

**O-312-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3376430**

**BY BRIAN GERAGHTY**

**TO REGISTER:**

**THE PLANT FARMACY**

**AS A TRADE MARK IN CLASSES: 1, 3, 5, 29, 30, 32, 34 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416785 BY**

**AVA FARMACY LIMITED**

## BACKGROUND & PLEADINGS

1. On 18 February 2019, Brian Gergahty (“the applicant”) applied to register the words **THE PLANT FARMACY** as a trade mark for a range of goods and services in classes 1, 3, 5, 29, 30, 32, 34 and 35 (shown in the Annex to this decision). The application was published for opposition purposes on 3 May 2019.

2. On 1 July 2019, the application was opposed by AVA Farmacy Limited (“the opponent”). The opposition, which is only directed against the goods in classes 3, 29, 30, 32 and services in class 35 of the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon all the goods and services (shown in paragraph 12 below) in United Kingdom trade mark no. 3117614 which consists of a series of two trade marks i.e. **THE FARMACY** and **FARMACY** which were applied for on 14 July 2015 and entered in the register on 9 October 2015. In its Notice of opposition, the opponent states:

“2...The Applicant's Mark is similar to the Opponent's Mark because it contains the word FARMACY being the whole of the Opponent's Mark. A consumer, may be confused into believing that both marks emanate from the same undertaking. The additional word PLANT in the Applicant's Mark is a generic, descriptive word which is not sufficient to distinguish the marks apart. The word PLANT merely acts as a description of the base substance of the goods and services offered, and the term should be disregarded when comparing the marks for the purpose of these opposition proceedings. Therefore, the most distinctive element of the Applicant's Mark and the Opponent's Mark is the word FARMACY.

3. The Applicant's Mark and the Opponent's mark are visually, orally and semantically similar. As such, it would be difficult for a consumer, upon seeing

the terms 'THE FARMACY' and 'THE PLANT FARMACY' for the identical or similar goods and services, to distinguish the marks apart...”

3. The applicant filed a counterstatement in which it denies there is a likelihood of confusion.

4. In these proceedings, the opponent is represented by Addleshaw Goddard LLP and the applicant by Hanna IP. Although only the applicant filed evidence (accompanied by written submissions), the opponent filed written submissions in reply to the applicant's evidence/submissions. Neither party requested a hearing nor did they elect to file written submissions in lieu of attendance.

## **EVIDENCE**

### **The applicant's evidence**

5. This consists of a witness statement, dated 25 November 2019, from Neil Ritchie, the applicant's trade mark Attorney. Mr Ritchie's statement is accompanied by fourteen exhibits, which I will, where I consider it appropriate, refer to below. Using as far as possible the words contained in Mr Ritchie's written submissions, the evidence has been provided to show that:

- “...no English speaker would find the substitution of an “PH” for an “F” distinctive generally or for the goods and services under opposition”;
- Collinsdictionary.com defines “pharmacy” as, inter alia, “a shop or department in a shop where medicines are sold or given out” (exhibit BG2);

- “the English speaking public would clearly and without hesitation identify that the word "FARMACY" is merely a misspelling of the normal English language word "pharmacy" due to the common knowledge of many European languages wherein English word beginning with "ph" conventionally begin with and "f" for example that of the common term "farmacia" which is the Spanish word for "pharmacy";
- “it is highly likely in light of UK to Spain visitor numbers which have substantially increased over the course of recent years with an average annual growth of 6.3% between 2014 to 2018 that the average consumer would immediately understand the Spanish word "farmacia";
- “The UK Office for National Statistics reports that there were approximately 12.246 million UK resident visits to Spain in 2014. This number increased to 15.618 million in 2018; resulting in an average visitor number of approximately 14.28 million each year between 2014 and 2018”;
- “there was 176,000 Spanish born nationals living within the UK, excluding students in halls and people in communal establishments (e.g. hotels, boarding houses, hostels, mobile home sites) between January 2018 and December 2018”;
- “in the school year 2016/2017 Spanish, among all other foreign languages, was the second most popular language (behind French) in England at GCSE and A-level with over 91,000 students sitting a Spanish language exam at GCSE and 7,566 sitting a Spanish language exam A-Level standard in 2017”;
- The Board of Appeal of the EUIPO determined that the mark "FARMACY" (EU trade mark application no. 014569561) was descriptive for [a range of goods in class 3]... and “further noted that the science of 'pharmacy' and the profession of

a pharmacist is written 'Farmacija' in Croatian, 'Farmacie' in Czech, 'Farmacja' in Polish and 'Farmacie' in Romanian. 'Drugstore' in Portuguese is written 'Farmacia'" (exhibit BG8 refers);

- "...Portugal and Poland typically feature in the top 10 countries visited by UK residents for at least one night...";
- "The UK Office for National Statistics reports that there were approximately 1.693 million UK resident visits to Poland in 2015. This number increased to 2.472 million in 2018; resulting in an average visitor number of approximately 2.26 million each year between 2015 and 2018...Further, The UK Office for National Statistics report on the population estimates of the UK by country of birth and nationality states that there was 905,000 Polish born nationals living within the UK, excluding students in halls and people in communal establishments (e.g. hotels, boarding houses, hostels, mobile home sites) between January 2018 and December 2018";
- "The UK Office for National Statistics reports that there were approximately 2.192 million UK resident visits to Portugal in 2014. This number increased to 2.818 million in 2018; resulting in an average visitor number of approximately 2.66 million per year between 2014 and 2018...Further, The UK Office for National Statistics report on the population estimates of the UK by country of birth and nationality states that there was 224,000 Portuguese born nationals living within the UK, excluding students in halls and people in communal establishments (e.g. hotels, boarding houses, hostels, mobile home sites) between January 2018 and December 2018";
- "while the definition of a pharmacy is generally in relation to the preparation and dispensing of medicinal products it will be greatly appreciated that it is very

common that they will sell numerous other items irrespective of whether the pharmacy is a large retail chain such as Boots® or Superdrug® or a smaller independent store and the average consumer will be well aware of such”. Exhibit BG12 consists of pages downloaded on 25 November 2019 from, inter alia, the websites of Boots, Superdrug, Lloyds Pharmacy and coopers Pharmacy in support;

- Exhibit BG13 consists of an extract obtained from *the Pharmaceutical Journal* dated 27 October 2006 entitled: “Baby clothes, sandwiches and T-shirts spoil pharmacy’s professional image.”
- there are other trade marks registered in the names of unrelated undertakings which contain the word “FARMACY” i.e. “FRESH FARMACY” (class 3), “FARMACY BEAUTY” (class 3), “The Naked Farmacy” (classes 5 and 44) and  (class 44) – exhibit BG14 refers.

6. Mr Ritchie concludes his statement in the following terms arguing that his submissions and evidence show that:

“16... the PLANT aspect of the filed trade mark cannot be considered merely a generic descriptive word which is not sufficient to distinguish the marks "THE PLANT FARMACY" and "THE FARMACY"/"Farmacy" and cannot be merely disregarded as the Opponent has suggested within the notice of opposition...the term "FARMACY" is a clear misspelling of the word "pharmacy" and will be easily and readily identified as such by any native English-speaker who would by instinct alone take the spelling "FARMACY" as an equivalent of "pharmacy".

7. That concludes my summary of the evidence filed to the extent I consider it necessary.

## DECISION

8. The opposition is based upon section 5(2)(b) of the Act which 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.

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

9. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(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.”

10. The trade mark upon which the opponent is relying qualifies as an earlier trade mark under the above provisions. Given the interplay between the date on which the opponent’s trade mark was entered in the register and the application date of the trade mark being opposed, the earlier trade mark is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent can rely upon all the goods/services claimed without having to demonstrate they have made genuine use of them.

### **Case law**

11. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(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

12. The competing goods and services are as follows:

The opponent's goods and services	The applicant's goods and services being opposed
<p><b>Class 3</b> - Soaps; perfumery; toiletries; essential oils; cosmetics; hair products; dentifrices.</p> <p><b>Class 29</b> - Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.</p> <p><b>Class 30</b> - Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</p>	<p><b>Class 3</b> - Cosmetics; toiletries; essential oils; soaps; perfumery; non-medicated cosmetics and toiletry preparations; non-medicated preparations for the care of the skin, eyes, nails and hair; body cleaning and beauty care preparations; skin, eye and nail care preparations; preparations and substances for use in the care and appearance of the skin, hair, nails, eyes and teeth; non-medicated skin serums and skin salves; body cream; hand cream; body creams [cosmetics]; facial creams [cosmetic]; cosmetic creams and lotions; body and facial creams [cosmetics]; massage oils and lotions; aromatic essential oils;</p>

<p><b>Class 31</b> - Grains and agricultural, horticultural and forestry products not included in other classes; flowers and plants; fresh fruits and vegetables.</p> <p><b>Class 32</b> - Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.</p> <p><b>Class 33</b> - Alcoholic beverages (except beers).</p> <p><b>Class 35</b> - Retail services relating to the operation of a delicatessen.</p> <p><b>Class 43</b> - Services for providing food and drink; fast food services; restaurant, cafe, bistro, snack-bar and coffee shop services; bar, wine bar and cocktail lounge services; hotel and accommodation services; banqueting and catering services; provision of facilities for meetings, seminars, conferences, exhibitions and fairs; rental of rooms for meetings.</p> <p><b>Class 44</b> - Health and nutrition advisory services.</p>	<p>aromatherapy oils; cleansing oil; bath oils; face oils; non-medicated oils; facial creams; body creams; face creams; cosmetics containing cannabinoids; creams and lotions containing cannabinoids; toiletries containing cannabinoids; anti-ageing serums; serums for cosmetic purposes; facial serums for cosmetic use; beauty serums; bath herbs.</p> <p><b>Class 29</b> - Edible oils and fats; hemp oil; processed edible hemp seeds; hemp protein powder for use as a nutritional food additive for culinary purposes; hemp milk used as a milk substitute.</p> <p><b>Class 30</b> - Herbal infusions; herbal tea; non-medicated herbal infusions; herbal preparations for making beverages; culinary herbs; processed herbs; preserved herbs; dried herbs.</p> <p><b>Class 32</b> - Essences for making beverages; essences for making non-alcoholic beverages, not in the nature of essential oils; cannabidiol essences for use in drinks.</p> <p><b>Class 35</b> – please see Annex.</p>
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13. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

14. 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.

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

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

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

17. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

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

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

21. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

22. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for

determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

23. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court’s 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 trade mark was registered (or proposed to be registered).

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

24. In its Notice of opposition, the opponent claims that the opposed goods and services “are identical with, or similar to, goods and services for which the earlier trade mark is protected” and, in its counterstatement, the applicant simply denies that is the case. In its submissions filed in response to the applicant’s evidence and submissions, the opponent maintains its position, again without providing any explanation of why it considers that to be the case. While in some instances the clash may be obvious, that is not always the case. Where it is not obvious, absent evidence or submissions to assist me from either party, I will have to reach my own conclusions based upon my own experience and applying the guidance reproduced above.

### **Class 3**

25. The terms “cosmetics”, “toiletries”, “essential oils”, “soap” and “perfumery” appear in both parties’ specifications and are literally identical. “Perfumery”, “toiletries”, “cosmetics”, “hair products” and “dentifrices” in the opponent’s specification are broad terms which encompass a wide range of goods. As the remaining goods in the application are encompassed by one or more of these broad terms, they are to be regarded as identical to those of the opponent on the inclusion principle outlined in *Meric*.

### **Class 29**

26. The term “Edible oils and fats” appears in both parties’ specifications and is literally identical. As the term “hemp oil” in the application is encompassed by the term “edible oils and fats” in the opponent’s specification, it is to be regarded as identical on the *Meric* principle. The application also contains “processed edible hemp seeds” and “hemp protein powder for use as a nutritional food additive for culinary purposes”. It is my understanding that hemp seeds can be eaten raw, are added to foodstuffs and drinks such as biscuits, bread and smoothies and may be ground up to make hemp protein powder, and that hemp protein powder may be used as, inter alia, a substitute

for flour. As the opponent's specification in class 30 includes "flour", it appears to me that there is likely to be an overlap in the users, intended purpose, method of use and trade channels. There is also likely to be a competitive relationship between the respective goods. Considered overall, the applicant's "processed edible hemp seeds" and "hemp protein powder for use as a nutritional food additive for culinary purposes" are similar to the opponent's "flour" to at least a medium degree. The application also contains "hemp milk used as a milk substitute", whereas the opponent's specification includes "milk...". Although the ingredients will differ, the physical nature of the competing goods will be the same i.e. a liquid and there will also be an overlap in the users, intended purpose, method of use, trade channels as well as a likely competitive relationship between the two sets of goods. They are, as a consequence, similar to a high degree.

### **Class 30**

27. The opponent's specification includes "tea" which would encompass the applicant's "herbal tea"; the competing goods are identical on *Meri*c. As the applicant's "herbal infusions" and "non-medicated herbal infusions" could also be tea based, they too are identical on the *Meri*c principle. However, even if that is not the case, as the users, nature, intended purpose, method of use and trade channels of the competing goods will be the same, they are similar to a high degree. The application also includes "herbal preparations for making beverages", "culinary herbs", "processed herbs", "preserved herbs" and "dried herbs", whereas the opponent's specification includes "spices". As both the applicant's herbs and herbal preparations and the opponent's spices are used as a seasoning in the preparation of food and drinks, the overlap in, at least, the users, nature, intended purpose, method of use and trade channels results in, at least a medium degree of similarity between them.

### **Class 32**

28. As all of the applicant's goods in this class would be encompassed by the term "syrups and other preparations for making beverages" in the opponent's specification, the competing goods are, once again, identical on the *Meric* principle.

### **Class 35**

29. The applicant's specification in this class includes: (i) "retail sales connected with...", (ii) "online retail services connected with...", and (iii) "subscription-based order fulfilment services connected with...". These retail and subscription-based services relate to many of the goods for which it seeks registration. It also contains a range of services relating to advertising, business management and administration and office functions. Although the opponent has not opposed the goods in classes 1, 5 and 34, it nonetheless objects to all of the applicant's services in this class. Applying the relevant case law and reminding myself of my comments in paragraph 24 above, I reach the following conclusions.

30. The opponent's goods in class 3 are complementary to the following services in the application and are, as a consequence, similar to a medium degree:

Retail services/online retail services/subscription-based order fulfilment services connected with the sale of cosmetics, toiletries, essential oils, soaps, perfumery, non-medicated preparations for the care of the skin, non-medicated preparations for the care of the eyes, non-medicated preparations for the care of nails, non-medicated preparations for the care of hair, body cleaning and beauty care preparations, non-medicated skin serums and skin salves, cosmetic creams and lotions, non-medicated oils, bath herbs; medicated topical creams and salves and lotions and balms for use on skin.

31. The goods in the opponent's specifications in classes 29, 30 and 32 I have identified above are complementary to the following services in the application and are, once again, similar to a medium degree:

Retail services/online retail services/subscription-based order fulfilment services connected with the sale of edible oils and fats, processed edible hemp seeds, hemp protein powder for use as a nutritional food additive for culinary purposes, hemp milk used as a milk substitute, herbal tea, non-medicated herbal infusions, culinary herbs, processed herbs, preserved herbs, dried herbs, essences for making beverages.

32. I am, however, unable to identify any meaningful degree of complementary relationship/similarity between the opponent's goods and services and the following:

Retail services/online retail services/subscription-based order fulfilment services connected with the sale of protein and hemp oil extracted from hemp for manufacturing various goods.

And:

Retail services/online retail services/subscription-based order fulfilment services connected with the sale of pharmaceuticals, medical marijuana and cannabis and derivatives thereof, cannabis oils, dietary supplements, herbal supplements, medicinal herbs, extracts of medicinal herbs and plants, herbal preparations for medical use; suppositories, herbal sprays for medical purposes, analgesic preparations, antibiotic preparations, products for administering medical marijuana or cannabis or cannabis oils or cannabis derivatives.

And:

Retail services/online retail services/subscription-based order fulfilment services connected with the sale of smokers' articles, electronic cigarettes, electronic cigarette cases and cleaners, electronic cigarette atomizers and cartomizers and clearomizers, cartridges for electronic cigarettes, liquid solutions and tobacco tar flavourings other than essential oils for use in electronic cigarettes, smoking sets for electronic cigarettes, lanyards specially adapted for holding electronic cigarettes, batteries for electronic cigarettes, herbs for smoking.

33. That leaves the following services in the application to be considered:

Advertising; promotional advertising services; direct market advertising; advertising services provided via the internet; radio and television advertising; business management; business administration; office functions.

34. These are all services likely to be provided on a business-to-business basis whose intended purpose is, broadly speaking, to either make a business more visible to potential customers or to improve its day-to-day functioning. Undertakings offering such services are likely to specialise in the provision of such services. As the users and intended purpose differ and as there is neither a competitive or complementary relationship between such services and the goods and services of the opponent, there is, in my view, no meaningful degree of similarity between the competing goods and services.

35. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be

considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

36. As a consequence, the opposition to the services shown in paragraphs 32 and 33 fail and are dismissed accordingly.

### **The average consumer and the nature of the purchasing act**

37. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods and services I have found to be identical or similar. I must then determine 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. 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.”

38. In its submission the applicant states:

“...the relevant goods and services are directed at the public at large.”

39. As the opponent suggests, the average consumer of the goods and services at issue is a member of the general public. As such goods and services are most likely to be the subject of self-selection either on the high street or on-line, visual considerations are likely to dominate the selection process. However, as aural considerations in the form of, for example, requests to sales assistants or word-of-mouth recommendations from one consumer to another will also form part of the process, such considerations must also be kept in mind. As to the degree of care the average consumer will display when selecting such goods and services, broadly speaking, the cost of the vast majority of the goods at issue is likely to be fairly low. The goods are, however, for use on or in the body. Considered overall, I think the average consumer is likely to pay a low to medium degree of attention to the selection of the goods and services at issue.

### **Comparison of trade marks**

40. 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 them, 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.”

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

due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

<b>Opponent's trade marks</b>	<b>Applicant's trade mark</b>
THE FARMACY & FARMACY	THE PLANT FARMACY

42. The opponent relies upon the series of two trade marks shown above. Both are presented in block capital letters. Although the word "THE" appearing in the first trade mark in the series has no distinctive character, the applicant's trade mark also contains this word in the same position. As the trade mark consisting exclusively of the "FARMACY" places the opponent in no better position, it is the first trade mark in the series i.e. "THE FARMACY" which is most like the applicant's trade mark and it is that trade mark I shall use for the purposes of comparison.

43. Although the word "THE" is the first component in the opponent's trade mark and will contribute to the overall impression conveyed, as I mentioned above, it is non-distinctive. It may also be used as an intensifier to suggest that the word that follows it is the best of its kind. The word "THE" will, as a consequence, have a low relative weight in the overall impression conveyed. Rather, it is the word "FARMACY" which will have by far the highest relative weight in the overall impression conveyed and it is primarily in this component any distinctiveness lies.

44. Many of the same considerations apply to the applicant's trade mark. In its submissions, the applicant provides a number of arguments leading to the conclusion that the word "PLANT" is:

“...when used in conjunction with the goods and services for which protection is sought,...distinctive in its own right.”

45. The word “PLANT” and its meaning will be very well known to the average consumer. Even in relation to goods for which that well-known meaning would not directly apply, I think it most unlikely the average consumer would accord the word any distinctive significance. Even if it is not directly descriptive, it is, in my view, likely to be regarded by the average consumer as non-distinctive. While both the words “THE” and “PLANT” will contribute to the overall impression conveyed, they will have a low relative weight and, like the opponent’s trade mark, it is the word “FARMACY” which will make by far the most significant contribution to the overall impression conveyed and the trade mark’s distinctive character. I will keep those conclusions in mind in the comparison which follows.

### **Visual similarity**

46. The opponent’s trade mark consists of two words and ten letters, whereas the applicant’s trade mark consist of three words and fifteen letters. The first and last words are identical, whereas the word “PLANT” is alien to the opponent’s trade mark. Weighing the similarities and differences and keeping in mind their relative importance, results in what I regard as a fairly high degree of visual similarity.

### **Aural similarity**

47. As the words “THE” and “PLANT” will be very well known to the average consumer, their pronunciation is predictable. As to the word “FARMACY”, given its obvious visual similarity to the well-known English language word “PHARMACY” and the fact that the articulation of the letters “PH” will create the same sound created by the articulation of the letter “F”, I have no doubt this word will be pronounced in exactly the same way as

the word "PHARMACY". Considered overall, the competing trade marks are aurally similar to a fairly high degree.

### **Conceptual similarity**

48. In its submissions, the applicant states:

**"Conceptually**, the term "FARMACY" within both the Applicant's and Opponent's mark will be immediately perceived by the average consumer as a misspelling of the common English language word "PHARMACY". This concept differs within the Applicant's mark with the incorporation of the word "PLANT" in so far as it is a pharmacy for plants. Otherwise the incorporation of the term PLANT within the Applicant's mark delimits any perceived concept. In any case the marks are conceptually highly different."

49. While I agree with the majority of the applicant's submission, I disagree that the addition of the word "PLANT" in its trade mark is sufficient to render the competing trade mark "conceptually highly different." Rather, the concept conveyed by the opponent's trade mark is of a pharmacy, whereas the applicant's trade mark relates to a pharmacy whose business is focussed on the use of plants. Considered overall, the competing trade marks are conceptually similar to a fairly high degree.

### **Distinctive character of the earlier trade mark**

50. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an

overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

51. As the opponent has filed no evidence, I have only the inherent characteristics of its trade mark to consider. In its submissions, the applicant contends:

“...that the Opponent's mark arguably consists exclusively of indications which serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods for which the Opponent's UK trade mark is registered and that there is a sufficiently direct and specific relationship between the meaning of the word "FARMACY" and the goods and services covered therein and relied upon with this opposition...”

52. Despite the above, the applicant has not sought to invalidate the trade marks upon which the opponent relies. Regardless, in support of its conclusion, the applicant has: (i) provided a decision of EUIPO's Board of Appeal in which the Board held that the trade mark “FARMACY” was not acceptable for goods in class 3, and (ii) refers to a number of trade marks in the names of unrelated undertakings in which the word “FARMACY” appears. I am, of course, not bound by the decision of the Board of Appeal and, as the opponent points out in its submissions, state-of-the-register evidence of the type filed by the applicant is rarely persuasive.

53. Even without the applicant's evidence on the point, as I mentioned above, given its obvious visual and aural similarity to the well-known English language word “PHARMACY”, I would have concluded that the word “FARMACY” in the opponent's trade mark would be treated by the average consumer as being equivalent to that word.

As the applicant points out in its evidence, the word “Pharmacy” is defined in collinsdictionary.com as “a shop or department in a shop where medicines are sold or given out.” That accords with my own understanding of the word and, more importantly, will, I am satisfied, accord with that of the average consumer. In reaching a conclusion, I must also keep in mind the applicant’s evidence to the effect that the average consumer is likely to be aware that such undertakings i.e. pharmacies also conduct a trade in goods other than medicines (exhibits BG12 and 13 refer).

54. As the evidence shows, I have no doubt that by the material date in these proceedings the average consumer would have been well aware that large undertakings such as Boots and Superdrug who have an in-store pharmacy also conduct a retail trade in a very wide range of goods. I also note that the pages from those undertakings who utilise the word “PHARMACY” in their trading titles i.e. Lloyds Pharmacy and Cooper’s pharmacy only relate to goods which might be broadly described as personal grooming products. As the word “FARMACY” is visually highly similar and aurally identical to the word “PHARMACY”, it is unsurprising that in October 2016 the Fourth Board of Appeal reached the conclusion it did in relation to a range of goods in class 3. I agree with that conclusion and, in relation to the goods in class 3 for which it is registered, the opponent’s trade mark is possessed of, at best, a very low degree of inherent distinctive character.

55. I further accept that undertakings such as Boots and Superdrug conduct a trade in a range of foodstuffs and drinks. However, when confronted with the words “THE FARMACY” used in relation to goods such as “milk...”, “edible oil and fats”, “tea”, “flour”, “spices” and “syrups and other preparations for making beverages” which are, in my experience, overwhelmingly obtained from other sources such as supermarkets, I think the average consumer is unlikely to assume that they indicate either the type of undertaking conducting a trade in such goods or that the goods concerned have benefitted from pharmaceutical know-how. In my view, it is far more likely that in relation to such goods the words “THE FARMACY” will be regarded by the average consumer

as somewhat unusual and, as a consequence, in relation to such goods, the words “THE FARMACY” are possessed of a below medium (but not low degree) of inherent distinctive character.

### **Likelihood of confusion**

56. In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind.

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

58. Earlier in this decision, I concluded that:

- the applicant’s goods in class 3 are either literally identical to those of the opponent in the same class or are to be regarded as such;

- where not identical (either literally or on the *Merck* principle), the applicant's goods in classes 29, 30 and 32 are similar to the opponent's named goods to at least a medium degree;
- the applicant's remaining services are similar to the opponent's goods to a medium degree;
- the average consumer is a member of the general public who, whilst not ignoring aural considerations, is most likely to select the goods and services at issue by predominantly visual means, whilst paying a low to medium degree of attention during that process;
- as the first trade mark in the opponent's series of two i.e. the words "THE FARMACY" is the most like the applicant's trade mark, it offers it the best prospect of success;
- the word "FARMACY" in the competing trade marks is likely to make by far the most significant contribution to both the overall impressions conveyed and their distinctiveness;
- the competing trade marks are visually, aurally and conceptually similar to a fairly high degree;
- the opponent's "THE FARMACY" trade mark possesses at best, a very low degree of inherent distinctive character in relation to its goods in class 3 and a below medium (but not low degree) of inherent distinctive character in relation to "milk..." and "edible oil and fats" in class 29, "tea", "flour" and "spices" in class 30 and "syrops and other preparations for making beverages" in class 32.

59. In *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU found that:

“41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

60. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark,

one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

### **Class 3 and the applicant’s services in class 35 associated with such goods**

61. I have found the goods to be identical and the services similar to a medium degree, that the average consumer will pay a low to medium degree of attention during the selection process (thus making him or her more prone to the effects of imperfect recollection) and that the competing trade marks are similar to a fairly high degree. Those are all points in the opponent’s favour. I have, however, also found that the opponent’s trade mark possess, at best, a very low degree of inherent distinctive character in relation to such goods, which is a point in the applicant’s favour. In reaching a conclusion, I am, of course, mindful of the findings in *Formula One* and *L’Oréal* and accept that the word “PLANT” in the applicant’s trade mark is likely to be regarded by the average consumer as descriptive/non-distinctive.

62. Despite the points in the opponent’s favour, the, at best, very low degree of inherent distinctive character the words “THE FARMACY” possesses in relation to such goods is decisive. In my view, only a de minimis number of average consumers are likely to either mistake one trade mark for the other or assume that they come from related undertakings merely because they share, alia, the word “FARMACY”. As a consequence, the opposition to the applicant’s goods in class 3 and the associated services in class 35 fails.

### **Classes 29, 30, 32 and the associated services in class 35**

63. I have found the applicant's goods and services in these classes to be either identical or similar to the opponent's named goods in classes 29, 30 and 32 to at least a medium degree. Once again the competing trade marks are similar to a fairly high degree and the average consumer will pay only a low to medium degree of attention during the selection process.

64. Crucially, unlike class 3, I have found that in relation to the goods which I have found to be identical or similar, the average consumer is likely to regard the opponent's "THE FARMACY" trade mark as somewhat unusual and, as a consequence, possessed of a below medium (but not low degree) of inherent distinctive character. Given the descriptive/non-distinctive nature of the word "PLANT" in the applicant's trade mark, such an average consumer is, in my view, far more likely to accord the word "FARMACY" trade mark significance. Having reached that conclusion, although the average consumer is unlikely to mistake one trade mark for the other, there is a likelihood that they will erroneously assume that the applicant's trade mark is a variant trade mark being used by the opponent to indicate, for example, a different line of products and associated services. As that is likely to result in indirect confusion, the opposition to the goods in the classes mentioned and the associated services in class 35 succeeds.

### **Overall conclusion**

65. As the goods in classes 1, 5 and 34 of the application are not subject to opposition they may, in due course, proceed to registration regardless. Insofar as the opposed goods and services are concerned, the opposition has failed in relation to the following goods and services:

**Class 3** - Cosmetics; toiletries; essential oils; soaps; perfumery; non-medicated cosmetics and toiletry preparations; non-medicated preparations for the care of

the skin, eyes, nails and hair; body cleaning and beauty care preparations; skin, eye and nail care preparations; preparations and substances for use in the care and appearance of the skin, hair, nails, eyes and teeth; non-medicated skin serums and skin salves; body cream; hand cream; body creams [cosmetics]; facial creams [cosmetic]; cosmetic creams and lotions; body and facial creams [cosmetics]; massage oils and lotions; aromatic essential oils; aromatherapy oils; cleansing oil; bath oils; face oils; non-medicated oils; facial creams; body creams; face creams; cosmetics containing cannabinoids; creams and lotions containing cannabinoids; toiletries containing cannabinoids; anti-ageing serums; serums for cosmetic purposes; facial serums for cosmetic use; beauty serums; bath herbs.

**Class 35** - Retail services connected with the sale of protein and hemp oil extracted from hemp for manufacturing various goods; online retail services connected with the sale of protein and hemp oil extracted from hemp for manufacturing various goods; subscription-based order fulfilment services connected with the sale of protein and hemp oil extracted from hemp for manufacturing various goods.

**Class 35** - Retail services connected with the sale of cosmetics, toiletries, essential oils, soaps, perfumery, non-medicated preparations for the care of the skin, non-medicated preparations for the care of the eyes, non-medicated preparations for the care of nails, non-medicated preparations for the care of hair, body cleaning and beauty care preparations, non-medicated skin serums and skin salves, cosmetic creams and lotions, non-medicated oils, bath herbs; online retail services connected with the sale of cosmetics, toiletries, essential oils, soaps, perfumery, non-medicated preparations for the care of the skin, non-medicated preparations for the care of the eyes, non-medicated preparations for the care of nails, non-medicated preparations for the care of hair, body cleaning and beauty care preparations, non-medicated skin serums and skin salves, cosmetic creams and lotions, non-medicated oils, bath herbs; subscription-based

order fulfilment services connected with the sale of cosmetics, toiletries, essential oils, soaps, perfumery, non-medicated preparations for the care of the skin, non-medicated preparations for the care of the eyes, non-medicated preparations for the care of nails, non-medicated preparations for the care of hair, body cleaning and beauty care preparations, non-medicated skin serums and skin salves, cosmetic creams and lotions, non-medicated oils, bath herbs.

**Class 35** - Retail services connected with the sale of pharmaceuticals, medical marijuana and cannabis and derivatives thereof, cannabis oils, dietary supplements, herbal supplements, medicinal herbs, extracts of medicinal herbs and plants, herbal preparations for medical use, medicated topical creams and salves and lotions and balms for use on skin, suppositories, herbal sprays for medical purposes, analgesic preparations, antibiotic preparations, products for administering medical marijuana or cannabis or cannabis oils or cannabis derivatives; online retail services connected with the sale of pharmaceuticals, medical marijuana and cannabis and derivatives thereof, cannabis oils, dietary supplements, herbal supplements, medicinal herbs, extracts of medicinal herbs and plants, herbal preparations for medical use, medicated topical creams and salves and lotions and balms for use on skin, suppositories, herbal sprays for medical purposes, analgesic preparations, antibiotic preparations, products for administering medical marijuana or cannabis or cannabis oils or cannabis derivatives; subscription-based order fulfilment services connected with the sale of pharmaceuticals, medical marijuana and cannabis and derivatives thereof, cannabis oils, dietary supplements, herbal supplements, medicinal herbs, extracts of medicinal herbs and plants, herbal preparations for medical use, medicated topical creams and salves and lotions and balms for use on skin, suppositories, herbal sprays for medical purposes, analgesic preparations, antibiotic preparations, products for administering medical marijuana or cannabis or cannabis oils or cannabis derivatives.

**Class 35** - Retail services connected with the sale of smokers' articles, electronic cigarettes, electronic cigarette cases and cleaners, electronic cigarette atomizers and cartomizers and clearomizers, cartridges for electronic cigarettes, liquid solutions and tobacco tar flavourings other than essential oils for use in electronic cigarettes, smoking sets for electronic cigarettes, lanyards specially adapted for holding electronic cigarettes, batteries for electronic cigarettes, herbs for smoking; online retail services connected with the sale of smokers' articles, electronic cigarettes, electronic cigarette cases and cleaners, electronic cigarette atomizers and cartomizers and clearomizers, cartridges for electronic cigarettes, liquid solutions and tobacco tar flavourings other than essential oils for use in electronic cigarettes, smoking sets for electronic cigarettes, lanyards specially adapted for holding electronic cigarettes, batteries for electronic cigarettes, herbs for smoking; subscription-based order fulfilment services connected with the sale of smokers' articles, electronic cigarettes, electronic cigarette cases and cleaners, electronic cigarette atomizers and cartomizers and clearomizers, cartridges for electronic cigarettes, liquid solutions and tobacco tar flavourings other than essential oils for use in electronic cigarettes, smoking sets for electronic cigarettes, lanyards adapted for holding electronic cigarettes, batteries for electronic cigarettes, herbs for smoking.

advertising; promotional advertising services; direct market advertising; advertising services provided via the internet; radio and television advertising; business management; business administration; office functions.

66. The opposition has, however, succeeded in relation to the following goods and services:

**Class 29** - Edible oils and fats; hemp oil; processed edible hemp seeds; hemp protein powder for use as a nutritional food additive for culinary purposes; hemp milk used as a milk substitute.

**Class 30** - Herbal infusions; herbal tea; non-medicated herbal infusions; herbal preparations for making beverages; culinary herbs; processed herbs; preserved herbs; dried herbs.

**Class 32** - Essences for making beverages; essences for making non-alcoholic beverages, not in the nature of essential oils; cannabidiol essences for use in drinks.

**Class 35** - Retail services connected with the sale of edible oils and fats, processed edible hemp seeds, hemp protein powder for use as a nutritional food additive for culinary purposes, hemp milk used as a milk substitute, herbal tea, non-medicated herbal infusions, culinary herbs, processed herbs, preserved herbs, dried herbs, essences for making beverages; online retail services connected with the sale of edible oils and fats, processed edible hemp seeds, hemp protein powder for use as a nutritional food additive for culinary purposes, hemp milk used as a milk substitute, herbal tea, non-medicated herbal infusions, culinary herbs, processed herbs, preserved herbs, dried herbs, essences for making beverages; subscription-based order fulfilment services connected with the sale of edible oils and fats, processed edible hemp seeds, hemp protein powder for use as a nutritional food additive for culinary purposes, hemp milk used as a milk substitute, herbal tea, non-medicated herbal infusions, culinary herbs, processed herbs, preserved herbs, dried herbs, essences for making beverages.

**67. Subject to any successful appeal, the application will be allowed to proceed to registration in respect of the goods and services shown in paragraph 65 and will be refused in respect of the goods and services shown in paragraph 66.**

## **Costs**

68. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. The opponent opposed five of the eight classes for which registration was sought. The applicant has retained class 3 and five of the six categories of services in class 35, whereas the opponent has succeeded in its opposition to classes 29, 30 and 32 and one category of services in class 35. Adopting a “rough and ready” approach to the matter, I have concluded that both parties should bear their own costs.

**Dated this 5<sup>th</sup> day of June 2020**

**C J BOWEN**

**For the Registrar**

## Annex

**Class 1** - Protein and hemp oil extracted from hemp for manufacturing various goods, including but not limited to body care products and toiletry articles, dietary and nutritional supplements, nutritional food additive for culinary purposes, beverages and food, fabrics and clothing.

**Class 3** - Cosmetics; toiletries; essential oils; soaps; perfumery; non-medicated cosmetics and toiletry preparations; non-medicated preparations for the care of the skin, eyes, nails and hair; body cleaning and beauty care preparations; skin, eye and nail care preparations; preparations and substances for use in the care and appearance of the skin, hair, nails, eyes and teeth; non-medicated skin serums and skin salves; body cream; hand cream; body creams [cosmetics]; facial creams [cosmetic]; cosmetic creams and lotions; body and facial creams [cosmetics]; massage oils and lotions; aromatic essential oils; aromatherapy oils; cleansing oil; bath oils; face oils; non-medicated oils; facial creams; body creams; face creams; cosmetics containing cannabinoids; creams and lotions containing cannabinoids; toiletries containing cannabinoids; anti-ageing serums; serums for cosmetic purposes; facial serums for cosmetic use; beauty serums; bath herbs.

**Class 5** - Pharmaceuticals; medical marijuana and cannabis and derivatives thereof; medical marijuana, cannabis, cannabis oils, and cannabis derivatives; dietary supplements; nutritional supplements; herbal supplements; medicinal herbs; medicinal herbs in dried or preserved form; extracts of medicinal herbs; medicinal herb infusions; herbs (smoking-) for medical purposes; liquid herbal supplements; herbal preparations for medical use; anti-inflammatory gels; gels for dermatological use; gelatine capsules for pharmaceuticals; topical analgesic creams; tinctures for medical purposes; medicated topical creams, salves, lotions, and balms for use on skin to relieve aches or pains; medicated topical creams, salves, lotions, and balms for use on skin; suppositories; herbal infusions [medicinal drinks]; hemp based beverages for medicinal and health purposes; herbal sprays for medical purposes; herbal creams for medical purposes; herbal beverages for medical purposes; plant and herbal extracts for medicinal purposes; nutraceuticals for use as a dietary supplement; delivery systems in the nature of topical applications, namely, foams, gels, creams, sprays, lotions and ointments which act as a base and prepare the skin to receive therapeutic preparations that are absorbed into the blood stream through the skin; topical anaesthetics; analgesic preparations; antibiotic preparations; nutraceuticals for use as a dietary supplement for pain relief; products for administering medical marijuana, cannabis, cannabis oils, and cannabis derivatives namely, buccal sprays, gel caps, and transdermal patches; homeopathic remedies and preparations; vitamin preparations; mineral and vitaminized food preparations, supplements and concentrates for medical purposes; dietary

supplements and dietetic preparations containing CBD oil; cannabidiol capsules; cannabidiol medicinal spray. .

**Class 29** - Edible oils and fats; hemp oil; processed edible hemp seeds; hemp protein powder for use as a nutritional food additive for culinary purposes; hemp milk used as a milk substitute.

**Class 30** - Herbal infusions; herbal tea; non-medicated herbal infusions; herbal preparations for making beverages; culinary herbs; processed herbs; preserved herbs; dried herbs.

**Class 32** - Essences for making beverages; essences for making non-alcoholic beverages, not in the nature of essential oils; cannabidiol essences for use in drinks.

**Class 34** - Smokers' articles; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; electronic cigarettes; vaporisers for the inhalation of herbs and smoking mixtures; electronic cigarette cases; lanyards specially adapted for holding electronic cigarettes; electronic cigarette cleaners; electronic cigarette atomizers; electronic cigarette cartomizers; electronic cigarette clearomizers; cartridges for electronic cigarettes; refill cartridges for electronic cigarettes; cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; liquid solutions for use in electronic cigarettes; electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; electronic cigarette liquid [e-liquid] comprised of propylene glycol; electronic cigarette liquid [e-liquid] comprised of vegetable glycerine; tobacco tar for use in electronic cigarettes; flavourings, other than essential oils, for use in electronic cigarettes; chemical flavourings in liquid form used to refill electronic cigarette cartridges; herbs for smoking; smoking sets for electronic cigarettes.

**Class 35** - Retail services connected with the sale of protein and hemp oil extracted from hemp for manufacturing various goods; Retail services connected with the sale of cosmetics, toiletries, essential oils, soaps, perfumery, non-medicated preparations for the care of the skin, non-medicated preparations for the care of the eyes, non-medicated preparations for the care of nails, non-medicated preparations for the care of hair, body cleaning and beauty care preparations, non-medicated skin serums and skin salves, cosmetic creams and lotions, non-medicated oils, bath herbs; Retail services connected with the sale of pharmaceuticals, medical marijuana and cannabis and derivatives thereof, cannabis oils, dietary supplements, herbal supplements, medicinal herbs, extracts of medicinal herbs and plants, herbal preparations for medical use, medicated topical creams and salves and lotions and balms for use on skin, suppositories, herbal sprays for medical purposes, analgesic preparations, antibiotic preparations, products for administering medical marijuana or cannabis or cannabis oils or cannabis derivatives; Retail services connected with the sale of edible oils and fats, processed edible hemp seeds, hemp protein powder for use as a nutritional food additive for culinary purposes, hemp milk used as a milk substitute, herbal tea, non-

medicated herbal infusions, culinary herbs, processed herbs, preserved herbs, dried herbs, essences for making beverages; Retail services connected with the sale of smokers' articles, electronic cigarettes, electronic cigarette cases and cleaners, electronic cigarette atomizers and cartomizers and clearomizers, cartridges for electronic cigarettes, liquid solutions and tobacco tar flavourings other than essential oils for use in electronic cigarettes, smoking sets for electronic cigarettes, lanyards specially adapted for holding electronic cigarettes, batteries for electronic cigarettes, herbs for smoking; online retail services connected with the sale of protein and hemp oil extracted from hemp for manufacturing various goods; online retail services connected with the sale of cosmetics, toiletries, essential oils, soaps, perfumery, non-medicated preparations for the care of the skin, non-medicated preparations for the care of the eyes, non-medicated preparations for the care of nails, non-medicated preparations for the care of hair, body cleaning and beauty care preparations, non-medicated skin serums and skin salves, cosmetic creams and lotions, non-medicated oils, bath herbs; online retail services connected with the sale of pharmaceuticals, medical marijuana and cannabis and derivatives thereof, cannabis oils, dietary supplements, herbal supplements, medicinal herbs, extracts of medicinal herbs and plants, herbal preparations for medical use, medicated topical creams and salves and lotions and balms for use on skin, suppositories, herbal sprays for medical purposes, analgesic preparations, antibiotic preparations, products for administering medical marijuana or cannabis or cannabis oils or cannabis derivatives; online retail services connected with the sale of edible oils and fats, processed edible hemp seeds, hemp protein powder for use as a nutritional food additive for culinary purposes, hemp milk used as a milk substitute, herbal tea, non-medicated herbal infusions, culinary herbs, processed herbs, preserved herbs, dried herbs, essences for making beverages; online retail services connected with the sale of smokers' articles, electronic cigarettes, electronic cigarette cases and cleaners, electronic cigarette atomizers and cartomizers and clearomizers, cartridges for electronic cigarettes, liquid solutions and tobacco tar flavourings other than essential oils for use in electronic cigarettes, smoking sets for electronic cigarettes, lanyards specially adapted for holding electronic cigarettes, batteries for electronic cigarettes, herbs for smoking; subscription-based order fulfilment services connected with the sale of protein and hemp oil extracted from hemp for manufacturing various goods; subscription-based order fulfilment services connected with the sale of cosmetics, toiletries, essential oils, soaps, perfumery, non-medicated preparations for the care of the skin, non-medicated preparations for the care of the eyes, non-medicated preparations for the care of nails, non-medicated preparations for the care of hair, body cleaning and beauty care preparations, non-medicated skin serums and skin salves, cosmetic creams and lotions, non-medicated oils, bath herbs; subscription-based order fulfilment services connected with the sale of pharmaceuticals, medical marijuana and cannabis and derivatives thereof, cannabis oils, dietary supplements, herbal supplements, medicinal herbs, extracts of medicinal herbs and plants, herbal preparations for medical use, medicated topical creams and salves and lotions and balms for use on skin, suppositories, herbal sprays for medical purposes, analgesic preparations, antibiotic preparations, products for administering medical marijuana or

cannabis or cannabis oils or cannabis derivatives; subscription-based order fulfilment services connected with the sale of edible oils and fats, processed edible hemp seeds, hemp protein powder for use as a nutritional food additive for culinary purposes, hemp milk used as a milk substitute, herbal tea, non-medicated herbal infusions, culinary herbs, processed herbs, preserved herbs, dried herbs, essences for making beverages; subscription-based order fulfilment services connected with the sale of smokers' articles, electronic cigarettes, electronic cigarette cases and cleaners, electronic cigarette atomizers and cartomizers and clearomizers, cartridges for electronic cigarettes, liquid solutions and tobacco tar flavourings other than essential oils for use in electronic cigarettes, smoking sets for electronic cigarettes, lanyards adapted for holding electronic cigarettes, batteries for electronic cigarettes, herbs for smoking; advertising; promotional advertising services; direct market advertising; advertising services provided via the internet; radio and television advertising; business management; business administration; office functions.