O-0408-24

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION No. 3738727

IN THE NAME OF ANAND SHANKER HIRA

TO REGISTER

MEGA MUTANT

AS A UK TRADE MARK

AND

OPPOSITION No. 431873 THERETO

BY FIT FOODS LTD

BACKGROUND AND PLEADINGS

1. This opposition decision concerns UK trade mark application number 3738727 ("**the Application**") to register the word mark "MEGA MUTANT" ("**the Contested Mark**").

2. The Application was filed on 2 January 2022 ("**the Relevant Date**") in the name of Anand Shanker Hira ("**the Applicant**"). The Application was published on 21 January 2022 in respect of the goods and services across classes 3, 4, 9, 10, 11, 14, 21, 28, 32, 33, 34, 36, 38, 41 and 43 set out below. The Application had initially also included goods in classes 18, 25, 29 and 30, but on 31 May 2023, after the Opponent filed its evidence, the Applicant filed a form TM21B removing those four classes.

Class 3: *Liquid perfumes; Perfumes; Perfume; Perfume oils; Perfumed soap; Amber [perfume]; Perfumed water; Perfumed powder; Perfumed creams; Perfume water; Perfumed soaps; Perfumed sachets; Perfuming sachets; Perfumed potpourris; Solid perfumes; Perfumed tissues; Perfumed powders; Perfumed toilet waters; Perfumes for ceramics; Room perfume sprays; Fumigation preparations [perfumes]; Extracts of perfumes; Aromatics for perfumes; Perfumes for cardboard; Flowers (Extracts of -) [perfumes]; Perfumed lotions [toilet preparations]; Extracts of flowers [perfumes]; Natural oils for perfumes; Perfumes in solid form; Room perfumes in spray form.*

Class 4: *Perfumed candles; Candles (Perfumed -); Candles; Tallow candles.*

Class 9: *Downloadable cryptographic keys for receiving and spending crypto assets; Downloadable cryptographic keys for receiving and spending crypto assets; Electronic currency converters; Downloadable software, namely virtual currency; E-passports; Fashion eyeglasses.*

Class 10: *Sex toys.*

Class 11: *Coffee roasting machines; Expresso coffee machines; Percolators (Coffee -), electric; Electric coffee pots; Refillable coffee capsules.*

Class 14: *Fashion jewellery.*

Class 21: *Perfume bottles.*

Class 28: *Toys; Toy bakeware and toy cookware; Toy banks; Toy horns; Bathtub toys; Toy balls; Toy tools; Toy dolls; Toy flowers; Fabric toys; Toy watches; Toy projectors; Toy tents; Pet toys; Squeeze toys; Toy swords.*

Class 32: *Beer; Beers; Flavored beer.*

Class 33: *Wine; Wines; Red wine; Sparkling wines; Rose wines; Sparkling wine; Alcoholic wines; Brandy; Cherry brandy; Cooking brandy.*

Class 34: *Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Liquids for electronic cigarettes; Liquid for electronic cigarettes; Cigarettes; Electric cigarettes [electronic cigarettes]; Electronic cigarettes; Cigarette lighters; Cigarette paper; Cigarette rolling papers; Cigarette rolling machines; Electronic cigarette boxes.*

Class 36: *Electronic transfer of crypto assets; Financial exchange of crypto assets; electronic transfer of crypto assets; financial exchange of crypto assets; Currency trading; Foreign currency exchange; Virtual currency services; Virtual currency exchange; Exchange services (Currency -); Foreign currency services; Foreign currency dealing; Trading in currencies; Buying and selling currency; Swaps of currency rates; E-wallet payment services.*

Class 38: *E-mail services*

Class 41: *E-sports services.*

Class 43: *Coffee shops.*

3. On 16 March 2022, Fit Foods Ltd ("**the Opponent**") filed an opposition based on the following three earlier filed trade mark registrations, all of which are for the word "MUTANT":

Earlier Mark 1 **MUTANT**
UKTM No. 912436291 **Filing date:** 13 December 2013 **Registration date:** 8 May 2014 **Class 5:** *Drink mixes used as a meal replacement; protein powders; dietary and nutritional supplements; dietary and nutritional supplements containing protein for building body mass; dietary supplements for body building; dietary supplements for increasing bodyweight; dietary supplements for increasing muscle mass; dietary supplements for increasing muscle mass; dietary supplements for enhancing strength; dietary supplements for enhancing sports performance; protein-based preparations; protein for use as a dietary supplement; protein powder; powder used in the preparation of dietary and nutritional supplements; powdered protein supplements; protein supplements in powder form; dietary supplements for reducing body fat; protein supplements in capsule form; dietary supplements for reducing bodyweight; protein supplements in tablet form*
Earlier Mark 2 **MUTANT**
UKTM No. 917958425 **Filing date:** 18 September 2018 **Registration date:** 20 February 2019 **Class 29:** *Milk and dairy products, namely protein shakes, ready to drink protein shakes, concentrates for making protein shakes, powder for making protein shakes; milk protein, whey protein; powdered milk; protein enriched powdered milk; powdered whey protein; dairy based protein powder; milk protein*

concentrate; whey protein concentrate; dry powdered mixes, namely soup mixes. **Class 30:** *Dry powdered mixes, namely pancake mixes, biscuit mixes, cake mixes, muffin mixes, all with high protein content; high-protein cereal bars; high-protein granola-based snack bars; protein-based snack foods made from granola; protein-based snack food made from rice; high-protein candy bars; high-protein chocolate bars; high-protein chocolate-based meal replacement bars.*
Earlier Mark 3 **MUTANT**
UKTM No. 3593727 **Filing date:** 10 February 2021 **Registration Date:** 1 October 2021 **Class 18:** *Gym bags; Backpacks* **Class 21:** *Plastic bottles; Sports bottles sold empty; Water bottles; Shaker cups* **Class 25:** *T-shirts; Hoodies; Hats; Caps* **Class 28:** *Weightlifting straps; Wrist straps.*

4. The opposition claims are based on **sections 5(2)(b)** and **5(3)** of the Trade Marks Act 1994 ("**the Act**"). The claims under section 5(2)(b) are directed only at some of the applied-for goods; the claims under section 5(3) are directed at all of the applied-for goods and services.

5. The Opponent's claims under **section 5(2)(b)** allege similarity between Earlier Marks "Mutant" and the Contested Mark, and between certain of the applied-for goods and certain of the Opponent's earlier registered goods such that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the Opponent's earlier trade marks. I set out the particular goods at issue later in this decision.

6. The Opponent's claims under **section 5(3)** allege a reputation (and use) in respect of all of the goods registered under Earlier Marks 1, 2 and 3 such that use of the Contested Mark in respect of all or any of the applied-for goods and services would take unfair advantage of, or be detrimental to, the distinctive character or reputation of each of the three Earlier Marks.

Defence and proof of use request

7. The Applicant filed a notice of defence, requesting that the Opponent provide proof of use in respect of Mark 1. The Opponent's counterstatement included the following points:
   i. it denied that MEGA MUTANT and MUTANT are confusingly similar;
   ii. it denied the claimed similarity of goods;
   iii. it denied any likelihood of confusion;
   iv. it denied that the marks are similar for the purposes of section 5(3);
   v. it denied that the Earlier Marks have a reputation;
   vi. it put the Opponent to proof in respect to the reputation, unfair advantage and detriment claims.

Representation and papers filed

8. The Applicant is represented in these proceedings by Wilson Gunn; the Opponent by FR Kelly. During the evidence rounds the Opponent filed evidence in relation to use of its marks. The Applicant filed no evidence. Submissions in lieu of an oral hearing were filed for both parties. I have read all the papers on the electronic case file and will refer in this decision to particular submissions and points of evidence as warranted.

RELEVANCE OF EU LAW

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive, hence this decision continues to refer to the case law of the EU courts, such as the General Court and the Court of Justice of the European Union ("**CJEU**").

STATUTORY PROVISIONS

10. Section 5(2)(b) of the Act reads:

"5. – […]

(2) A trade mark shall not be registered if because – […]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

11. Section 5(3) of the Act reads:

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b) . . . .

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

12. Section 5(3A) states that those provisions apply "irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

PROOF OF USE

13. Earlier Marks 1 and 2 relied on by the Opponent are comparable UK trade marks, created by the UKIPO on 1 January 2021 (prefixed with UK009), that mirror rights held under EUTMs registered before that date.[1] The meaning of "earlier trade mark", under the Act includes a comparable trade mark (EU).[2] All three of the registrations relied on by the Opponent have filing dates that predate the filing date

1 European Union (Withdrawal Agreement) Act 2020.

2 Section 6(1)(aa) of the Act.

of the Application and all thus qualify as earlier trade marks for the purposes of the Opponent's claims.[3]

14. Section 6A of the Act reads:

6A Raising of relative grounds in opposition proceedings in case of non-use

(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) […]

(5). . . . .

(5A). . . . .

3 Section 6 of the Act.

(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. Related to the above cited section 6A, the following paragraphs of Schedule 2, Part 1 of the Act provide:

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

16. Earlier Mark 1 relied on by the Opponent had been registered for more than five years at the filing date of the Application and is subject to the use conditions set out in section 6A of the Act. Since the Applicant has requested proof of use, the Opponent is able to rely on Mark 1 only to the extent that the evidence satisfies the requirements of 'genuine use' as envisaged under section 6A(3)(a) of the Act, and in line with principles discernible from the well-established case law, set out below. The Opponent must prove use of its marks is the five-year period ending with the date of the Application, namely: from 3 January 2017 to 2 January 2022 "**the Relevant Period**".

17. In recognition that many comparable UK trade marks correspond to EUTMs that may never have been used in the UK, the legislation ensures that any use of the mark in the EU made before 1 January 2021, whether inside or outside the UK, counts as use of the comparable UK right. However, the evidence in this case referred to no territories other than the UK.

Case law on genuine use

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. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*,[4] Daniel Alexander Q.C. sitting 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

4 Case BL O/230/13

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."

20. In *Dosenbach-Ochsner*[5], Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

"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."

THE OPPONENT'S EVIDENCE

21. The Opponent's evidence was filed late and following a case management conference to consider the Opponent's extension of time request.

22. The official letter sent on 17 March 2023 from the tribunal caseworker listed the filed evidence as comprising a witness statement of Paul Kelly (dated 28 February 2023), with Exhibits PJK1 - PJK11.[6] That letter noted that the witness statement of Paul Kelly refers to Exhibits PJK12, PJK13 and PJK14, but that those exhibits were not filed. It was also noted that the evidence filed amounted to 324 pages which slightly exceeds the limit given in Tribunal Practice Notice (TPN 1/2015). The official letter

5 *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13
6 (This was confirmed in the end-of-evidence-rounds letter of 10 July 2023.)

stated that since the Opponent had already been afforded the indulgence of additional time to file its late evidence, the Opponent's evidence filed on 1 March 2023 is to be admitted as presented.

23. Before considering the Opponent's evidence, I find it useful to have in mind its presumed purposes.

(i) The Opponent's claims under section 5(2)(b) require proof of use of Earlier Mark 1. I set out the full list of goods in Class 5 registered under Earlier Mark 1 in the background section of this decision. The section 5(2)(b) claim based on Earlier Mark 1 relies only on certain terms from that full list, namely: *protein-based preparations; protein powder; powder used in the preparation of dietary and nutritional supplements; powdered protein supplements; protein supplements in powder form; protein supplements in capsule form; protein supplements in tablet form.*

(ii) The Opponent's claims under section 5(3) also require proof of use of Earlier Mark 1, but also evidence to establish the reputation claimed for the goods registered under Earlier Marks 1, 2 and 3, which include goods in Classes 18, 21, 25, 28, 29 and 30.

24. The witness states that he is an attorney with the Opponent's legal representatives and he states that he is authorised to make his witness statement on behalf of the Opponent, and that the contents of his statement are based on Mr Kelly's own knowledge or are taken from documents and records supplied by the Opponent.

25. Paragraph 2 of the witness statement states that "the Trade Mark MUTANT was first used in the United Kingdom in 2007 and the total sales of goods in the United Kingdom since the date of first use €20 million." Paragraph 3 of the witness statement states that "the annual turnover of goods for the years 2015 to 2022 was as follows:

2015	$ 1.91 million
2016	$ 1.64 million
2017	$ 1.93 million
2018	$ 1.1 million

2019	$ 921,000 million
2020	$ 1.07 million
2021	$ 897,000 million”

26. The UK total for the period 2007 – 2021 is given in Euros, but in terms of the Relevant Period (January 2017 – January 2022) the sales are stated to total around six million dollars (and it is not unambiguously clear that the information given at paragraph 3 of the witness statement relates to the United Kingdom). A significant weakness of the evidence is that because the witness statement does not specify what goods have been sold in the Relevant Period, it is difficult to assess whether there has been genuine use of mark in respect of the protein supplement-type goods relied on under Earlier Mark 1. The assertion as to sales levels is supplemented by Exhibits PJK1 to PJK11, which the witness refers to in the following terms

“5. …copies of invoices evidencing sale of goods under and by reference to the Trade Mark MUTANT. These have been separated into separate Exhibits to evidence the continuous sale of goods throughout the United Kingdom for the years 2007 to 2021 inclusive.

6. The invoices and orders have been redacted to remove personal information but they clearly show that they were dispatched to the United Kingdom. The invoices clearly identify the Trade Mark relied upon by the Opponent.

27. For the purposes of showing genuine use of Earlier Mark 1, Exhibits PJK1-PJK6 are of limited significance, since they predate the Relevant Period. Exhibits PJK7 – PJK11 do show numerous invoices from the Relevant Period, examples of which are shown below – one from 2017, the other from 2021. I have added arrows to highlight the references to the United Kingdom.

Exhibit PJK7 extract

INVOICE

PORT COQUITLAM
Tel: 604-464-3524 Toll Free Tel: 1-888-337-0127
Fax: 604-464-8598 Toll Free Fax: 1-888-464-8598
1589 Kebet Way, Port Coquitlam BC V3C 6L5

0000752327

DATE: 25-Jan-17

United Kingdom   United Kingdom

Customer Number   Ship to ID

P.O. NUMBER	ORDER DATE	ORDER NO.	SALESPERSON	GST Number	SHIP VIA	F.O.B.
	25-Jan-17	00935640-0				

PART NUMBER	WHS	DESCRIPTION	QUANTITY REQ.	SHIPPED	B.O.	LIST PRICE	DISC	UNIT PRICE	EXTENDED PRICE
21002EX	04A	MUTANT WHEY Triple Chocolate Flavour 908 g (2 lbs)	120	120			0.00%		
21004EX	04A	MUTANT WHEY Strawberry Cream Flavour 908 g (2 lbs)	120	120			0.00%		
21001EX	04A	MUTANT WHEY Vanilla Ice Cream Flavour 908 g (2 lbs)	72	72			0.00%		
21003EX	04A	MUTANT WHEY Cookies & Cream Flavour 908 g (2 lbs)	120	120			0.00%		
22002EX	04A	MUTANT MICELLAR CASEIN Chocolate Milk Flavour 1.8 kg (4 lbs)	36	36			0.00%		
21152EX	04A	MUTANT WHEY Triple Chocolate Flavour 4.54 kg (10 lbs)	324	324			0.00%		
21154EX	04A	MUTANT WHEY Strawberry Cream Flavour 4.54 kg (10 lbs)	189	189			0.00%		
21151EX	04A	MUTANT WHEY Vanilla Ice Cream Flavour 4.54 kg (10 lbs)	189	189			0.00%		
21153EX	04A	MUTANT WHEY Cookies & Cream Flavour 4.54 kg (10 lbs)	324	324			0.00%		
21052EX	04A	MUTANT WHEY Triple Chocolate Flavour 2.27 kg (5 lbs)	1,512	1,512			0.00%		
21051EX	04A	MUTANT WHEY Vanilla Ice Cream Flavour 2.27 kg (5 lbs)	1,134	1,134			0.00%		
21054EX	04A	MUTANT WHEY Strawberry Cream Flavour 2.27 kg (5 lbs)	1,134	1,134			0.00%		
21053EX	04A	MUTANT WHEY Cookies & Cream Flavour 2.27 kg (5 lbs)	1,512	1,512			0.00%		

NET AMOUNT

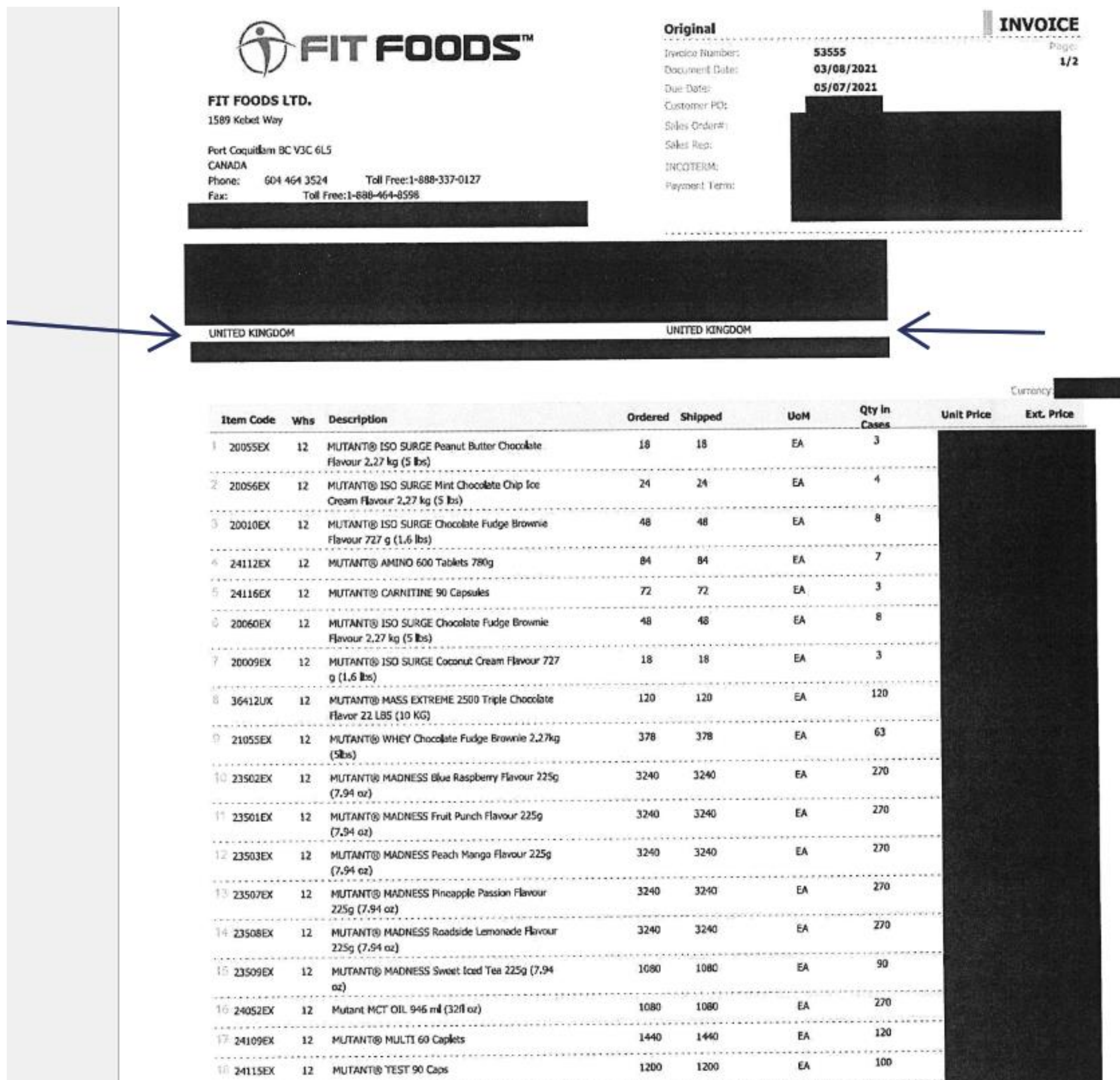
FREIGHT

AMERICAN DOLLARS TOTAL DUE

PLEASE REMIT PAYMENT TO: FIT FOODS LTD. 1589 Kebet Way, Port Coquitlam, BC V3C 6L5

Inspect your shipments IMMEDIATELY. Claims for damaged goods or short shipments must be made within 24 hours from receipt of goods.

Exhibit PJK11 extract



FIT FOODS™

FIT FOODS LTD.
1589 Kebet Way

Port Coquitlam BC V3C 6L5
CANADA
Phone: 604 464 3524 Toll Free:1-888-337-0127
Fax: Toll Free:1-888-464-8598

Original **INVOICE**

Invoice Number: 53555
Document Date: 03/08/2021
Due Date: 05/07/2021
Customer PO:
Sales Order#:
Sales Rep:
INCOTERM:
Payment Term:

Page: 1/2

UNITED KINGDOM

UNITED KINGDOM

Currency:

	Item Code	Whs	Description	Ordered	Shipped	UoM	Qty in Cases	Unit Price	Ext. Price
1	20055EX	12	MUTANT® ISO SURGE Peanut Butter Chocolate Flavour 2.27 kg (5 lbs)	18	18	EA	3		
2	20056EX	12	MUTANT® ISO SURGE Mint Chocolate Chip Ice Cream Flavour 2.27 kg (5 lbs)	24	24	EA	4		
3	20010EX	12	MUTANT® ISO SURGE Chocolate Fudge Brownie Flavour 727 g (1.6 lbs)	48	48	EA	8		
4	24112EX	12	MUTANT® AMINO 600 Tablets 780g	84	84	EA	7		
5	24116EX	12	MUTANT® CARNITINE 90 Capsules	72	72	EA	3		
6	20060EX	12	MUTANT® ISO SURGE Chocolate Fudge Brownie Flavour 2.27 kg (5 lbs)	48	48	EA	8		
7	20009EX	12	MUTANT® ISO SURGE Coconut Cream Flavour 727 g (1.6 lbs)	18	18	EA	3		
8	36412UX	12	MUTANT® MASS EXTREME 2500 Triple Chocolate Flavor 22 LBS (10 KG)	120	120	EA	120		
9	21055EX	12	MUTANT® WHEY Chocolate Fudge Brownie 2.27kg (5lbs)	378	378	EA	63		
10	23502EX	12	MUTANT® MADNESS Blue Raspberry Flavour 225g (7.94 oz)	3240	3240	EA	270		
11	23501EX	12	MUTANT® MADNESS Fruit Punch Flavour 225g (7.94 oz)	3240	3240	EA	270		
12	23503EX	12	MUTANT® MADNESS Peach Mango Flavour 225g (7.94 oz)	3240	3240	EA	270		
13	23507EX	12	MUTANT® MADNESS Pineapple Passion Flavour 225g (7.94 oz)	3240	3240	EA	270		
14	23508EX	12	MUTANT® MADNESS Roadside Lemonade Flavour 225g (7.94 oz)	3240	3240	EA	270		
15	23509EX	12	MUTANT® MADNESS Sweet Iced Tea 225g (7.94 oz)	1080	1080	EA	90		
16	24052EX	12	Mutant MCT OIL 946 ml (32fl oz)	1080	1080	EA	270		
17	24109EX	12	MUTANT® MULTI 60 Caplets	1440	1440	EA	120		
18	24115EX	12	MUTANT® TEST 90 Caps	1200	1200	EA	100		

28. I note that the invoices mention various goods listed by reference to the trade mark "Mutant" – for example, there are references to: "Iso surge" and "Madness" in various flavours - peanut butter chocolate, raspberry etc; and to "multi caplets" and "Test caps"; other exhibits refer to "Mayhem", "Caffeine", "BCAA". It is not clear to me what any of these goods are. However, the invoices also contain references to "amino tablets", and numerous references to "whey" (again in various flavours). Although the witness statement does not clearly identify the goods to which the evidence is addressed, I am prepared to infer from the general knowledge of the average consumer that "amino tablets" and certainly "whey" are likely to be protein supplements. I have also noted the presence in the invoice of the words "United Kingdom".

29. However, even accepting those points, the evidential value of Exhibits PJK7 – PJK11 remains limited. The extent of redaction means that it cannot be discerned to whom any goods may have been invoiced – it may, for example, have been to numerous retailers at different locations across the UK, or it may have been limited to a single retailer in one town. Likewise, there is no way of determining the value of the goods sold. And even assuming that the content of the numerous invoices mostly exemplify sales of goods of the type relied on under Earlier Mark 1 (protein supplements), this does not fully rectify the fundamentally vague references to unspecified "goods" made in the witness statement.

30. At paragraph 4 of his witness statement, Mr Kelly states "*the total amount spent in advertising and promotional activities was in the region of $325,000*." Again, it is not clear that this is promotional activity directed to the United Kingdom, still less which of the goods under the Earlier Marks are said to be the subject of the promotion.

31. The witness refers at his paragraph 7 of his statement to **Exhibit PJK12**, which he states are "*copies of advertisements in the UK that advertise and promote goods under and by reference to the Trade Mark MUTANT relating to the Trade Mark MUTANT* [sic]." As noted earlier in this decision, the official letter sent of 17 March 2023 highlighted that Exhibit PJK12 was not among the filed materials, and the 10 July 2023 end-of-evidence-rounds letter listed the exhibits admitted into the proceedings as only Exhibit PJK1 - PJK11. Therefore, certainly in the absence of Exhibit PJK12, it is unclear what goods were advertised, in what publications, how frequently and so on.

32. Paragraph 7 also states: "*The Opponent also exhibits at the BodyPower Expo in the United Kingdom, which is renowned as being the number one health and fitness show in the United Kingdom*." It refers to **Exhibit PJK13** as "*evidencing the Opponent exhibiting at the Expo. The Opponent also advertises on and is active over social media such as Facebook, Instagram, YouTube and TikTok*". It states that **Exhibit PJK14** presents *"statistics for social media that shows that the Trade Mark of the Opponent is one of the top five for Instagram, YouTube and TikTok*." Exhibit PJK13 and Exhibit PJK14 are not among the papers filed or admitted in

these proceedings. It is therefore unclear what goods may have been advertised by reference to the earlier mark, when, to what territorial audience and so on.

33. Even insofar as the evidence may be intended to demonstrate genuine use of Earlier Mark 1 for the goods in Class 3, the shortcomings I have highlighted are clearly significant. The Opponent was afforded ample time to prepare its evidence and it should have been straightforward to show goods bearing the Earlier Mark (or in respect of which it has been used), how many of any relevant goods have been sold, and so on. The evidence before the Tribunal is not strong. However, during the evidence rounds, the Applicant filed no submissions or evidence to challenge the evidence in chief filed by the Opponent. Looking at matters in the round, I am prepared to proceed on the basis that some of the €20 million - that Mr Kelly states is the total of UK sales since 2007 under the Opponent's trade mark "Mutant" - derives from goods that are those relied on in Class 3. I take this position based on the numerous references to goods such as 'whey', in invoices that are seemingly directed to the UK, throughout each of the five years of the relevant period. I also take into account the statements – uncorroborated by exhibits, but unchallenged at the evidence stage – that at least suggest that the mark may have had some promotional exposure in the UK, for instance at what Mr Kelly states to be a major health and fitness show.

34. Based on this finding of genuine use, the Opponent may rely on Earlier Mark 1.

DECISION

The Section 5(2)(b) claim

35. Determination of a section 5(2)(b) claim must be made in light of the following principles, gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The principles are:

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

(a) 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;

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

(c) 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;

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

(e) 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;

(f) 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;

(g) 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;

(h) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the marks

36. Section 5(2)(b) - as well as under section 5(3) - of the Act requires similarity between the earlier mark(s) and the contested mark.

37. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* 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*."[7]

38. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

Earlier Marks 1, 2 and 3 4	Contested Mark
Mutant	Mega Mutant

7 *Bimbo SA v OHIM, Case C-591/12P (*at paragraph 34)

39. The overall impression of the earlier word mark is that it is simply the ordinary English-language word MUTANT. The overall impression of the contested mark is that it comprises two ordinary English-language words. The second word is marginally more dominant within the mark, since it is likely that the first word will be seen as an amplifying qualifier of the second word.

40. Visually, the two marks are similar to at least a medium degree. The identical single word of the Earlier Mark is wholly contained in the Contested Mark. Although the word "Mega" in the Contested Mark may be read first, the total mark is fairly brief and "Mutant" is the longer of the two words.

41. Aurally, the two marks are similar to at least a medium degree. Although the Contested Mark opens with the two additional syllables of the word MEGA, the second word will be spoken identically, and the first word MEGA is laudatory, and may be considered less distinctive and dominant than the identical word 'MUTANT' that the parties' marks share.

42. Conceptually, there is at least a medium degree of similarity based on the shared identical word 'MUTANT'. The word 'MUTANT' has an ordinary dictionary meaning that the average consumer in the UK would understand as describing something that has permanently changed at a fundamental level. The word 'MEGA' has an ordinary dictionary meaning that the average consumer in the UK would understand as indicating something very good or very big. The word MEGA is therefore somewhat laudatory and amplifies the significance of the shared word MUTANT.

43. The parties' marks may be considered similar overall to at least a medium degree.

Comparison of goods

44. For the Opponent to succeed based on its claims under section 5(2)(b) of the Act there must be at least some degree of similarity between the goods relied on under the Earlier Mark(s) and the contested goods under the Application. In considering this question of similarity, I take account of the factors identified in case law:

"*In assessing the similarity of the goods … all the relevant factors relating to those goods .. themselves should be taken into account. Those factors include, inter alia,*

their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.[8]

45. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* the European Court ruled that goods can be considered as identical when the goods designated by the trade mark application the earlier mark are included in a more general category designated by the earlier mark or vice versa.[9]

46. It is settled case law that assessing whether goods and services at issue are similar must be on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary.[10] Goods and services are complementary when "… there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."11

47. In construing the meaning of terms, I keep in mind the guidance from case law that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise, but that "where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."[12]

48. Section 60A of the Act states goods and services are not to be regarded as being similar to each other simply because they appear in the same class, nor are they to be regarded as being dissimilar from each other on the ground that they appear in different classes.

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8 The essence of case law points on similarity made in relation to goods applies correspondingly to services.

9 See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05

10 See *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]

11 *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

12 See paragraph 12 Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)

49. The section 5(2)(b) claim based on **Earlier Mark 1** is directed at the applied-for goods in Class 3, namely:

Class 3: *Liquid perfumes; Perfumes; Perfume; Perfume oils; Perfumed soap; Amber [perfume]; Perfumed water; Perfumed powder; Perfumed creams; Perfume water; Perfumed soaps; Perfumed sachets; Perfuming sachets; Perfumed potpourris; Solid perfumes; Perfumed tissues; Perfumed powders; Perfumed toilet waters; Perfumes for ceramics; Room perfume sprays; Fumigation preparations [perfumes]; Extracts of perfumes; Aromatics for perfumes; Perfumes for cardboard; Flowers (Extracts of -) [perfumes]; Perfumed lotions [toilet preparations]; Extracts of flowers [perfumes]; Natural oils for perfumes; Perfumes in solid form; Room perfumes in spray form.*

50. The Opponent claims that those Class 3 goods are similar to the following goods registered under Earlier Mark 1: *protein-based preparations; protein powder; powder used in the preparation of dietary and nutritional supplements; powdered protein supplements; protein supplements in powder form; protein supplements in capsule form; protein supplements in tablet form.*

51. The Opponent makes no submissions to explain why those goods could be considered similar. I find that the goods are **dissimilar**. In the absence of any similarity between the goods, **the section 5(2)(b) objection based on Earlier Mark 1 inevitably fails**.

52. The section 5(2)(b) claim based on **Earlier Mark 2** was directed at the goods applied for in Classes 29 and 30, which no longer form part of the Application.

53. The section 5(2)(b) claim based **Earlier Mark 3** is directed at the applied-for goods in Classes 14, 21 and 28, namely:

Class 14: *Fashion jewellery.*

Class 21: *Perfume bottles.*

Class 28: *Toys; Toy bakeware and toy cookware; Toy banks; Toy horns; Bathtub toys; Toy balls; Toy tools; Toy dolls; Toy flowers; Fabric toys; Toy watches; Toy projectors; Toy tents; Pet toys; Squeeze toys; Toy swords.*

54. The Opponent claims that those contested goods in Classes 14, 21 and 28 are similar to the following goods registered under Earlier Mark 3:

Class 18: *Gym bags; Backpacks*
Class 21: *Plastic bottles*
Class 25: *T-shirts; Hoodies; Hats; Caps*
Class 28: *Wrist straps.*

55. I consider first the contested goods in Class 14: *Fashion jewellery.* The Opponent provided no submissions comparing specific goods in any detail at all. It is not the role of the Tribunal to seek to make a case for an opposition where a claimed key element, such as similarity, is not obvious. Looking at the goods asserted to be similar, I find that there is little or no similarity even comparing the applied-for goods *Fashion jewellery* to *t-shirts* or *hoodies* in Class *25* and with *wrist straps* in Class 28 under Earlier Mark 3*.* Some clothing shops may sell not only t-shirts and hoodies but also fashion jewellery, so there may be a limited overlap in channels of trade to the public, but the goods differ in physical nature, method of use and purpose and are not complementary or in competition with one another. Fashion jewellery may include bracelets, which are items worn on the wrist. Clearly a wrist strap is also worn on the wrist, but it is my understanding that a wrist strap serves the function of supporting the wrist for sporting or potentially medical purposes. The goods differ in method of use and purpose and are not complementary or in competition with one another. I find that the contested goods in Class 14: *Fashion jewellery* are – at most – similar to the goods under Earlier Mark 3 to **a very low degree**.

56. I next compare the contested goods in Class 21: *Perfume bottles* with the Class 21 goods *Plastic bottles* under Earlier Mark 3. While a perfume bottle may typically be made of glass, I see no reason why a perfume bottle may not be plastic. I therefore find the goods are **identical** based on the principle stated in *Gérard Meric.*

57. I next consider the contested goods in Class 28. Those are all different types of toys. I have no submissions to support similarity and I find the goods are **dissimilar**. In the absence of any similarity between the goods, the section 5(2)(b) objection based on Earlier Mark 3 inevitably fails in respect of the Applicant's goods in Class 28.

The average consumer and the purchasing process

58. In *Hearst Holdings Inc,*[13] Birss J explained that "… *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 relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical".*

59. The goods remaining at issue under section 5(2)(b) are: *Fashion jewellery, T-shirts; Hoodies, Perfume bottles, Plastic bottles* and *Wrist straps.* The average consumer for these goods will be a member of the general public. I recognise too that the average consumer may include businesses or professionals.

60. The average consumer will purchase the goods either by self-selection from a retail outlet, or from a website or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase, given the potential for oral recommendations and that advice may be sought from retail assistants. None of the goods will be particularly expensive and in my view the general public will typically pay no more than a medium degree of attention in purchasing the goods at issue. I note that the Opponent's submissions in lieu state at paragraph 7 that the average consumer would be an adult who would "pay an above average degree of attention to the goods or services being sought". I agree that the attention levels of business or professional consumers would likely be higher.

13 *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), at paragraph 60.

Distinctiveness of the earlier mark

61. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.[14] In *Lloyd Schuhfabrik*, 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-2779, 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)".

62. Since I have found similarity of goods only under Earlier Mark 3, my task is to assess the distinctive character of "Mutant" in respect of the relevant (similar or identical) goods, namely Class 21: *Plastic bottles* and Class 25: *T-shirts; Hoodies.* The word "mutant" is an ordinary English-language dictionary word indicating something that has undergone change or showing the effect of mutation. The word can be no more than vaguely allusive of a potential characteristic of the goods relied on under Earlier Mark 3 – there is nothing in the word that is essentially descriptive of the goods. I consider the word Mutant to be inherently distinctive to a medium degree in respect

14 *Sabel BV v Puma AG*, Case C-251/95 at [24]

of the relevant goods. Although the section 5(3) grounds of opposition include a claim of reputation for all of the goods of the Earlier Marks, the Opponent does not explicitly claim enhanced distinctiveness of the relevant goods under Earlier Mark 3 for the purposes of the section 5(2)(b) ground. In any event, although a close scrutiny of the invoice evidence may disclose limited references to goods such as "shaker cups" – which may be a form of plastic bottle – the evidence certainly fails to show use of the Earlier Mark 3 in respect of its relevant goods on a scale or with clarity anywhere nearly sufficient to enhance the distinctive character (or indeed show a reputation).

Conclusion as to likelihood of confusion

63. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods and services down to the responsible undertakings being the same or related.

64. In my global assessment of likelihood of confusion, I take account of all of my findings relevant to this ground. The factors operate interdependently:

(i) The applied-for goods in Class 21: *Perfume bottles* are identical to goods under Earlier Mark 3. The applied-for goods in Class 14: *Fashion jewellery* are similar to no more than a very low degree.

(ii) I have found the marks to be visually, aurally and conceptually similar to at least a medium degree;

(iii) The average consumer will be a member of the general public, who is reasonably well informed and reasonably circumspect and observant, and who will typically pay no more than a medium degree of attention in selecting and purchasing the goods at issue, and in that process visual considerations are likely to dominate, even where there may be an aural aspect in the purchase;

(iv) The earlier mark is inherently distinctive to a medium degree and there has been no enhancement to the distinctiveness of the earlier mark through use in relation to the goods.

65. I note that the Opponent's submissions in lieu state at paragraph 7 that the average consumer "will readily recognise the differences between the respective trade marks", but then says that the consumer "will believe that those [goods] originating from the Applicant under and by reference to its Trade Mark originate or are, in any way, associated with the Opponent or an economically linked undertaking." Moreover, the Opponent states later in its submissions in lieu that "given the clear and obvious similarities between the respective Trade Marks, the average consumer would [mistake one Mark for the other] and, therefore, there is direct confusion." It submits alternatively that where the consumer notices the difference between the Marks, they will conclude "that the later Mark is another brand of the owner of the earlier Mark or a related undertaking".

66. I bear in mind that a lesser degree of similarity between marks may be offset by a great degree of similarity between the goods (and vice versa). I find that given that between the marks "Mutant" and "Mega Mutant" there is at least a medium degree of similarity overall (and visually, which is significant in the purchasing process), and the greater significance of the shared word "mutant" (in dominance and distinctiveness), there is a real risk that the average consumer paying a medium degree of attention (or even a degree above that) may imperfectly recall the marks where used in respect of goods that may be considered identical – namely *Perfume bottles.* Equally, if the average consumer notices the additional word "mega", used in respect of identical goods, they may understandably conclude that the word "mega" is not distinctive but a sub-brand or brand extension of the earlier mark "Mutant" – for use, for instance, in respect of larger plastic bottles/perfume bottles.[15]

67. However, again taking the factors into account overall, and particularly the very low degree of similarity between the applied-for *fashion jewellery* and the goods relied on by the Opponent under Earlier Mark 3, I do not find that the average consumer

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15 See paragraph 17 of Case BL-O/375/10 17, the appeal decision of Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*

would be confused either directly or indirectly. I doubt that the shared presence of the word Mutant on goods of such low similarity would be enough even to call one mark to mind on encountering the other, but even if that were the case, that would be mere association, not indirect confusion. The section 5(2)(b) fails against the Applicant's goods in Class 14.

Outcome: There is a likelihood of confusion and the opposition based on section 5(2)(b) succeeds only in respect of the Applicant's goods in **Class 21:** *Perfume bottles.* Those goods may not proceed to registration.

The section 5(3) ground

68. The relevant wording of this section is set out at my paragraph 11 above. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, General Motors [1999] ETMR 950; Case 252/07, EU:C:2008:655 Intel, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, Adidas-Salomon, [2004] ETMR 10; and C-487/07, EU:C:2009:378, L'Oréal v Bellure [2009] ETMR 55; Case C-323/09, EU:C:2011:604, Marks and Spencer v Interflora; and Case C-383/12P, EU:C:2013:741, Environmental Manufacturing LLP v OHIM. The law appears to be as follows:

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: Intel, paragraph 42.

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark: L'Oréal v Bellure NV, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: L'Oréal v Bellure NV, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it: L'Oréal v Bellure NV, paragraph 44. Page 42 of 50

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

69. To succeed on this ground, the Opponent must establish (i) that Marks 1, 2 and 3 are similar to the Contested Mark, (ii) that they have a reputation in respect of the goods relied on and (iii) that use of the Contested Mark, without due cause, would lead to one or more of the heads of damage listed in the section. Those elements are cumulative, so the absence of any one element will defeat the claim.

70. The Earlier Mark "Mutant" and the Contested Mark are similar, satisfying the first requirement. The next matter is the claimed reputation for all of the goods under each of the Earlier Marks. To show that an earlier mark has acquired a reputation there must be clear and convincing evidence to establish all the facts necessary for a tribunal to conclude safely that the mark is known by a significant part of the public. Reputation cannot be merely assumed and must be evaluated by making an overall assessment of all factors relevant to the case.

71. In *Enterprise Holdings Inc. v Europcar Group UK Ltd,*[16] Arnold J (as he then was) stated that proving a reputation "is not a particularly onerous requirement." However, the evidence before Arnold J in that case showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that proving a reputation "is not a particularly onerous requirement." He had no reason to turn his mind to situations

16 [2015] EWHC 17 (Ch)

where the claimant had only a small and/or unquantified share of the relevant market.

72. Professor Phillip Johnson, as the Appointed Person in the SACURE appeal decision,[17] stated to the effect that it is not the case that a party relying on an earlier mark who has filed only weak, incomplete, or irrelevant evidence to establish the reputation should be given the benefit of the doubt at the expense of the other party. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time consuming) where a mark has the necessary reputation.

73. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I "take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it." That said, such evidential factors are only examples of relevant evidence; other "detailed and verifiable evidence" may be sufficient to establish reputation.[18]

74. While, on a generous construction, I have allowed that the evidence filed is sufficient to establish a limited degree of genuine use, there are notable aspects in which the evidence is very weak. The detail on what goods have been sold or promoted is lacking, there is, no information at all on UK market share and scant evidence of the general public in the UK having encountered the marks. Taken in the round the evidence falls hopelessly short of what would be needed to conclude that the Earlier Marks benefit from a reputation among the UK general public. This is the case even for the whey products that I have construed as covering the Class 5 goods such as *powdered protein supplements.* Evidence of use of the Opponent's mark for any of the other goods in respect of which a reputation is claimed is virtually or entirely absent.

75. **Outcome**: Since the Earlier Marks have no reputation, the opposition based on section 5(3) fails.

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17 Case BL O/360/20

18 *Farmeco AE Dermokallyntika v OHIM* Case T-131/09 at paragraph 59.

76. For the sake of completeness, while I bear in mind that similarity of goods is not a requirement under section 5(3), even if I had found the evidence sufficient to establish that Earlier Mark 1 had a limited reputation for its Class 5 goods, the distance in similarity between those goods and the contested goods and services is such that the relevant public would not call to mind the Earlier Mark "Mutant".

77. **Overall outcome of the opposition**:

- The Application may proceed to registration in respect of the applied-for goods and services in classes 3, 4, 9, 10, 11, 14, 28, 32, 33, 34, 36, 38, 41 and 43.

- The Application may not proceed to registration in respect of the applied-for goods in **Class 21:** *Perfume bottles.*

COSTS

78. The Applicant has successfully defended much of its Application – except in respect of *Perfume bottles* in Class 21. It is entitled to a fair contribution towards its costs in successfully defending the opposition, taking account of the scale published in the annex to Tribunal Practice Notice (2/2016). However, I bear in mind that the Applicant filed only a short counterstatement, chose (entirely appropriately) not to attend the case management conference, did not file evidence and filed only brief submissions in lieu. Its costs have therefore not been substantial. Moreover, I note that the opposition led the Applicant to withdraw its Application in respect of the goods opposed in classes 18, 25, 29 and 30. It is my view that each party should bear its own costs in these proceedings.

Dated this 3rd day of May 2024

Matthew Williams
Hearing Officer
For the Registrar