

O/850/22

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3670910
BY DOLLY'S NATURAL APIARY LTD
TO REGISTER THE TRADE MARK:



IN CLASSES 3 AND 30

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 428943
BY SEO GLOBAL NET LTD

Background and pleadings

1. On 20 July 2021, Dolly's Natural Apiary Ltd ("the applicant") applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3670910 ("the contested mark"). The contested mark was published in the Trade Marks Journal for opposition purposes on 10 September 2021. Registration is sought for the following goods:

Class 3: Bath bombs; Bath soap; Bath powder; Bath crystals; Bath flakes; Bath soaps; Bath salts; Cosmetic bath salts; Cosmetics; Cosmetic soaps; Cosmetic soap.

Class 30: Herbal honey; Honey; Honeys; Natural honey; Natural ripe honey; Honey [for food]; Sweet spreads [honey].

2. On 9 December 2021, SEO Global Net Ltd ("the opponent") filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the goods of the application. To support its claim, the opponent relies upon the following trade marks:

NATURAL APIARY

UK registration number: 3325038

Filing date: 17 July 2018

Registration date: 19 October 2018

("the first earlier mark")



UK registration number: 3326987¹

Filing date: 25 July 2018

Registration date: 11 January 2019

("the second earlier mark")

3. The first earlier mark is registered in respect of goods in classes 4, 8, 9, 20 and 31, while the second earlier mark is registered in respect of goods in classes 4, 8, 9, 20, 21 and 31. For the purpose of the opposition, all of the opponent's goods under both of the earlier marks are relied upon. These are detailed in the Annex to this decision.

4. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with section 6 of the Act. Although the applicant has requested that the opponent provide proof of use of the earlier marks,² they have not been registered for five years or more at the filing date of the application; therefore, they are not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier marks are registered without having to establish genuine use.

5. In its notice of opposition, the opponent essentially argues that the respective goods are similar and that the marks are similar. The opponent contends that these factors will give rise to a likelihood of confusion, submitting that, in particular, the competing marks will be perceived as variations of the same brand.

6. The applicant filed a counterstatement denying the ground of opposition. Contrary to the opponent's arguments, the applicant disputes the competing marks are similar

¹ The registration consists of a series of two figurative marks. However, as the only difference between the marks in the series is the use of colour in one and greyscale in the other, I will refer to them in the singular (i.e. "the second earlier mark") unless it becomes necessary to distinguish between them.

² Applicant's counterstatement, paragraph 21

to any meaningful degree. The applicant also denies that the goods are identical or similar. As a result, the applicant denies that there is a likelihood of confusion, whether direct or indirect.

7. The opponent is professionally represented by Katarzyna Eliza Binder-Sony, whereas the applicant represents itself. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Neither filed written submissions in lieu of an oral hearing, though I note that the opponent filed written submissions during the evidence rounds. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

Preliminary Issue

9. Within its counterstatement, the applicant has attempted to prove genuine use of the contested mark. I note that the following evidence has been provided:

- A screenshot of a Certificate of Incorporation, which shows that Dolly's Natural Apiary Ltd was registered with Companies House on 2 June 2020 (Exhibit 1);
- Screenshots of information relating to domain names that have been registered for use by the company (paragraph 19);
- Google search results and Google image search results for the term "dollys natural apiary" (Exhibit 2);

- Screenshots of a Facebook page entitled “Dolly’s Natural Apiary” which includes the image of the applicant’s mark (Exhibit 3);
- Screenshots of an Instagram account which includes a picture of the applicant’s mark used on what appears to be a jar of honey (Exhibit 4);
- Screenshots from the website nextdoor.co.uk promoting products bearing the contested mark (Exhibit 5).

10. The applicant has also made submissions on the matter. For example, it argues that it has been running a small, family business since 2016, and that its mark has a very strong online presence and is well known to its customer base.³

11. Whilst I note the contents of the evidence and submissions on the point, I must clarify that they will have no bearing on the outcome of my decision. Firstly, the evidence has not been submitted in the correct format at the appropriate time. Secondly, the proof of use provisions in section 6A of the Act apply to earlier marks (that being a registered trade mark which has an earlier filing date than the trade mark in issue) that have been registered for five years or more at the filing date of the trade mark in issue. As the contested mark is not yet registered and does not fall into this category of trade marks, the applicant is not required to demonstrate proof of use. When assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which that mark might be used if it were registered.⁴ As a result, even though the applicant has attempted to demonstrate the ways in which the contested mark is used, my assessment later in this decision must take into account only the applied-for mark – and its specification – and any potential conflict with the opponent’s earlier marks.

³ Applicant’s counterstatement, paragraphs 20 and 21.

⁴ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

Decision

Section 5(2)(b)

12. Sections 5(2)(b) and 5A of the Act read as follows:

“5(2) 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”.

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

Case law

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

14. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

15. Put simply, this means that whether the goods and services are in the same or different classes is not decisive in determining whether they are similar or dissimilar. Therefore, what matters is the actual goods at issue and whether they are similar or not having regard to the case law that follows.

16. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons

(see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

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

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

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

whilst on the other hand:

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

21. The goods to be compared are outlined at paragraph 1 and in the Annex to this decision.

Class 3

Bath bombs; Bath soap; Bath powder; Bath crystals; Bath flakes; Bath soaps; Bath salts; Cosmetic bath salts; Cosmetics; Cosmetic soaps; Cosmetic soap.

22. The opponent argues “[...] there is a clear link between the goods in class 3 in the specification of the opposed mark and goods in class 4 in the specification of the earlier mark, since beeswax can serve as an ingredient of the cosmetics sold under the opposed mark.” However, the fact a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.⁵ I certainly consider that to be the case here. The respective goods differ in nature: the opponent’s goods comprise beeswax as an ingredient for use in the manufacture of other goods, whereas the applicant’s goods are finished products for bathing or for skincare. The method of use and the intended purpose also differ as the opponent’s goods will be used in the manufacture of cosmetics or other goods for the purpose of creating a finished product. In contrast, the applicant’s goods are already finished goods used for bathing or applied to the body for the purpose of improving its appearance. The trade channels would differ as it is not typical of trade for undertakings that offer bath preparations and cosmetics to also offer beeswax for use in manufacturing. The users are likely to be different as the users of the applicant’s goods will be members of the general public looking for items to use at home for bathing and for their skin. Conversely, users of the opponent’s goods are more likely to be business users that will purchase beeswax for use in the manufacturing of other products, which they may go on to sell. The goods are not in competition as beeswax for use in manufacture will not typically be used by consumers as an alternative to bathing products and cosmetics. Neither are the goods complementary as, despite, for example, some cosmetics containing beeswax as an ingredient, consumers will not expect the

⁵ *Les Éditions Albert René v OHIM*, Case T-336/03, paragraph 61

responsibility for both these products to rest with the same undertaking. Consequently, I find that the respective goods are dissimilar.

23. I should add that I have also considered the other goods relied upon by the opponent. However, to my mind these share no obvious points of similarity with the applicant's goods in class 3 and, therefore, do not put the opponent in a more favourable position.

Class 30

Herbal honey; Honey; Honeys; Natural honey; Natural ripe honey; Honey [for food]; Sweet spreads [honey].

24. The opponent argues that the goods in classes 8, 9, 20, 21 and 31 of the earlier marks are "all related to beekeeping and thus naturally linked to the byproduct of this activity – honey." However, these goods differ in nature. The opponent's goods consist, broadly, of tools, protective clothing, beehives (and parts thereof) and animal feed, most of which appear to relate to apiculture itself. The applicant's goods are food products for consumption, albeit being by-products of apiculture. The method of use and intended purpose are different as the opponent's goods will be used for the housing, feeding, and upkeep of bees, or for the protection of their keepers, whereas the applicant's goods are for consumption, usually with other food or drink for the purpose of improving/sweetening the taste. The trade channels differ as businesses that offer beehives, hive tools, protective clothing for beekeeping and food for bees would not typically also offer the by-products of beekeeping, such as honey products. Likewise, honey products are commonly found in retail establishments, such as supermarkets, which do not ordinarily offer the opponent's goods. Users would also be different. The users of the opponent's goods would be consumers interested in keeping bees themselves, either as a hobby or for business purposes. By contrast, the users of the applicant's goods are likely to be members of the general public that enjoy eating honey. The goods are not competitive: I can see no reason why a consumer would purchase the opponent's goods over the applicant's goods, and vice versa. Neither are the goods complementary as although the opponent's goods may be important in the manufacture/production of honey and honey-based products,

consumers would not believe that the responsibility for the respective goods lies with the same undertaking. In light of all this, I find that the respective goods are dissimilar.

25. For the sake of completeness, I have also considered the other goods relied upon by the opponent. However, as they share no obvious points of similarity with the applicant's goods in class 30, they do not put the opponent in a more favourable position.

26. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion,⁶ my findings above (i.e. that the respective goods are all dissimilar) mean that the opposition must fail.

Conclusion

27. The opposition under section 5(2)(b) of the Act has failed. Subject to any appeal, the application will proceed to registration in the UK.

Costs

28. As the opposition has been unsuccessful, ordinarily the applicant would be entitled to an award of costs. However, as it has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated 22 July 2022 that, if the pro-forma was not completed, no costs would be awarded. The applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

Dated this 30th day of September 2022

**Sarah Wallace
For the Registrar**

⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

Annex

Goods of UK registration no. 3325038

- Class 4: Beeswax for use in further manufacture; Beeswax for use in the manufacture of cosmetics; Beeswax for use in the manufacture of candles.
- Class 8: Hive tools.
- Class 9: Articles of protective clothing for wear by beekeepers, namely, beekeeping suits, hats, veils, gloves, pants, shirts and jackets for use in protecting against injury or bee stings.
- Class 20: Beekeeping frames, namely, frames for beehives; Beehives; Comb foundations for beehives; Beehives; Sections of wood for beehives.
- Class 31: Bee feed; Animal feed; Animal feed for strengthening animals; Dietary compounds for strengthening animals.

Goods of UK registration no. 3326987

- Class 4: Beeswax for use in further manufacture; Beeswax for use in the manufacture of cosmetics; Beeswax for use in the manufacture of candles.
- Class 8: Hive tools.
- Class 9: Articles of protective clothing for wear by beekeepers, namely, beekeeping suits, hats, veils, gloves, pants, shirts and jackets for use in protecting against injury or bee stings.
- Class 20: Beekeeping frames, namely, frames for beehives; Beehives; Comb foundations for beehives; Beehives; Sections of wood for beehives.
- Class 21: Swarm catchers and queen catchers for beekeeping.

Class 31: Bee feed; Animal feed; Animal feed for strengthening animals;
Dietary compounds for strengthening animals.