

O/211/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003461608

BY IXORA GENERAL TRADING LLC

TO REGISTER THE FOLLOWING MARK:



IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 419867

BY HENKEL AG & CO. KGAA

BACKGROUND AND PLEADINGS

1. On 27 January 2020, Ixora General Trading LLC (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 7 February 2020 and registration is sought for the following goods:

Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices.

2. On 18 March 2020, Henkel AG & Co. KGaA (“the opponent”) partially opposed the application based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against only those goods underlined above. Under sections 5(2)(b) and 5(3), the opponent relies upon UK trade mark no. 3204665 for the mark **IGORA**. The opponent’s mark was filed on 3 January 2017 and registered on 31 March 2017. The opponent relies upon all goods and services for which its mark is registered, namely:

Class 3 Hair-care preparations, cosmetics, namely shampoos, hair-care preparations and conditioners being different care preparations and treatments for the hair and scalp; soaps, perfumery, essential oils, preparations for tinting, dyeing, bleaching, setting and perming hair.

Class 21 Combs, brush goods, toilet utensils (included in class 21), mechanical cosmetic applicators and appliances for removing cosmetics, sponges, brushes (except paint brushes), apparatus and containers for applying hair dye.

Class 44 Hygienic and beauty care for human beings.

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because the parties' respective marks are similar, and the goods are identical or similar.

4. Under section 5(3), the opponent claims a reputation in relation to all goods and services for which its mark is registered. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

5. Under section 5(4)(a), the opponent claims to have used the sign **IGORA** throughout the UK since 2017 in relation to:

“Hair care preparations, namely shampoos, hair-care preparations and conditioners being different care preparations and treatments for the hair and scalp; soaps, perfumery, essential oils, preparations for tinting, dyeing, bleaching, setting and perming hair; Combs, brush goods, toilet utensils, mechanical cosmetic applicators and appliances for removing cosmetics, sponges, brushes (except paint brushes), apparatus and containers for applying hair dye; hygienic and beauty care for human beings.”

6. The applicant filed a counterstatement denying the grounds of opposition.

7. The opponent is represented by D Young & Co LLP and the applicant is represented by IP Lab. Both parties filed evidence in chief. The opponent did not file evidence in reply. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief in the form of the witness statement of Joachim Renner dated 12 October 2020, which is accompanied by 8 exhibits. Mr Renner is Corporate Trade Mark Counsel for the opponent, a position he has held since 2002.

9. The applicant filed evidence in chief in the form of the witness statement of David Anthony Evans dated 22 January 2021, which is accompanied by 2 exhibits. Mr Evans is the Director of the applicant's representative, a position he has held since 2005.

10. The applicant's evidence was accompanied by written submissions dated 22 January 2021.

11. The opponent filed written submissions in lieu dated 2 March 2021.

12. Whilst I have taken all of the evidence and submissions into consideration in reaching my decision, I do not propose to summarise it here, but will refer to it below where necessary.

PRELIMINARY ISSUE

13. In its counterstatement, the applicant states:

[...] the opponent appears to use their mark in relation to professional hair products, marketed directly to salons and not to the general public. As a result, the opponent is operating in a different market to that of the applicant, despite any similarity between the goods of the applicant and those of the opponent."

14. In his evidence, Mr Evans has filed a screenshot from the website of one of the opponent's third-party suppliers which confirms it sells to the trade only.¹ Mr Evans states:

"7. Based on the fact that the Opponent's goods are not available to the general public, but only directly to hair salons for professional use, and with no retail range, there appears to be very little chance of the general public being confused by the two marks. For one thing, these products will never be placed side by side and any salon will know that IGORA is coming from Schwarzkopf. In addition, the Applicant's goods are designed to be sold directly to the public

¹ Exhibit DE2

and will not have the sales channel as those of the Opponent. As a result, the likelihood of confusion is lessened as a result.”

15. However, the way in which the parties use (or intend to use) their marks is not relevant to my assessment. I must undertake the comparison based upon the full breadth of the specifications applied for/registered. This line of argument does not, therefore, assist the applicant.

DECISION

Section 5(2)(b)

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

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

(a)...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

17. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier trade mark had not completed its registration process more than five years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services identified.

18. 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 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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly 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

19. In its counterstatement, the applicant states:

“[...] it is accepted that there is a similarity between the respective goods of the parties [...]”

20. Although the applicant accepts that there is some similarity between the parties' respective goods, it does not confirm the extent to which any such similarity exists. Consequently, it is necessary for me to undertake a full goods and services comparison. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods
<u>Class 3</u> Hair-care preparations, cosmetics, namely shampoos, hair-care	<u>Class 3</u> Non-medicated soaps; perfumery, essential oils, non-medicated cosmetics,

<p>preparations and conditioners being different care preparations and treatments for the hair and scalp; soaps, perfumery, essential oils, preparations for tinting, dyeing, bleaching, setting and perming hair.</p> <p><u>Class 21</u> Combs, brush goods, toilet utensils (included in class 21), mechanical cosmetic applicators and appliances for removing cosmetics, sponges, brushes (except paint brushes), apparatus and containers for applying hair dye.</p> <p><u>Class 44</u> Hygienic and beauty care for human beings.</p>	<p>non-medicated hair lotions; non-medicated dentifrices.</p>
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21. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. “Soaps, perfumery, essential oils, preparations for tinting, dyeing, bleaching, setting and perming hair” in the opponent’s specification will be identical on the principle outlined in *Meric* to “Non-medicated soaps”, “perfumery” and “essential oils” in the applicant’s specification.

24. “Cosmetics, namely shampoos, hair-care preparations and conditioners being different care preparations and treatments for the hair and scalp” in the opponent’s specification will be identical on the principle outlined in *Meric* to “non-medicated cosmetics, non-medicated hair lotions” in the applicant’s specification.

25. “Non-medicated dentifrices” in the applicant’s specification refers to non-medicated substances used for cleaning teeth.² The opponent claims that these are identical to “cosmetics”. I disagree. Whilst there may be some overlap in trade channels with the opponent’s goods in class 3, the goods are likely to differ in nature, method of use and purpose. They will be neither in competition nor complementary. However, I note that the opponent also has “brush goods” and “brushes (except paint brushes)” in class 21. These goods could be sold through the same retailers as the applicant’s goods. For example, it is not uncommon for undertakings to sell both toothbrushes and toothpaste. The goods will differ in nature and method of use. However, they will overlap in purpose, user and will be complementary within the meaning of the case law.³ Taking all of this into consideration, I consider the goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In

² <https://www.collinsdictionary.com/dictionary/english/dentifrice>

³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

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 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.”

27. The average consumer is likely to be a member of the general public. The goods are likely to be relatively low cost and purchased reasonably frequently. However, various factors will still be taken into consideration such as the ingredients, sensitivity and fragrance/flavour. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

28. The goods are likely to be self-selected from the shelves of a retail outlet or their online or catalogue equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods given that advice may be sought from retail assistants.


Comparison of trade marks

29. It is clear from *Sabel BV 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. 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.”

30. 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.

31. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
<p style="text-align: center;">IGORA</p>	

32. The earlier mark consists of the word IGORA. There are no other elements to contribute to the overall impression which lies in the word itself. The applicant's mark consists of the word IXORA, with a curved line intersecting the raised letter 'O'. Next to the word appears a series of characters that appear to be from a foreign language, and are likely to be attributed little trade mark significance as they will be viewed as a translation of the word presented in the English alphabet (i.e. IXORA). Both elements

are presented in white on a black background. The eye is naturally drawn to the element that can be read i.e. the word IXORA and curved line. It is that element that plays the greater role in the overall impression. The foreign language characters and background will play a lesser role.

33. Visually, the marks overlap in the presence of the letters I-ORA, which appear identically in the same order in both marks. They differ in the second letter of each word which is 'G' in the opponent's mark and 'X' in the applicant's mark. The applicant submits that the fact that the differing letter is towards the beginning of the mark will make the difference more pronounced. The applicant is, of course, correct that the beginnings of marks tend to make more of an impact than the ends.⁴ The curved line and raised letter 'O' also act as a point of visual difference, as does the presence of the foreign language characters and the background. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

34. Aurally, the opponent's mark is likely to be pronounced IGG-ORR-AHH. The only element of the applicant's mark that will be pronounced is the word IXORA, which is likely to be pronounced IKS-ORR-AHH. I consider the marks to be aurally highly similar.

35. Conceptually, the words IGORA and IXORA are invented words which will convey no particular meaning. Similarly, the foreign language characters in the applicant's mark will convey no meaning to the UK average consumer. Consequently, the conceptual position is neutral.

Distinctive character of the earlier trade mark

36. 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

⁴ *El Corte Ingles, SA v OHIM* Cases T-183/02 and T184/02

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

38. Mr Renner gives evidence that the opponent began using the earlier mark in the UK in 1960. He states that it has been used since that date in relation to hair colourant and hair care related goods. Printouts from the opponent’s .co.uk website have been provided dated 2014 to 2019 which show the earlier mark in use.⁵ I note that the products displayed include hair colourants, although it is not clear what some of the other products are as the text on the products shown in the images is too small. The opponent states that its products are available through third party UK retailers, but the

⁵ Exhibit JR2

screenshots of the websites provided are dated after the relevant date.⁶ Further, Mr Renner does not confirm when these websites started selling the products. The opponent has provided a series of invoices dated 2019 which it states show use of the earlier marks.⁷ The invoices do not actually display the earlier marks themselves, but Mr Renner explains that the codes “IG”, “IR” or “IRA” are used on the invoices to denote IGORA products. Proceeding on that basis, not all of the products listed on the invoices relate to goods sold under the earlier marks. However, over 7,500 units do relate to sales made under the earlier marks, although it is not clear to what goods they relate. The opponent has provided the following sales figures for goods sold under the earlier marks:

2015	£12,692,313
2016	£14,578,062
2017	£14,831,643
2018	£14,795,151
2019	£15,029,082 ⁸

Clearly, these are not insignificant sums, although I have no information as to what proportion of these figures relate to the goods in issue.

39. Mr Renner states that the opponent’s advertising budget for promoting the earlier mark in the UK has been £75,000 per year between 2015 and 2019. In this regard, the opponent has provided some examples of advertisements from 2019 and June/July 2020.⁹ I note that only those circulated in 2019 will be prior to the relevant date. All of the examples relate to hair colouring products. I note that Mr Renner has listed the publications in which these adverts are said to have been placed, although no information is provided about the circulation of these publications. Mr Renner has provided examples of the opponent’s social media accounts, including posts dating back to 2015.¹⁰ The posts appear to relate predominantly to hair colouring products.

⁶ Exhibit JR3

⁷ Exhibit JR4

⁸ Exhibit JR5

⁹ Exhibit JR6

¹⁰ Exhibit JR8

40. The opponent has not provided any market share figures, although I accept that the sales figures provided are not insignificant. However, no breakdown is provided to confirm what proportion of these figures relate to the goods in issue. I also note that the earlier mark has been used in the UK for a number of years, but I have no information about how geographically widespread the use has been. The opponent's advertising budget is not insignificant, but I have no information about how much of this was actually spent each year or how broad the reach of the advertisements placed in the publications listed would have been. It seems to me that the opponent's best possible case is that the distinctiveness of its mark has been enhanced through use in relation to preparations for dyeing hair only. It is these goods to which the majority of the opponent's evidence relates (where it is possible to identify any goods at all). However, on balance, I am not satisfied that the evidence is sufficient to establish that the opponent's mark has acquired enhanced distinctiveness through use for the goods relied upon in these proceedings.

41. I have, therefore, only the inherent position to consider. The earlier mark is an invented word – IGORA. It has no relationship with the goods relied upon. Consequently, I consider the earlier mark to be inherently highly distinctive.

Likelihood of confusion

42. 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 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 earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the

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.

43. I have found the marks to be visually similar to a medium degree, aurally highly similar and conceptually neutral. I have found the earlier mark to be inherently highly distinctive. I have found the average consumer to be a member of the general public, who will pay a medium degree of attention during the purchasing process. I have found the purchasing process to be predominantly visual, although I do not discount an aural component. I have found the goods to vary from similar to a medium degree to identical.

44. I recognise that there are clearly visual differences between the marks, created by the curved line through the raised 'O' and the foreign language characters. However, as the foreign language characters are likely to be attributed little trade mark significance (as they will merely be viewed as a translation of the English-alphabet word i.e. IXORA) they are likely to be forgotten by the average consumer when trying to recall the mark. I also consider it likely that the average consumer will overlook the different second letter and the raised 'O' and curved line, just remembering an invented word that begins with 'I' and ends with the suffix -ORA. In those circumstances, there is a likelihood of direct confusion in respect of all goods against which the opposition is directed.

45. Even if I am wrong in that finding, and the foreign language characters and raised 'O' with curved line through it are recalled by the average consumer, I still consider that they are likely to misremember the second letter. There will be no conceptual hook to assist the average consumer in recalling the word and the earlier mark is highly distinctive. Consequently, they are likely to view the raised 'O' with curved line and the presence of foreign language characters as denoting a different mark being used by the same or economically related undertakings (perhaps indicating goods originating from or targeting a different geographical market). Consequently, I consider there to be a likelihood of indirect confusion.

46. The opposition based upon section 5(2)(b) succeeds in its entirety.

Section 5(3)

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

“5(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.”

48. As noted above, the mark relied upon qualifies as an earlier mark pursuant to section 6 of the Act. As it had not been registered for more than 5 years at the date of the application in issue, the opponent can rely upon all of the goods and services identified.

49. I bear in mind the relevant case law set out 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* and *Case C-323/09, Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of the 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.

50. The relevant date for the assessment under section 5(3) is the date of the application i.e. 27 January 2020.

Reputation

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

52. In determining whether the opponent has demonstrated a reputation for the goods and services in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with the goods and services. In reaching this decision, I must take all of the evidence into account including “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”

53. I have set out a brief summary of the opponent's evidence at paragraphs 38 to 40 above. The same deficiencies apply when considering the evidence in the context of the test for reputation. Firstly, parts of the opponent's evidence are undated or dated after the relevant period by virtue of the print date. Secondly, whilst the opponent's sales are not insignificant, no breakdown is given as to what proportion of these sales relate to the goods and services relied upon in these proceedings. Thirdly, whilst the opponent's advertising budget is not insignificant, no information is provided as to how much of this was actually spent and in what way. I note in this regard that there are some examples of advertisements placed in publications dated before the relevant date (although no circulation figures are provided). Fourthly, no market share figures have been provided and no information is supplied to enable me to accurately assess the size of the market (although no doubt it is extensive). Fifthly, it is difficult to determine how geographically widespread use of the mark has been based upon the evidence before me. Taking all of the evidence into account, I am not satisfied that the opponent has established a reputation in the UK.

54. The opposition based upon section 5(3) is dismissed.

Section 5(4)(a)

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

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

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

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”.

56. Subsection (4A) of section 5 of the Act 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.”

57. The prima facie relevant date is the date of the application i.e. 27 January 2020. There is no suggestion that the applicant has traded prior to this date such that a second relevant date may apply.

58. 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).”

59. The opponent’s pleaded case under section 5(4)(a) is that it has been using the sign relied upon in the UK since “circa 2017” in relation to the goods set out above. Clearly, the opponent’s evidence shows use of the sign in the UK prior to that date.

For example, sales figures have been provided which date back to 2015. However, this criticism was raised by the applicant in their written submissions filed during the evidence rounds. Despite this, it was not addressed by the opponent in their written submissions in lieu. I do not consider that the opponent should be permitted to broaden its claim under this ground during the evidence rounds, without having made an application to amend its pleadings. Consequently, I consider it should be limited to relying upon the evidence of use dated between 2017 and the relevant date for the purposes of establishing goodwill under section 5(4)(a).

60. In any event, the opponent's best case, in my view, is that it had a moderate degree of goodwill in relation to "preparations for dyeing hair" at the relevant date. Consequently, the only clear overlap in terms of fields of activity with the applicant's specification would be "non-medicated hair lotions". The remaining "non-medicated soaps", "perfumery", "essential oils" and "non-medicated dentifrices" in the applicant's specification are unlikely to overlap in terms of fields of activity or, if they do, any overlap will be limited. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity.¹¹ However, it is a factor to be taken into account. I consider that the opponent could only establish misrepresentation and damage in relation to "non-medicated hair lotions" under this section, as the distance between the fields of activity, combined with the only moderate degree of goodwill, would be sufficient to offset the similarity between the marks for the applicant's other goods.

61. Consequently, this ground of opposition would not put the opponent in a stronger position than its section 5(2)(b) ground of opposition, and I need not consider the issue with the opponent's pleadings any further.

CONCLUSION

62. The opposition under section 5(2)(b) is successful and the application is refused in relation to those goods against which the opposition is directed, namely:

¹¹ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

Class 3 Non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices.

63. The application may proceed to registration in relation to the goods against which the opposition was not directed, namely:

Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations;

COSTS

64. The opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. As the opponent's sections 5(3) and 5(4)(a) grounds have not put it in any better position than those under section 5(2)(b), I do not consider it appropriate to award the full official fee. In the circumstances, I award the opponent the sum of **£1,550**, calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£350
Filing evidence and considering the applicant's evidence	£750
Written submissions in lieu	£350
Official fee	£100
Total	£1,550

65. I therefore order Ixora General Trading LLC to pay Henkel AG & Co. KgaA the sum of £1,550. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of March 2021

S WILSON

For the Registrar