

# O-468-16

## TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 3037243  
IN THE NAME OF TIANA FAIR TRADE ORGANICS LIMITED**

**AND IN THE MATTER OF OPPOSITION No. 402620 THERETO  
BY BARONY UNIVERSAL PRODUCTS PLC**

**AND IN THE MATTER OF TRADE MARK REGISTRATION No. 2388167  
IN THE NAME OF BARONY UNIVERSAL PRODUCTS PLC**

**AND IN THE MATTER OF REVOCATION No. 500489 THEREOF  
BY TIANA FAIR TRADE ORGANICS LIMITED**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY TIANA FAIR TRADE ORGANICS LIMITED  
AGAINST DECISIONS OF MR MARK KING DATED 30 DECEMBER 2015**

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## DECISION

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### Introduction

1. On 9 January 2014, Tiana Fair Trade Organics Limited applied under number 3037243 to register the designation TIANA for use as a trade mark in the UK including in relation to:  
  
Class 3  
Skin and Hair products
2. The application was published in the Trade Marks Journal on 2 May 2014. On 4 August 2014, the application was opposed in Class 3 by Barony Universal Products Plc. The grounds of opposition were under Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994. The objections under Section 5(2)(b) and Section 5(3) were based on the earlier trade mark TIAMA belonging to Barony Universal Products Plc registered in the UK under number 2388167 on 4 November 2005 for goods in Class 3 including as relied on: Perfumery; cosmetics; deodorants for personal use.
3. On 15 July 2014, Tiana Fair Trade Organics Limited applied under number 500489 partially to revoke the earlier trade mark number 2388167 for non-use under Section 46(1)(a) of the Act relevantly in respect of perfumery and cosmetics. There was no challenge in the non-use revocation action to “deodorants for personal use”.
4. Both actions were defended with evidence being filed on both sides. The 2 x sets of proceedings were consolidated by the UK IPO and came to be heard before Mr. King, the Hearing Officer acting for the Registrar, on 13 October 2015.

5. Mr. King issued his decision in writing under reference number BL O/602/15 on 30 December 2015.

6. That decision was, in brief:

A. In Revocation 500489

- (1) Barony Universal Products Plc had succeeded in proving genuine use of its TIAMA trade mark in the UK in relation to perfumery in the form of body sprays.
- (2) Since the registration had not been challenged for deodorants for personal use, Registration number 2388167 would remain on the Register for: Perfumery in the form of body sprays; Deodorants for personal use.
- (3) Registration number 2388167 would be revoked with effect from 5 November 2010 for the other registered goods namely: Bleaching preparations and other substances for laundry use; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

B. In Opposition 402620

- (a) The average consumer was the general public who would be reasonably well informed and reasonably observant and circumspect. The level of attention paid to the purchase act, likely visual although there may be aural recommendations, was in between low and medium.
- (b) The goods – skin and hair products/perfumery in the form of body sprays (for which proof of use was established) – were similar to a low degree.
- (c) The marks – TIANA/TIAMA – were visually and aurally similar to a high degree. Since neither mark had a meaning the conceptual aspect was neutral.
- (d) The earlier trade mark was inherently highly distinctive (no enhanced distinctiveness through use was claimed).
- (e) Globally assessed, there was a likelihood of direct confusion between the marks.
- (f) Any defence of honest concurrent use/coexistence on the market was not made out.
- (g) The opposition under Section 5(2)(b) succeeded in its entirety. Application number 3037243 would be refused registration in Class 3 for: Skin and Hair products. It was unnecessary to consider the grounds under Section 5(3) and Section 5(4)(a).

C. Costs

Each party should bear its own costs.

7. On 27 January 2016, Tiana Fair Trade Organics Limited filed Notice of appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer's decisions both in the revocation action and in the opposition. A Respondent's notice was filed on 15 March 2016.
8. At the appeal hearing before me, Tiana Fair Trade Organics Limited was represented by Mr. Max Stacey of Baron Warren Redfern (who appeared also for his client below). Barony Universal Products Plc did not attend, was not represented and made no further written representations.
9. The Hearing Officer referred to Tiana Fair Trade Organics Limited as "TFTOL" and Barony Universal Products Plc as "Barony". I shall do the same.

### **Standard of appeal**

10. Mr. Stacey accepted that the appeal was by way of review and not re-hearing, and that I should be reluctant to interfere with the Hearing Officer's decisions in the absence of material error on his part (*REEF Trade Mark* [2003] RPC 101, Robert Walker LJ at 109 – 110).

### **Revocation/proof of use appeal**

11. The Hearing Officer was concerned with 2 x periods of relevant use of Barony's earlier trade mark TIAMA (UK Registration number 2388167):
  - (1) Under Section 46(1)(a) in the revocation action, from 5 November 2005 – 4 November 2010.
  - (2) Under Section 6A for proof of use in the opposition proceedings, from 3 May 2009 – 2 May 2014.
12. The Hearing Officer noted the provisions of Section 46(3), which states that:

“(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”
13. He therefore concentrated on the later proof of use period in Section 6A, since (subject to revocation not being claimed in respect of deodorants for personal use) any genuine use established for that period would to that extent serve also to fend off the attack under Section 46(1)(a).

### **Meaning of genuine use**

14. On the question of what constituted genuine use, the Hearing Officer instructed himself by reference to: (a) the summary of established case law of the Court of Justice of the European Union (“CJEU”) in *Stichting BDO v. BDO Unibank Inc.* [2013] EWHC 418 Ch, paragraph 51; and (b) the subsequent Order of the CJEU in Case C-141/13 P, *Reber Holding GmbH & Co. KG v. OHIM* [EU:C:2014: 2089] at paragraph 32.
15. In *Reber*, referring to its previous case law, the CJEU made clear that genuine use must globally be assessed. The question for the tribunal is whether the use shown is warranted in the economic sector concerned to maintain or create a share in the market for the registered goods or services. That involves the tribunal making a consideration of all the relevant facts and circumstances of the particular case including the nature of the goods or services in question, the characteristics of the market concerned and the scale, geographical scope and frequency of the proprietor’s use for those goods or services.
16. Moreover, the proprietor’s evidence of genuine use must be looked at as a whole (see, e.g., Case T-40/09, *Advance Magazine Publishers, Inc. v. OHIM* [EU:T:2016:119] para. 41: “*an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts ...*”).
17. I did not understand Mr. Stacey to suggest that the Hearing Officer made any error in relation to his statement of the applicable law. Instead, TFTOL’s challenge on appeal was to the Hearing Officer’s application of the relevant principles to the evidence in hand.

### **Barony’s evidence of genuine use**

18. Barony’s main witness was Ms. Louise McCullagh, Marketing Director of Barony since 2014 (formerly Marketing Manager of Barony since 2011). She stated that the facts set out in her Witness Statement dated 21 January 2015 (accompanied by a statement of truth) were from her own knowledge or obtained from Barony’s records to which she had unrestricted access.
19. Although the brand was adopted in 1999, Barony had only kept full TIAMA sales volume records as from January 2011. From January 2011 – October 2014, 10,339,320 units of TIAMA products were made and sold in the UK, and UK turnover in TIAMA products for the years, 2011, 2012 and 2013 was £1,767,768, £3,210,696 and £2,691,876 respectively (McCullagh, paras. 11, 13). As the Hearing Officer noted none of these figures were broken down into type/category of products beyond being listed by Ms. McCullagh as: “*personal care products, body care products, toiletries, perfumer, cosmetics, deodorants and skin products in the form of body sprays*”.
20. Mr. Stacey referred me to TFTOL’s written critique before the Hearing Officer of Exhibits LM1 - LM6 to Ms. McCullagh’s Witness Statement, the main points of which were repeated in the grounds of appeal and Mr. Stacey’s skeleton argument.

21. Going through each of those exhibits in turn, with TFTOL's comments:

- LM1 contained photographs of various TIAMA body spray/body fragrance canisters said to derive from 2001, 2003, 2005 and 2012. Mr. Stacey drew attention to the fact that the dates were handwritten on each of the photographs, and that the 2001 and 2003 photographs pre-dated the relevant use periods. The former was expressly noted by the Hearing Officer in his decision, and I have no doubt that he recognised the latter (although evidence pre-/post- dating the relevant use periods can be useful in indicating a continuous pattern of trading). Further, the get-ups of the TIAMA Celeb and TIAMA Passion body fragrances each displayed in 2 of the hand-dated 2012 photographs at LM1 were in my view corroborated by print-outs from Amazon at LM3 (and also in TFTOL's evidence<sup>1</sup>) containing photographs of the same products stated to have been first available on Amazon in October 2013.
- LM2 included examples of Barony's other ranges of products (marketed under different brands). I agree with TFTOL that LM2 was not relevant to the use issues at hand, but the Hearing Officer expressly recognised that it had no bearing on these proceedings.
- LM3 contained at the end, the Amazon print-outs I have referred to above in connection with LM1. They offered for sale the TIAMA Celeb and TIAMA Passion body fragrances (stated first to have been available in October 2013). The rest of LM3 comprised according to Ms. McCullagh, details of some of Barony's outlets. TFTOL pointed out that this was merely an address list with no indication of which TIAMA products were stocked and when. That said, some of the outlets listed at LM3 tally with the recipients of the invoices for TIAMA products exhibited at LM4 (e.g., Wilkinson Group and Anaiya Limited) to which I now turn.
- LM4 comprised sample copy invoices. TFTOL appeared to accept that a significant number of these fell within the relevant use periods under Section 46(1)(a) and Section 6(A). Further it was incontrovertible that the copy invoices related to the sale and supply of a significant number of TIAMA + sub brand products (matching the names of those shown at LM1, e.g., TIAMA Celeb, TIAMA Passion, TIAMA Truth, TIAMA Catwalk). Mr. Stacey's main criticism of the copy invoices seemed to be that they evidenced sales of TIAMA products to first, discount retailers and second, exporters. There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the origin of the goods for which it is registered, in order to create or preserve an outlet for those goods. Proven use is not disqualified from being genuine simply because a market for those goods happens to be discount retailers (*Laboratoires Goemar SA v. La Mer Technology Inc.* [2005] EWCA Civ 978). Further, Mr. Stacey accepted that export use could qualify as genuine use under Section 46(3) of the Act. It became apparent at the hearing that his points here were more directed to TFTOL's case in the opposition appeal.

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<sup>1</sup> The canister get ups shown at LM1 of the TIAMA Truth and TIAMA Catwalk body sprays were also confirmed by web-retailer print-outs in TFTOL's evidence (but not their first availability – the print-outs were made after the relevant periods).

- LM5 was a copy order by Barony for re-inclusion from the previous year of an advert for: “*Tiama 75ml Female Body Sprays, created to appeal to the modern consumer using the latest fine fragrance trends*”, in the catalogue for the Cosmoprof, Bolgna 1 – 4 April 2005, which Ms. McCullagh explained was the leading worldwide event for the professional beauty sector. This was exhibited in support of Ms. McCullagh’s statement that Barony spent around £120,000 per annum on trade shows and promotional materials promoting its TIAMA products. The Hearing Officer remarked that it was unclear what the 1 – 4 April 2005 date referred to<sup>2</sup>, and that UK circulation figures were not given by Ms. McCullagh who had merely stated that the catalogue was distributed worldwide. Mr. Stacey also pointed out that this was before the relevant use periods.
- LM6 shows some copy artworks for TIAMA + sub-brand body sprays packaging, dated September 2008. Mr. Stacey remarked that the mock-ups were supplied to Barony by a Czech company, which I failed to see was a relevant objection<sup>3</sup>.

22. I accept that were each document to be viewed individually (not collectively) shortcomings could be identified in Barony’s evidence of use. However, the Hearing Officer was charged with making an *overall* assessment of the relevant circumstances, which factors were interdependent, in order to determine whether genuine use was established in this case. That meant, as the General Court made clear in Case T-204/14, *Victor International GmbH v. EUIPO* [EU:T:2016:448] at para. 55:

*“... Thus each piece of evidence is not to be analysed separately, but rather together, in order to determine the most likely and the most coherent meaning. In the context of that analysis, it cannot be ruled out that a range of pieces of evidence may allow the necessary facts to be established, even though each of those pieces of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts ...”.*

23. Having carefully reviewed the evidence in the light of TFTOL’s arguments, I consider that the Hearing Officer was entitled to come to the view that genuine use had been established at the relevant times in the UK of the TIAMA trade mark for perfumery in the form of body fragrance sprays.
24. TFTOL’s final point in the revocation/proof of use appeal was regarding the Hearing Officer’s characterisation of the products in respect of which the TIAMA trade mark had been used. TFTOL argued that the correct characterisation of such products was deodorants for personal use. On appeal it was contended that the Hearing Officer had ignored Mr. Stacey’s evidence exhibited at JMS05 of his Witness Statement dated 18 June 2015 as to Mr. Stacey’s personal investigations conducted in June 2015 into where Tesco (Neasden), Asda (Park Royal) and Boots (Brent Cross) displayed on the one hand deodorants and on the other hand body fragrance sprays for sale in their stores.

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<sup>2</sup> Although it seems likely that this was the dates of the event.

<sup>3</sup> Accompanying text on the copy mock ups was in English as was the first language on the packaging. Instructions for use/warnings were additionally provided in other languages but it was clear from Ms. McCullagh’s evidence that Barony’s TIAMA products were exported.

25. I reject this contention. The Hearing Officer made special reference to JMS05 in his decision, but did not accept that deodorants and body sprays were the same (para. 45):

*“It is clear from the evidence that the only product being used is body sprays. There is no evidence to show use of the mark on any other product. Mr Stacey argues that “deodorants” are the same goods as “body sprays”. He has filed evidence which shows that the goods are sold in very close proximity to one another and even examples of products which make reference to “deodorising body sprays”. I accept that deodorants may be fragranced to give a pleasant spray. However, I do not accept that deodorants and body sprays are the same. The evidence shows that the definition of deodorants is “1. a substance applied to the body to suppress or mask the odour of perspiration or other body odours”. The purpose of a body spray is to enhance the smell of one’s body. It may be either applied directly to the body or over one’s clothes. Whilst there is a fine distinction between the goods, they are not the same products and are not described in the same manner.”*

I agree.

26. The revocation/proof of use appeal fails.

### **Opposition appeal**

27. TFTOL’s grounds of appeal in the opposition were fourfold.

#### Canon/Treat

28. First, it was said that the Hearing Officer erred in his application of the *Canon/Treat* tests in finding any similarity in the goods namely: Perfumery in the form of body fragrance on the one hand (Barony); and Skin and hair products on the other hand (TFTOL).
29. The Hearing Officer held that although the nature and intended purpose of the respective goods were different, they each formed part of a person’s beautification process, would be sold in the same shops and shared the same channels of distribution. He concluded, therefore, that they were similar to a low degree.
30. It is well recognised that the distribution channels of the goods concerned are a relevant factor in the comparison of goods for the purposes of Section 5(2)(b) (Case T-443/05, *El Corte Inglés, SA v. OHIM* [2007] II-2579, para. 37). I do not accept that either his comparison of the respective goods or his conclusion that they were similar to a low degree contained any error.

#### Interdependence

31. Second, TFTOL contended that the Hearing Officer afforded too much weight to the interdependence principle when globally assessing likelihood of confusion. This was an unpromising argument especially in view of the Hearing Officer’s other findings that the parties’ trade marks were visually and aurally similar to a high degree, the earlier trade mark being an invented word was possessed of high inherent distinctive character, and the level of attention paid to the predominantly visual purchase act was between low and medium. Again, I found no error in his assessment.

Trading styles

32. Third, it was argued that there was no likelihood of confusion because of the different price points, markets and retail outlets for the respective goods as shown by the parties' evidence. This was where Mr. Stacey's observations regarding Barony's stockists being discount houses and exporters were directed.
33. It is well established that the Hearing Officer was required globally to assess the likelihood of confusion under Section 5(2)(b) on the basis of normal and fair use of the parties' marks across the specifications of goods registered in the earlier mark on the one hand (albeit restricted by the proof of use provisions) and applied for in the later mark on the other hand (Case C-533/06, *O2 Holdings Limited and O2 (UK) Limited v Hutchison 3G UK Limited* [2008] ECR I-4231, para. 66, Case T-147/03, *Devinlec Développement innovation Leclerc SA v. OHIM* [2006] ECR II-0011, para. 104).
34. The third ground of appeal is also dismissed.

Honest concurrent use

35. TFTOL's fourth ground of appeal was that the Hearing Officer failed to take into account TFTOL's defence to the opposition of honest concurrent use/coexistence (which in my view sat uneasily with TFTOL's third ground of appeal).
36. This defence started life in TFTOL's Notice of defence and counterstatement as a claim to the defence of honest concurrent use in Section 7 of the Act, which the Hearing Officer explained was otiose since the UKIPO no longer examined applications for trade mark registration on relative grounds, and in any event it did not apply in opposition proceedings.
37. The Hearing Officer also dealt with TFTOL's claim (if this was intended to be such) that there were no instances of actual confusion by reference to *The European Limited v. The Economist Newspaper Ltd* [1997] EWCA Civ 2771, per Millett L.J.:

*"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.*

38. The Hearing Officer could also have drawn on the following passage from the judgment of Laddie J. in *Compass Publishing BV v. Compass Logistics Ltd* [2004] EWHC 520 (Ch) at paragraph 22:

*"It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion ... So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of*



*infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place ...”*

39. In the appeal grounds, TFTOL’s honest concurrent use defence was characterised by apparent reliance on the *Budweiser* case (Case C-482/09, *Budějovický Budvar, národní podnik v Anheuser-Busch Inc.* [2011] ECR I-8701).
40. Mr. Stacey accepted that the particular circumstances of *Budweiser* were exceptional, but contended that the registration and use of TFTOL’s TIANA mark in the UK would have no adverse effect on the functions of Barony’s TIAMA mark (which under Section 5(2)(b) would be by reason of likelihood of confusion, O2 para. 57).
41. In support, the grounds of appeal relied on the crossover of the TIANA brand from food to skincare and hair products. However this was not an exceptional circumstance in any relevant legal sense in this context. The grounds/Mr. Stacey also relied on the availability of the respectively branded products in the UK in retail outlets<sup>4</sup> and on the Internet particularly Amazon, the widespread media coverage of TFTOL’s but not Barony’s products, and the absence of any instances of actual confusion coming to the attention of his client. Nevertheless, Mr. Stacey continued to maintain that the products were different.
42. I have carefully reviewed the papers on file. I agree with the Hearing Officer that there was no evidence that demonstrated that the relevant public had shown itself able to distinguish between the respective trade marks (Case C-498/07 P, *Aceites del Sur-Coosur SA v Koipe Corporación SL* [2009] I-7371, para. 82). I do not consider that the Hearing Officer erred in rejecting TFTOL’s honest concurrent use defence (however expressed), and I therefore reject the fourth ground of appeal.

### **Conclusion and costs**

43. In the event, both the revocation/proof of use appeal and the opposition appeal have failed.
44. The Hearing Officer felt that there was a score draw below, with TFTOL largely succeeding in the revocation and Barony entirely succeeding in the opposition. He therefore made no order as to costs.
45. Barony did not participate in the appeal proceedings beyond the filing of its Respondent’s notice. I will order TFTOL to pay Barony the sum of £150 as a contribution towards Barony’s costs of this appeal, such sum to be paid within 28 days of the date of this decision.

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<sup>4</sup> Mr. Stacey specifically referred to TIANA products being distributed through Holland & Barrett.

46. It has proved unnecessary to deal with Barony's Respondent's notice. In any case, this upheld the Hearing Officer's decision and made submissions on the grounds of appeal, which I have taken into account.
47. Finally, Mr. Stacey said that the Hearing Officer failed to mention in his decision TFTOL's proposal at the hearing to limit its specification to: "Skincare and Haircare products" (from: "Skin and Hair products"). I do not consider that this would have made any difference to the outcome of the opposition.

Professor Ruth Annand, 3 October 2016

Mr. Max Stacey, Baron Warren Redfern appeared on behalf of the Appellant/Applicant for Revocation/Applicant

The Respondent/Proprietor/Opponent did not appear and was not represented