

O/722/18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATIONS NO. 3269757,  
3269760 AND 3269761 BY**

**JUSTINGREDIENTS LIMITED**

**TO REGISTER:**

**JUSTINGREDIENTS**



**JUST  
INGREDIENTS  
TRADE**

**AS A TRADE MARK IN CLASSES 3, 5, 29 AND 30**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NOS. 411449,411450 AND 411452 BY**

**ULRICH JUSTRICH HOLDING AG**

## Background and pleadings

1. JustIngredients Limited (“the applicant”) applied to register the following trade marks in the United Kingdom on 10 November 2017:

3269757	JUSTINGREDIENTS
3269760	 JUSTINGREDIENTS Essentials
3269761	 JUST INGREDIENTS TRADE

They were accepted and published in the Trade Marks Journal on 24 November 2017 in respect of the following goods:

### Class 3

*Bath herbs; henna; aromatherapy oils; bath oils; almond oil; oils; essential oils; aromatic oils; cosmetic oils; bath oils [sic]; natural essential oils; blended essential oils; aromatic essential oils; pot pourri.*

### Class 5

*Medicinal herbs; extracts of medicinal herbs; pollen as a dietary supplement; gums and resins for medicinal use; medicinal oils; Chinese herbs; Chinese medicinal herbs; supplements; capsules; herbal capsules; tinctures.*

### Class 29

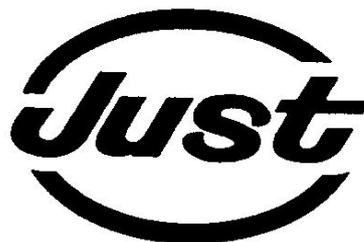
*Dried vegetables; preserved vegetables; dehydrated vegetables; preserved leaves for culinary use; preserved onion; kibbled onion; edible seeds; processed seeds; preserved chilli peppers; dried chilli peppers; dehydrated*

*mushrooms; dehydrated horseradish; pollen prepared as a foodstuff; dried fruit; preserved fruits; fruit snacks; crystallised fruit; fruit peel; nuts; processed nuts; olive oil; edible oil; nut oils; coconut oil; edible flowers; purees.*

Class 30

*Herbs; dried herbs; culinary herbs; processed herbs; spices; mixed spices; edible spices; spices in the form of powders; seasonings; seasoning blends; salt; pepper; teas; fruit teas; herbal teas; garlic; garlic powder; minced garlic; sesame seeds; caraway seeds; dried cumin seeds; processed cereal seeds; dried coriander seeds; ginger; cinnamon sticks; pre-prepared spice mixes; dried spices; vanilla pods; vanilla paste; saffron; liquorice; guar gum; cereals; cereal preparations; sugar; muesli; coffee; coffee beans; ground coffee; sauces; purees.*

2. All the applications were opposed by Ulrich Justrich Holding AG (“the opponent”). The oppositions are based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concern all the goods covered by the applications. These oppositions have been consolidated.
3. The opponent is relying upon the following trade marks:
  - a) EU (formerly Community) Trade Mark No. 153809 (“Earlier Mark A”):



This mark was applied for on 1 April 1996 and registered on 7 July 1998 in respect of the following goods, all of which the opponent states it is relying on under section 5(2)(b) of the Act:

Class 3

*Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils, cosmetics, hair lotions; dentifrices.*

Class 21

*Brushes (except paint brushes), materials for the manufacture of brushes.*

b) UK Trade Mark No. 2245480 (“Earlier Mark B”):

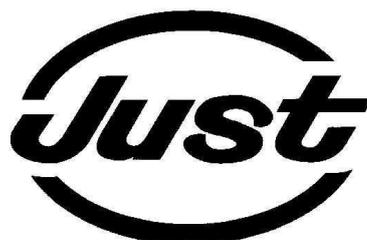


This mark was applied for on 14 September 2000 and registered on 6 April 2001 in respect of the following goods, all of which the opponent states it is relying on under section 5(2)(b) of the Act:

Class 3

*Substances for laundry use; cleaning, polishing and scouring preparations, soaps; perfumery, cosmetics, hair lotions; but not including cotton-wool, cotton-wool balls or cotton buds.*

c) International Registration (designating the EU) No. 831061 (“Earlier Mark C”):

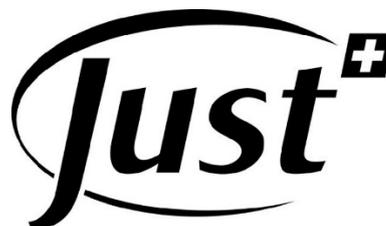


This mark has a priority date of 21 April 2004 and was granted protection in the EU on 20 October 2008 in respect of goods in Classes 5, 29, 30 and 32. In these oppositions, the opponent is relying on the following goods:

Class 5

*Dietetic substances adapted for medical use, food for babies.*

d) EU (formerly Community) Trade Mark No. 10450741 (“Earlier Mark D”):



ORIGINAL - SINCE 1930

This mark was applied for on 28 November 2011 and registered on 5 October 2012 in respect of the following goods, all of which the opponent states that it is relying on under section 5(2)(b) of the Act:

Class 3

*Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils, cosmetics, hair lotions; dentifrices.*

Class 5

*Sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; disinfectants.*

4. The opponent claims that the marks are highly similar and that the goods covered by the applicant's specifications are the same as, or highly similar to, goods covered by the earlier marks, leading to a likelihood of confusion under section 5(2)(b) of the Act.

5. The applicant filed a counterstatement, denying all the grounds. It also requested that the opponent provide evidence of proof of use of the earlier mark for all the goods relied upon.
6. Both the opponent and the applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
7. The opponent also filed written submissions dated 8 May 2018.<sup>1</sup> Both applicant and opponent made written submissions in lieu of a hearing, on 25 September 2018 and 26 September 2018 respectively. These will not be summarised but will be referred to as and where appropriate during this decision.
8. In these proceedings, the opponent is represented by Forresters IP LLP and the applicant by Indelible IP Limited.

#### **Relevant dates**

9. The opponent's earlier marks had been registered for more than five years on the date on which the contested applications were published. They are, therefore, subject to proof of use provisions under section 6A of the Act, and the applicant has requested such proof for goods in Classes 3, 5 and 21. The opponent has made a statement that it has made genuine use of the marks in the EU (Earlier Marks A, C and D) and the UK (Earlier Mark B) in the relevant period for all of the goods upon which it is relying. The relevant period for these purposes is the five years prior to and ending on the date of publication of the contested applications: 25 November 2012 to 24 November 2017. The relevant date for the purposes of section 5(2)(b) is the date the applications were filed: 10 November 2017.

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<sup>1</sup> The written submissions were dated 8 May 2017, but the applicant does not dispute that this was an error.

## Evidence

### ***Opponent's Evidence***

10. The opponent's evidence comes from Mr Heinz Moser, Chief Executive Officer of Ulrich Justrich Holding AG. It is dated 4 May 2018.

11. Mr Moser explains that the company was founded by Ulrich Jüstrich in the early 1930s when he started producing brushes in his father's factory. In 1941, Mr Jüstrich began to develop and produce cosmetic products under the JUST trade mark, which had first been adopted in 1937. Mr Moser states that "The JUST marks have been used in connection with various baths, body care, face care and foot care products". These are shown in the three brochures that are presented as Exhibits to the Witness Statement:

- HM1 is a 2015 brochure for the Australian market;
- HM2 is undated, but Mr Moser states that it is directed at the UK market and was available in 2016;
- HM3 is a 2018 brochure for the Italian market.

12. Mr Moser provides figures for sales of goods under the trade marks in the EU:

<b>Year</b>	<b>Amount (CHF)</b>	<b>Converted to GBP</b>
2012	48.4 million	35.5 million
2013	52.6 million	38.6 million
2014	52.7 million	38.6 million
2015	51.6 million	37.9 million
2016	51.0 million	37.4 million
2017	52.7 million	38.6 million

13. The Witness Statement and brochures enable me to piece together a picture of the opponent's distribution model. Ulrich Justrich Holding AG has two affiliated companies, *JUST*Germany GmbH and *JUST*France Sarl. Mr Moser states that

these two companies sell the goods in Europe to other commercial or independent distributors and to end-consumers by direct, telephone or internet sales.

14. Ulrich Justrich Holding also sells goods to what Mr Moser describes as “independent foreign companies with which it has a licensing and/or distribution agreement”.<sup>2</sup> All the companies listed have “JUST” in their name, apart from the Hungarian company which is called JNS. Exhibit HM4 consists of 51 invoices to distributors based in France, Italy, Germany, Hungary, Slovenia, Slovakia, the Czech Republic, Benelux (Belgium), Latvia, and Poland, covering the years 2012 to 2017. The first three of these invoices date from January 2012, and thus fall outside the relevant period.

15. The brochure exhibited at HM2 describes how the goods reach the end-consumer:

“We value and respect our Consultants in the knowledge that they are key members of our organisation being the interface with you, our valued customer...

We strongly believe that the personal and informal approach offered by our Consultants within the comfort of your own home, and with family and friends, is an optimum ideal to fully understand **Just** products and their many uses. We believe it is less intimidating than in the big store approach and you can make suitable choices for your personal needs after freely sampling our product range and fully luxuriating in a **Just** spa experience.

Finally, our Consultant will personally deliver your orders to your hostess, thereby continuing with support and after care, that is our quality cycle...”

16. The same brochure notes that the company operates in more than 35 countries and has 60,000 consultants, who solicit orders at parties arranged in a customer’s home. These orders are then delivered to the party host, for distribution to the

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<sup>2</sup> The list in the Witness Statement contains firms covering Latvia, the Czech Republic, Austria, Spain, Italy, Benelux, Hungary, Poland, Slovenia, Slovakia, Ukraine and Russia.

purchasers. Samples of invoices to named individuals are supplied as Exhibits HM5 and HM6. The German invoices in the latter of these Exhibits contain orders under the names of customers other than the addressee.

***Applicant’s Evidence***

17. The applicant’s evidence comes from Mr Andrew Barker, Managing Director of JustIngredients Limited since June 2012, when the company was incorporated. His witness statement is dated 12 July 2018. A further witness statement has been made by Ms Michelle Anne Ward, Chartered Trade Mark Attorney and the applicant’s representative. Her witness statement is also dated 12 July 2018. I shall not summarise Ms Ward’s evidence here. It reflects research undertaken as part of the defence of the opposition and I will refer to it later, where appropriate.

18. Mr Barker set up JustIngredients Limited in 2010 to sell culinary and medicinal herbs and spices via the internet. It was originally a division of his other company, PBA Trading, but was spun out into a separate business in June 2012. Mr Barker states that the company sells “a wide range of ingredients for a variety of applications including culinary, beverage, cosmetic, health, crafts, pet and equine”. These products are sold on the company’s own website and on e-commerce platforms such as Amazon Marketplace.

19. Sales figures for the business since its start-up are as follows:

<b>Year</b>	<b>Sales (GBP)</b>
2010	42,011
2011	171,195
2012	342,615
2013	674,091
2014	1,072,333
2015	1,679,504
2016	2,015,570
2017	2,178,865

20. The company's products have featured in a range of lifestyle and food publications, including the relevant sections of national newspapers *The Daily Telegraph* and *The Daily Mail*.<sup>3</sup>

## **Proof of Use**

21. Section 6A of the Act states that:

“(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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<sup>3</sup> See Exhibit AB12.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

22. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J summarised the principles guiding the assessment of whether there has been genuine use of a trade mark. These principles are drawn from the following case law: *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01), *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02), *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-416/04 P), *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft “Feldmarschall Radetzky”* (C-442/07), *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07), *Leno Merken BV v Hagelkruis Beheer BV* (C-149/11), *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* (C-609/11), and *P Reber Holding & Co KG v OHIM* (C-141/13):

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

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

(3) The use must be consistent with the essential function of a trade mark which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37-38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant

goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].<sup>4</sup>

23. As noted under point (6) above, I must assess whether use has been shown in the appropriate territory. For Earlier Mark B, this is the UK; for Earlier Marks A, C and D, this is the European Union: see the ruling of the Court of Justice of the European Union (CJEU) in *Leno*:

“Article 15(1) of Regulation No. 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.”

24. The onus is on the opponent, as the proprietor of the earlier mark, to show such use. Section 100 of the Act states that:

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

25. Turning now to the evidence that the opponent claims shows genuine use of the marks, I note that the applicant has made the following criticisms:

- A brochure for the Australian market cannot form part of the proof of use of the opponent’s trade marks within the EU;

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<sup>4</sup> Paragraph 219.

- The opponent states that Exhibit HM2 is a brochure from 2016 for the UK. The applicant counters that the brochure does not contain a clear indication of its intended market or date, and therefore its relevance is “highly questionable and [it] cannot be stated, on its own, to prove use in the UK (or EU) within the Relevant Period, particularly as a catalogue for the UK is not consistent with the distributor information set out in the witness statement of Mr Heinz Moser”;
- Exhibit HM3, the 2018 brochure for the Italian market, is outside the relevant period;
- Exhibits HM3-6 are in foreign languages. The applicant refers to the decision of the Appointed Person in *Pollini*, BL O/146/02 and paragraph 4.8.4.2 of the Work Manual, which state that such exhibits should be translated into English;
- Sales to distributors, as shown in Exhibit HM4, are internal use and cannot be said to be genuine use within the marketplace;
- The invoices in Exhibit HM5 appear to show “the provision of material for promotional purposes” and therefore not public sales.

26. The case law states that, when assessing the evidence provided, a global approach should be adopted. In *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09, the General Court commented that:

“In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that 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 (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07, *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36).”<sup>5</sup>

27. It seems to me that the situation is similar here. I find that there is merit in some of the applicant’s criticisms, if each piece of evidence is taken individually. On its own, a catalogue for the Australian market cannot demonstrate genuine use within the EU. A catalogue dated 2018 cannot provide proof of use within a period that ends on 24 November 2017. Providing evidence without an English language translation can make it difficult to work out exactly which products have been sold. However, I am required to determine what the evidence as a whole shows.

28. First, I will consider the issue of the evidence in a foreign language. In the Hearing Officer’s decision on *Pollini* (BL O/296/01), he disregarded some of the supplied invoice evidence which was in Italian. He stated that he could guess the meanings of some of the words on the invoices but found himself unable to assess the nature of any protectable goodwill. On appeal to the Appointed Person, Professor Ruth Annand was required to consider this point. She noted the general lack of guidance on exhibits in a foreign language, although a Practice Direction to Part 32 of the Civil Procedure Rules dealt with the same issue in relation to affidavits. She went on:

“It seems to me that exhibits in a foreign language ought to be treated in the same way as the statutory declaration, affidavit or witness statement in conjunction with which they are used. Accordingly, where an exhibit is in a foreign language, a party seeking to rely on it in registry proceedings must provide a verified translation into English.”<sup>6</sup>

29. The Appointed Person’s comments were reflected in the *Trade Marks Manual* (i.e., the Work Manual) (my emphasis):

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<sup>5</sup> Paragraph 53.

<sup>6</sup> Paragraph 32.

“Statements made in foreign languages will normally be accepted as being valid under local law unless successfully challenged by the other party. If a challenge is made it should be supported with the reasons to explain the basis of the challenge. Any challenge should be made as soon as possible. Unless the person making the declaration has a good command of the English language, they will be unable to testify in English. In such cases, the declaration may be filed in their mother tongue accompanied by a certified translation prepared by a competent translator. **Exhibits must similarly be translated if they are to be relied upon (Pollini BL O/146/02).** The translator should prepare their own witness statement, statutory declaration or affidavit stating that they are (at least) familiar with English and the other language. As an exhibit to the declaration, the translator should file copies of the foreign declaration and its translation.”<sup>7</sup>

30. In *Pollini*, the Hearing Officer had found himself unable to identify with any certainty exactly what goods were covered by a set of invoices. Those invoices were in Italian; he was not an Italian speaker. The circumstances here are slightly different. It is true that almost all the invoices are in French, German or Italian.<sup>8</sup> I am, however, able to identify a majority of the goods on the invoices in Exhibits HM4 (apart from the Italian ones) and HM6, with the aid of product codes.<sup>9</sup> Where the same products are included in the 2015 Australian brochure and the second brochure (claimed by Mr Moser to be for the UK market in 2016), the codes are identical. Both of these exhibits are in English. I am persuaded that the second brochure is intended for the UK market, as it contains on its final page a UK telephone number to contact “if you wish to buy Just products, hold a Home Spa Experience or enquire about business and career opportunities”.<sup>10</sup> It is the case that Mr Moser does not mention a UK distributor in his witness statement, but neither does he claim his list is exhaustive.<sup>11</sup>

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<sup>7</sup> Paragraph 4.8.4.2 of the Tribunal section.

<sup>8</sup> The exceptions are the two Polish invoices, which are in English.

<sup>9</sup> The product codes on the Italian invoices are different. 15 out of the 48 “in period” invoices are Italian. The product codes on the invoices in Exhibit HM5 are also different.

<sup>10</sup> Exhibit HM2, page 19.

<sup>11</sup> His wording is as follows: “A list of such independent foreign companies which sells [sic] JUST goods in Europe to other commercial or independent distributors and to end consumers via Direct, Internet or telephone sales, **including** in Latvia, the Czech Republic, Germany, Austria, Spain, Italy, Austria [sic], Slovakia, Ukraine, Benelux, Hungary, Poland and Slovenia, is set out below.” – my emphasis.

31. Given that I have been able to identify most of the goods listed on the non-Italian invoices in Exhibit HM4, I will now consider the applicant's argument that these are internal sales between connected companies and therefore do not represent genuine use of the mark. The applicant refers me to the CJEU's decision in *Ansul* and I reproduce the relevant paragraphs below:

“36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential functions of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned.”

The applicant contends that “sales to affiliated companies amounts to nothing more than ‘internal’ use and cannot be stated to be genuine use within the marketplace.”

32. The opponent, however, submits that

“outward use does not necessarily imply use aimed at end consumers. For instance, the relevant evidence can validly stem from an intermediary, whose activity consists of identifying professional purchasers, such as distribution companies, to whom the intermediary sells products it has had manufactured by original producers (judgment of 21/11/03, T-524/12, RECARO, EU:T:2013:6014, § 25-26). Relevant evidence can also validly come from a distribution company forming part of a group. Distribution is a method of business organisation that is common in the course of trade and implies use of the mark that cannot be regarded as purely internal use by a group of

companies, since the mark is also used outwardly and publicly (judgment of 17/02/2011, T-324/09, *Friboi*, EU:T:2011:47, § 32).”

33. The applicant maintains that the evidence provided by the opponent of sales to appointed distributors is not consistent with the findings in either of these cases. In *Recaro* (an invalidity case), the proprietor was an intermediary who had footwear manufactured by other companies and sold them on to professional purchasers, such as distribution companies. The General Court found that in this case those professional purchasers did constitute “the relevant public” and dismissed the applicant’s plea that there was no genuine use. In *Friboi*, the opponent had submitted in evidence invoices to a distribution company. The General Court accepted that, taken alongside brochures indicating that the goods were offered for sale on the market, these invoices showed genuine use of the mark in question.
34. Each of these cases turned on its specific facts and I must return to the particular facts before me. I have already described the opponent’s distribution model in paragraphs 13-16 above. The invoices in Exhibit HM4 show sales to some of the “independent foreign companies” referred to in paragraph 14. The invoices in Exhibits HM5 and HM6 show sales from the affiliated companies referred to in paragraph 13 to independent distributors, and the latter Exhibit contains orders by several named individuals. Taken as a whole, together with the information in the brochures, in my view, this provides evidence of sales which are not purely internal.
35. The applicant submits that the volume of sales, and the prices of the goods shown in Exhibits HM5 and HM6 are of a type and level that suggests they may not be public sales, but rather “largely the provision of material for promotional purposes”. It will be recalled that both these Exhibits are in foreign languages. HM5 contains a set of invoices to two named individuals. The items listed are in French and the reference numbers do not correspond to product numbers anywhere else in the opponent’s evidence. Bearing in mind the decision in *Pollini* to which I have already referred, I shall not consider this Exhibit further.

36. Exhibit HM6, however, is a different matter. This consists of 11 invoices from Germany (1 of which is outside the relevant period). Each invoice shows a relatively small volume of sales to one of two named individuals, and a larger volume of sales to a different individual. This is consistent with the distribution model already described. The table below shows the value of orders placed by each of the different individuals.<sup>12</sup>

<b>Date</b>	<b>Individual</b>	<b>Value of Items Ordered (EUR)</b>
28 November 2012	Ms H	543.90
26 February 2013	Ms S	407.00
8 April 2013	Ms K1	518.00
27 February 2014	Ms M	360.40
18 February 2015	Ms K2	636.00
2 June 2015	Ms L	466.49
20 October 2016	Ms W	775.48
16 January 2017	Ms K3	359.47
25 October 2017	Ms G	875.47

37. In my view, the evidence as a whole shows that the opponent has made sales within the EU. The opponent has not, however, provided evidence of sales within the UK. Consequently, I find that it cannot rely upon Earlier Mark B in these proceedings.

38. I must now consider whether it has shown that it has made genuine use of the other earlier marks. In making my assessment I have taken account of the goods which I am able to identify with product codes or which are recorded in English on the Polish invoices. I have also borne in mind the guidance given by Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) on construing terms in trade mark specifications:

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<sup>12</sup> I have omitted the invoice from 12 June 2014 as this contains an order for products with a code that cannot be matched.

“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 (Trade Marks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. ... 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.”

39. The opponent submits that the earlier marks had been filed before the CJEU ruling in *IP TRANSLATOR*, and that at the time of filing it had intended, when it used the Nice Classification heading for Class 3, that the relevant marks should cover all the goods within this class. In response to this submission, the applicant notes that the opponent had not made a declaration that this had been its intention, as required by Article 28(8) of the Amending Regulation (EU) 2015/2424, by the deadline of 24 September 2016.<sup>13</sup> This Article states that:

“EU trade marks for which no declaration is filed within the period referred to in the second subparagraph shall be deemed to extend, as far from the expiry of that period, only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.”

40. The opponent accepts that it did not file such a declaration but submits that as its registrations were filed in 1996, 2000, 2004 and 2011 “it is appropriate at least to consider the Applicant’s mind set back in those years when considering what the applicant intended to cover.” The opponent has, however, provided no evidence to enable me to do this, even were such an approach to be consistent with the legislation quoted above. I must restrict my assessment to the literal meaning of the terms in the specifications.

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<sup>13</sup> Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

### ***Class 3 goods (Earlier Marks A and D)***

41. The first goods listed in the specifications for Earlier Marks A and D are ***Bleaching preparations and other substances for laundry use***. The brochure in Exhibit HM3 shows a product described as “detergente”, but as I have already noted this falls outside the relevant period. There are no indications of sales of these goods in the invoices I have been able to check. I therefore find that the opponent has not shown genuine use of the mark on these goods.
42. Earlier Marks A and D are registered for ***cleaning, polishing, scouring and abrasive preparations***. In my view, the ordinary and natural meanings of these phrases do not include goods such as shower gel and facial cleansers that the average consumer would more usually describe as *toiletries*. The words *scouring* and *abrasive* in particular suggest household or industrial cleaning and are unlikely to be used in the context of body care; instead, the goods would be described as *exfoliating* or even *dermabrasive*. On appeal, Arnold J saw no reason to disagree with a similar assessment of this term by the Hearing Officer in *DABUR UVEDA*.<sup>14</sup> I find that the opponent has not shown genuine use for these goods.
43. I now move on to ***soaps***. Soap is used for cleaning the body and is supplied either in solid or liquid form.<sup>15</sup> The opponent has provided evidence of sales of shower gels and bath foams, but to my mind these are not the same thing as soaps, which are more versatile, being able to be used in baths, showers, and for quick washing of individual parts of the body, such as the hands or feet. The opponent has provided no evidence of sales of soaps and so I find that it has not shown genuine use of the marks on these goods.
44. The next goods for consideration are ***perfumery***. Perfumes are intended to make the body or a room smell attractive or pleasant. They often contain essential oils, but to my mind the ordinary and natural meaning of a term in a trade mark

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<sup>14</sup> See *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch), paras. 58-60.

<sup>15</sup> It is defined in the Nice Classification as “a cleansing and emulsifying agent made usually by the action of alkali on fat or fatty acids and consisting essentially of sodium or potassium salts of such acids”.

specification would not necessarily include its ingredients. The opponent submits that “Perfumed products such as oils, balms and sprays” are covered by its earlier marks. To my mind this is a stretching of the meaning of the term within the specification. Many different products might be perfumed: from handcream to candles and drawer liners to bathroom cleaners. I am not persuaded that the consumer would describe such products as “perfumery”. Room sprays may, in my view, be included in this category and the 2018 Italian brochure does contain images of household sprays. However, the comments I made in paragraph 41 on this particular Exhibit apply equally here. This same brochure also shows images of **dentifrices**, which are pastes and powders used for cleaning and treating teeth. They do not appear in any other brochure or in the invoices I have been able to check. Consequently, I find that there is no evidence of use of the marks on *perfumery* or *dentifrices* during the relevant period.

45. The invoices show that the opponent has made sales of **essential oils**. It has also shown that individual customers have purchased these products.<sup>16</sup> In the brochure aimed at the UK market, Earlier Mark A can be made out on the packaging and labels attached to the bottles. On the pages of this same brochure is found a variant of Earlier Mark D.

46. Settled case law states that “use” of a mark encompasses independent use and use as part of another mark taken as a whole or in conjunction with that other mark: see *Colloseum Holdings AG v Levi Strauss & Co*, C-12/12, paragraph 32. It may also include use in an acceptably differing form. The test for this was set out by Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06:

“33. ... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

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<sup>16</sup> See Exhibit HM6.

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. ... this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

47. Looking at Earlier Mark D, I note that the word "Just" is in bold, sans serif letters, slanted to the right, with a capital "J". It is surrounded by an incomplete oval, at the upper right-hand side of which is a small dark square containing a white cross. Beneath the oval can be found in smaller, but upper-case, letters: "ORIGINAL – SINCE 1930". The distinctiveness of the mark lies in the stylised representation of the word "JUST", surrounded by the oval and combined with the device which resembles a flag. The words at the bottom are, to my mind, less significant and may not be noticed. In the brochure, the word "ORIGINAL" is replaced with "NATURAL". The change does not, in my view, alter the distinctiveness of the mark, and I consider that the opponent has shown use of the Earlier Marks A and D for *essential oils*.

48. The *Oxford Dictionary of English* defines **cosmetics** as "preparation(s) applied to the body, especially the face, to improve its appearance". The opponent submits that the category includes eye creams, lip balms, oils and gels, for all of which it is claiming use of its marks. The brochure at Exhibit HM2 shows use of the marks for personal care creams, foot creams, foot balms and skincare. The latter claims to "restore youthful looking skin on our face and neck region". The marks are presented in the same way as they are for essential oils, with Earlier Mark A on the packaging and labels and the acceptable variant form of Earlier Mark D printed in the brochure.

49. I find that the opponent has shown use of the earlier marks for some of the goods which meet the literal definition of "cosmetics", but there are significant gaps – notably products which would also be described as "make-up", such as lipsticks

and mascara. There is no evidence that the opponent sells these goods. I must therefore consider whether in such circumstances it would be fair for the opponent to be able to rely on the broad term *cosmetics*.

50. Carr J summed up the relevant law in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). This was a revocation case, but the same principles apply in an opposition:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

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51. In my view, a fair specification would be *cosmetic preparations for skincare*. This term does not include make-up, but neither does it simply enumerate the goods that appear in the opponent’s brochures. I find that the opponent has shown use of Earlier Marks A and D for *cosmetic preparations for skincare*, in the forms described in paragraphs 45-47 above.

52. The final goods in the Class 3 specification for Earlier Marks A and D are **hair lotions**. The brochure at Exhibit HM2 shows images of both shampoo and hair treatment masks<sup>18</sup> and the invoices show sales of shampoo. “Shampoo” has a distinct meaning as a product used for cleaning the hair. However, I take account of Carr J’s point (v) cited in paragraph 50 above. It is not my task to describe the opponent’s use of its marks in the narrowest way possible. A “lotion” is a thick liquid that is applied for a specific cosmetic or medical purpose. Shampoo has the same nature and many shampoos have additional uses to the primary purpose of cleansing, such as boosting the volume of the hair or maintaining its colour. It seems to me that excluding shampoo from *hair lotions* is an overly literal interpretation of these terms, and I find that the opponent has shown genuine use of Earlier Marks A and D for these goods, in the forms described in paragraphs 45-47 above.

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<sup>17</sup> Paragraph 47.

<sup>18</sup> See page 17.

### ***Class 5 goods (Earlier Marks C and D)***

53. The opponent seeks to rely on the Class 5 goods registered to both Earlier Marks C and D: ***dietetic substances adapted for medical use, food for babies***. The first of these describes nutritional substances, such as vitamins or minerals, added to food or beverages for specific medical purposes. I can find nothing in the opponent's evidence to suggest that any of its goods are meant to be ingested, and so I cannot find that there has been genuine use of the marks for *dietetic substances adapted for medical use or food for babies*.

54. Earlier Mark D is also registered for ***sanitary preparations for medical purposes***. These goods are designed to clean or disinfect wounds or other medical conditions, or sterilise equipment. Some of the essential oils and creams that are sold by the opponent have antiseptic properties and are marketed as having medical uses: tea tree and manuca oil and cream, eucalyptus oil, lavender oil.<sup>19</sup> The invoices provided show sales of these products. I find that there is use for *sanitary preparations for medical purposes*.

55. The final good in this class is ***disinfectants***. These are defined by the *Oxford Dictionary of English* as "a chemical liquid that destroys bacteria". The opponent submits that this term includes hand gel sanitisers and cleansing gels. The brochure at HM2 contains an image of hand gel, with the following text:

"Engaging in daily hygiene activities is essential both as a cosmetic and personal ideal, but also to promote and maintain health and prevent the spread of infection."

Exhibit HM4 contains invoices which indicate sales to the distributors. As these goods also appear in the brochure, following the General Court in *Friboi*, and taking this evidence together, I find that there is evidence of use of the marks on these products.

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<sup>19</sup> Exhibit HM1.

56. Disinfectants for the body, such as hand gel sanitisers, are a subcategory distinct from other types of disinfectants, such as those that are used around the home or in the workplace. The goods sold by the opponent do not, to my mind, warrant the protection of the broad term “disinfectants” and *disinfectants for personal hygiene purposes* would be a fairer specification.

### **Class 21 goods (Earlier Mark A)**

57. Earlier Mark A is also registered for ***Brushes (except paint brushes)*** and ***materials for the manufacture of brushes***. Images of body brushes are shown in the brochure at Exhibit HM2, but without a product code, and I am unable to identify any sales of these goods. There is also no evidence of use for *materials for the manufacture of brushes*.

### **Summary of proof of use**

58. I find that the opponent has not provided evidence of genuine use or proper reasons for non-use, of its Earlier Marks B or C. I will not consider them further in this decision.

59. I find that the opponent may rely in this opposition on Earlier Marks A and D for *essential oils, cosmetic preparations for skincare and hair lotions* and Earlier Mark D for *sanitary preparations for medical purposes and disinfectants for personal hygiene purposes*. It has not shown use, or proper reasons for non-use, for the other goods in its specifications.

### **Decision**

60. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

...

(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.”

61. In these proceedings, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

- (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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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**

62. The goods to be compared are shown in the table below:

Opponent's goods	Applicant's goods
<p data-bbox="264 253 719 291"><u>Class 3</u> (Earlier Marks A and D)</p> <p data-bbox="264 309 762 450">Essential oils Cosmetic preparations for skincare Hair lotions</p> <p data-bbox="264 696 608 734"><u>Class 5</u> (Earlier Mark D)</p> <p data-bbox="264 752 810 947">Sanitary preparations for medical purposes Disinfectants for personal hygiene purposes</p>	<p data-bbox="839 253 951 291"><u>Class 3</u></p> <p data-bbox="839 309 1385 618">Bath herbs; henna; aromatherapy oils; bath oils; almond oil; oils; essential oils; aromatic oils; cosmetic oils; bath oils [sic]; natural essential oils; blended essential oils; aromatic essential oils; pot pourri.</p> <p data-bbox="839 696 951 734"><u>Class 5</u></p> <p data-bbox="839 752 1385 1061">Medicinal herbs; extracts of medicinal herbs; pollen as a dietary supplement; gums and resins for medicinal use; medicinal oils; Chinese herbs; Chinese medicinal herbs; supplements; capsules; herbal capsules; tinctures.</p> <p data-bbox="839 1140 967 1178"><u>Class 29</u></p> <p data-bbox="839 1196 1385 1883">Dried vegetables; preserved vegetables; dehydrated vegetables; preserved leaves for culinary use; preserved onion; kibbled onion; edible seeds; processed seeds; preserved chilli peppers; dried chilli peppers; dehydrated mushrooms; dehydrated horseradish; pollen prepared as a foodstuff; dried fruit; preserved fruits; fruit snacks; crystallised fruit; fruit peel; nuts; processed nuts; olive oil; edible oil; nut oils; coconut oil; edible flowers; purees.</p>

	<p><u>Class 30</u>  Herbs; dried herbs; culinary herbs; processed herbs; spices; mixed spices; edible spices; spices in the form of powders; seasonings; seasoning blends; salt; pepper; teas; fruit teas; herbal teas; garlic; garlic powder; minced garlic; sesame seeds; caraway seeds; dried cumin seeds; processed cereal seeds; dried coriander seeds; ginger; cinnamon sticks; pre-prepared spice mixes; dried spices; vanilla pods; vanilla paste; saffron; liquorice; guar gum; cereals; cereal preparations; sugar; muesli; coffee; coffee beans; ground coffee; sauces; purees.</p>
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63. Some of the contested goods (i.e. essential oils) are identical to some of the goods on which the opposition is based. These goods are contained in the specifications of both Earlier Marks A and D. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade mark(s). If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

**Average consumer and the purchasing act**

64. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

65. 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:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”<sup>20</sup>

66. The average consumer of essential oils is a member of the general public or a business in the alternative health or personal care sector. The evidence submitted by the applicant suggests that these goods are sold in a range of sizes.<sup>21</sup> They will be purchased in specialist shops, such as alternative health shops, or online. The purchasing process will mainly be visual, although the possibility of word-of-mouth recommendations and telephone purchases means that aural considerations cannot be ignored. Invoices from the opponent state that a 10ml bottle of tea tree and manuka oil cost €17.00 in 2016 and a 10ml bottle of anti-stress essential oil cost €12.00 in 2014.<sup>22</sup> According to the applicant’s evidence, a 100ml bottle of apricot kernel oil costs £2.70.<sup>23</sup> Another Exhibit containing a print from the applicant’s website indicates that basil oil can be purchased from £180.66, bergamot oil from £288.75, and carrot oil from £347.61.<sup>24</sup> The goods therefore appear to range in price, from the relatively inexpensive to the fairly costly, and are likely to be purchased relatively infrequently as essential oils are used in small quantities. Business users will be buying the goods more often.

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<sup>20</sup> Paragraph 60.

<sup>21</sup> Exhibit AB3 (a 2012 product catalogue) lists size options for essential oils as 1 litre bottle; 10 ml bottle, 5ml bottle. The smaller bottles may be purchased singly or in packs of three.

<sup>22</sup> See Exhibit HM6.

<sup>23</sup> The price is quoted in a small item taken from the *Telegraph* magazine. The article is undated. See page 9 of Exhibit AB12.

<sup>24</sup> See Exhibit MAW9. The print is undated and the size of the bottles is unclear.

Bearing these factors in mind, I find that the average consumer would be paying an average degree of attention when making a purchase.

### **Comparison of marks**

67. It is clear from *SABEL BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, C-591/12 P, that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”<sup>25</sup>

68. It would be wrong, therefore, artificially to dissect the 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 created by the marks.

69. The respective marks are shown below:

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<sup>25</sup> Paragraph 34.

Earlier marks	Contested mark
<p data-bbox="264 309 715 340">EUTM 153809 (Earlier Mark A):</p>  <p data-bbox="264 734 753 766">EUTM 10450741 (Earlier Mark D):</p>  <p data-bbox="363 1093 724 1124">ORIGINAL - SINCE 1930</p>	<p data-bbox="847 309 983 340">3269757:</p> <p data-bbox="967 416 1267 448">JUSTINGREDIENTS</p> <p data-bbox="847 528 983 560">3269760:</p>  <p data-bbox="847 766 983 797">3269761:</p> 

70. The applicant’s first mark (3269757) consists of the word “JUSTINGREDIENTS”. The word is in a standard font with no stylisation and is presented in capital letters.<sup>26</sup> The overall impression of the mark would be of the words “JUST” and “INGREDIENTS” joined together and it will be viewed as a whole.

71. The applicant’s second mark (3269760) consists of the word “JUSTINGREDIENTS” in capital letters placed above the word “ESSENTIALS” in smaller, lower-case letters. The font is a standard, serified font and the text is black. To the left of the first word is a small device with shapes in two shades of green, orange and dark pink. The lighter green shape is placed partly covering the darker green shape. The shapes bring to mind leaves or petals. The opponent submits that this figurative element “is so small and insignificant and banal ... that it does not carry any significant weight in the comparisons of the marks”. In my view, the

<sup>26</sup> Registration of a trade mark in capital letters covers use in lower case, as stated by Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

greater weight will be carried by the words but the placing of the device just where the viewer starts to read means that this also will contribute to the overall impression of the mark.

72. The applicant's third mark (3269761) consists of the words "JUST INGREDIENTS TRADE" in capital letters and set out with each word on a separate line. The first word "JUST" is presented in a standard sans serif font, while the other two words are in a serifed font. The first two words are in black text, while the final word, "TRADE", is in white letters within a pale orange block. This different presentation means that the word "TRADE" will be viewed as a separate element from the other two words, but all make a contribution to the overall impression of the mark.
73. The opponent's Earlier Mark A (EU153809) consists of the word "JUST", in a standard black sans serif font, slanted to the right, with the first letter capitalised. Above and below the word are two curves which produce the appearance of a broken oval on which the word has been placed. The overall impression is of a stylised presentation of the word "JUST", with the curves drawing attention to this word.
74. I have already described the opponent's Earlier Mark D (EU10450741) in paragraph 47 above. The overall impression of this mark rests in the stylised presentation of the word "JUST", with the flag-like device making a contribution.

### ***Contested Mark 3269757***

75. The contested mark 3269757 consists of the two words "JUST" and "INGREDIENTS" joined together to make a string of 15 letters. This string begins with the same four letters that make up the word element of the opponent's earlier marks. I have already found that the earlier marks will be viewed as stylised presentations of the word "JUST", while the contested mark will be viewed as a unitary phrase. The fact that the word elements begin in the same way results in a level of visual similarity, but this is low.

76. The opponent submits that there is a strong aural similarity between the contested mark and its earlier marks because of the presence of the word “JUST”. The contested mark will, to my mind, be articulated as two words, comprising five syllables, in contrast to the single syllable of the earlier marks. While the opponent states that in general the beginnings of word marks are given more weight, it is important to note that this is not a general rule: see *CureVac GmbH v OHIM*, T-80/08. In the contested mark, the longer word comes second and more time is spent articulating that. I consider that these marks are aurally similar but only to a low degree.
77. The opponent submits that the marks are conceptually similar, based on the presence of “JUST” in all the marks. “JUST” is a word found in the dictionary and in everyday use. It has several different meanings: for example, now, exactly, only, very, fair, morally correct.<sup>27</sup> On its own, it does not describe or allude to the goods that are sold under the mark.
78. The contested mark will, in my view, be likely to be interpreted as meaning that the applicant only sells ingredients under the mark. The word appears on its own, not as part of a phrase, in the earlier marks. It is unlikely to have the same meaning for the average consumer as in the contested mark, as there is no indication of what is sold under the mark. Instead, the word on its own could suggest natural products, without harmful additives, or ones that are produced in a way that minimises environmental damage. I find that the marks are conceptually dissimilar.

### ***Contested Mark 3269760***

79. In paragraph 71 above. I found that the figurative device made a contribution to the overall impression of the contested mark 3269760, although the greater weight would be carried by the words. The word element of the contested mark is significantly longer (at 25 characters) than the word element of Earlier Mark A. The word “Essentials” is more than half the height of the first word of the contested mark: “JUSTINGREDIENTS”. Comparing this with Earlier Mark D, I note that the

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<sup>27</sup> See Exhibit MAW7

words “ORIGINAL – SINCE 1930” are less than half the height of the word “Just”. Consequently, I think it more likely that the average consumer will notice both the words in the contested mark, than they would notice all the words in Earlier Mark D. Visually, I find that these marks are dissimilar.

80. The comments I have made in paragraph 76 on an aural comparison between the opponent’s mark and contested mark 3269757 apply here. The additional word, “ESSENTIALS”, in the contested mark makes the differences in length greater still. In my view, they are aurally similar to a low degree. This similarity rests on the identical beginning of the marks.
81. Conceptually, the figurative element of contested mark 3269760 brings to mind leaves and petals, as I have already noted in paragraph 71 above. The larger shapes are green, a colour which is associated with nature. The word “ESSENTIALS” suggests that the goods covered by the mark are commonplace, relatively cheap items that are used on an everyday basis. I find that conceptually there is at most a fairly low level of similarity between the marks, based on possible associations with nature.

### ***Contested Mark 3269761***

82. In contested mark 3269761, the words “JUST” and “INGREDIENTS” are configured differently from how they are presented in the other two contested marks. Instead of being combined into one string of letters, they are kept separate, on individual lines. Although “JUST” is in a sans serif font and “INGREDIENTS” in a serifed font, the differences are slight. There is a greater contrast between these two words and “TRADE”, which is in white on an orange background. I find there to be a low level of visual similarity between the contested mark 3269761 and the earlier marks.
83. The contested mark would be articulated as the two words “JUST INGREDIENTS”. The word “TRADE” would, in my view be seen as a description of the market to which the relevant goods are directed. Consequently, I consider that this mark is aurally similar to the opponent’s earlier marks to a low degree.

84. With regard to a conceptual comparison, the comments that I have already made in paragraph 77 apply here. Furthermore, as noted above, “TRADE” is likely to be interpreted as the customers for these particular goods, which could be expected to be sold in larger-sized packs than goods intended for the general public. “TRADE” therefore carries less conceptual weight than “JUST INGREDIENTS”. However, as with the first contested mark (3269757), I find that the marks are conceptually dissimilar.

### **Distinctiveness of the earlier marks**

85. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark’s distinctive character in *Lloyd Schuhfabrik Meyer*:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

86. The opponent claims that its marks have acquired an enhanced distinctiveness in the industry, through the use which has been made of them over a lengthy period of time. As I have noted in paragraph 11 above, Mr Moser states that a form of the “JUST” trade mark has been in use since 1937. However, it is not enough to have used a mark for a long time. While Mr Moser has supplied EU sales figures, these have not been placed within the context of the size of the market, so I am unable to tell what market share is held by the marks. Nor is there any information on how the marks have been promoted and how much has been invested in those activities. I do not have the evidence to make a finding of enhanced distinctiveness, so must restrict my attention to the inherent distinctiveness of the earlier marks.

87. The word “JUST” is, as I have already noted in paragraph 77, a word in everyday use, one that will be familiar to the average consumer. The applicant refers me to the *Examination Manual*, which cites the case of *Bignell (t/a Just Employment (a firm)) v Just Employment Law Ltd* [2007] EWHC 2203 (Ch).<sup>28</sup> In this case, the court found that the mark “JUST EMPLOYMENT” lacked inherent distinctiveness, as it described the services provided by the registered proprietor. In the marks under consideration here, the appearance of the word “JUST” on its own, together with the stylisation, give the marks some distinctiveness, but in my view this is fairly weak.

### **Conclusions on likelihood of confusion**

88. The applicant submits that there is no likelihood of confusion between the marks. It states that:

“The lack of confusion is further supported by the fact that the Applicant has been operating for a period of some years in the marketplace with no instances of confusion arising. It is clearly a matter of fact that the Applicant and

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<sup>28</sup> Exhibit MAW6

Opponent have been able to co-exist in the marketplace with no confusion due to the differences in their marks, goods and markets.”

89. The opponent rightly notes that there is no requirement of actual confusion in section 5(2)(b) of the Act, only that there is a likelihood of confusion. I recall the comments of Millett LJ in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283:

“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.”

90. The applicant also submits that the existence on the Register of other marks beginning with the letters “JUST” shows that “there is clear frequent co-existence of ‘just’ marks in Class 3”. An argument based on the state of the register is unpersuasive, as this does not provide evidence that the marks are effectively being used in the market: see *Zero Industry Srl v OHIM*, T-400/06, paragraph 73.

91. The applicant also claims that the Registry did not identify the opponent’s marks in its examination letters:

“... on every occasion that the Applicant has applied for a trade mark around the ‘JustIngredients’ name, whether in the UK or the EU, there has been no finding of a likelihood of confusion at the search/examination stage by the examiners at the UK Intellectual Property Office or the EU Intellectual Property Office.”

Exhibit MAW1 contains the letters sent from the Registry concerning the applications in question. These state that the applications will be published for opposition purposes and are clear that during the 2 months following publication in the Trade Marks Journal the marks may be opposed. A party may bring an opposition, whether it has been notified of the application by the Registry or not.

92. Having dismissed these points, I will now make an assessment of the likelihood of confusion. In doing so, I must adopt the global approach set out in the case law to which I have already referred in para. 61. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods/services may be offset by a greater degree of similarity between the marks, and vice versa.<sup>29</sup> The distinctiveness of the earlier mark must also be taken into account.
93. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods/services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.<sup>30</sup>
94. There are two types of confusion: direct and indirect. These were explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’<sup>31</sup>

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<sup>29</sup> *Canon Kabushiki Kaisa*, paragraph 17.

<sup>30</sup> *Lloyd Schuhfabrik Meyer*, paragraph 27.

<sup>31</sup> Paragraph 16.

95. I will first consider direct confusion. It is important to keep in mind the circumstances in which the average consumer will encounter the marks. The opponent submits that:

“...there is a strong aural similarity and a significant chance of consumer confusion in respect of the pronunciation of the marks (JUST and JUST ESSENTIALS) which would be a particular issue when making sales via telephone”.

Earlier in the decision, I found that the visual element will be the most important as the consumers select the product from websites, brochures or in interactions with a sales consultant. Mr Moser’s witness statement informs me that the opponent’s goods may be ordered directly by customers over the telephone. However, this statement is not supported by the evidence supplied. The brochures stress a distribution model based on parties given in individuals’ homes where products are demonstrated and orders taken. There is only one reference which suggests that direct telephone sales can take place. This is at the back of the brochure aimed at the UK market. I do not have the evidence to persuade me that direct telephone sales are a widely used distribution channel. I cannot ignore the aural element, but must not give it too much weight. Earlier in the decision, I found that for the goods in question the consumer would be paying an average level of attention. Given such levels of attention, the weak distinctiveness of the earlier marks and the relatively low degree of similarity between the marks, in my view, there is no likelihood of direct confusion, even in the case of identical goods.

96. The opponent submits that the consumer may be indirectly confused:

“The average consumer is likely to bring to mind the Earlier Registrations with their reputation when met with a range of similar marks which all start with the identical word JUST.

The average consumer may see the contested Applications as a derivative or a sub-brand of the Earlier Registrations, in the same way that Armani uses the

sub-brands ARMANI COLLEZIONI or ARMANI JEANS. Indeed brand owners often use sub-brands after house marks in order to rely on the goodwill and reputation in the house mark in the sub-brand, e.g. SONY PLAYSTATION, ADIDAS PREDATOR or COCA-COLA ZERO.

Further, it is well-known that grocery stores ... use language like 'Essentials' to describe a range of products which thus renders the term lacking in any distinctive character."

That a mark brings to mind an earlier mark is not, however, sufficient for a finding of indirect confusion, as Mr James Mellor QC, sitting as the Appointed Person, stated in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. He stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. If a mark merely calls to mind another mark, that is association, not indirect confusion. In paragraph 81.4 of this decision, he commented on Mr Iain Purvis's decision in *L.A. Sugar*:

"When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.' (my emphasis)"

97. As noted above in paragraph 95, I found that the visual aspect would be most significant for the average consumer during the purchasing process. The contested marks will, in my view, be read as unitary phrases, and in the third mark (3269760) "trade" will be seen as indicating that these goods are marketed towards businesses, within a wholesale relationship. "JUST" is an everyday word and it would require a large mental leap for the average consumer to assume that (not just wonder whether) the two companies have an economic connection. Given that I have found the earlier marks to be weakly distinctive, it seems to me that the average consumer would not assume an economic connection between the two undertakings. Consequently, I find that there is no likelihood of indirect confusion.

## Conclusion

98. All three oppositions have failed. The applications by JustIngredients Limited may proceed to registration in respect of all the goods applied for.

## Costs

99. The applicant has been successful. I award the applicant the sum of £1000, as a contribution towards its costs. The sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	<i>£200</i>
<i>Preparing evidence and considering and commenting on the other side's evidence</i>	<i>£500</i>
<i>Preparation of written submissions in lieu of a hearing</i>	<i>£300</i>
<b><i>Total</i></b>	<b><i>£1000</i></b>

100. I therefore order Ulrich Justrich Holding AG to pay JustIngredients Limited the sum of £1000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 13<sup>th</sup> day of November 2018**

**Clare Boucher**  
**For the Registrar,**  
**Comptroller-General**