

**BLO/361/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. UK0000332778  
OASIS**

**IN THE NAME OF OASIS FASHIONS ONLINE LIMITED**

**AND IN THE MATTER OF OPPOSITION NO. OP000414539  
BY SMITHERS-OASIS COMPANY**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
FROM THE DECISION OF MR ANDREW FELDON  
DATED 1 OCTOBER 2021**

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**DECISION**

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1. This is an appeal from a decision of Mr Andrew Feldon, on behalf of the Registrar, BL O/725/21, by which he upheld in part the opposition of Smithers-Oasis Company (“the Opponent”) to a trade mark application filed by Oasis Fashions Online Ltd (“the Applicant”). The Applicant appeals.

**Background**

2. On 27 July 2018, the Applicant applied to register the Mark OASIS for a range of goods in Classes 2, 8 and 21. The goods in Class 2 and some of the goods in Class 21 were qualified to exclude broadly (and I summarise, as the qualifications differ between the two Classes) goods for use in the floral industry or directed towards the floral trade.
3. An opposition was lodged on 30 November 2018 by the Opponent against all of the goods in the specification on the basis of sections 5(1), 5(2)(a) and 5 (4)(a) of the Trade Marks Act 1994 (“the Act”). The Opponent relied upon two earlier EUTMs, both for the word OASIS:

- a. EUTM 6565444 was relied upon to oppose the Class 2 goods of the contested application, that earlier Mark being registered for goods in Class 2.
- b. EUTM 5867965 was relied upon in relation to oppose the Applicant's Class 8 goods, as that earlier Mark is registered for goods in Class 8.

In each case certain of the goods in the Applicant's specification were said to be identical and others were said to be similar to the goods in the specifications of the earlier Marks. Both of the earlier Marks had been registered for more than 5 years and the Opponent was put to proof of use.

4. In addition, the Opponent relied upon its goodwill in the name OASIS, which it claimed arose from use of that mark since 1992 in relation to a variety of household goods, tableware, glassware, etc. This was relied upon to oppose the goods in Class 21 of the Applicant's specification.
5. Evidence was filed by the Opponent, and both sides were represented at a video hearing before Mr Feldon by the same representatives as appeared before me on the appeal.

#### **The decision below**

6. The Hearing Officer decided, in summary, that:
  - a. The Opponent had proved use of the earlier EUTMs for some but not all of its goods in Class 2 and 8.
  - b. A fair specification for the Opponent's goods in Class 2 was "Spray paints" and for those in Class 8 "Hand tools for the care, preparation and/or arrangement of plants, flowers and floral displays; cutting tools for use by florists and crafters; floral scissors, floral pruners, floral foam knives, foam knives, retractable cutters, florals snips, flower thorn strippers, floral pruning shears, wire cutters, and wire pliers."
  - c. Some of the Applicant's Class 2 goods, such as paints and acrylic paints, were identical to the Opponent's spray paints. Other Class 2 goods such as varnishes, dyes, and inks were similar to a high degree to spray paints. The Applicant's proposed limitation to its specification in Class 2 ("all specifically for painting home interiors or exteriors and none of the aforementioned goods being for use in the floral industry or in relation to flower arranging") did nothing to distance its goods from the Opponent's spray paints.

- d. The Applicant's Class 8 goods were dissimilar to the Opponent's Class 8 goods.
- e. The average consumer for both parties' goods was the general public.
- f. The earlier marks were inherently distinctive to a medium degree. No enhanced distinctiveness had been proved.
- g. There was a likelihood of confusion for the identical and similar goods in Class 2, so that registration should be refused for those goods.
- h. The Opponent had proved goodwill by the relevant date for “Household containers; tableware; earthenware; glassware, jars; candle holders and candle sticks; bottles; vases; plant pots; plates; plant holders; jugs; plant baskets; urns; dishes; crates.”
- i. Use of the identical mark for the following goods in the Applicant’s Class 21 specification would lead to a misrepresentation: “Household or kitchen utensils and containers; glassware, porcelain and earthenware; chinaware; crockery; cups and mugs; dishware; glasses; hollowware; porcelain ware; metal pans; glass pans; pots; none of the aforesaid goods for use in or directed towards the floral trade or specifically designed to receive flower arrangements in floral foam; kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; bakeware; dinnerware; drinking vessels and barware; oven ware; cooking pans; cooking pots; parts and fittings for all the aforesaid goods.” Registration of the mark would therefore be refused for those goods pursuant to s 5(4)(a).

### **The scope of the appeal**

- 7. The Applicant appealed. The main grounds of appeal were, essentially, that:
  - a. The Hearing Officer should not have held that the fair specification for the Opponent’s Class 2 goods was “spray paints.” This was too wide, as the only sales shown were for paints to be used on plants, flowers or floral displays by professional florists. That led the Hearing Officer to err in finding a likelihood of confusion for the Class 2 goods.
  - b. The Hearing Officer erred in his assessment of the evidence of the Opponent’s goodwill, as any goodwill outside the floral trade and ‘impermanent plastic containers adapted to receive floral foam’ was trivial. That led to an error in the application of s 5(4)(a) to the goods in Class 21.

8. The Opponent lodged a Respondent's Notice, which identified various reasons why the decision was correct, rather than adding additional reasons why the decision should have gone in its favour, as required by Rule 71(5). Hence, the opposition to the Class 8 goods plays no part in the appeal.

### **Standard of appeal**

9. There was no dispute between the parties as to the appropriate standard of appeal. Both sides referred me to the usual passage in *Talk for Learning* [2017] RPC 17, and the Applicant referred to my own decision in O/654/21 *EZDRM*. I do not think it necessary to repeat here my comments at paragraphs 9-11 of that decision.

### **Merits of the appeal**

10. The Applicant's complaints related to the Hearing Officer's analysis of the evidence, rather than his analysis of the law.

#### *Class 2*

11. The Applicant's submission in relation to the Class 2 goods was that the Hearing Officer had not taken properly into account the limitations of the evidence produced by the Opponent to show its use of its mark on paints. It said that had he done so he would have realised that the only paint products shown were spray paints specifically intended for use in creating floral arrangements.
12. The Applicant first contended that the documents exhibited in the Opponent's evidence did not clearly show the use of OASIS in relation to paints. I accept that some of the paints and other goods shown were marked with or sold by reference to the mark "Floralife," but I am satisfied (as was the Hearing Officer) that others do show use of OASIS. It seems to me that there was sufficient evidence to show that the Opponent had sold and advertised for sale a range of spray paints over a substantial period of time. The scale of such sales may not have been especially high, nor was a turnover figure given for paints alone, but the Applicant accepted that the evidence showed that "a few thousand cans" had been sold. In my judgment it was open to the Hearing Officer to

decide, as he did at paragraph 47, that the Opponent had shown genuine use of the OASIS Mark in relation to some Class 2 goods, and to find at paragraph 49 that there was reasonable evidence of use of the Mark on a range of spray paint products.

13. That leads on to the Applicant's submission that the Hearing Officer erred in concluding that a fair specification for the paints shown to have been sold was "spray paints."
14. There was no dispute between the parties as to the correct approach to take to the assessment of a fair specification, and they referred me to the authorities cited by the Hearing Officer, *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10 and *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). In broad terms, the test is to identify the goods or category of goods for which use has been shown, and to decide how the average consumer would fairly describe them.
15. The Applicant submitted that an appropriate specification would be "Spray paints for use in the floral trade for decorating flowers and flower arrangements." It said that this was what the evidence showed, and the Hearing Officer went wrong in giving weight to the possibility that the Opponent's paints would not only have been sold by specialist floristry outlets, but also by more generalist third parties such as Hobbycraft. The Applicant pointed out that the pages in evidence from the Hobbycraft site did not offer paints for sale, but showed a variety of other goods, such as floristry foam, wire, bowls, scissors, and secateurs, all in the flower arranging supplies part of the website. Whilst those pages did not directly support the Opponent's case about sales of paint, it does not seem to me that the Hearing Officer should have inferred (as the Applicant suggests) that it proved that the Opponent's spray paints were never sold to such retailers. Some of the (redacted) invoices in evidence appeared to me to show sales, including sales of paint, at volumes likely to have been supplies to retailers rather than florists, supporting to that extent the narrative in Mr Short's witness statement. Other invoices are marked "wedding" which would not necessarily show that the customer was a florist. It seems to me that the Hearing Officer was entitled to summarise the evidence as showing that *some* of the Opponent's goods were sold by retail and so were available to the general public.

16. At paragraph 61 of the Decision, the Hearing Officer set out his reasons for rejecting both the Opponent's claim that a fair specification would have been "paint" and the Applicant's claim that it should be "Spray paints for use in the floral trade for decorating flowers and flower arrangements." The Applicant pointed out that there was a mistake in the Hearing Officer's analysis of a relevant part of the evidence: he pointed to the inclusion of spray paints in webpages, but mistakenly said that these were from the Opponent's Home and Hobby website which is aimed at the general public. In fact, they were from its "oasisfloral" trade website. I agree that the Hearing Officer got that point wrong, but I do not consider that the error vitiates the logic of his analysis, or the conclusion he reached, especially when one takes into account his full reasoning at paragraphs 73-74. First, that was not the only evidence he relied upon, as he explained, and he concluded that the consumers of the spray paints might not use them solely for floristry/floral displays, but might use them for wider craft projects. That point would apply regardless of where the consumer might have bought the paint. In addition, the narrower specification contended for by the Applicant does not seem to me to be a realistic description which would be used by the average consumer. Spray paint bought for floristry might not be expected to be used interchangeably with all paints, but the average consumer might very well think that such paint could be used for other hobbies, crafts or art projects for which use of the small amount of paint in a spray can would be realistic. I think that would be the case even if the label on the can has the words "florist products" under the OASIS name, as the Opponent's paint labels do. That perception should be reflected in the wording of the specification. In my judgment, the specification adopted by the Hearing Officer was compatible with the evidence and within the range of findings which it was open to him to make.
17. The Applicant's criticism of the Hearing Officer's conclusions on the s 5(2)(b) objection to the Class 2 goods depended upon its success in narrowing the specification. As that argument has failed, in the circumstances I reject the Grounds of Appeal relating to the Class 2 goods.

#### *Class 21*

18. The Grounds of Appeal relating to the goods in Class 21 again turn upon criticisms of the Hearing Officer's assessment of the evidence. The Applicant suggested that if there

was any goodwill at all in relation to the Class 21 goods it was trivial, and not capable of protection by a passing off action.

19. The Applicant pointed to the lack of specificity in the Opponent's evidence as to the scale and nature of sales of the Class 21 goods. First, Ms Ayres said that whilst very significant turnover figures were provided, they were not broken down by category, for it to be possible to see what part of it related to these goods, and she argued that the sample invoices provided did not resolve that inadequacy. Whilst the Applicant was right to say that the Opponent had failed to divulge the scale of its sales of the Class 21 goods, it seems to me that the Hearing Officer had taken into account the turnover figures as a whole, the invoices in evidence (many of which did relate to the Class 21 goods) and a helpful schedule produced by Ms Ayres, which analysed the invoices to show the numbers of various Class 21 goods sold. This showed sales of many thousands of candlesticks, and thousands of household containers of various kinds, such as vases and bowls. That reflected the catalogues and webpages exhibited by the Opponent, which also showed that it offered a wide range of Class 21 goods. It does not seem to me in the circumstances that I may say that the Hearing Officer erred in finding at paragraph 50 that there was evidence of sales of such goods, or erred at paragraph 100 in finding that such sales, made over a lengthy period, had generated goodwill in relation to those goods. I do not accept the submission that the Hearing Officer should have found the goodwill in those goods to be so trivial as not to qualify for protection under the law of passing off. That finding was open to him.
20. The Applicant again stressed that the invoices in evidence appeared to relate to sales to the trade, that is, it surmised, the floristry trade. I am not sure that one can draw that inference, still less that the Hearing Officer should have done so, or found that it in some way limited the Opponent's goodwill.
21. The Applicant also submitted, however, that the evidence of sales did not support the claim that such sales were made under the OASIS mark so as to build up goodwill in that mark for the Class 21 goods. It submitted that the use shown was for retail services provided by the Opponent, rather than in relation to the goods sold. Ms Ayres pointed to paragraph 49 of the decision, where the Hearing Officer said: "I note [Ms Ayre's] argument that on many of the goods for which the evidence shows sales, the OASIS mark does not appear to be placed or branded. Whilst this may be the case to some

extent, I find that there are reasonable examples of the mark at issue on the goods under consideration.” The rest of paragraph 49 relates only to the paints in issue, and the point about whether OASIS was used on the goods, as opposed to in relation to retail sales, does not re-appear in paragraphs 98-99 where the Hearing Officer dealt with the extent of the Opponent’s goodwill in the household goods in Class 21. Ms Ayres submitted that there was no evidence of use of the OASIS mark on any such goods (as opposed to the spray paint cans). Mr Wylie however pointed to the use of the name OASIS on the catalogues, webpages, and invoices.

22. There is some force in the Applicant’s argument that it is possible that the goods bore a third party’s mark and it is correct to say that the invoices did not bear the mark as such, but used the name “Smithers-Oasis UK Ltd.” However, the catalogues and webpages offering the Class 21 goods for sale did use the OASIS mark, often in the form “OASIS ® floral products.” The name OASIS was generally used in a slightly stylised font, distinguishing it from “floral products,” as did the ® sign. Mr Short described these as “OASIS branded products” though he did not expressly say that the Class 21 goods bore the mark. As far as I can see, there was little evidence equivalent to that for the spray paints, to show that the OASIS mark had been used on any of the Class 21 goods, although I identified one example of a glass bowl with an oval green OASIS sticker on it. It seems unlikely that this was a one-off, and I would infer that more of the goods were similarly marked OASIS, though the exhibits did not show this.
23. Taking all of these factors into consideration, it seems to me that it was open to the Hearing Officer to conclude that the Opponent had shown use of the mark in relation to the Class 21 goods in ways which would have led to it acquiring goodwill in such goods, as opposed to goodwill for retail services. In the circumstances, I do not consider that I should set aside that part of the decision below.
24. I was invited to find that even on the basis of the Hearing Officer’s findings as to goodwill, his conclusions as to misrepresentation were wrong because he did not take into account the exclusion in the Applicant’s specification: “Household or kitchen utensils and containers; ...[etc, etc]; none of the aforesaid goods for use in or directed towards the floral trade or specifically designed to receive flower arrangements in floral foam.” I am concerned that this point was not included in the Grounds of Appeal;

paragraph 10 referred to the Opponent's sales into the professional floral trade, but this did not seem to relate to the impact that might have on misrepresentation. It would not be open to the Applicant to take the point now. In any event, I do not consider that the limitation would avoid any likelihood of misrepresentation – it is much too narrow and would for instance permit the use of the Applicant's mark for glassware suitable for flower arrangements, if not designed to hold an arrangement in floral foam. That being so, it could certainly include goods identical to those sold by the Opponent. In the circumstances, I am satisfied that the Hearing Officer's conclusions cannot be said to be in error.

25. For all these reasons, the appeal is dismissed.
26. The Applicant must make a contribution to the Opponent's costs of the appeal, in the sum of £750, to be paid by 5 pm on Wednesday 18<sup>th</sup> May 2022.

Amanda Michaels  
The Appointed Person

Dated: 3<sup>rd</sup> day of May 2022

**Ms Cathy Ayres** (of Wilson Gunn) appeared for the Appellant/Applicant

**Mr Richard Wylie** (of HGF Ltd) appeared for the Respondent/ Opponent