) ground, the applicant claims that its mark has a reputation in the UK for the goods relied upon and that the proprietor's use of the contested registration would, without due case, take advantage of or be detrimental to the distinctive character or repute of the applicant's mark.
5. In respect of the 5(4)(a) ground, the applicant relies on the unregistered earlier right of 'POTETTE PLUS' that it claims to have used throughout the UK since 2007 in respect of 'toilet seat trainers' and 'travel potties'. As a result of this use, the applicant claims to enjoy an extensive level of goodwill. The applicant claims that any use of the contested registration by the proprietor would constitute a misrepresentation and would cause confusion with the applicant's mark and

¹ The applicant's mark is a comparable trade mark based on the applicant's pre-existing EUTM, being EUTM no. 06017016. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

damage the applicant's goodwill. In light of this, the applicant claims that the proprietor's registration is liable to be cancelled by virtue of the law of passing off.

6. Lastly, in respect of the 3(6) ground, the applicant argues that the contested registration was filed in bad faith. The basis for this claim is that the proprietor has been well aware of the applicant's use of its mark for several years and that it has a history of misappropriating the applicant's intellectual property. The applicant, therefore, claims that the proprietor filed its mark with the intention of taking advantage of its rights and to engage in unfair competition.
7. The proprietor filed a counterstatement denying the claims made and requested that the applicant provide proof of use in respect of its mark.
8. The applicant is represented by Maguire Boss and the proprietor is represented by Roger Moor & Associates Limited. Only the applicant filed evidence. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

10. The applicant filed evidence in the form of the witness statements of Mr David Eugene Kalozdi and Mr David Tate. Mr Kalozdi's witness statement is dated 13 February 2023 and is accompanied by 16 exhibits, being those labelled DEK1 to DEK16. Mr Kalozdi is an executive of the applicant and I note that his evidence speaks to the use of the applicant's mark. As for Mr Tate's statement, this is dated 15 February 2023 and is accompanied by two exhibits, being those labelled DT1

and DT2. Mr Tate is a trade mark attorney employed by the applicant's legal representative and is, therefore, duly authorised to file evidence on its behalf. I note that Mr Tate's evidence speaks to the allegations of bad faith made against the proprietor.

11. I do not propose to summarise the applicant's evidence or the parties' submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

PRELIMINARY ISSUE

12. I note that in its written submissions in lieu, the proprietor responded to the evidence of use filed by the applicant. This included a number of criticisms as to the relevance and sufficiency of the evidence provided. In the applicant's written submissions, it sets out that it was not appropriate for the proprietor to raise these issues at such a late stage, particularly given that it did not file any evidence in chief or raise these issues at an earlier date by way of written submissions. On this point, I remind myself that the onus is on the party bearing the burden of proving use to file its best case as evidence in chief. Having said that, I do appreciate that where the party challenging the evidence appears to have avoided doing so during the evidence rounds, only to unveil an attack after the evidence rounds have closed, there is potential for unfairness.

13. Having considered the submissions, I am of the view that it was inappropriate for the proprietor to raise some of the issues it did at such a late stage. For example, the proprietor has raised an issue regarding the actual role of Mr Kalozdi in the applicant's company on the basis that he simply refers to himself as 'an executive'. In my view, such an issue should have been raised earlier and an answer could have been provided by way of evidence in reply. Further, and perhaps more importantly, I note that the proprietor has argued that the applicant's evidence regarding sales are not supported by any external evidence or an explanation as to how they have been calculated. Again, this is something that the proprietor could have raised earlier in the proceedings, thereby prompting a reply from the applicant

with further information as to the nature of this evidence. As it stands, notwithstanding the proprietor's criticisms of the applicant's evidence, I do not consider that there is any reason for me to disbelieve that accuracy and truth of such evidence, especially given that it was accompanied by a sworn statement of truth. That being said, this issue does not apply to all of the criticisms/issues raised. Ultimately, where said criticisms relate to questions regarding the sufficiency of the applicant's evidence, I am of the view that the proprietor was entitled to raise them at this stage.

DECISION

14. Sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

"47. -

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[...]

(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, or

(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.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(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."

15. As the earlier mark relied upon under the 5(2)(b) and 5(3) grounds is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.—

(1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 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 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

Proof of use

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in

question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

17. Section 100 of the Act is also relevant, which reads:

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

18. Given its filing date, the applicant’s mark qualifies as an earlier trade mark under the above provisions. The applicant’s mark had completed its registration process both over five years prior to the filing date of the contested registration and the date of the application at issue. Therefore, the applicant’s mark is subject to the proof of use assessment and, as set out above, the proprietor requested that the applicant provide proof of use in respect of the same.

19. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it

guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

20. Pursuant to Section 47(2B) of the Act, there are two relevant periods for assessing whether there has been genuine use of the applicant’s mark, the first being the five-year period ending with the deemed filing date of the contested registration, being 11 June 2020, and the second being the five-year period ending with the date of the application of the invalidity declaration, being 29 September 2022. Therefore, the relevant periods for this assessment are 12 June 2015 to 11 June 2020 (“the first relevant period”) and 30 September 2017 to 29 September 2022 (“the second relevant period”). While different, they do overlap considerably.

21. The applicant’s mark is a comparable mark based upon an earlier EUTM, which means that use of the mark in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.² As the first relevant period falls entirely prior to IP Completion Day, the EU is the relevant territory for proof of use for this period. In respect of the second relevant period, the relevant territory is the EU (which included the UK) up until 31 December 2020 but, thereafter, it is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same

² See paragraph 4 of Tribunal Practice Notice 2/2020

time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

22. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”³ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Sufficient Use

23. As I have mentioned above, I have detailed submissions from the proprietor regarding the sufficiency of the applicant’s evidence. I do not intend to reproduce this here but note that, in short, it claims that the applicant has failed to provide cogent evidence in support of genuine use of its first mark, particularly given that the territory at issue (for the entirety of the first relevant period and the majority of the second) is the EU at large. While I bear the points raised by the proprietor in mind, I will proceed to conduct my own assessment of the evidence.

³ *Jumpman* BL O/222/16

Form of the mark

24. I appreciate that 'POTETTE PLUS' (in a word only format) appears consistently throughout the evidence via a range of distributor's purchase orders and on webpages, for example. Such evidence is plainly use of the applicant's mark as registered. Having said that, I note that there is evidence showing the mark in a different form. While this point was not raised by the proprietor, it is still necessary to briefly consider the form of the mark. The different form of use is as follows:



25. Clearly, this is not use of the mark as registered. Having said that, I remind myself that, as per section 47(2C) of the Act, use of a mark in a variant form is acceptable so long as that variant form does not alter the distinctive character of that mark. Having considered the above use in line with the test for variant marks as set out in the case of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, I am of the view that it is an acceptable variant of the applicant's mark. I make this finding on the basis that the arrangement of the words in the mark, the use of colour or the addition of non-distinctive square devices are such that they do not alter the distinctive character of the applicant's mark. As a result, the applicant's reliance upon this use is acceptable for the purposes of my genuine use assessment.

Evidence of use

26. The evidence sets out that the POTETTE folding potty was first launched in 1989 by a partnership trading as 'THANK HEAVENS'. There is a document before me regarding the history of the brand that not only confirms this but also sets out that the business and Intellectual Property rights were eventually acquired by the applicant.⁴ The narrative evidence goes on to confirm that this acquisition took place in October 2012.

⁴ DEK1

27. Also provided are a range of screenshots from 2003 (as acquired from the internet archive facility, the Wayback Machine) of the website 'potette.com' regarding the folding potty.⁵ The narrative evidence confirms that, at this time, the webpage belonged to 'THANK HEAVENS'. While being a '.com' website, it does make reference to the POTETTE product and packs of disposable refills being available in most UK high street stores including Boots, Mothercare and Tesco. It also refers to the fact that the POTETTE has been actively marketed through licensees in the UK, France and the USA and even shows an ordering page that has a list of prices in British pounds. The presence of these screenshots is noted, however, as they are from prior to the relevant periods and refer to the 'POTETTE' brand rather than the 'POTETTE PLUS', they are of no assistance to the present assessment.

28. A second set of 'potette.com' screenshots from 2008 (also taken from the Wayback Machine) are provided that make reference to the fact that the product is now called 'POTETTE PLUS'.⁶ The website sets out that the 'POTETTE PLUS' can be used as a folding potty with disposable liners but also as a trainer seat for use on an adult toilet. I note that the screenshots set out that the POTETTE PLUS was launched in the UK in March 2008 at the Harrogate Nursey Fair by 'BIBS & STUFF' wherein it was labelled as 'a star of the show' by customers. The screenshots also make reference to a range of awards but some of these are expressly American awards and for those that are not, there is no indication that they are UK or EU based awards. As such, they are of no assistance.

29. The narrative evidence then goes on to confirm that the applicant's mark has been used in the UK by both the applicant and the previous owners on a continuous basis since March 2008 in relation to '2-in-1' potties, toilet seats, travel potties, collapsible reusable potty liners and disposable potty liners. By 2013, the applicant had distributors for the POTETTE PLUS product throughout the world, including the UK and in many Member States of the EU. In support of this, the applicant has provided more screenshots of its website, this time from 2013, which shows a list of each countries' respective distributor. While I appreciate that this evidence falls

⁵ DEK2

⁶ DEK3

outside the relevant period, I am summarising it here as it is still relevant to the 5(3) and 5(4)(a) grounds that I will come to discuss below.

30. The applicant has also filed a total of 77 pages worth of screenshots from its website between 2014 and 2022.⁷ These screenshots list the distributors of the POTETTE PLUS products and show a range of awards that the product has won. In respect of the awards, I have nothing to suggest that these are UK or EU awards so are of no assistance. I note that these screenshots make reference to the POTETTE PLUS branding but I fail to see why 77 pages of what is essentially a repeated list of distributors is relevant, especially given that the narrative evidence go on to set out each distributor that has distributed the applicants goods in the UK and EU.

31. I note that another set of screenshots from websites are provided that show, again, the range of distributors in the UK and the EU during the relevant periods.⁸ I note that these show images of the products for sale on third party websites but I'm not convinced that this evidence adds anything beyond that has already been discussed above.

32. At this point in the evidence, the applicant discusses actual sales figures for its POTETTE PLUS products in the UK. I note that the evidence sets out that these figures are as a result of use by a distributor. Further, the narrative evidence sets out that these sales figures cover the sale of '2-in1 potties', 'toilet seats' and 'potty liners'. For ease of reference, I have reproduced the table setting out these figures below:

Year	Retail Sales Value (UK)
2015	£600,000 (approx.)
2016	£550,000 (approx.)
2017	£500,000 (approx.)
2018	£484,128.68

⁷ DEK5

⁸ DEK6 and 7

2019	£437,523.83
2020	£403,430.91
2021	£429,595.92
2022	£375,359.21

33. Helpfully, the applicant has also provided an estimated proportion as to how these figures relate to the above products. It states that 40% of the figures relate to ‘2-in-1 potties/toilet seats’, 50% relates to ‘disposable potty liners’ and 10% relates to collapsible reusable potty liners’. In respect of the sales, I note that additional evidence in support of the same has been provided by way of purchase orders issued by third party retailers for ‘POTETTE PLUS’ products.⁹

34. The narrative evidence also confirms that between 2017 and 2022, the applicant’s UK advertising expenditure ranged from £17,000 to £25,000 per year. It also sets out that the UK marketing activities undertaken included e-commerce pay-per-click advertising, in-store promotional marketing, social media promotion, Google search engine optimization and print and on-line coverage in various magazines, blogs and publications. In support of this, I note that copies of the Coverage Reports for 2019, 2020 and 2021 prepared by one of the applicant’s UK distributor have been provided.¹⁰ I do not intend to discuss these reports in full but note that they show the types of advertising undertaken and the reach of such (being social reach for social media influencer posts and circulation for websites and magazines).

35. Awards that the applicant’s products have achieved in the UK are discussed. Firstly, only two of these awards can be said to fall within the relevant periods, being in 2015 and 2018.¹¹ In any event, regardless of whether they are in the relevant periods or not, there is nothing to confirm the reach of said awards and whether they are awards voted on by the relevant public or a select panel of judges. As a result, I do not consider that the awards evidence is of any assistance to the present assessment.

⁹ DEK11

¹⁰ DEK8

¹¹ On this point, I note that the 2015 award potentially only applies to the first relevant period.

36. The applicant has provided a range of reviews from various third-party retailers such as JoJoMaman Bébé, John Lewis, Boots and Amazon.co.uk.¹² I note that the reviews that are dated from January 2016 to December 2022 (which is after the conclusion of both relevant periods). As for the Boots reviews, these are not accurately dated but are simply referred to vaguely as being posted 'X year(s) ago'. The reviews from JoJoMaman Bébé cover just five reviews for the POTTE PLUS '2-in-1 potty'. The John Lewis reviews cover 55 reviews for the POTETTE PLUS 'potties/toilet seats' and 44 reviews for the POTETTE PLUS disposable liners. The Amazon.co.uk print-outs show 337 'ratings' for the POTETTE PLUS '2-in-1 potty' and 1,173 'ratings' for the POTETTE PLUS 'disposable liners'. Given that these ratings are referred to as 'global ratings' and the international nature of Amazon (despite being from the UK-based version of the website), I do not accept these fully relate to UK sales. Of the actual reviews from verified purchases in the UK, I note that they show 19 reviews for the 2-in-1 potty and eight for the disposable liners.

Conclusions on use

37. Before considering whether the use described above is sufficient to be deemed genuine, I wish to briefly discuss two points. The first being the issue with sales being via a third party distributor and the second being the proprietor's position in respect of the evidence being aimed at the UK market and not the EU market at large. In considering the third-party distributor point first. I note that all of the sales before me appear to be done so by a range of third-party distributors. Firstly, the proof of use provisions that I have reproduced above allow for use to be undertaken by third parties so long as it is with the consent of the owner of the trade mark. In the present case, I note that there is a distribution agreement between the applicant and one of its distributors in the UK.¹³ Clearly such evidence can be construed as express extent to use the mark with the applicant's consent. As a result, the turnover figures set out above are relevant to the present assessment.

¹² DEK12 to DEK15

¹³ DEK9

38. Moving to the issue of the territorial scope of use, I note that the proprietor refers to the cases of *Leno Marken* (which I have cited above) and *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC). In respect of the former case, the passage reproduced above can clearly be construed as confirming that use in just one Member State of the EU is sufficient. On this point, I note that use in just one Member State is routinely accepted as sufficient to prove use of an EUTM in proceedings before the Registry. As for the latter case (which was decided prior to the UK's departure from the EU), the proprietor explains that the court found no genuine use of an EUTM as there was no use of the same in any EU country other than the UK. While this case is noted, it is not on all fours with the present case that I must consider. In the *Sofa Workshop* case, there was no dispute as to genuine use on an extensive scale in the UK but, outside of that, the only use was confined to advertorial content in magazines but, when viewed objectively, those adverts were not targeted at readers outside of the UK. While I appreciate that the evidence before me in the present case regarding use outside of the UK is not significant, it is, in my view, beyond that which was at issue in the *Sofa Workshop* case. In the present case, the applicant has provided an extensive list of distributors for its products in many countries throughout the EU during the entirety of the relevant periods. While the evidence before me could have benefitted from evidence of sales in those countries, I consider the evidence to be clear enough to indicate that the applicant had an intention to target EU customers. Therefore, I do not consider much turns on the point raised by the proprietor.

39. I note that I have no evidence as to the size of the relevant market for the goods at issue. Even without such evidence, I am of the view that the market at issue is likely to be a very large one. As set out above, the evidence before me covers the sale of approximately £2.9 million worth of goods in the UK during the first relevant period and £2.1 million during the second.¹⁴ Clearly, when compared against a large market, these figures might appear relatively low, however, they are still indicative of decent amount of goods being sold. Further, as set out in the case law cited above, use does not need to be quantitatively significant in order for it to be

¹⁴ These figures are approximate because they may include sales from outside of each respective relevant period. For example, the figures provided for 2015 and 2020 include for the entire years' sales so, inevitably, a proportion of the same will fall outside of the first relevant period. I have no way to break down how the figures relate specifically to each relevant period and this is a point that I must bear in mind in making my overall assessment.

deemed genuine. I also note that aside from the sales figures, I have evidence of advertising expenditure of between £17,000 and £25,000 per annum between 2017 and 2022. Like the sales figures already discussed, these are not large sums of expenditure. However, they are plainly representative of a genuine attempt to create and preserve a market share for the goods at issue. Further, I note that the reports demonstrate the types of advertising undertaken and this shows a varied presence across different forms of media.

40. Taking all of the above into account, I am satisfied that the applicant has genuinely used its mark throughout the relevant territory during both relevant periods. For the avoidance of doubt, if I am wrong to find use of the mark because use is only shown in relation to the UK market, I am of the view that the post-IP Completion Day use in the UK is still sufficient in itself to prove genuine use. I say this on the basis that the use between 1 January 2021 and 29 September 2022 stands at approximately £800,000. Further, the applicant has still sought to advertise and promote its mark in the UK during the time by incurring an advertising expenditure of approximately £34,000 to £50,000 over two years. While the figures constitute a relatively low level of use, they are still sufficient to demonstrate a genuine attempt to create or preserve a market share for the goods at issue. Lastly, I appreciate that such use comes towards the end of the relevant period, however, consistent and repeated use over two years is still, in my view, sufficient to demonstrate genuine use of the mark in the UK.

41. The above being said, I do not consider that the proprietor's use of its mark is such that it should be permitted to rely on the entirety of its specification. I say this because the use before me covers goods that solely relate to use by children or infants or, in respect of 'liners', they relate to liners for potties or foldaway toilets only. In considering the specification at issue, I note that 'toilet seats', 'liners and bags' and 'chamber pots' all have utility beyond the use before me. As such, I do not consider it appropriate to grant use for the entirety of those terms when use has only been shown in respect of one easily identifiable sub-category of the same.¹⁵ Such terms should, therefore, be limited accordingly. As for those goods

¹⁵ See *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

that are already reserved for use by children or infants, I am of the view that they may continue to be relied upon here.

42. In light of the above, I consider that the following is reflective of a fair specification for the applicant's use of its mark:

Class 11: Toilet seats for infants and children; foldaway toilets for children.

Class 16: Liners for potties and foldaway toilets for children, all made of plastic.

Class 21: Chamber pots for infants and children; potties for infants and children.

43. For the avoidance of doubt, I do not consider that the above limitations strip the applicant of an appropriate level of protection for the use made of its mark.

Section 5(2)(b): legislation and case law

44. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

45. Section 5A of the Act states as follows:

“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.”

46. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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

47. The competing goods and services are as follows:

The applicant's goods	The proprietor's goods
<u>Class 11</u> Toilet seats for infants and children; foldaway toilets for children.	<u>Class 16</u> Liners, made from plastic; disposable bags, made from plastic; Liners, made

<p><u>Class 16</u> Liners for potties and foldaway toilets for children, all made of plastic.</p> <p><u>Class 21</u> Chamber pots for infants and children; potties for infants and children.</p>	<p>from bio-degradable materials; Disposable bags, made from bio-degradable materials.</p> <p><u>Class 21</u> Potties and toilet potties; toilet seat trainers; travel potties; parts and fittings for all the aforesaid goods included in Class 21.</p> <p><u>Class 35</u> Retail and wholesale services connected with the sale of potties and toilet potties, toilet seat trainers, travel potties, liners, made from plastic, disposable bags, made from plastic, Liners, made from bio-degradable materials, Disposable bags, made from bio-degradable materials. parts and fittings for all the aforesaid goods enabling customers to conveniently view and purchase those goods from a mail order catalogue, by means of telecommunication or via an internet website specialising in the aforesaid; advertising, marketing and promotional services; distribution of advertising, marketing and promotional materials; marketing campaign services; promotion of products; advertising and promotion using social media platforms; product demonstration services and advisory and consultancy</p>
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	services in connection with all the aforesaid services.
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48. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

49. “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”.

50. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Classes 16 and 21

51. In its submissions, the proprietor accepts that its goods in classes 16 and 21 are identical or highly similar to the applicant's goods. I appreciate that this concession was made in respect of the full specification of the applicant which, as above, has been limited. That being said, I do not consider that this alters the position to any sufficient degree on the basis that the proprietor's goods can all be said to reasonably cover goods that fall within those limitations. Therefore, I consider that the concession can still be said to apply to the present comparison. As a result, I do not intend to conduct a full goods comparison. However, for completeness, I will set out which goods I consider identical and those which I consider highly similar.

52. In respect of the class 16 goods, I consider that the proprietor's "liners, made from plastic" are identical to the applicant's "liners for potties and foldaway toilets for children, all made of plastic". As for the remaining class 16 goods of the proprietor, namely "disposable bags, made from plastic", "liners, made from bio-degradable materials" and "disposable bags, made from bio-degradable materials" are highly similar to the applicant's "liners for potties and foldaway toilets for children, all made of plastic".

53. Turning to the class 21 goods, I consider that the proprietor's "potties and toilet potties", "toilet seat trainers" and "travel potties" are identical to the applicant's "potties for infants and children". As for the proprietor's "parts and fittings for all the aforesaid goods included in Class 21", I consider this to be similar to a high degree with the applicant's "potties for infants and children".

Class 35 services

54. In respect of these services, the proprietor submits that there is only a low degree of similarity between some of its retail services and the goods of the applicant. This submission is made on the basis that there is a degree of complementarity between those goods and services where the retail services cover the retail of goods which are identical to the goods of the applicant. However, the submissions go on to state

that where the goods covered by the proprietor's services are not identical to the applicant's goods, they are dissimilar because they differ in nature, purpose and method of use. I note that there are no submissions on the point of the services that cannot be said to be retail services.

55. While the proprietor's submissions in respect of the retail services are noted, I disagree with the position that the goods and services are only similar to a low degree. While the goods and services clearly differ in nature, purpose and method of use, it is common for producers of the goods covered by the applicant's specification to also retail in said goods meaning that there is an overlap in trade channels between them. I also consider that the user of the goods and services will overlap. Lastly, average consumers are aware of the complementary relationship between producers of such goods and the retailing of the same.¹⁶ This is, in my view, sufficient to warrant a finding that these goods and services are similar to a medium degree.

56. I also disagree with the proprietor's submissions in respect of the need for the retailing services to cover identical goods in order for there to be level of similarity between them. I say this because, as set out in the case law, it is sufficient that the goods retailed are only similar to the actual goods themselves. There is no requirement that they be identical. On this point, I refer to paragraph 24 of *Tony Van Gulck v Wasabi Frog Ltd*,¹⁷ wherein Mr Geoffrey Hobbs Q.C., as the Appointed Person, set out that the General Court's ("GC") findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's mark was registered. As a result, I find that even where the goods of the applicant are not identical to those goods covered by the proprietor's retail services, the goods and services are similar to a medium degree. I make this finding on the basis that, while they may not be identical, they are sufficiently close enough to result in the same overlaps as those discussed in the preceding paragraph.

¹⁶ In respect of a comparison of goods and the retail services in respect of the same, see paragraphs 46 to 57 of *Oakley, Inc v OHIM*, Case T-116/06

¹⁷ Case BL O/391/14

57. For the sake of completeness, I am of the view that the proprietor's "retail and wholesale services connected with the sale of potties and toilet potties, toilet seat trainers, travel potties, liners, made from plastic, disposable bags, made from plastic, Liners, made from bio-degradable materials, Disposable bags, made from bio-degradable materials. parts and fittings for all the aforesaid goods enabling customers to conveniently view and purchase those goods from a mail order catalogue, by means of telecommunication or via an internet website specialising in the aforesaid" are similar to a medium degree to the class 16 and 21 goods of the applicant.

58. This leaves the remaining terms in class 35 of the proprietor, namely:

"Advertising, marketing and promotional services; distribution of advertising, marketing and promotional materials; marketing campaign services; promotion of products; advertising and promotion using social media platforms; product demonstration services and advisory and consultancy services in connection with all the aforesaid services."

59. In its submissions, the applicant argues that these services are similar to its own goods because they are complementary and are distributed through the same trade channels as the applicant's goods. The above services relate to advertising, marketing and promotion (or the demonstration, advisory and consultancy services in relation to the same). In considering the applicant's position, I do not agree that such services are important and/or indispensable to the applicant's goods to the point that the average consumer would consider that they emanate from the same undertakings.¹⁸ Further, I do not consider that an undertaking that provides advertising services will also be the same undertaking that actually provides the applicant's class 11, 16 or 21 goods. I agree that they may advertise such goods but this is not the same as actually being the provider of said goods. As such, I find that the above advertising, marketing and promotional services (and the demonstration, advisory and consultancy services in relation to the same) are dissimilar to the applicant's goods.

¹⁸ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

60. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, the application aimed against those services that I have found to be dissimilar will fail.¹⁹ These services will, therefore, survive the present application based on Section 5(2)(b) regardless of its outcome. They are as follows:

Class 35: Advertising, marketing and promotional services; distribution of advertising, marketing and promotional materials; marketing campaign services; promotion of products; advertising and promotion using social media platforms; product demonstration services and advisory and consultancy services in connection with all the aforesaid services.

The average consumer and the nature of the purchasing act

61. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

¹⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

62. The proprietor submits that the goods and services will be selected by a parent buying a product that is important for their child's development. As such, the consumer will be highly observant and careful in the selection of the goods and services at issue to ensure that it fulfils the correct function. Further, in relation to the portable products at issue, the proprietor submits that the consumer will consider factors such as the correct size and sturdiness of the product. As for the selection process, the proprietor submits that it will be primarily visual. On the contrary, the applicant's position is that the goods and services at issue are relatively low-cost products and are directed at the public at large who will pay a low to average degree of attention.

63. In respect of the identity of the consumer, I agree with both parties in that it will include members of the general public at large. Turning to the factors that the consumer will consider when selecting the goods at issue, I agree with the proprietor's submissions and find that these will include considerations as to the correct size and sturdiness of the goods. In addition, I find that additional considerations will play a role such as materials used and price. I also agree with the proprietor in respect of the visual nature of the selection process as they will either be self-selected at general or specialist retailers or via their websites where they will be selected after viewing an image of the product. Having said that, I do not discount an aural component playing a part. As for the level of attention paid, I do not agree with either party. This is on the basis that the goods at issue are relatively inexpensive and while I appreciate that they will be selected for the purpose of aiding a child's development, the considerations discussed above are fairly ordinary and will not attract a high degree of attention. On the contrary, the goods are not every day products and the consumer will clearly want to ensure that they are safe for use and serve their designated purpose. As such, I do not agree that the degree of attention will be on the lower end of the scale. Instead, I am of the view that the goods at issue will attract a medium degree of attention.

64. Turning to the services, I find that they are most likely to be selected having considered, for example, promotional material (in hard copy or online) and signage appearing on the high street. While visual considerations will be an important part of the selection process, the services are also likely to be the subject of word-of-

mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process. When selecting these services, average consumers are likely to consider such things as stock, price of goods offered in comparison to other retailers and expertise/knowledge of staff. I am of the view that average consumers are likely to pay a medium degree of attention during the selection process for the services.

Comparison of the marks

65. It is clear from *Sabel v Puma AG* (particularly paragraph 23) 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.

66. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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 relative 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.”

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

68. The respective trade marks are shown below:

The applicant's mark	The contested registration
POTETTE PLUS	Pote Plus POTE PLUS (Series of two)

69. As set out above, the contested registration is a series of two marks. Both marks in the series are word only marks consisting of the words 'POTE' and 'PLUS'. While the marks differ in their use of title and lower case lettering, I am of the view that I can deal with them as one. I say this because a word only mark is registered for use in either upper case, lower case or any customary combination of the two. As a result, the differing use of cases across the marks are of no consequence to the following assessment. For ease of reference during the marks comparison only, I will refer to the marks in the contested registration as, simply, the contested mark.

70. I have comments and submissions from both parties that I do not intend to reproduce here but will, if necessary, deal with them where appropriate below.

Overall Impression

71. The contested mark is a word only mark that consists of the words 'POTE' and 'PLUS'. For reasons that I will come to discuss further below, I am of the view that the word 'POTE' will play the greater role in the overall impression of the mark with 'PLUS' playing a lesser role. As for the applicant's mark, this is also a word only mark that consists of the words 'POTETTE' and 'PLUS'. Again, for reasons that I will come to discuss further below, I find that the word 'POTETTE' will play the greater role in the overall impression of the mark with 'PLUS' playing a lesser role.

Visual Comparison

72. As I have already discussed above, word only marks are capable of being displayed in upper case, lower case or any customary combination of the same.

As such, the differing use of capitalisation across the parties' marks is of no consequence here and I will say no more about it. Visually, both marks share the same first four letters, being 'P-O-T-E' and an identical second word, being 'PLUS'. The marks differ in the presence of the letters 'T-T-E' that sits in the middle of the applicant's mark and between the identical elements. Given that average consumers tend to focus on the beginnings of marks,²⁰ whilst also factoring into account that the ends are also identical, I find that the marks are similar to a high degree.

Aural Comparison

73. Despite the role that 'PLUS' plays in both parties' marks (which I will discuss in further detail below), I consider that it will be pronounced by the consumer. I say this whilst bearing in mind the case of *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22, wherein Mr Philip Harris, sitting as the Appointed Person, found that the descriptiveness of an element does not necessarily make it aurally invisible. As such, I find that, aurally, the applicant's mark consists of three syllables that will either be pronounced as 'POT-ETT-PLUS' or 'POAT-ETT-PLUS' by equally significant proportions of average consumers. As for the contested mark, I have submissions from the proprietor which sets out that this consists of two syllables that will be pronounced 'POT-EE'. While I agree that a significant proportion of consumers will pronounce 'POTE' this way (especially given the goods at issue), I am of the view that an equally significant proportion of consumers will pronounce it as 'POAT'. The proprietor's submissions made no reference to the pronunciation of 'PLUS'²¹ which, as above, I consider will be pronounced. As a result, depending on the pronunciation of 'POTE', the contested mark consists of either two or three syllables, i.e. 'POAT-PLUS' or 'POT-EE-PLUS'.

74. In comparing the pronunciation of the marks, I find that regardless of how they are pronounced, they are aurally similar to a high degree. I say this because in the event that the first syllables of both marks are pronounced as 'POAT', the first and

²⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

²¹ Seemingly because the proprietor's position is that it may be overlooked by some consumers (as per paragraph 26(a) of its submissions).

last syllables of the marks are identical with the only point of difference coming in the middle syllable of the applicant's mark. In the event that consumers pronounce 'POTE' in the proprietor's mark as 'POT-EE', I consider that those same consumers will pronounce 'POTETTE' in the applicant's mark as 'POT-ETTE'. As a result, the marks are aurally the same length with identical first and last syllables. While the middle syllables differ, there is still some similarity in the shared use of the letter 'E' (albeit one being a long e sound and the other being a short e sound).

Conceptual Comparison

75. The submissions of the proprietor set out that its mark will be seen as relating to a potty whereas the word 'POTETTE' in the applicant's mark has either no meaning or will be viewed as meaning 'little pot' if a consumer broke the word down. As for the applicant's submissions, I note that when considering the distinctiveness of its mark, it sets out that it has no meaning for any of the goods in question. However, it goes on to state that the 'ETTE' element of its mark will be seen as meaning small.

76. Following on from my findings in the aural comparison above, I am of the view that a significant proportion of consumers (those who pronounce 'POTE' as 'POT-EE') will view the contested mark as a play on the word 'potty'. However, for those (still significant proportion of) consumers that do not, I consider that they will attribute the word no obvious meaning. As for 'PLUS', I am of the view that this will be seen as a suggestive word that points to the character or quality of the goods and services at issue, i.e. that there is something 'additional' being offered to consumers. I find that this applies regardless of how the consumers view the word 'POTE'. As a result, I consider that some consumers will view the contested mark as a reference to a 'potty with additional/enhanced features or qualities'. However, an equally significant proportion of consumers will view it as having no obviously identifiable concept outside of the reference to something having additional/enhanced features or qualities.

77. Turning to the applicant's mark, I am of the view that 'POTETTE' will have two identifiable concepts. The first is that of a made-up or foreign language word with no obvious meaning. On this point, I remind myself that the parties' submissions set out that 'ETTE' means 'small' or 'little'. While noted, I do not agree that this will be the understanding of average consumers on the basis that the submissions on this point are seemingly based on the fact that 'ETTE' is a foreign language word. There is nothing before me to suggest (1) what language it is and (2) whether a significant proportion of average consumers would understand it as such. Alternatively, I find that some consumers will view 'POTETTE' as being a play on the word 'potty', especially given the goods at issue. As for 'PLUS', this will have the same meaning as discussed above. As a whole, the applicant's mark will either be seen as having no obviously identifiable concept outside of the reference to something having additional/enhanced features or qualities or a reference to a potty with additional/enhanced features or qualities. For the avoidance of doubt, these concepts will be understood by different but equally significant proportions of consumers.

78. In comparing the marks from a conceptual viewpoint, I am of the view that regardless of how they are viewed, some degree of conceptual similarity will exist between them. Where both marks are viewed as a play on the word 'potty', they will be conceptually similar to a high degree. Where they are not, 'POTETTE' and 'POTE' will be conceptually neutral, however, the shared use of 'PLUS' (which I appreciate is allusive of the fact that the product at issue offers additional/enhanced features or qualities) will give rise to only a low degree of conceptual similarity.

Distinctive character of the applicant's mark

79. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

80. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods and services, ranging up 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 made of it. The applicant did not specifically plead that its mark enjoys an enhanced degree of distinctive character as a result of the use made of it, however, it has filed evidence of use. In proceedings before the Tribunal, it is not necessary for an applicant to specifically plead enhanced distinctiveness at the outset of a matter and, therefore, such an issue may be live regardless of the pleadings. I have summarised the entirety of the applicant’s evidence of use at paragraphs 26 to 36 above. Such evidence is applicable here. Having considered that evidence in the scope of the present assessment, I am of the view that it is not sufficient to prove that the applicant’s mark’s distinctiveness have been enhanced to any degree. In short, the limited turnover and advertising evidence before me does not warrant such a finding. In making this finding, I remind myself that the evidence may have been sufficient to demonstrate genuine use, however, the requirements for proving enhanced

distinctiveness are more onerous than those for genuine use. As a result, I only have the inherent position to consider.

81. I note that the applicant sets out that as its mark has no meaning for any of the goods at issue, its distinctiveness must therefore be seen as being at least normal to high. As above, I have found that the word 'POTETTE' will either have no obvious meaning (on the basis that it will be viewed as either a made-up word or a foreign language word) or be viewed as a play on the word 'potty'. In respect of the former understanding, I am of the view that its distinctiveness will be high as it neither alludes to nor describes the goods at issue. In the latter, however, 'POTETTE' will be allusive to the goods at issue. That being said, it will still be considered somewhat inventive to the point that it does enjoy some degree of distinctive character, albeit I consider this to be low. In either situation, I do not consider that 'PLUS' will contribute to the distinctiveness of the mark to any material degree. This is on the basis that it merely indicates something additional/enhanced about the goods. As a result, I find that the distinctiveness of the mark will be dominated by the role of 'POTETTE' and, depending on how it is viewed by the consumers, the applicant's mark is either distinctive to a high or low degree.

No evidence of actual confusion

82. I note that in its written submissions, the proprietor set out that there is no evidence of actual confusion between the marks at issue and because there has been parallel trade on Amazon for a number of years, this is evidence against a likelihood of confusion. In considering this point, I remind myself that in order to find a likelihood of confusion in proceedings such as these, it is not necessary for all opponents (in opposition proceedings) or applicants (in cancellation proceedings) to file evidence of actual confusion. Having said that, I appreciate that evidence of actual confusion may be of some assistance and, conversely, a lack of evidence of confusion may contribute to a finding of no confusion where the extent of the side-by-side use of marks is such that, if there were confusion, there would be an abundance of evidence of such.

83. I have considered the proprietor's argument but, having reviewed the evidence, there is no evidence of 'side-by-side' use that could be said to support the proprietor's position. I say this because the Amazon evidence referred to by the proprietor is that which was filed by the applicant in support of its 3(6) ground.²² This evidence simply shows images of what the applicant alleges to be the proprietor's listings on Amazon (and also eBay) wherein it reproduces the applicant's mark rather than using its own registration. To assist in demonstrating my point, I reproduce one of those images below:



84. The above listing is by 'Venture' (seemingly a reference to the proprietor, a point not opposed by the proprietor itself) and reproduces the 'POTETTE PLUS' mark. There is no reference in this listing to the proprietor's own registration, being 'POTE PLUS'. This is an issue that is consistent with the eBay listings also.²³ As a result, I fail to see how the Amazon evidence can be said to support the proprietor's position as, clearly, this is not side-by-side use of the marks at issue which could

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²³ I note that the proprietor did not file its own evidence of concurrent use of the marks on Amazon and, in raising this point, simply refers to the applicant's evidence which the proprietor claims as indicative of parallel trade on Amazon for a number of years. Having considered the evidence, this is the only evidence that I can construe as being that which the proprietor refers to. If this is incorrect, I consider it reasonable to expect the proprietor to have precisely pointed me to what evidence it actually referred to.

give rise to an argument that there would be no possibility of 'confusion' between them. This argument is, therefore, dismissed and I will now proceed to consider a likelihood of confusion in the ordinary way.

Likelihood of confusion

85. 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 applicant's 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 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.

86. As I have set out in my marks comparison above, I consider that there are two equally significant proportions of average consumers that will understand the marks at issue as either being references to a 'potty' or, simply, made-up or foreign language words with no obvious meanings (save for the reference to 'PLUS', of course). For the sake of my assessment as to whether there exists a likelihood of confusion, I will focus on the latter group of consumers, i.e. those that see no reference to 'potty'. In doing so, I rely on the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 wherein Kitchin LJ set out that if a court was satisfied that a significant proportion of the relevant public is likely to be confused to warrant the intervention of the court then it may properly find infringement. While this case was an infringement case, the principle applies equally under 5(2) proceedings before the Tribunal. Therefore, if the consumer

base that views 'POTE' and 'POTETTE' as having no obvious meanings is confused, then that is sufficient for the opposition to succeed insofar as it relates to similar/identical goods and services.

87. I have found the parties' goods and services to be identical or similar to between a high and medium degree. I have also found that the average consumer for the goods and services will be members of the general public who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods and services at issue. I have found that the applicant's mark is inherently distinctive to a high degree. In respect of the similarity of the marks at issue, I have found that the parties' marks are visually and aurally similar to a high degree and low degree of conceptual similarity.

88. I note that the proprietor's position is that there is no likelihood of confusion because the marks are dissimilar, the high degree of attention paid by consumers and the lack of evidence of actual confusion. Given that I have found none of these arguments to carry any weight, these submissions are of no assistance in the present case.

89. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that the average consumer will inaccurately recall or misremember the parties' marks for one another, particularly given their high level of visual similarity and the high level of distinctiveness in the applicant's mark. In making this finding, I have borne in mind the case of *Quelle AG v OHIM*, Case T-88/05, wherein the GC found that visual similarity is most important in cases where a consumer sees the mark when purchasing the goods.²⁴ Secondly, the beginnings of the marks at issue are identical and I remind myself that, as a general rule, consumers tend to attach more importance to the beginnings of marks.²⁵ Even taking into account the ends of the marks, I note that these too are identical and there is case law to suggest that common elements at the ends of marks may also

²⁴ While this case expressly relates to goods, the principle may equally apply to services also.

²⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

be sufficient to create a likelihood of confusion.²⁶ Lastly, I remind myself that I have found that the marks are conceptually similar to only a low degree. In my view, this factor isn't necessarily compelling in favour of either party's position. I say this because this level of similarity only stems from the shared use of 'PLUS' which contributes very little to either parties' marks. Further, any conceptual neutrality between 'POTE' and 'POTETTE' is not sufficient to counteract the visual and aural levels of similarity between the marks as wholes. Consequently, I find that there is a likelihood of direct confusion. I am of the view that this finding applies to all of those goods or services that I have found to be similar to any degree. I consider this to be the case because the level of similarity between the marks is such that it offsets any lower level of similarity between the goods and services.

Final remarks under 5(2)(b)

90. As above, I have found that there is a likelihood of confusion in respect of the significant proportion of consumers that view 'POTE' and 'POTETTE' as having no obvious meaning. This is sufficient to warrant a finding of overall confusion between the marks. However, for the avoidance of doubt, I am of the view that those consumers that view both marks as alluding to 'potties' would still be directly confused. I say this because the level of visual and aural similarity between the marks is such that the consumer would still mistakenly recall them for one another. I appreciate that the lower level of distinctive character of the applicant's mark is a factor in favour of the proprietor, however, I remind myself that a weak distinctive character of an earlier mark does not preclude a likelihood of confusion.²⁷ Further, I do not consider that the shared concept of an allusion to 'potties' on potty related goods or services in both marks would be sufficient enough to avoid confusion. I say this because, despite its low distinctive character, 'POTETTE' is still somewhat inventive and does not directly describe the goods at issue to the point that the consumer would see the shared allusion to potties as being coincidental use by two different undertakings.

²⁶ *Bristol Global Co Ltd v EUIPO*, T-194/14

²⁷ *L'Oréal SA v OHIM*, Case C-235/05 P

91. As a result of my above findings, the application succeeds in respect of a majority of the goods and services at issue. I will now proceed to consider the remaining grounds.

Section 5(3)

92. Section 5(3) of the Act states:

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) 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 repute of the earlier trade mark.”

93. 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’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, 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 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/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'Oreal 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 holder 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'Oreal v Bellure*).

94. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the applicant must also show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. The applicant must also establish that the public will make a link between the marks, in the sense of the earlier marks being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and 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.

95. I am of the view that I can deal with this ground relatively briefly. The proprietor put the applicant to proof of use for its mark and I have summarised the evidence in support of the same at paragraphs 26 to 36 above. While I have found this evidence to be sufficient to prove genuine use, the bar for proving the existence of a reputation is higher than that for genuine use. In my view, the evidence before me is not at a sufficient enough level of demonstrate that the applicant's mark enjoyed a reputation in its mark across a significant proportion of the relevant public in the relevant territory at the relevant date. As a result, the applicant's reliance upon the 5(3) ground must fail.

96. Even if I am wrong to conclude as I have above, I do not consider that the present ground offers anything beyond the 5(2)(b) ground assessed above. I appreciate

that the existence of a reputation may result in a successful 5(3) application against those goods and services that I have identified to be identical or similar. However, I do not consider that the level of any reputation would, based on the evidence before me, be at a significant enough level to overcome the dissimilarity between the applicant's reputed goods and the services for which there was no likelihood of confusion under the above ground.

Section 5(4)(a)

97. Section 5(4)(a) of the Act reads as follows:

“(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,

(aa)

(b)

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.”

98. Subsection (4A) of Section 5 states:

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

99. 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).”

100. 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 reputation¹ 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 source² 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 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.”

Relevant Date

101. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., 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 Alan 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.’ ”

102. The contested registration does not have a priority date meaning that the relevant date for the present ground is its filing date, being 11 June 2020. While there is evidence of the proprietor’s activity on Amazon, this is not under the contested registration so is not evidence of earlier use of that may be capable of being considered as the start of the behaviour complained about.

Goodwill

103. The first hurdle for the applicant is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the sign relied upon was distinctive and/or associated with that goodwill. 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.”

104. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

105. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

106. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

107. Before proceeding to consider goodwill, I remind myself that the applicant relies on the sign ‘POTETTE PLUS’ that it claims to have used throughout the UK since 2007 for ‘toilet seat trainers’ and ‘travel potties’.

108. Goodwill arises as a result of trading activities. I have summarised the applicant’s evidence in respect of the use of its mark at paragraphs 26 to 36 above. Given that the applicant relies on a sign that is identical to the mark that was assessed under the genuine use assessment, I find that the same evidence summarised above is relevant here. Having said that, I do not consider that the entirety of the evidence is of assistance under the present ground. This is on the basis that the relevant date for the present assessment is 11 June 2020 meaning that the figures provided for 2021 and 2022 are of no assistance. Further, the only goods relied upon under this ground are ‘toilet seat trainers’ and travel potties’. Given that 60% of the turnover provided related to liners, a significant proportion of the evidence is in respect of goods not relied upon under the present ground.

By my calculation, I have determined that the turnover relevant here is just £1,190,033.20. On this point, I note that these figures include the entirety of 2020 and given that the relevant date sits halfway through the year, a sizeable proportion of those figures are likely to have accrued after the relevant date. Another factor that provides a hurdle for the applicant to overcome is that the evidence before me is only from 2016 onwards, meaning that only 4 years' worth of trading activities are before me. I appreciate that the POTETTE PLUS products may have been on the market since 2008 but there is no evidence of any trading activities between this date and 2016. As such, I do not consider that the evidence of trading activities is particularly longstanding.

109. I appreciate that small businesses which have more than a trivial goodwill can protect signs which are distinctive of those businesses under the law of passing off even though the goodwill and reputation may be small.²⁸ Whilst bearing this in mind, I find that, despite the issues before me regarding the scale and longevity of the applicant's use, the applicant's evidence is sufficient to demonstrate the existence of a protectable level of goodwill in the applicant's business for the goods relied upon (albeit limited in the same way as set out in my assessment of use above). I also find that the sign relied upon was distinctive of and/or associated with the business as at the relevant date. That being said, I am of the view that any level of goodwill is likely to be low.

Misrepresentation and damage

110. 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

²⁸ See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

“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.”

111. In considering the issue of misrepresentation, I remind myself that, under the 5(2)(b) ground, I found there to be a likelihood of confusion between the parties' marks for those goods and services that are identical and/or similar. In assessing the present ground, I remind myself of the case of *Comic Enterprises* (cited above), wherein Kitchin LJ set out that it was doubtful whether the difference between the legal tests for likelihood of confusion and misrepresentation will (all other factors being equal) produce different outcomes. I am of the view that this principle applies here and, as such, I am satisfied that a finding of misrepresentation (and subsequently, damage) follows the outcome of the 5(2)(b) ground, i.e. that it is successful in respect of all identical and/or similar goods and services.²⁹ That being

²⁹ On this point, I remind myself that the goods for which the applicant enjoys a level of goodwill in do not include the 'liners' goods relied upon under the 5(2)(b) ground. However, I still consider that there is some degree of similarity between the goods relied upon by the applicant and the goods and services of the opponent and that this gives rise to a finding of misrepresentation.

said, those services that survived the 5(2)(b) ground on the basis that they are dissimilar to the applicant's goods also survive the present ground. On this point, I appreciate that while a claim for passing off may succeed where there is no common field of activity (as is the case for the dissimilar services), the burden to overcome this hurdle is a significant one.³⁰ I have found above that the applicant only enjoys a low level of goodwill and, plainly, this is far from sufficient to be able to overcome such a burden.³¹ Therefore, I find that the applicant is unable to demonstrate the existence of a misrepresentation between those goods and services that I have found to be dissimilar.

Section 3(6): legislation and case law

112. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith”

113. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

³⁰ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

³¹ For the avoidance of doubt, I am of the view that the same finding would be reached even if the applicant had demonstrated a stronger level of protectable goodwill.

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

114. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard

applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

115. The basis for the applicant's claim under the 3(6) ground is that the proprietor has been well aware of the applicant's use of its mark for several years and that it has a history of misappropriating the applicant's intellectual property. The applicant claims that the proprietor filed its mark with the intention of taking advantage of its rights and to engage in unfair competition.

116. The evidence in support of the present ground consists of a copy of an email dated 25 September 2018 from the applicant's Spanish attorneys to the proprietor objecting to the proprietor's unauthorised use of the marks 'POTETTE' and 'POTETTE PLUS' on e-commerce websites such as Amazon and eBay.³² The second piece of evidence is an email from the proprietor to the applicant's present representatives confirming that it was aware of the applicant's use of its mark for several years but setting out its defence of the same and that, once the issue was brought to its attention, it sought to alter its listings to both respect and conform to the applicant's requirements.³³

117. Taking the evidence into account, it is clear that the proprietor was aware of the applicant and its use of its mark prior to filing its registration. However, I remind myself of paragraph 40 of *Lindt* (cited above) which states that:

“the fact that an applicant knows or must know that a third party has long been using [...] an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.”

118. It is not enough to simply suggest that the proprietor was aware of the applicant's mark and that by filing for its own registration (which consists of different, albeit similar, marks) it was acting in bad faith. Further, I note that the

³² DT1

³³ DT2

proprietor's rebuttal of the 3(6) ground was that while it was aware of the applicant's mark, it filed the contested registration with the intention of building its own brand. While I have found above that this is confusingly similar to the applicant's mark, the registration of a mark that may fall foul of 5(2)(b) grounds is not, in itself, sufficient to warrant a finding of bad faith.

119. The main crux of the applicant's case appears to be reliant on the allegation that, approximately three years prior to the relevant date, the proprietor was misappropriating the applicant's own 'POTETTE PLUS' mark on e-commerce websites such as Amazon and eBay. As rightfully argued by the proprietor, the relevant activity for the present assessment is the proprietor's actions as at the relevant date. Further, I appreciate that the applicant's own evidence of correspondence from the proprietor sets out that the proprietor would, going forward, alter its listings. Even if it could be said that the applicant's evidence pointed towards an unsavoury activity (a finding I am not willing to make), this was something that occurred three years prior to the relevant date. I also note that there is no further evidence of any misappropriation of the applicant's mark after this occurrence. As above, the proprietor's defence is that, while it was aware of the applicant's mark, it's application was filed with the intention of building its own brand. I have no reason to doubt that this was the case and, without anything further pointing to the actual actions of the proprietor as at the relevant date, I am not willing to find that the proprietor has acted in bad faith. This is particularly the case given that, as set out above, an allegation of bad faith is a serious one and must be distinctly proved. In the present case, I do not consider that the evidence before me is sufficient to give rise to a *prima facie* case that the proprietor, in filing the contested registration, was acting in bad faith.

120. Taking all of the above into account, I do not consider that the applicant's evidence is sufficient in demonstrating that the proprietor, in filing for the contested registration, acted in bad faith. The 3(6) ground, therefore, fails.

CONCLUSION

121. While the 5(3), 5(4)(a) and 3(6) grounds have failed, the application filed under the 5(2)(b) ground has succeeded against a majority of the goods and services. Subject to any appeal, the contested registration will be cancelled for the following goods and services:

Class 16: Liners, made from plastic; disposable bags, made from plastic; Liners, made from bio-degradable materials; Disposable bags, made from bio-degradable materials.

Class 21: Potties and toilet potties; toilet seat trainers; travel potties; parts and fittings for all the aforesaid goods included in Class 21.

Class 35: Retail and wholesale services connected with the sale of potties and toilet potties, toilet seat trainers, travel potties, liners, made from plastic, disposable bags, made from plastic, Liners, made from bio-degradable materials, Disposable bags, made from bio-degradable materials. parts and fittings for all the aforesaid goods enabling customers to conveniently view and purchase those goods from a mail order catalogue, by means of telecommunication or via an internet website specialising in the aforesaid.

122. However, the contested registration may remain registered for the following services:

Class 35: Advertising, marketing and promotional services; distribution of advertising, marketing and promotional materials; marketing campaign services; promotion of products; advertising and promotion using social media platforms; product demonstration services and advisory and consultancy services in connection with all the aforesaid services.

COSTS

123. As the applicant has enjoyed a greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Having said that, I consider that the costs should be reduced by 10% to reflect the partial success of the proprietor in defending some services in its registration. In the circumstances, I award the proprietor the sum of **£900** as a contribution towards its costs. The sum is calculated as follows:

Preparing the invalidation application:	£300
Preparing evidence:	£500
Preparation of written submissions:	£300
<u>Sub-total:</u>	<u>£1,100</u>
<i>10% reduction:</i>	<i>£110</i>
Total:	£990

124. I hereby order Venture Distribution Ltd to pay OakStrong International Limited the sum of £990. The above 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 10th day of November 2023

A COOPER
For the Registrar