

O-808-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3229347
BY TASTY SNACKS LTD
TO REGISTER THE FOLLOWING AS A TRADE MARK:**



IN CLASS 29

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410529
BY COSMETIC WARRIORS LIMITED**

Background and pleadings

1. On 6 May 2017, Tasty Snacks Ltd (“the applicant”) applied to register the trade mark shown below, under number 3229347 (“the contested mark”):



The colours red, white and gold are claimed. The application was published for opposition purposes on 14 July 2017 in respect of “snacks consisting of mixtures of nuts; crisps”, in class 29.

2. The application is opposed by Cosmetic Warriors Limited (“the opponent”). The opposition is brought under ss. 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the application under both of these grounds.

3. Under s. 5(3) the opponent relies upon two earlier trade marks. The first is European Union trade mark (“EUTM”) number 1388313 **LUSH**, which has a filing date of 18 November 1999 and was entered in the register on 29 January 2001. The mark is registered in classes 3 and 5; for the purposes of these proceedings, the opponent relies upon the following goods:

Class 3: Perfumes; bath preparations; non-medicated toilet preparations; cosmetic preparations; lotions; powders and creams all for use on the skin; dentifrices; depilatory preparations; deodorants; toilet articles; preparations for care of the hair; shampoos; soaps; essential oils; massage creams and lotions.

4. The second mark relied upon is UK trade mark number 2013346 **LUSH**. The mark was filed on 7 March 1995 and was entered in the register on 15 December 1995. There is a recorded licence for Lush Limited. This mark is also registered in classes 3 and 5; the following goods are relied upon for the purpose of this opposition:

Class 3: Perfumes; non-medicated toilet preparations; cosmetic preparations; lotions; powders and creams all for use on the skin; dentifrices; depilatory preparations; deodorants; toilet articles; preparations for care of the hair; shampoos; soaps; essential oils.

5. The opponent claims that its marks have a reputation in the UK such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the applicant and the opponent, where no such connection exists. In particular, the opponent claims that it has a reputation for fresh, handmade and ethically produced goods. It claims that use of the contested mark would allow the applicant to take unfair advantage of the opponent's carefully developed reputation. The opponent also claims that use of the contested mark would cause detriment to the earlier marks' reputation, through confusion and because use of the contested mark would dilute and lessen the brand allure of the earlier marks, causing damage. It also claims that there would be detriment to the distinctive character of the earlier trade marks because the consumer would assume a link between the companies, creating a diversion of trade or an expectation that the goods would meet the standards of the opponent, i.e. fresh, handmade, ethically sourced and fair trade products. The opponent is also concerned that use of the contested mark would erode the distinctive character of the earlier marks, diminishing their attractive force and their ability to serve as a guarantee of quality products and good service.

6. Both of the marks relied upon qualify as earlier marks in accordance with s. 6 of the Act. Given their registration dates, they are also subject to the proof of use provisions contained in s. 6A and the opponent indicated that both marks have been used for all of the goods upon which the opponent relies.

7. The opponent further claims under s. 5(4)(a) of the Act that the sign **LUSH** has been used throughout the UK since 1995 in respect of the following goods and services:

Cosmetics; skincare; haircare; soaps; essential oils; perfumes and fragrances; make-up; shower and bath products; bags; clothing; retail services in store or online connected with the aforementioned goods; spa and healthcare services.

8. The opponent claims that it has established goodwill in association with the sign and that the use of the contested mark would amount to a misrepresentation to the relevant public that the applicant is connected to or endorsed by the opponent. The goodwill of the opponent would, it claims, be damaged as a consequence.

9. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of its claims. I note in particular that the applicant denies that the average consumer would make a link between the marks because the goods are disparate and that, even if s/he did, there would be any resulting damage. The applicant also indicated that it would require the opponent to provide evidence of use for all of the goods relied upon. The relevant period for genuine use is, therefore, 15 July 2012 to 14 July 2017.

10. Only the opponent filed evidence. It also filed written submissions during the evidence rounds, which I will take into account. A hearing took place before me on 5 December 2018, at which the opponent was represented by Georgina Messenger of counsel, instructed by Lewis Silkin LLP, and the applicant by Terry Rundle of Wilson Gunn.

11. At the hearing, Ms Messenger accepted that, if the opposition fails insofar as it is based upon goods in/proper to class 3, it has no more chance of success in relation to the other goods and services relied upon. That is, in my view, a sensible approach and one I will follow in considering the various grounds.

Evidence

12. The opponent's evidence consists of the witness statement of Nicola Karen Dear, with twenty-eight exhibits. Ms Dear is the Group Trade Mark Manager for the opponent and its licensee, Lush Limited. I do not intend to describe all of the evidence in detail at this juncture, particularly given the acceptance by the opponent that its best case rests with its goods in class 3 and the concessions made by the applicant (detailed below); rather, I will return to the relevant material at the appropriate point in this decision.

Proof of use

13. Mr Rundle confirmed at the hearing that the applicant accepts that the earlier marks have been put to genuine use in respect of the goods relied upon. The opponent may rely upon all of the goods in class 3, specified at paragraphs 3 and 4, above.

Section 5(3)

14. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

15. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure*

[2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the

earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

16. The applicant accepts that the earlier marks have a significant reputation in relation to the goods relied upon. I will assess the s. 5(3) ground on that basis.

Link

17. Having initially submitted that it was highly unlikely that a link would be established between the respective marks, Mr Rundle accepted at the hearing that the average consumer would make the required link.

Damage

18. Actual evidence of damage is not required. In *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded *prima facie* that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38)”.

Tarnishing

19. This is the primary basis upon which the opponent’s case under s. 5(3) is put. The head of damage was helpfully summarised in *Champagne Louis Roederer v J. Garcia Carrion S.A. et al* as follows:¹

“89. Detriment to the repute of the mark, also referred to as 'tarnishment' or 'degradation', is caused when the goods or services for which the offending

¹ [2015] EWCA 2760 (Ch)

sign is used may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The concept was described by Arnold J in *Red Bull v Sun Mark* [2012] EWHC 1929 (Ch) at [93] where he quoted the relevant passage from Kerly's Law of Trade Marks and Trade Names (15th ed) at para 9-131. Detrimental effect occurs where the later mark is used for goods or services which provoke a reaction of annoyance or displeasure whether through their intrinsic nature or because of the unpleasant mental association with the goods for which the earlier mark is reputed. It may also occur when the trade mark applied for is used in an unpleasant, obscene or degrading context, or in a context which is not inherently unpleasant but which process to be incompatible with the earlier mark's image. This leads to tarnishment whereby "the reputed mark ceases to convey desirable messages to the public: hence the detriment to its distinctive character.

90. No criticism is made of the quality of JGC's cava and there is no evidence as to whether it is good or bad of its kind. There is nothing inherently unpleasant or degrading about cava wine. The case law on this type of injury is less well developed than the other two types. It appears to me that it would be a step forward in the law to find that tarnishment is made out merely by using a sign on a product which is a cheaper and more ordinary than the product to which the mark is attached. I do not need to take any such step in order to decide this case and I therefore make no finding on the issue of tarnishment".

20. In her evidence, Ms Dear explains that one of the twin pillars of the opponent's business was, from the outset, ethical trading.² The opponent's products contain a high proportion of ingredients from "fresh, natural, fruit, vegetables and flowers".³ However, the labels at NKD5 suggest that other ingredients may be present (although these examples appear to be dated 2004). Ms Dear states that the opponent's goods have never been tested on animals and are vegetarian.⁴ A banner reading "100%

² §§3, 37.

³ §10.

⁴ §39.

vegetarian”, “ethical buying”, “fighting animal testing”, “freshest cosmetics online”, “handmade” and “naked packaging!” is said to appear at the bottom of each page of the opponent’s website, although the date from which this occurred is not given.⁵ The banner does not appear on any of the web prints at exhibit NDK10, which are dated within the five-year period prior to publication of the contested mark or a little earlier. The phrase “FRESH HANDMADE COSMETICS” does, however, appear next to the logo at the top of these pages, where they are in English; the animal testing logo is visible at p. 124, there is a link to an article apparently concerning the culling of badgers because of TB at p. 126 and a link to a page on “Mother nature’s finest” at p. 130, all of which are from the UK site.

21. A number of national press articles are provided which show the opponent’s involvement in campaigns on animal and human rights issues, some of which have involved publicity stunts in the opponent’s shop windows, the latter in 2009 and April 2012.⁶ The opponent has on several occasions supported animal rights/welfare campaigns by selling products in aid of the cause (for example, NKD16, p. 163), although it is not clear whether the latest of these have been outside Asia.⁷ I note that an article from the *Mail on Sunday*, dated May 2016, describes the opponent as “famed for its bath bombs, natural ingredients and its brightly coloured stores”.⁸

22. At the hearing, Ms Messenger stressed the natural ingredients in the opponent’s products, many of which are also foodstuffs, such as pineapple, mint and orange juice (NKD 8, p. 48, not dated). She also pointed to the presentation of the goods, which was inspired by a cheese shop (Dear, §11) and involves, for example, soaps presented unwrapped and in blocks, and samples in bowls, sometimes dressed with foods such as nuts (e.g. NKD4, p. 8).

⁵ Dear, §33.

⁶ NKD13, NKD16.

⁷ NKD15, NKD20, p. 194.

⁸ NKD20, p. 198.

23. Although much of the evidence is not dated, it is clear that the opponent has been offering ethically traded products which have a high level of natural ingredients for many years and that it continued to do so up to and beyond the date of application. I am satisfied that it was known for such products at the relevant date.

24. Ms Messenger submitted that the opponent's claim of tarnishing was on three bases. The first is the conflict between the opponent's healthy, natural products and the contested goods, which are likely to be perceived as unhealthy, of dubious origin, and containing additives and synthetic ingredients. The second is that snack foods are inherently associated with low-cost, mass-produced products without concern for ethics, animal welfare or the environment. The third is that much of the opponent's success is because of its refusal to compromise its principles, strictly controlling the outlets for its goods.⁹ Ms Messenger submitted that an association with the contested goods would lead to consumers considering the opponent as a corporate sell-out.

25. It has been accepted by the applicant that there is a link. In determining whether there will be damage, the strength of the link is relevant. In my view, the link is not strong. The goods do not coincide in nature, purpose, channels of trade or method of use; they are neither in competition nor complementary. In short, whilst there is a very superficial overlap in users (the general public), the goods are different. The word "LUSH" is the only component of the earlier marks. That same word dominates the overall impression of the contested mark. There is a high degree of visual similarity, and aural and conceptual identity. Ms Messenger argued that the earlier marks have enhanced their distinctive character through use. Mr Rundle did not seem seriously to dispute that. However, where the parties differ is in the inherent distinctiveness of the earlier marks. Ms Messenger submitted that "LUSH" is inherently highly distinctive because it has no meaning in respect of the goods; Mr Rundle countered that the word has multiple meanings, such as luxuriant or as slang for "good", and that its inherent distinctiveness is below normal. I prefer Mr Rundle's submission. "LUSH" may be perceived as indicating that the goods are luxurious or, in the case of foodstuffs, tasty

⁹ See also opponent's skeleton, §§42-45.

and therefore has laudatory connotations. Its inherent distinctiveness is, at best, below normal. The opponent's extensive use of the mark has enhanced its distinctive character but only to the extent that the mark is distinctive to a medium degree. The laudatory meaning of "LUSH" also has the effect that the consumer may interpret the word in a host of ways and that the opponent's "LUSH" mark is unlikely to be the sole meaning brought to mind or, if that is the case, only by a very small proportion of consumers. Despite the opponent's strong reputation, the association is, particularly given the disparity between the goods, unlikely to be more than fleeting, unlike in the *Nivea Trade Mark* case cited by Ms Messenger.¹⁰ In that case, once a link had been established, the earlier invented, highly distinctive mark would offer no other meaning to a consumer other than as a signifier of that opponent's business.

26. In terms of the inherent characteristics of the contested goods, I accept that both 'healthy' and 'unhealthy' snacks are covered by the specification. However, even those which are 'unhealthy' are everyday snacks unlikely to cause a particularly strong negative reaction, in contrast with goods such as those in the *Nivea Trade Mark* case (tobacco goods). The allegation of inferior quality is hypothetical and insufficient, absent other evidence going to the context of use, to found an opposition on detriment to reputation.¹¹ Ms Messenger submitted that the opponent's positioning of itself in the wellbeing market indicates the opponent's goods do more good than harm. That is hardly unusual but in any event takes the opponent no further, nor does the point regarding strict control of outlets: the gap between the goods and services, coupled with a link which is not strong, are insufficient for there to be damage to the opponent's reputation, even for goods such as crisps.

27. Taking all of the competing factors into account, I find that there is no detriment to the reputation of the opponent's marks. Any link with the earlier marks will be too transitory for there to be any real consequence for the opponent's reputation. This head of damage is dismissed.

¹⁰ *Beiersdorf AG v Just Enough Programme Limited* BL O/564/18.

¹¹ *Unite The Union v The Unite Group Plc*, BL O/219/13 at [46]-[47].

Detriment to distinctive character

28. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment)”.

It went on:

“42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.¹²

29. The opponent claims that the attractive force of its brand would be damaged through the use of the contested application. Ms Messenger submitted that the presence on the market of the contested mark for the goods at issue would result in the earlier marks being associated with mainstream, mass-market products. As a result, it

¹² See also *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch) at [133], in which the judge held that a change in consumers’ economic behaviour could be inferred from the inherent probabilities of the situation and para. 137 of - *Ziff Management Europe Ltd v Och Capital LLP* [2011] F.S.R. 11 (HC).

was submitted, consumers of the opponent's goods will purchase more widely available alternatives rather than the opponent's goods.

30. Given the weakness of the link and the large gap between the goods at issue, I do not consider it likely that the use of the contested mark will have any negative effect on the earlier marks. I am not persuaded that any bringing to mind of the earlier marks would result in the consumer supposing that the undertakings providing the goods were connected or that the claimed negative effect would ensue. There is no evidence that the economic behaviour of the relevant public would change, nor do I consider it a logical inference, having considered all of the competing factors, that there would be such a change. This head of damage is rejected.

Unfair advantage

31. Unfair advantage was considered in *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch). Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill

of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.

81. The second question is whether there is a requirement for evidence of a change in the economic behaviour of consumers or a serious likelihood of such a change. As counsel for House of Fraser pointed out, the CJEU has held that proof that the use of the sign is or would be detrimental to the distinctive character of the trade mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the trade mark is registered or a serious likelihood that such change will occur in the future: see *Intel* at [77], [81] and Case C-383/12 *Environmental Manufacturing LLP v Office for Harmonisation in the Internal Market* (unreported, 14 November 2013) at [34]-[43]. As counsel for House of Fraser accepted, there is no requirement for evidence of a change in the economic behaviour of consumers of the *trade mark proprietor's* goods or services in order to establish the taking of unfair advantage of the distinctive character or repute of the trade mark. He submitted, however, that it was necessary that there should be evidence of a change in the economic behaviour of the consumers of the *defendant's* goods or services.

82. Counsel for Jack Wills did not dispute that, in order for advantage to be taken of the trade mark's distinctive character or repute, it was necessary for there to be some change in the behaviour of the defendant's consumers as a result of the use of the allegedly infringing sign, or a serious likelihood of such a change. Nor did he dispute that what was required was a change in the behaviour of the consumers as consumers of the relevant goods and services, and in that sense in their economic behaviour. He submitted, however, that the trade mark proprietor could not be expected to adduce positive evidence that consumers had changed their behaviour as a result of the use of the sign.

83. In my judgment the correct way to approach this question is to proceed by analogy with the approach laid down by the CJEU in *Environmental Manufacturing* in the following passage:

“42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”.

32. The opponent's case is pleaded only in general terms, with the claim that confusion because of the “identical” marks would lead to a perceived economic connection and unfair advantage to the applicant. Ms Messenger submitted that the average consumer is more likely to purchase the applicant's goods because of an association with the opponent. She relied in particular upon the use of both marks in a way which associates them with food and the perception of the applicant's goods as healthy food, as a result of the link with the opponent. Mr Rundle argued that there would be no such consequence.

33. I am not persuaded that the applicant would gain any advantage through use of the contested mark, let alone an unfair one. The presentation of the opponent's goods in a way which resembles food displayed in a delicatessen is not, in my view, an impression which would be clearly made upon the average consumer. Even if it were, there is a world of difference between including edible ingredients in toiletries and the

manufacture of foodstuffs. Moreover, whilst the opponent may include in its goods more natural ingredients than many other manufacturers, it is not a practice which is either new or unusual in the industry. I note Ms Messenger's submissions regarding the concept of natural, 'healthy' products but the distance between the goods is too great, particularly when considered with a relatively weak link, for any image which the opponent may have for natural ingredients in its products to be transferred to the applicant. Nor can I see any other way in which unfair advantage would be taken. There is no risk of an unfair advantage.

34. The claim under s. 5(3) is dismissed.

Section 5(4)(a)

35. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

36. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341,

HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)".

37. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

38. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander Q.C., sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”.

39. There is no claim and no evidence that the contested mark was in use prior to the date of application. That being the case, the relevant date is 6 May 2017.

Goodwill

40. The applicant accepts that the opponent had, at the relevant date, a protectable goodwill in respect of goods in class 3.

Misrepresentation

41. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101”.

And later in the same judgment:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion”.

42. It appears to be common ground between the parties that there is no need for a common field of activity in order to establish a claim in passing off. In *Harrods Limited v Harroddian School Limited* [1996] RPC 697 (CA), Millet LJ made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch.

282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

“...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant”: *Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is

likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

43. The signs are highly similar and the goodwill is significant. For all of the goods, the consumer is a member of the public. However, the opponent's sign is not, as explained above, inherently highly distinctive; even with the extensive use which has been made of it, it is only distinctive to a medium degree. The allusive nature of the word “lush”, in my view, makes it less likely that any connection will be made between these two businesses. What is more, the fields of activity are wholly separate. The inclusion of natural ingredients in the opponent's does not, in my view, make a connection probable. The opponent contends that the nature of the displays in its stores, in which its goods are said to be presented as foodstuffs, is relevant. I accept that the way in which the sign has been used is relevant. However, I am not persuaded that the presentation of goods in the manner claimed by the opponent is sufficiently marked to make an impression on the relevant public, or that such an impression, if it were made, would

cause the public to associate the two businesses. For all these reasons, there will be no misrepresentation. The s. 5(4)(a) ground of opposition is dismissed.

Final remarks

44. As the opponent has accepted that, were its opposition unsuccessful on the basis considered above, it would also be unsuccessful based upon its other goods and services, there is no need for me to consider the position further.

Conclusion

45. The opposition has failed. Subject to appeal, the application will proceed to registration.

Costs

46. The applicant has been successful and is entitled to an award of costs. The parties are agreed that an award on the scale is appropriate (Tribunal Practice Notice 2/2016 refers). The award below takes into account in particular that the applicant filed no evidence. I award costs to the applicant as follows:

Considering the notice of opposition and preparing a counterstatement:	£200
Considering the other party's evidence	£500
Preparing for and attending the hearing	£800
Total:	£1500

47. I order Cosmetic Warriors Limited to pay Tasty Snacks Ltd the sum of **£1500**. This sum is to 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 14th day of December 2018

**Heather Harrison
For the Registrar**