

O/0385/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003695820
BY PETER KERTELS TO REGISTER:**

Eros Bodyglide

AS A TRADE MARK IN CLASSES 3, 5, 10 & 35

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 432420 BY
W STERNOFF LLC**

BACKGROUND AND PLEADINGS

1. On 16 September 2021, Peter Kertels (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The application was published for opposition purposes on 7 January 2022 and registration is sought for the goods and services set out in the **Annex** of this decision.
2. By virtue of the applicant’s mark being filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the European Union, it is deemed to have the same filing date as the proprietor’s identical EUTM, being 11 April 2017. This is, therefore, the relevant date for the purpose of these proceedings.
3. On 7 April 2022, the applicant’s mark was opposed by W Sternoff LLC (“the opponent”). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). In respect of the section 5(2)(b) ground, the opponent relies on the following marks:

BODY GLIDE

UK registration no. 900357376

Filing date 13 September 1996; registration date 20 January 1999

Priority date: 15 March 1996 (USA)

Relying on all goods, namely:

Class 3: An applicant and coating for superficial epidermal anti-chafing balm.

(“the opponent’s first mark”);

BODYGLIDE

UK registration no. 900559138

Filing date 11 June 1997; registration date 17 June 1999

Priority date: 23 May 1997 (USA)

Relying on some goods, namely:

Class 5: Solar products.

("the opponent's second mark");

BODYGLIDE

UK registration no. 903984549

Filing date 11 August 2004; registration date 3 January 2006

Priority date: 2 August 2004 (USA)

Relying on some goods, namely:

Class 3: Non-medicated skin care preparations.

Class 5: Medicated skin care preparations.

Class 25: Men's, women's and children's clothing; and insoles.

("the opponent's third mark");

FOOTGLIDE

UK registration no. 905333943

Filing date 22 September 2006; registration date 30 August 2007

Relying on all goods, namely:

Class 3: Skin care preparations and substances; skin lubricants, anti-friction preparations and substances, barrier preparations and substances; sun protection preparations and sun screens.

Class 5: Medicated skin care preparations and substances.

("the opponent's fourth mark"); and

SKINGLIDE

UK registration no. 910761369

Filing date 27 March 2012; registration date 13 August 2012

Priority date: 28 November 2011 (USA)

Relying on all goods, namely:

Class 3: Non-medicated skin care preparations.

("the opponent's fifth mark").

4. The opponent's marks are all comparable marks based on earlier EUTMs. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.
5. Generally, the opponent's position under its section 5(2)(b) ground is that the marks are similar, that the respective goods are identical or highly similar and that the services are similar. The opponent also claims that all of its marks enjoy an enhanced degree of distinctive character due to their unusual and fanciful nature. As a result, the opponent claims that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.
6. Under the section 5(3) ground, the opponent only relies on its first through third marks for the same goods listed above. The opponent claims that its marks enjoy a reputation and due to the similarity between the marks at issue, the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between them. As such, the opponent claims that use of the applicant's mark would take unfair advantage of its reputed marks. Further, the opponent argues that the applicant, in using his mark, would cause detriment to the reputation and/or distinctive character of the earlier marks.

7. The applicant filed a counterstatement wherein he, generally, made a series of denials in respect of the claims against him. In addition, he requested that the opponent provide proof of use for its first through fourth marks.
8. The applicant is represented by Mewburn Ellis LLP and the opponent is represented by Barker Brettell LLP. Both parties filed evidence in chief. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

10. The opponent's evidence came in the form of the witness statement of Mr William R Sternoff dated 19 January 2024. Mr Sternoff is the CEO and founder of the opponent. His statement is accompanied by 18 exhibits, being WRS1 to WRS18, and was adduced to prove use of the opponent's marks and that in support of its claims that the marks relied upon under section 5(3) ground enjoy a reputation.
11. The applicant's evidence came in the form of the witness statement of Karolina Fryzlewicz dated 5 April 2024. Ms Frylewicz is a Technical Assistant and a part-qualified Trade Mark Attorney at the applicant's representative firm. Her statement is accompanied by two exhibits, being KM1 and KM2. The evidence comprises some independent internet research in respect of the opponent's brand and in respect of a Google search for "what should not be used as lube".

12.I do not intend to summarise the evidence in full here (or the submissions of the parties, for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

13.An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. Section 6A is also relevant. It reads:

“(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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.

(5)-(5A) [Repealed]

(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.”

15. Section 100 of the Act is also relevant. It reads:

“100. 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.”

16. As the opponent's marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

17. Given their earlier filing dates (and priority dates in some instances), the opponent's marks all qualify as earlier trade marks under the above provisions. The opponent's first through fourth marks all completed their registration processes over five years prior to the deemed filing date of the applicant's mark. The fifth mark did not so is, therefore, not subject to the use provisions. As set out above, the applicant requested that the opponent provide proof of use in respect of its first

through fourth marks. As a result, the opponent's first through fourth marks are subject to the proof of use assessment.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(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]; *Ferrari* at [32].

(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]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]; *Ferrari* at [33].

(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].”

19. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period prior to the deemed filing date of the applicant’s mark, being 11 April 2017. The relevant period is, therefore, 12 April 2012 to 11 April 2017 (“the relevant period”).

20. As the opponent’s marks are comparable marks based upon an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is

relevant to the present assessment.¹ As the relevant period falls entirely prior to IP Completion Day, the EU as a whole is the relevant territory. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice for the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”² because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

¹ See paragraph 4 of Tribunal Practice Notice 2/2020

² *Jumpman* BL O/222/16

22. Before proceeding to consider the evidence, I note that in its written submissions in lieu, the applicant claimed that the opponent's evidence of use was insufficient and that, if genuine use was to be found, it must be limited to "an applicant and coating for superficial epidermal anti-chafing sports balm" or, at best, "an applicant and coating for superficial epidermal anti-chafing balm". The submissions of the applicant are noted and while I will not reproduce them here, I can confirm that I have taken them into account. On this point, I will say that despite the submissions, and as is always the case with genuine use assessments in proceedings before the Tribunal, my assessment is to be based on my own assessment of the evidence before me. Having said that, I note that some of the criticisms raised are in line with my own issues with the evidence, which I will expand upon below.

Evidence of use

23. The opponent's evidence begins with an extensive background as to the origin of the company. This includes information regarding the intention behind the product the opponent sells, discussions surrounding investments made by the witness, being Mr Sternoff and reference to use made of the marks in the USA. It is noted that during this section of the evidence, the opponent confirms that it was founded in 1997 and claims that, at that time, it began selling (and continues to sell) products under the marks relied upon (being "an applicant and coating for superficial epidermal anti-chafing balm", "topical products, namely analgesics", "solar products" and "non-medicated skin care preparations"). However, the majority of this evidence is not relevant to the issue I must consider here on the basis that it not only relates to use in the USA but activities of the opponent prior to the relevant period. Therefore, I will say no more about it.

24. In respect of use in the relevant territory, I note that the evidence sets out that between 2003 and 2017, it entered into agreements with manufacturers, representatives and wholesale distribution companies in Brighton, London,

Southport and Bristol. These included companies such as Jogshop in Brighton, Contrabands Ltd and Rain City Brands in London, DJM Products in Southport and UNNU in Bristol. While noted, I have nothing in the evidence before me speaking to the reach of these companies and the range of their agreements.

25. While on the point of retailers offering the opponent's goods, the evidence does go on to state that in Sweden, 'BODY GLIDE' is sold in 'Stadium' stores, which has over 100 locations in that country. Additionally, in the UK alone the opponent claims that prior to the COVID-19 pandemic, there were hundreds of retailers of the opponent's goods across the UK. Some of these closed since the pandemic or moved their business primarily online. A printout is provided that shows a sample of the list of retailers.³ I do not intend to reproduce the entirety of this list but note that it includes retailers such as Evans Cycles, Core Running and Total Fitness. An issue with this is there is nothing sufficiently clear in respect of what is meant by 'prior to the COVID-19 pandemic'. The pandemic did not occur until March 2020, being almost 3 years after the conclusion of the relevant period. As such, it is possible that the reference to hundreds of retailers in the UK may cover stores that sold the opponent's goods from April 2017 onwards and not necessarily those that sold the goods during the relevant period.

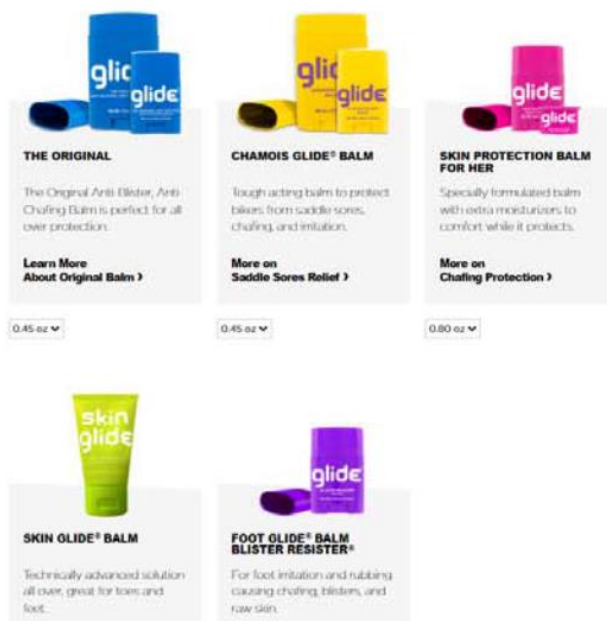
26. There are numerous screenshots provided of the opponent's website. These were obtained via the internet archive facility, the Wayback Machine, and show printouts from 2 March 2000 to 2 February 2022.⁴ Of the screenshots relevant to the present assessment, I note that these range from 22 April 2013 to 17 July 2015. The websites all show images of the opponent's products and while they are not necessarily all that clear, I note that prior to (and including) the printout dated 22 April 2013, the 'BODY GLIDE' products appear as follows:

³ WRS09

⁴ WRS10



27. While not entirely clear, the 'BODY GLIDE' and 'SKIN GLIDE' branding can be made out on these products. As for the screenshots, from 27 May 2014 onwards, I note that the websites show products that appear packaged as below:



28. While appearing on the 'BODY GLIDE' website, the goods themselves no longer appear to be clearly branded as 'BODY GLIDE', though I do note that 'SKIN GLIDE' and 'FOOT GLIDE' products maintain their branding. On this point, I note that no additional packaging is shown and neither are there any images of the rear of the product to determine if the relevant 'BODY GLIDE' branding appears anywhere else.

29. In addition to the above, I note that the screenshots are all taken from the opponent's US facing '.com' website. While I appreciate that they may be accessible globally (more on this below), some screenshots refer to free shipping for customers in the US and, further, show endorsements from American based publications, such as The Chicago Tribune, for example. This clearly indicates that the website has a focus on the US consumer.

30. In respect of the website mentioned in the preceding paragraphs, I note that the opponent has provided figures in respect of visitors from the EU and the UK during the relevant period.⁵ These are as follows:

Year	UK visitors	EU visitors
2013 (April to December only)	6,723	6,857
2014	10,669	9,024
2015	24,614	21,237
2016	19,792	16,858
2017	26,150	20,396
Total	87,948	74,372

31. While these visitor figures are noted, there is nothing to suggest whether these were unique visits or whether they cover multiple visits from the same user. Additionally, there is nothing before me to indicate whether the opponent's website

⁵ WRS11

actually offered the sale of goods to EU/UK consumers (as opposed to just US sales) and, further, I have no information as to whether these visits actually resulted in any sales made via any other form of retail (such as in stores, for example).

32. The opponent has provided a number of reviews it has achieved via its website between 2012 and 2021.⁶ I appreciate that a number of the reviews are from within the relevant period, a lot of them are not. I do not intend to discuss all of the reviews but note, by way of example, one review makes reference to the reviewer being from Croatia, being in the EU. However, that reviewer expressly states that they cannot buy the product there and, instead, gets them from their friend when they visit from the USA. Further, some reviews specifically appear to be from USA based customers in that they refer specifically to locations in the US such as the city of Vegas and WA (presumably being Washington) and Florida, both of which being states. As a result, I have some difficulty in accurately attributing these reviews to UK or EU based customers.

33. While not reviews per se, there is another printout shown from an actual UK facing website, being 'runnersworld.co.uk'.⁷ In this printout, there is a discussion between users on a forum regarding recommendations for balms to prevent chafing when running. While noted, the posts all pre-date the relevant period.

34. While on the topic of Runners World, I note that a printout from its '.com' website is provided regarding the 'BODY GLIDE' products.⁸ However, this is from 2021 and, therefore, after the relevant period so it is of no assistance here.

35. The evidence goes on to discuss the opponent's presence on Amazon.com. A screenshot of a listing for an 'anti-chafe balm stick' is provided in evidence.⁹ While a US facing website, the evidence does confirm that the opponent sells goods to

⁶ WRS6

⁷ WRS7

⁸ WRS8

⁹ WRS12

consumers in the UK from this website. On this point, I note that the printout provided does include some reviews from UK-based customers. There are seven reviews provided but they are all from after the conclusion of the relevant period.

36. Turning to sales of the products, the opponent's evidence sets out that it has created and sustained a high share of the relevant market. No information is provided as to the level of the share claimed and neither is there anything to suggest what precisely is the relevant market. All it says in respect of the latter point can be found at paragraph six of Mr Sternoff's evidence which sets out that the products are relatively niche and are aimed at a niche target market. But again, it does not specify what this market is or provide any evidence in support of this claim.

37. The first mention of sales figures comes in respect of the figures for 2003 which confirm that, in the EU and the UK, the opponent sold 9,600 units across the full range of its 'BODY GLIDE' products. This equated to \$35,009 in gross revenue. While this information is from before the relevant date, the opponent does go on to provide turnover figures for different countries in the EU as well as the UK. The breakdown provided for these figures include individual revenue figures for countries including Denmark, France, Germany, Greece, Ireland, Netherlands, Spain, Sweden and the UK. Rather than reproduce all of the figures individually, I will only refer to the total amounts provided for each year across all of these countries. In respect of the years for which these figures are provided, I note that it is not stated when the financial year of the opponent begins and ends but, for completeness, I will reproduce all figures below (even though the financial year of 2012¹⁰ is likely to include figures from prior to the relevant period):

¹⁰ I say this because the relevant period begins in April 2012. If it is the case that the financial year runs from April to March of any given year, the 2012 figures may completely fall outside of the relevant period. If not (and the figures are for the calendar years), then at least some of these figures will fall outside of the relevant period.

Year	Revenue (\$)
2012	138,156
2013	219,414
2014	146,593
2015	303,680
2016	397,620
2017	336,226
Total	1,541,689

38. As I have explained above, the figures for 2012 may fall outside the relevant period.

Even if the entirety of the figures do not, it is inevitable that some will. As for the 2017 figures, based on a financial year of April to March of that year, then I am content to conclude that it falls entirely within the relevant period. However, if it is the case that the opponent's financial year is the calendar year for 2017, then it is again likely that some of the 2017 figures fall outside of the relevant period. All this is to say that there is no breakdown of the figures provided or information regarding the opponent's financial year. As such, it makes the above figures somewhat imprecise as I cannot say with a degree of certainty that *all* figures from 2012 to 2017 are relevant here. This is something that I will bear in mind going forward.

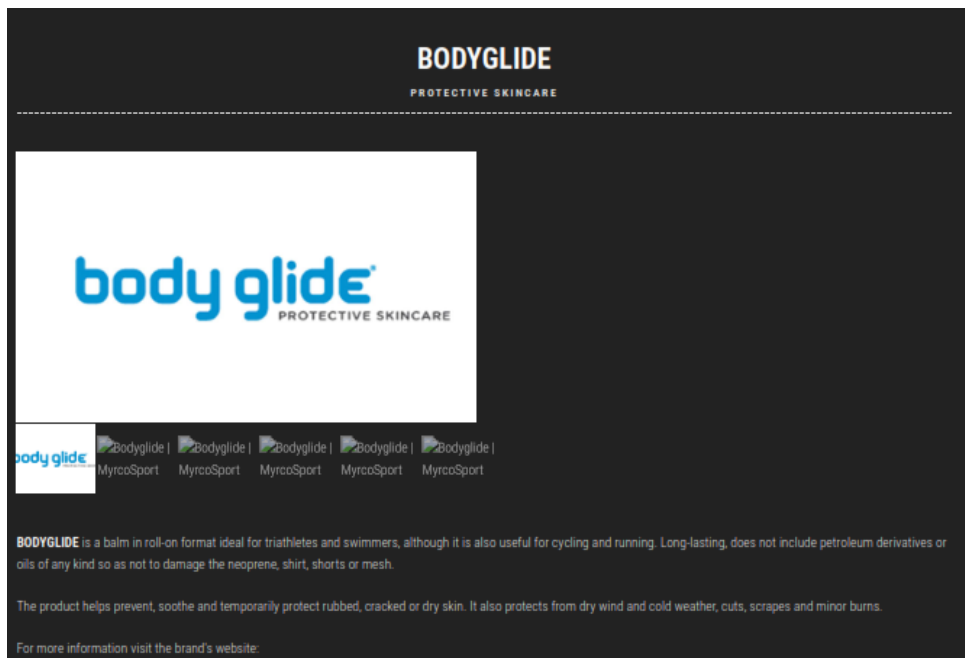
39. In presenting the above figures, the opponent sets out that they relate to the 'BODYGLIDE Trade Marks', being a defined term in the witness statement of Mr Sternoff. At paragraph 11 of his statement he sets out that this definition covers the first three marks, being the opponent's 'BODY GLIDE' marks. While noted, I am not convinced that the turnover figures can be said to relate to these marks only. I say this because in filing evidence in support of the turnover, the opponent provided approximately 40 pages worth of sample invoices to various customers across the UK and EU.¹¹ I appreciate that the invoices all show the wording 'BODY GLIDE', however, they expressly cover some goods that are not within the 'BODY

¹¹ WRS14

GLIDE' range of goods. For example, the branding 'Footglide' appears throughout the invoices. In addition, the invoices refer to a product under a branding not relied upon under the present proceedings, being 'Chamoisglide'. On this point, I note that a range of other products are not branded at all (such as reference to anti-chafe balms, anti-chafing sticks, 'For Her' products, Liquified powder tubes and Cycling sticks). In respect of some of the products that are not referred to by a specific branding, I note that the evidence I have reproduced as paragraph 27 above shows the 'For Her' products as not being branded as 'BODYGLIDE'. I also consider it reasonable to assume that the 'Cycling sticks' are sold under the 'CYCLE' brand, again shown at paragraph 27 above. Therefore, it cannot simply be inferred that the unbranded goods are branded as 'BODYGLIDE' simply because the invoice is referred to as a 'BODYGLIDE' invoice.

40. In respect of the invoices provided, it is not confirmed who the customers are as all details aside from the destination country are redacted. That being said, I note that the total sales amounts of the invoices seem to reflect bulk purchases and, further, a majority of the goods list 'suggested retail prices' in the description columns. As such, it is reasonable to infer that they cover the sale of goods to retailers for onward sale to end consumers in the respective countries. This presents a further problem for the opponent as while the invoices themselves include the wording 'body glide', there is nothing to suggest how the end consumers would be confronted with this branding in the retail environments. On this point, I note that various printouts are provided from third party retailers' websites as they appeared during the relevant period.¹² These were obtained from the Wayback Machine and while they refer to 'Body Glide' branding, there is nothing to actually show how the goods appeared to consumers. For example, the following printout from Spanish retailer, mycrosport, shows a webpage that simply refers to the brand at large and not the actual products:

¹² WRS15



41. In considering all of the printouts, there is one printout provided (being a printout from a Swedish retailer dated 10 March 2017) that covers the listing of a product referred to as 'BODYGLIDELEATHERGLIDEANTI-FRICTIONBALM'. While 'BODYGLIDE' is mentioned in the name of the product, there is also reference to 'Skin glide' in the description, being another brand of the opponent. Further, it is noted that the name also includes reference to 'LEATHERGLIDE', which could possibly be reference to another branding used by the opponent. Lastly, an image of the actual product is not shown.

42. In respect of the above issue regarding what goods the invoices cover, I refer back to the fact that the goods shown on the website appear not to be branded as 'BODY GLIDE' from 27 May 2014 onwards. This point is compounded further by the introduction of the opponent's social media evidence, that I will discuss further below.

43. Returning to the topic of the opponent's revenue, I note that further on in the evidence, the opponent has provided a detailed printout of its revenue from 2003

to 2021.¹³ This includes information as to unit sales which was not present in the table provided in the narrative evidence. In comparing this printout to the total figures provided in the table above, I note that the data in the table above is identical to the data in this printout. As such, I consider it likely that the opponent formulated the table provided in its narrative evidence from this printout, whilst omitting the unit sales figures. For completeness, the unit sales figures are 35,640 for 2012, 60,000 for 2013, 40,915 for 2014, 78,760 for 2015, 116,230 for 2016 and 97,392 for 2017. In total, this amounts to 428,937 unit sales. As was the case with the revenue figures, I am unable to consider how the 2012 and 2017 figures are broken down (so as to whether they fall within the relevant period or not) and, further, the issue with regard to the branding on the opponent's goods remains relevant here.

44. The evidence goes on to discuss the opponent's social media presence. A printout of the opponent's Irish account is provided which, while dated after the relevant date, includes posts from the relevant period.¹⁴ In respect of the posts on this account, I note that those from the relevant period show products that appear packaged as follows:



¹³ Page 14 of WRS16

¹⁴ Pages 1 to 11 of WRS16

45. I note that the opponent's Irish Facebook page also offers insight in to how the opponent's goods actually reach the market. This comes via a post regarding the 'Dublin City Marathon Expo' which I note contains the following image of a display stand of the opponent:



46. The post that includes this image is dated 27 October 2017, being a few months after the conclusion of the relevant period.

47. On the point of the opponent's social media presence, I note that the cover image of the opponent's main Facebook account (rather than just its Irish account) is also shown and I note that it includes products that look very similar to those reproduced at paragraph 44 above.¹⁵ However, the products shown in the cover image include the wording 'body glide' at the top of the packaging. While noted, the printout of the account was captured on 8 December 2023 and, as such, it is not possible for

¹⁵ See page 2 of WRS17

me to determine whether or not this cover image was present on the account during the relevant period.

48. I note that printouts of the opponent's Instagram, X/Twitter and YouTube accounts are provided.¹⁶ In terms of followers of these accounts, I note that they have 21,100, 4,983 and 56, respectively. The opponent's narrative evidence confirms that the videos uploaded to the opponent's YouTube account have amassed 50,000 views. Lastly, in respect of the Facebook printout, I note that this account has 10,000 likes and 10,000 followers. While all of this is noted, these appear to be the global accounts for the opponent and the information is all taken from printouts taken from over 6 years after the conclusion of the relevant period. Therefore, I do not consider that this evidence is of any real assistance to the opponent as it is incapable of reflecting the position during the relevant period.

Assessment of the evidence

49. In looking at the opponent's level of use, I remind myself that it sold approximately 428,000 units for a total of approximately \$1.5 million during the relevant period. In the face of such figures, it could be said that the opponent's sales and turnover indicate a respectable level of use. That being said, upon assessing the evidence in detail and going beyond the surface level of the same, I am of the view that it presents a number of significant issues. I will discuss these in turn below.

50. The first issue relates to the overall size of the use. On this point, I remind myself that the opponent claims that the market in which it operates is a niche one and that its presence in said market has resulted in a sizeable market share. In my view, these are somewhat vague claims as nothing further has been provided in support of the same. For example, no evidence of the opponent's actual market share or details of the market it operates in have been provided. In considering the

¹⁶ See pages 3, 4 and 5 of WRS17, respectively.

goods the opponent sells, I am of the view that they are not particularly niche and will, instead, be targeted at the general public at large. While I appreciate that they may have a specific aim at those consumers who suffer from chafing or blistering, I have nothing to suggest how many consumers suffer from such ailments. On this point, it is my understanding that these consumers are still likely to represent a large portion of the general public at large across the relevant territory. As a result, while I appreciate that I have no evidence as to the size of the market, I consider it reasonable to conclude that it is likely to be a large one. When considering the unit sales and turnover evidence in the context of a market of this size, it is clear that it represents a low level of use. In respect of a low level of use, I remind myself that use need not be quantitatively significant in order for it to be deemed genuine. That being said, and as alluded to above, there are issues with the evidence beyond the simply low level of use.

51. I remind myself that the opponent relies on two separate brands in attempting to prove use. These are 'BODY GLIDE' (or 'BODYGLIDE') and 'FOOTGLIDE'. While not an issue in and of itself, the opponent has not sought to provide any breakdown whatsoever as to how the turnover or unit sales can be said to apply to either brand. In considering the 40 pages of invoice evidence provided, I note that only 14 entries relate to the 'FOOTGLIDE' brand (with some simply referred to as 'FOOT' which is in line with the product packaging referred to at both paragraphs 27 and 44 above). I also note that the information regarding the actual number of products covered by these orders have been redacted so I'm unable to determine their volume. Additionally, there are some brands included in the invoices that relate to separate brands such as 'Chamois Glide' and 'Cycle'. Further, there are some products that show no reference in their description to any branding whatsoever so it is unclear what brand of the opponent these goods fall under. As a result, and without any breakdown of the figures, it is not possible for me to assess the unit sales/turnover with any degree of certainty so as to be able to accurately attribute the relevant brands with the appropriate turnover/unit sales.

52. A further issue is that the evidence is not particularly consistent when it comes to the packaging of the opponent's actual goods. While I appreciate that its '.com' website includes reference to 'BODY GLIDE', as does its social media accounts, the goods do not appear to have been consistently branded in the same way throughout the entirety of the relevant period. I have reproduced the various ways in which the goods appear throughout my evidence summary above. I can only say with certainty that only prior to 22 April 2013 did the opponent's goods appear to actually bear the 'BODY GLIDE' branding. Thereafter, it appears that the branding used is without the words 'BODY GLIDE'. On this point, I refer again to the images of products from the opponent's website and the social media evidence reproduced at paragraphs 27 and 44 above, though I appreciate that the 'FOOT GLIDE' branding remained in place. In respect of the website, I appreciate that EU/UK visitor figures are provided. Further, I accept that these consumers will have been confronted by the relevant 'BODY GLIDE' branding on said website (because it is the name of the website). However, I remind myself of my issues with the opponent's visitor data taken from its website, namely that there is nothing to suggest that sales were made to EU/UK consumers from this site or whether the visitors eventually went on to seek the goods in retail stores in the EU or UK. In respect of the latter point, even if consumers did select the opponent's goods in stores, I have nothing to suggest the presence of the 'BODY GLIDE' branding by way of images of how the goods appear on shelves or in displays.¹⁷ As a result of the uncertainty surrounding the opponent's use of branding during the relevant period, it is again not possible for me to determine with any degree of certainty whether the opponent's goods (and if so, how many) were appropriately branded during the relevant period. Therefore, I am unable to say that consumers would have been confronted with the marks actually relied upon instead of being branded

¹⁷ I appreciate that one image of a 'BODY GLIDE' display stand is provided. However, this is from a 'Marathon' Expo' after the end of the relevant period. Therefore, I have nothing to show how the goods were actually displayed in retail environments during the relevant period.

simply as either 'GLIDE', 'BODY', 'FOR HER', 'FOOT' or 'CYCLE', as demonstrated in the evidence reproduced above.¹⁸

53. In considering these issues, I pause to remind myself of the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13, wherein Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has

¹⁸ In respect of this issue, I also note that I have nothing to actually show how the opponent's goods appeared to consumers on retail websites or in stores during the relevant period. On this point, only one image of goods in a display case is provided but this is from outside the relevant period so is of no assistance.

been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

54. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to

satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not '*show*' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

55. Bearing in mind the case law reproduced above, section 100 of the Act (also reproduced above) and the issues I have with the evidence before me, my conclusion in respect of genuine use is that the opponent has failed to demonstrate with any degree of sufficiency precisely how much use there has been of the relevant branded products during the relevant period and in the relevant territory. In short, while I appreciate that unit sales and revenue figures have been provided, this inevitably covers sales of goods under brands not relied upon here (such as 'Chamois Glide', for example). Further, the fact that the goods do not appear to be branded with the 'BODY GLIDE' marks is an issue that causes a great deal of uncertainty with the evidence as a whole.¹⁹ Lastly, the website evidence or social media evidence is far from compelling enough to overcome the aforementioned issues. In light of this, I consider that to make an inference that the use shown must be attributable to the relevant brands to the point that it is at a sufficient level and that said goods were branded accordingly would be an unreasonable one to make. To do so would (1) inappropriately remove the burden of proof from the opponent and (2) unfairly be prejudicial to the applicant.

¹⁹ The same criticism can be equally levied at the 'FOOTGLIDE' brand also as while there is additional evidence referring to this brand, there are images of product packaging and entries in the invoices simply referring to the word 'FOOT' as opposed to the mark relied upon.

56. Taking all of the above into account, I am not satisfied that the opponent has provided sufficiently solid evidence in order to demonstrate that it has genuinely used any of its marks in the relevant territory during the relevant period. As a result, the opponent is not permitted to rely on its first through fourth marks for the purposes of this opposition. Therefore, the present decision may only proceed in respect of the opponent's fifth mark. On this point, because proof of use is equally applicable to section 5(3) grounds as it is to section 5(2)(b) grounds and as the opponent relies only on its first three marks under the section 5(3) ground, this finding means that any reliance upon section 5(3) must fall away.

57. For ease of reference for the remainder of this decision, I will refer to the opponent's fifth mark simply as 'the opponent's mark'.

Section 5(2)(b): legislation and case law

58. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) [...]

(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 or association with the earlier trade mark.”

59. Section 5A of the Act states as follows:

“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.”

60. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

61. As set out above, the opponent’s mark had not completed its registration process more than five years before the deemed filing date of the application. As such, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on all of the goods highlighted in its notice of opposition for this mark.

62. The following principles 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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 and services

63. The applicant's goods and services can be found in the Annex of this decision. The opponent's goods that remain relevant to the present decision are "non-medicated skin care preparations".

64. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

65. 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.

66. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

67. I have submissions from both parties in respect of the goods and services comparison. I will not reproduce those submissions here but will, where necessary discuss them further below.

68. In addition, I note that the opponent has sought to provide evidence that purports to show that the parties' goods are frequently sold in the same outlets such as pharmacies and that consumers would expect to find lubricants and products for sexual health and wellbeing in most pharmacies as well as major mainstream supermarkets. In support of this claim, the opponent has provided a number of screenshots from various online retailers that sell both parties' goods.²⁰ While these are noted, they are all dated after the relevant date for these proceedings. In any event, even if it were of relevance here, I do not consider this evidence to be of any real assistance here. I say this because it is my understanding that large pharmacies also sell a disparate range of goods including sunglasses and foodstuffs, for example. However, such goods will be available at distinct locations in the stores when compared with the parties' goods. Additionally, supermarkets sell goods such as television sets and frozen fish. Again, such goods will be displayed on different aisles/sections to the parties' goods. As a result, it is my view that the fact that some retailers may sell a disparate range of goods is not sufficient to give rise to a meaningful overlap in trade channels.

69. On the point of the evidence filed, I note that the applicant has also sought to file evidence purporting to show a range of goods that are not suitable for being used as lubricant. This consists of a number of printouts taken from online searches which say that goods such as glycerine, olive oil, Vaseline and saliva should not be used as sexual lubricants. The applicant goes on to submit that this evidence, when compared to the list of ingredients in the opponent's goods, proves that the opponent's goods cannot be used as a sexual lubricant. While this evidence is noted, it is of no real assistance here. I say this because the inherent position with the goods at issue here is that, plainly, the opponent's goods will not be viewed as goods intended to be used as a lubricant during sexual intercourse.

²⁰ WRS18

Class 3

Toiletry preparations; cleaning [...] preparations.

70. The opponent's specification includes the term "non-medicated skin care preparations". This is a very broad term that can cover any type of good used for the purpose of caring for the skin. This can include a range of toiletry and cleaning preparations. As toiletry and cleaning preparations cover a wide range of goods other than goods for caring for the skin, I find that the opponent's term is encompassed by the applicant's. As such, these goods are identical under the principle outlined in *Meric*.

Cosmetics.

71. While cosmetics is a very broad term, it can cover a range of skin care preparations. As such, I find that the applicant's term covers the opponent's "non-medicated skin care preparations". These goods are, therefore, identical under the principle outlined in *Meric*.

Soaps.

72. While a soap is a cleaning preparation, I consider that such goods will commonly include ingredients that offer benefits to the skin, such as those that aim to moisturise the skin. As such, it can equally be said to be a type of good that falls within the opponent's term of "non-medicated skin care preparations". Therefore, I find these goods to be identical under the principle outlined in *Meric*. Failing that, the goods will be similar to a high degree on the basis that they overlap in nature, method of use, trade channels and user.

Massage oils; non-medicated massage preparations.

73. In comparing the above goods to the opponent's "non-medicated skin care preparations", I am of the view that while they are goods applied to the skin and may have some ingredients that offer protective benefits to the skin, they are not skin care products. I find that their natures and method of use differ. As for purpose, the applicant's goods will be used to lubricate the skin so as to allow for easier massaging whereas the opponent's will be to care for the skin. In terms of trade channels, I consider it likely that an undertaking that provides the above goods will also provide skin care preparations. Further, skin care preparations are likely to be found in close proximity to massage oils and other massage preparations in stores. Lastly, while the goods are not complementary or competitive, they are aimed at the same user. Taking all of this into account, I find that the goods are similar to a low degree.

Essential oils.

74. As far as I understand it, essential oils have numerous benefits. This can include oils that are inhaled by the user to calm or soothe them. Further, they can be applied to the user's skin to offer it moisturising or other skincare benefits. As such, an essential oil can be a form of skin care preparation. In this context, I find that the above term can be said to fall within the opponent's "non-medicated skin care preparations". These goods are, therefore, identical under the principle outlined in *Meric*. Alternatively, if I am wrong to find that essential oils cover goods that have skincare benefits and are, instead, goods inhaled to calm or soothe the user or oils for imparting scents on to the user, there is still a degree of similarity between these goods. I say this because providers of skincare preparations and essential oils are, in this context, likely to overlap. Further, they will be sought by the same user. Therefore, as a very worst case, I consider that these goods are similar to a low degree.

Perfumery; fragancing preparations; aromatic extracts.

75. The above goods are different in nature, method of use and purpose when compared to the opponent's term of "non-medicated skin care preparations". That being said, there is an overlap in trade channels and user. I say this because the producer of a wide range of skincare preparations is also likely to sell its own perfumery goods (be that via perfume itself or other fragancing or aromatic preparations). Further, the goods will be targeted at the same user and someone buying skin care preparations is also likely to buy the applicant's goods. As such, I find that these goods are similar to a low degree.

Animal grooming preparations.

76. Upon the plain reading of the opponent's term, being "non-medicated skin care preparations", I am of the view that it will cover goods used on humans. As such, I do not consider that it can be said to be a term that can be used to care for the skin of animals. Further on this point, grooming suggests something to do with the hair, not the skin. These goods are clearly different in nature, method of use and purpose. Lastly, I see no obvious reasons as to why they would share any meaningful overlap in trade channels or user. Therefore, I find that these goods are dissimilar.

Class 5

77. While the class 5 goods of the applicant are fairly disparate, I am of the view that my findings in respect of the same can, for the most part, be summarised together. I will therefore proceed to consider the bulk of the class 5 goods together, separating out only those I consider necessary below.

Dietary supplements and dietetic preparations; hygienic preparations and articles; sanitary preparations for medical purposes; medical and veterinary preparations and articles; pharmaceuticals; pharmaceuticals and natural remedies; spermicidal gels; aphrodisiacs, namely potency-enhancing preparations for external and internal use, pharmaceuticals for the treatment of erectile dysfunction; medical sexual aids, namely lubricating gels for personal use, silicone-based personal lubricants, water-based personal lubricants, hygienic lubricants, personal sexual lubricants, preparations for use in vaginal lubrication, vaginal lubricants, preparations for facilitating sexual coupling; lubricating creams and gels, [...] for medical purposes; lubricants for human use; medical lubricant substances; orgasm creams; orgasm creams, for medical purposes.

78. The above goods clearly differ in nature, method of use and purpose when compared to the opponent's term of "non-medicated skin care preparations". As for trade channels, I accept that they may be sought from the same retail environments but, as discussed above, this alone is not a compelling point of overlap. Further, as far as I am aware, the producer will be different and I have nothing before me to suggest that any overlap on this point is common in the trade. Turning to user, it may very well be the case that both parties' goods are aimed at the general public at large, however, I am of the view that this only gives rise to a very general level of overlap. Lastly the goods are not competitive or complementary in any way. Overall, I consider that these goods are dissimilar.

Vaginal moisturizers.

79. While a moisturiser may be used to care for the skin, I do not consider that a vaginal moisturiser is something that the average consumer would consider as a skincare preparation. As such, I do not consider that the above term can be said to fall within the opponent's term of "non-medicated skin care preparations". Further, the goods differ in nature, method of use and purpose. As for trade channels, I am of the view that the producer of the above goods will not also offer for sale a range of other

general skincare products. Further, if the goods are available via the same retailers, they will be available in different locations of said stores. Lastly, there may be some overlap in user as the user of the above goods is also likely to use general skincare products. However, I do not consider that this alone is sufficient to give rise to a finding of any degree of similarity between them. As a result, I find that these goods are dissimilar.

Medicinal creams for the protection of the skin; gels for dermatological use; body creams [medicated]; medicinal oils.

80. The above goods are all medical in nature so, therefore, are not the same as the opponent's "non-medicated skin care preparations". That being said, there can be said to be some overlap in method of use in that the goods are all those applied to the skin. As for purpose, the applicant's goods will be used to treat medical ailments, however, at their core, both parties' goods will be used to care for the skin so there is some degree of overlap here. In terms of trade channels, I am not aware of an undertaking that provides medical creams, gels or oils to also produce and sell non-medicated skin care preparations. While the end user will be the same, I do not consider this to be a particularly compelling overlap due to the broad nature of the user base for these goods. Taking all of this into account, I am of the view that these goods are similar to a low degree.

Massage oils [...] for medical purposes; Massage fluid for medical purposes.

81. Above, I found non-medicated massage oils and preparations to be similar to the opponent's "non-medicated skin care preparations" to a low degree. This was on the basis of there being overlaps in trade channels and user. While the user overlap remains, I am not willing to find that the trade channels for these goods overlap. I say this because, as far as I am aware, a producer of skincare preparations for non-medical purposes would not produce massage oils or fluids for medical purposes. While massage oils may be available at pharmacies, the medicated

goods will be prescribed and, therefore, available at different locations in store. As such, any overlap in the distribution of the goods is fleeting. Taking all of this into account, I do not consider that the overlaps are sufficient to give rise to a finding that these goods are similar to any degree. They are, therefore, dissimilar.

Class 10

Medical and veterinary apparatus and instruments; prosthetics and artificial implants; medical and hygienic instruments and apparatus, artificial limbs.

82. The above goods cover a range of different medical apparatus and instruments. I see no obvious reason why such goods would share any overlaps with the opponent's "non-medicated skin care preparations". Clearly, the goods are of different natures, methods of use and purpose. Further, there is no overlap in trade channels and while some fleeting overlap in user may exist, this alone is not sufficient to give rise to a finding of similarity between them. They are, therefore, dissimilar.

Sex aids; condoms; adult sexual aids; artificial penises [adult sexual stimulation aids]; artificial vaginas, being adult sexual aids; benwa balls, being adult sexual aids; penis enlargers, being adult sexual aids; love dolls [sex dolls]; sex toys; vibrators, being adult sexual aids.

83. Clearly, the above goods all differ in nature, method of use and purpose with the opponent's goods, being "non-medicated skin care preparations". While the opponent has filed evidence claiming that some goods relating to sexual health are sold via the same retailers that sell its own goods, I have set out above that this is not persuasive. In the present example, I accept that a pharmacy or supermarket will sell condoms and skin care preparations. However, the goods will be located in different sections or said stores. Further, the goods will not be produced by the same undertakings. As such, I am not willing to find that there exists a sufficient

overlap in trade channels between said goods. As for user, I accept that there may be some overlap, however, this alone is not sufficient to warrant a finding that these goods are similar. As such, I find them to be dissimilar.

Massage apparatus; electrically operated massagers.

84. While a massage apparatus may be bought at a large supermarket/pharmacy, following the same logic I have discussed above, this does not mean that it overlaps in trade channels with “non-medicated skin care preparations”. On this point, I have nothing to suggest that the producers of these goods would overlap either. In respect of these goods, they clearly have different natures, method of use and purpose. Again, the user of these goods may overlap but this alone is not sufficient to warrant a finding of similarity between them. As such, I find them to be dissimilar.

Class 35

Advertising; business management; business consultancy and advisory services; office functions.

85. The above services clearly differ in nature, method of use, purpose and trade channels when compared to the opponent’s term of “non-medicated skin care preparations”. The broad nature of the user base for both the goods and services is such that the user may ultimately overlap but as I have said several times throughout this comparison, this is not sufficient in itself to warrant a finding of similarity. These goods and services are, therefore, dissimilar.

Wholesale and retail services in relation to [...] body care preparations, cleaning [...] preparations, [...] essential oils, [...] cosmetics [and] soaps.

86. In considering the above services, I note that I have found the equivalent goods in the applicant's class 3 list of goods are identical to the opponent's "non-medicated skin care preparations". While the same does not apply to a comparison between the opponent's goods and the applicant's services, I remind myself of the case of *Oakley, Inc v OHIM*, Case T-116/06, wherein the GC, at paragraphs 46-57, held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.²¹ In considering the present goods and services, I consider that the overlaps mentioned in the case law mentioned above exist here. As such, I find that these goods and services are similar to a medium degree.

Wholesale and retail services in relation to [...] fragrancing preparations, [...] aromatic extracts, [...], perfumery, massage fluid [and] massage oils.

87. While I have found a degree of similarity between the goods covered by the above services and the opponent's "non-medicated skin care preparations", this was only to a low degree. In considering the same goods of the opponent against the above retail services, I am of the view that there exists some overlap in trade channels and user. On this point, it is my understanding that it is common in the trade for retailers who sell the goods covered by the above service will also produce and sell their own branded skincare preparations. As for user, I consider that those consumers who select the opponent's goods will also seek the services of the applicant. Overall, I consider that these goods and services are similar to a low degree.

²¹ See also the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14

Wholesale and retail services in relation to [...] medicated creams for protection of the skin, gels for dermatological purposes, medical body creams, oils for medical purposes.

88. Much like the goods covered by the retail services discussed in the preceding paragraph, I found above that those covered here are also similar to a low degree with the opponent's "non-medicated skin care preparations". Following the same logic used in the preceding paragraph, I find that these goods and services overlap in trade channels and user. As such, they are similar to a low degree.

Wholesale and retail services in relation to [...] animal care preparations; wholesale and retail services in relation to dietetic preparations and dietary supplements, sanitary preparations and articles, medical and veterinary preparations and articles, pharmaceuticals, medical sex aids, namely lubricating gels for personal use, silicone-based lubricants for personal use, water-based lubricants for personal use, hygienic lubricants, intimate lubricants; wholesale and retail services in relation to vaginal lubricants, lubricants for the vaginal area, preparations for facilitating sexual intercourse, vaginal humectants, orgasm creams, medical sanitary preparations, [...] spermicidal gels, aphrodisiacs, namely potency-enhancing preparations for external and internal use; wholesale and retail services in relation to medicines for treating erectile dysfunction, medicines and natural remedies, massage oils, lubricating creams and gels, orgasm creams for medical purposes, medical and non-medical gels and creams for prolonging sexual intercourse, medical lubricants, lubricating creams and gels, orgasm creams, not for medical purposes, massage fluid for medical purposes, lubricants for human use; wholesale and retail services in relation to medical and veterinary apparatus and instruments, prostheses and artificial implants, sex aids, medical and health-related instruments and apparatus, artificial limbs, sanitary rubber goods, condoms, massage apparatus, vibrators (for personal use), dildos, sexual aids, namely enema apparatus, potency pumps and rings; wholesale and retail services in relation to erection-enhancing and orgasm-enhancing articles for direct application to the human body, namely replicas of human body parts, electrically operated massage

apparatus, sexual stimulation aids for adults, artificial penises (sexual stimulation aids for adults); wholesale and retail services in relation to artificial vaginas being sexual aids for adults, love balls being sexual aids for adults, penis enlarging apparatus being sexual aids for adults, love dolls (sex dolls), sex toys; retail and wholesale services relating to clothing, footwear and headgear.

89. The retail of the above goods relates to a range of goods that I have found to be dissimilar to the opponent's "non-medicated skin care preparations". I appreciate that the case law (*Tony Van Gulck*) in respect of a comparison against goods and retail services sets out that the goods retailed do not need to be the same as the goods themselves for there to be similarity. However, the disparity between the opponent's goods and those covered by the applicant's services is such that I am not willing to find that there is any degree of overlap between these goods and services. Therefore, I find that they are dissimilar.

Conclusion of goods and services comparison

90. Where there is no similarity between goods and services, there can be no likelihood of confusion under section 5(2)(b) grounds.²² In light of my findings above, it follows that the present ground of opposition fails against the dissimilar goods and services. It will, however, proceed against the following goods and services, being those I have found to be identical or similar:

Class 3: Toiletry preparations; Cleaning [...] preparations; cosmetics; soaps; massage oils; non-medicated massage preparations; essential oils; perfumery; fragrancing preparations; aromatic extracts.

²² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

Class 5: Medicinal creams for the protection of the skin; gels for dermatological use; body creams [medicated]; medicinal oils.

Class 35: Wholesale and retail services in relation to [...] body care preparations, cleaning [...] preparations, [...] essential oils, [...] cosmetics [and] soaps; wholesale and retail services in relation to [...] fragrancing preparations, [...] aromatic extracts, [...], perfumery, massage fluid [and] massage oils; wholesale and retail services in relation to [...] medicated creams for protection of the skin, gels for dermatological purposes, medical body creams, oils for medical purposes.

The average consumer and the nature of the purchasing act

91. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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. (as he then was) described the average consumer in these terms:

"60. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

92. In my view, the average consumer of the goods and services at issue will be members of the general public at large, albeit I appreciate that in some instances, the medical goods will also be selected by medical professionals. The ordinary consumer goods are likely to be sold through a range of retail shops such as supermarkets or beauty and health stores and their online equivalents. The goods at issue are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply online where the consumer will select the goods having viewed an image displayed on a webpage. The selection of these goods is, therefore, primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants. As for the medical goods, these will be sought from medical professionals or bought in pharmacies. While the consumer is likely to view the goods, the aural component is equally important as the goods will be selected after discussions with suppliers or doctors.

93. Regardless of who is selecting the goods at issue, they will range in price but are likely to be fairly inexpensive. As for the frequency at which the goods will be purchased, I am of the view that they will be purchased on a regular basis, with some medical goods being selected less frequently. For these ordinary consumer goods, the average consumer is likely to consider such things as ingredients, scent, potential benefits and whether the products have been tested on animals. I am of the view that the average consumer is likely to pay a medium degree of attention during the selection process for the goods.

94. As for the medical goods, I am of the view that the healthcare professional will pay a higher degree of attention (but not outright high) on the basis that they will need to rely on their expertise in considering the active ingredients, symptoms of the patient and any risk of adverse reactions. As for the general public selecting medical goods, this will be lower and, in my view, will be at a medium degree. Even where the goods are cheap and frequently selected, consumers will be buying the goods to assist with a medical ailment so will be assessing the medical information

on the goods, whether they are suitable for their needs and their dosage requirements.

95. As for the services at issue, I consider these are most likely to be selected having considered, for example, promotional material (in hard copy and online) and signage appearing on the high street. Visual considerations will be an important part of the selection process. Such services are also likely to be the subject of word-of-mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process. When selecting these services, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method (for online retail, for example) and expertise/knowledge of staff. I am of the view that the average consumer is likely to pay a medium degree of attention when selecting such services.

Comparison of the marks

96. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

97. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

98. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

99. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
SKINGLIDE	Eros Bodyglide

100. I have submissions from both parties in respect of the comparison of the marks. While these have been considered in full, I do not consider it necessary to reproduce them here. Instead, I will refer to them below where necessary.

Overall impression

The applicant's mark

101. I will first consider the overall impression of the applicant's mark, being the word only mark 'Eros Bodyglide'. In its notice of opposition, the opponent claims that the word 'Eros' in the applicant's mark will not be considered to be significant by the consumer. On the contrary, the applicant submits that the words 'Eros' and 'Bodyglide' will combine to form a unitary meaning. I disagree with both parties. Firstly, I see no reason why 'Eros' would not be considered significant on the basis

that it is (1) the first element of the mark (being where consumers tend to focus)²³ and (2) it is a word of unknown meaning. In respect of the latter point, I appreciate that Eros is the Greek god of love and while some consumers may be aware of this, there is nothing in the evidence to suggest whether those consumers form a significant proportion of consumers. Secondly, I see no reason why consumers would consider that 'Eros Bodyglide' forms a unitary meaning, especially given that 'Eros' has no obvious meaning to the consumer.

102. In light of the above, I consider that the applicant's mark consists of the combination of two standalone words, one being unknown (Eros) and the other (Bodyglide) being a conjoining of two ordinary dictionary words, being 'Body' and 'glide'. I consider that the second element, being 'Bodyglide', carries its own meaning which, for reasons I will come to discuss below, has some laudatory/allusive qualities. As such, I find that it is 'Eros' that plays the greater role in the overall impression of the applicant's mark, with 'Bodyglide' playing a lesser role.

The opponent's mark

103. The opponent's mark is a word only mark, being the word 'SKINGLIDE'. While presented as one word, it will be understood as the conjoining of two ordinary words, being 'SKIN' and 'GLIDE'. There are no other elements that contribute to the overall impression of the mark, which lies in the word as a whole.

Visual comparison

104. Visually, the marks share the word 'GLIDE', which sits at the end of both parties' marks. The marks differ in the presence of the word 'Eros', which is the first word in the applicant's mark. Additionally, the word immediately preceding the common

²³ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

element differs, being 'Body' in the applicant's mark and 'SKIN' in the opponent's. Taking into account that consumers focus on the beginning of marks, being where the marks differ, and also the overall impressions of the respective marks, I find that they are similar to between a low and medium degree.

Aural comparison

105. Despite 'Bodyglide' playing a lesser role, I see no reason why it would not be pronounced when considering the applicant's mark. As such, I find that this mark consists of five syllables which will be pronounced as 'EE-ROSS-BODD-EE-GLAID' or 'EH-ROSS-BODD-EE-GLAID'. The opponent's mark consists of two syllables that will be pronounced as 'SKIN-GLAID'. The marks share their last syllables but, other than that, all other elements differ. Taking all of this into account and again reminding myself that consumers tend to focus on beginnings of marks, I find that these marks are aurally similar to a low degree.

Conceptual comparison

106. As set out above, 'Eros' in the applicant's mark will have no obvious meaning to the consumer. As for the word 'Bodyglide', this will be understood as a reference to something that *glides over, on or in the body* or *a body that glides*. In the context of the goods at issue, I am of the view that consumers may understand 'Bodyglide' as a reference to the fact that the goods will, upon application, *glide on or over the body* (i.e. easily applicable creams, for example) or, by using the product, it will allow the user's *body to glide* (i.e. give the user smooth skin, for example). It is for this reason that I consider 'Bodyglide' to be somewhat laudatory/allusive. I have set out above that when the mark is viewed as a whole, consumers will not be able to attribute it with any unitary meaning. Instead, they will view it simply as a combination of one unknown word and a conjoined word with the aforementioned meaning. In considering the opponent's mark, this consists solely of the word

‘SKINGLIDE’. Similarly to the word ‘Bodyglide’, this will be viewed as a reference to something that *glides over or on the skin*.

107. In comparing these marks, I find that the uses of ‘Bodyglide’ and ‘SKINGLIDE’ will result in a shared concept of something ‘gliding’. In the context of the goods at issue, all being for use on the exterior of the human body, the reference to ‘SKIN’ and ‘Body’, whilst not interchangeable, will be highly similar on the basis that the skin is a part of the body. That being said, the addition of the word ‘Eros’, despite having no meaning, is something that will take away from this higher level of similarity of the marks as whole. I say this because even though it carries no concept, consumers will notice it as something different in the applicant’s mark. Taking all of this into account, I am of the view that the marks are conceptually similar to a medium degree.

Distinctive character of the opponent’s mark

108. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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)."

109. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced through use and, on this point, I note that the opponent has filed evidence of use. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced through use. Before doing so, I will consider the inherent position.

110. The opponent's mark, as above, is a word only mark consisting of the word 'SKINGLIDE'. This will be viewed as a conjoining of the two words 'SKIN' and 'GLIDE'. This will be understood as a reference to something that *glides on or over the skin*. In respect of the distinctive character of its mark, I note that the opponent claims that the unusual and fanciful nature of the mark means that it is highly distinctive. I disagree. On the goods relied upon, I consider that this word has a somewhat laudatory message as, for skincare preparations, consumers may understand 'SKINGLIDE' as a reference to the fact that the goods will either, upon application, *glide on or over the skin* or, by using the product, it will allow the user's *skin to glide*, i.e. give them smooth skin. As a result, I consider that the distinctiveness of the opponent's mark sits somewhere on the lower end of the scale, though not outright low because it is not directly descriptive of the goods

relied upon. Instead, I consider that the opponent's mark is inherently distinctive to between a low and medium degree.

111. I turn now to consider the position in respect of an enhanced degree of distinctive character. In considering the evidence filed, I remind myself that I have summarised this at paragraphs 23 to 48 above. While this evidence related to the opponent's 'BODYGLIDE' and 'FOOTGLIDE' marks, it did include reference to the opponent's 'SKINGLIDE' mark. While that may have been the case, the reference to this mark was sparing and it is not possible for me to determine the precise level of use for the opponent's 'SKINGLIDE' brand to the point that I would be able to determine if such use was sufficient to give rise to a finding of an enhanced degree of distinctive character.

112. In addition, I remind myself that I had significant issues with the evidence's lack of precision in respect of its turnover and unit sales figures as a whole as well as how often the actual marks were shown on the goods sold. These issues were such that I was unwilling to find that the opponent demonstrated genuine use for its 'BODYGLIDE' or 'FOOTGLIDE' marks. Therefore, even if it was the case that the opponent's evidence had more of a focus on the 'SKINGLIDE' brand, it would still fall short of proving that the opponent's mark enjoyed an enhanced level of distinctive character. I say this because the assessment for enhanced distinctive character is significantly more onerous than the test for genuine use.²⁴ As a result, given that the issues with the evidence were such that they prevented me from finding genuine use, it follows that there is no enhanced degree of distinctive character.

113. As a result, I find that the inherent position applies and I remind myself that this sat somewhere between a low and medium degree.

²⁴ I say this on the basis that use need not be quantitatively significant in order for it to be genuine. On the contrary, a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking.

Family of marks

114. Before proceeding to consider the issue of a likelihood of confusion, I consider it necessary to discuss the fact that in its notice of opposition (and a point expanded upon in its submissions), the opponent sought to rely on a ‘family of marks’ argument. This was on the basis of its ‘BODYGLIDE’, ‘FOOTGLIDE’ and ‘SKINGLIDE’ marks. While noted, I remind myself that this decision proceeded in respect of one earlier mark only (being ‘SKINGLIDE’). As such, there can be no successful ‘family of marks’ argument meaning that this argument is of no assistance here.

Likelihood of confusion

115. In considering the issue of confusion, I note that the opponent’s submissions make reference to the *Medion* principle, to which the correct approach was laid out by Arnold J. (as he then was) in the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). While this argument was raised in a section discussing the global assessment of the marks and not in respect of a likelihood of confusion, I consider it necessary to address it here. In making this argument, the opponent sets out that the applicant’s mark does not form a unit and, as such, consumers will consider ‘Eros’ as the house brand with ‘Bodyglide’ being the sub-brand, thereby creating two separate elements, which each play an independent distinctive role.

116. I accept that the applicant’s mark does not form a unitary meaning and that ‘Eros’ will be viewed as a house brand (and therefore, the indicator of origin). However, I do not consider that the word ‘Bodyglide’ plays an independent distinctive role in the mark as a whole to the point that the *Medion* principle applies. I say this because the allusive/laudatory nature of the word ‘Bodyglide’ is such that I do not consider that the applicant’s mark would necessarily be viewed as a

composite mark which consists of two signs in the way described by *Whyte and Mackay*. Instead, consumers will view the mark as 'Eros' followed by a second word that hints at the goods available under the mark. As a result, I do not consider that the *Medion* principle applies in the present case. I will, therefore, say no more about it and, instead, proceed to consider confusion in the ordinary ways.

117. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their minds.

118. I have found the goods and services to either be identical or similar to varying degrees, including low. The average consumer base is, for the most part, formed of members of the general public. In addition, I have found that some of the medical goods at issue will also be selected by medical professionals. In terms of the selection process for the non-medical goods and services, these will be selected via primarily visual means (with the aural component contributing to some degree). However, when selecting the medical goods, the consumer will give consideration to both the visual and aural aspect of selection. In respect of the level of attention paid, I have found that the general public will pay a medium degree of attention

whereas the medical professional will pay a higher (though not outright high) degree of attention. In respect of the similarity of the marks at issue, I have found them to be visually similar to between a low and medium degree, aurally similar to a low degree and conceptually similar to a medium degree. Lastly, I have found that the opponent's mark is inherently distinctive to between a low and medium degree.

119. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I consider that the average consumer, upon being confronted by the parties' marks, even on identical goods, would be able to accurately recall or remember which mark was which. I appreciate that the parties' marks share the word 'GLIDE' at their ends and, on this point, I acknowledge that common elements at the end of marks *may* lead to confusion.²⁵ However, in the present case, I am of the view that the addition of the word 'Eros' at the start of the applicant's mark and the difference in 'BODY' and 'SKIN' will enable consumers to accurately recall the marks for one another. In support of this finding, I remind myself that the similarity of the marks is not on the higher end of the scale and even though there is a shared conceptual hook (in something that glides), this is not sufficient to overcome the aforementioned differences. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical goods.

120. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. 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

²⁵ *Bristol Global Co Ltd v EUIPO*, T-194/14

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized 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'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

121. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.
122. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.
123. I note that the arguments in respect of indirect confusion, as put forward by the opponent, relate to its ‘BODYGLIDE’ branding. These are not applicable here on the basis that the mark at issue is ‘SKINGLIDE’. Even ignoring this point, I note that even if I could transpose the submissions to the ‘SKINGLIDE’ mark, they would be of no real assistance. The opponent argues, firstly, that this mark is so distinctive that no other party should be using it. Secondly, it argues that the differences in the marks lend themselves to a natural brand extension or sub-brand and/or are indicative of a logical rebranding. I see no merit in either argument. Dealing with the first argument, I do not consider that the distinctiveness of the common element, being ‘GLIDE’, is such that consumers would think that only one undertaking would use it. Moving on, I see no reason why the addition of the unknown word ‘Eros’ at the beginning of the applicant’s mark would be seen as a logical indicator of a sub-brand, brand extension or rebranding. On this point, I appreciate that the change from ‘SKINGLIDE’ to ‘BODYGLIDE’ or vice versa, *may* be considered logical. However, this completely ignores the applicant’s mark’s dominant element, being ‘Eros’. Overall, based on my findings above and bearing in mind the comments set out in the case law discussed in the preceding

paragraph, I find that there exists no likelihood of indirect confusion between the marks at issue, even when viewed on identical goods.

124. The present ground fails in its entirety. While I note that the opponent relies on the section 5(3) ground, it only sought to rely on its first through third marks under that ground. I discussed above that the opponent failed to provide proof that it genuinely used these marks so is not, therefore, permitted to rely on the same for the section 5(3) ground of its opposition. This means that the opponent's failure to prove that it has genuinely used its marks in the relevant territory results in the section 5(3) ground falling away. As a result, I consider it necessary to conclude this decision at this stage.

CONCLUSION

125. The opposition fails in its entirety and, subject to any successful appeal of my decision, the applicant's mark is permitted to registration for all of the goods and services applied for.

COSTS

126. The applicant has succeeded in full and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2016. While I do not consider that the applicant's evidence was of any real assistance in the present proceedings, I note that it was required to consider the evidence of the opponent so should still be awarded costs in respect of this task.

127. In the circumstances, I award the applicant the sum of £1,000 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing a counterstatement:	£200
Considering evidence of the opponent and filing its own evidence:	£500
Filing written submissions in lieu:	£300
Total:	£1,000

128. I hereby order W Sternoff LLC to pay Peter Kertels the sum of £1,000. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 25th day of April 2025

A COOPER
For the Registrar

ANNEX

Class 3

Toiletry preparations; Cleaning and fragrancings preparations; Essential oils and aromatic extracts; Animal grooming preparations; Perfumery; Cosmetics; Soaps; Massage oils; Non-medicated massage preparations.

Class 5

Dietary supplements and dietetic preparations; Hygienic preparations and articles; Medical and veterinary preparations and articles; Pharmaceuticals; Medical sexual aids, Namely lubricating gels for personal use, Silicone-based personal lubricants, Water-based personal lubricants, Hygienic lubricants, Personal sexual lubricants, Preparations for use in vaginal lubrication, Vaginal lubricants, Preparations for facilitating sexual coupling, Vaginal moisturizers, Orgasm creams; Sanitary preparations for medical purposes; Medicinal creams for the protection of the skin; Gels for dermatological use; Body creams [medicated]; Medicinal oils; Spermicidal gels; Aphrodisiacs, Namely potency-enhancing preparations for external and internal use, Pharmaceuticals for the treatment of erectile dysfunction, Pharmaceuticals and natural remedies; Massage oils, lubricating creams and gels, orgasm creams, for medical purposes; medical lubricant substances; Massage fluid for medical purposes; Lubricants for human use.

Class 10

Medical and veterinary apparatus and instruments; Prosthetics and artificial implants; Sex aids; Medical and hygienic instruments and apparatus, artificial limbs, condoms; Massage apparatus; Electrically operated massagers; Adult sexual aids; Artificial penises [adult sexual stimulation aids]; Artificial vaginas, being adult sexual aids; Benwa balls, being adult sexual aids; Penis enlargers, being adult sexual aids; Love dolls [sex dolls]; Sex toys; Vibrators, being adult sexual aids.

Class 35

Advertising; Business management; Business consultancy and advisory services; Office functions; Wholesale and retail services in relation to body care preparations, cleaning and fragrancings preparations, essential oils and aromatic extracts, animal care preparations, perfumery, cosmetics, soaps, massage fluid, massage oils; Wholesale and retail services in relation to dietetic preparations and dietary supplements, sanitary preparations and articles, medical and veterinary preparations and articles, pharmaceuticals, medical sex aids, namely lubricating gels for personal use, silicone-based lubricants for personal use, water-based lubricants for personal use, hygienic lubricants, intimate lubricants; Wholesale and retail services in relation to vaginal lubricants, lubricants for the vaginal area, preparations for facilitating sexual intercourse, vaginal humectants, orgasm creams, medical sanitary preparations, medicated creams for protection of the skin, gels for dermatological purposes, medical body creams, oils for medical purposes, spermicidal gels, aphrodisiacs, namely potency-enhancing preparations for external and internal use; Wholesale and retail services in relation to medicines for treating erectile dysfunction, medicines and natural remedies, massage oils, lubricating creams and gels, orgasm creams for medical purposes, medical and non-medical gels and creams for prolonging sexual intercourse, medical lubricants, lubricating creams and gels, orgasm creams, not for medical purposes, massage fluid for medical purposes, lubricants for human use; Wholesale and retail services in relation to medical and veterinary apparatus and instruments, prostheses and artificial implants, sex aids, medical and health-related instruments and apparatus, artificial limbs, sanitary rubber goods, condoms, massage apparatus, vibrators (for personal use), dildos, sexual aids, namely enema apparatus, potency pumps and rings; Wholesale and retail services in relation to erection-enhancing and orgasm-enhancing articles for direct application to the human body, namely replicas of human body parts, electrically operated massage apparatus, sexual stimulation aids for adults, artificial penises (sexual stimulation aids for adults); Wholesale and retail services in relation to artificial vaginas being sexual aids for adults, love balls being sexual aids for adults, penis enlarging apparatus being sexual

aids for adults, love dolls (sex dolls), sex toys; Retail and wholesale services relating to clothing, footwear and headgear.