O/0757/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO UK00003874496
BY MICO HOWLES
TO REGISTER

MERAKHI

AS A TRADE MARK IN CLASSES 3, 14, 25, 26, 35 AND 42

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 442004
BY SOCIETY OF LIFESTYLES APS A.K.A HOUSE DOCTOR APS

BACKGROUND AND PLEADINGS

1. Mico Howles ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK on 3 February 2023. The application was accepted and published in the Trade Marks Journal on 21 April 2023 in respect of the following goods and services:

> **Class 3:** *Face masks.*
>
> **Class 14:** *Parts and fittings for jewellery; jewellery products; items of jewellery; jewellery items.*
>
> **Class 25:** *Clothing; Knitwear [clothing];jackets [clothing];ready-to-wear clothing; clothing layettes; clothes; gloves as clothing; gloves [clothing]; parts of clothing, footwear and headgear; embroidered clothing; windproof clothing; rainproof clothing; jackets (stuff -) [clothing]; ready-made clothing; bottoms [clothing];sports clothing; water-resistant clothing; men's clothing; beanie hats; hats; face masks [fashion wear] .*
>
> **Class 26:** *Clothing (Fastenings for -); fastenings for clothing.*
>
> **Class 35:** *Retail services connected with the sale of clothing and clothing accessories; retail services in relation to clothing accessories; wholesale services relating to automobile accessories; retail services in relation to fashion accessories.*
>
> **class 42:** *Design of clothing, footwear and headgear; designing of clothing; design of clothing; design of clothing accessories.*

2. On 19 July 2023, Society of Lifestyles ApS a.k.a House Doctor ApS ("the opponent") filed a notice of opposition based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at some of the goods in the application, namely:

Class 3: *Face masks*

3. The opponent relies on the following trade mark:

MERAKI
UK Trade mark no. 915887714[1]
Filing date 5 October 2016; date of entry in register 3 February 2017
Relying on some of the goods and services, namely:

> **Class 3:** *Face packs; Facial cleansers [cosmetic]; Cleaning masks for the face; Facial scrubs [cosmetic]; Lotions for face and body care, liquid soaps for hands and face.*

4. The opponent claims that due to the 'nearly identical' visual similarity and aural/conceptual identity alongside the identity/ high similarity between the goods at issue, there exists a likelihood of confusion on the part of the relevant public, which includes a likelihood of association. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark for all the goods relied upon.

5. The opponent is represented by Patrade A/S; the applicant represents itself. Only the opponent filed evidence in chief. No hearing was requested. No submissions in lieu of a hearing were filed. The decision is taken following a careful consideration of all of the papers.

6. 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

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law and retains its original filing date.

of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

7. As mentioned above, the opponent filed evidence. The opponent's evidence in chief came in the form of the statement of use of Troels Damgaard Madsen dated 24 November 2023. Mr Madsen holds the role of E-commerce Director at the Society of Lifestyle and is authorised to make this statement on behalf of the opponent. Mr Madsen's evidence is supported by 4 exhibits.

8. I do not intend to summarise the evidence in full here, however, I confirm that I have taken all of the filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of Use

9. Section 6A of the Act is as follows:

> "(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 sections 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."

10. The earlier mark is a comparable trade mark and so Paragraph 7 of Part 1 Schedule 2A of the Act is relevant, which reads as follows:

"(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."

11. Section 100 of the Act is as follows:

"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."

12. 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 I9223, 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 subcategory 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]."

13. Proven use of a mark which fails to establish that "the commercial exploitation of the marks is real" 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.

14. Given its filing date, the opponent's mark qualifies as an earlier trade mark under section 6 of the Act. The opponent's mark completed its registration process more than five years before the filing date of the application and, therefore, is subject to the proof of use conditions. As I have already said, the applicant has put the opponent to proof of use. The relevant period for the purpose of the proof of use assessment is the five-year period ending with the date of application for the contested mark. It is, therefore, from 4 February 2018 to 3 February 2023.

15. I am also guided by *Awareness Limited v Plymouth City Council,* Case BL O/236/13. 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."

16. I also note Mr Alexander Q.C.'s comments in *Guccio Gucci SpA v Gerry Weber International AG*, Case BL O/424/14. He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it." [original emphasis]

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* 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.

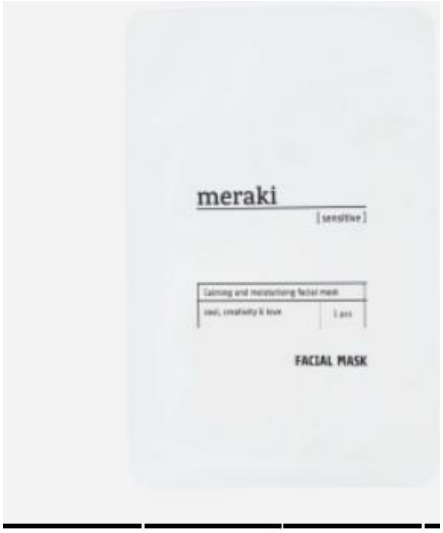
22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per 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."

The opponent's evidence

18. Mr Madsen submits that given that the opponent is only opposing the term face masks in the application, the relevant goods in the opponent's specification are "face packs". Accordingly, the opponent submits that the evidence it has provided pertains to the use of "face masks" in the opponent's mark. From its submissions, I am of the view that the opponent is submitting that face masks and face packs are interchangeable terms – I consider that this is the case.

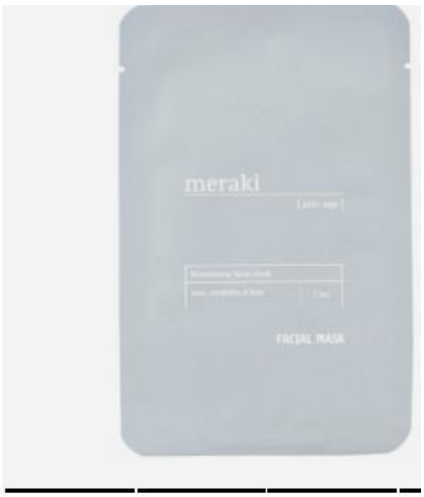
19. The opponent has provided evidence in the form of screenshots from three different online stores and sales figures pertaining to face masks from 2019 to 24 November 2023. I note the following evidence:

- Exhibit 1 contains snapshots from Buttiken.co.uk which demonstrate the use of the opponent's mark on facial masks. The snapshot was taken outside the relevant period on the 15 November 2023. Images of face masks bearing the opponent's marks appears in the screenshots as follows in the evidence:



FACIAL MASK – SENSITIVE

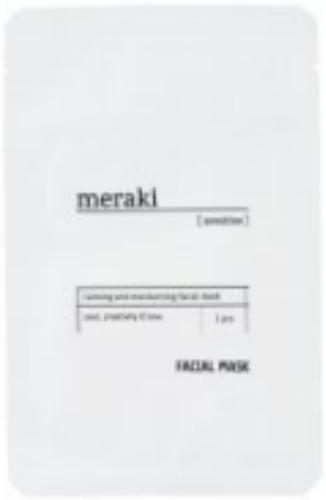
£6.00



FACIAL MASK – ANTI AGE

£6.00

- Exhibit 2 contains snapshots from the website danishcollection.co.uk which demonstrates the use of the opponent's mark on face masks. I note from the date at the bottom of the screenshots that they were taken on 15 November 2023 (outside the relevant period). An image bearing the opponent's mark on face masks appears as follows in the evidence:

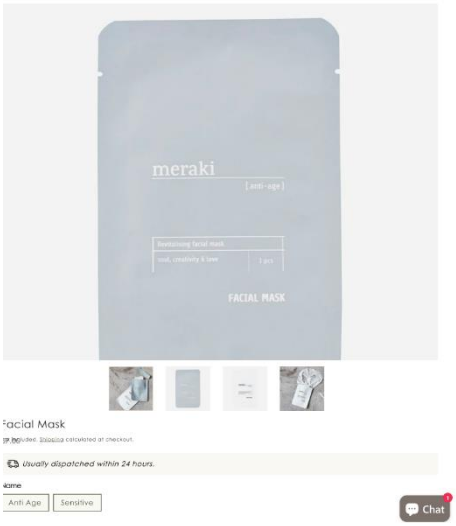


MERAKI

Facial Mask - Sensitive

£7.00

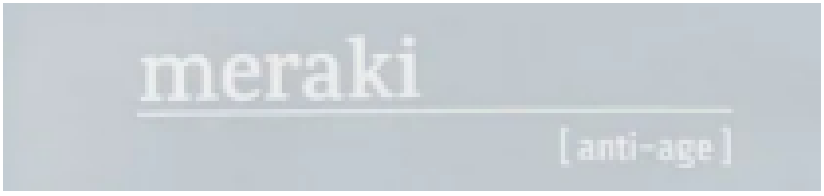
- Exhibit 3 contains snapshots from the website mynordicliving.co.uk which demonstrates the use of the opponent's mark on face masks. I note from the date at the top of the page that the snapshot was taken on 15 November 2023 (outside the relevant period). An extract from the snapshot demonstrating the opponent's mark appears as follows in the evidence:



- Exhibit 4 contains a list of sales figures that pertain to the sale of face masks between 9/1/2019 to 14/11/2023. Some of the sales figures are outside of the relevant period, subsequently, I have been unable to consider them in the figures. Each of the product names listed in the 'goods sold' section of the evidence contains the term facial mask. In its statement of use, the opponent indicates sales of 1455 (2019), 1985 (2020), 1556 (2021), 961 (2022) and 1228 (2023). From my assessment of the sales figures, I consider that the evidence demonstrates sales of 1455 (2019), 1985 (2020), 1556 (2021), 961 (2022) and 246 (2023). The difference in the figures summarised in the statement of use and those listed above can be attributed to the exclusion of figures in 2023 that fall outside of the relevant period and reductions in the total unit sales which, I can only attribute to, refunds or returns made by consumers of products purchased in the relevant period. I note that postcodes rather than locations have been provided to indicate the location of the purchasers. The postcodes provided indicate sales to the South East, South West, North East and North West of England, Scotland (including the outer islands in Scotland).

Form of the mark

20. Before considering whether the opponent has made genuine use of the mark and, if so, for what goods, I shall deal with the question of the form of the mark. The opponent's registration mark is the word 'Meraki' – it is a word only mark that is registered in black and white. In all instances throughout the evidence where the opponent has used the mark as registered – this is clearly use upon which the opponent can rely. I am of the view that the examples below are in line with fair and notional use of the mark as registered.



Genuine use of the mark

21. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown

22. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[2] I note that as the opponent's mark is a comparable mark it is

[2] *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

possible for the opponent to rely on evidence of use in the EU as set out in Tribunal Practice Notice 2/2020.[3]

23. I note that the opponent has not provided evidence regarding its turnover during the relevant period. However, as mentioned above, the opponent did provide figures pertaining to the number of units sold. The goods sold are described as "facial mask sensitive" and "facial mask firming" and the brand "Meraki" appears on the table. When cross referencing the opponent's unit sales to the opponent's goods as they appear on the websites discussed above in paragraph 19, I note that they show the opponent's mark on face mask products. On this point, the screenshots from the websites, while dated after the relevant period, may still be reflective of goods that were sold during the relevant period.

24. I note that the opponent has not provided evidence regarding its turnover figures during the relevant period other than the unit sales referenced above. However, I have calculated that the unit sales demonstrate evidence of the sale in the UK of 6203 units over the relevant period.

25. Although I do not have evidence or submissions from the parties to assist me on the size of the UK or EU market for the goods concerned, I believe the market to be substantial, numbering in hundreds of millions of pounds (and euros) per annum. In my view, when compared against the size of the relevant market, the total unit sales of 6203 (which according to the websites are sold at roughly £6 a unit) is low. Whilst I note that there is evidence of sales during the relevant period, I note that there is no evidence of sales in 2018. The figures provided are very small taking into account the likely size of the market for the goods and the number of units sold. However, I have taken into consideration that the market for face masks across the UK and EU is likely to be extremely competitive with a vast number of producers competing with one another.

26. Although the evidence is sufficient to establish that there have been some sales of the opponent's goods in the UK in the relevant period, the relevant test is whether the use shown is sufficient to qualify as genuine. As indicated in the case law cited

[3]https://www.gov.uk/government/publications/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings accessed 1/2/2022.

above, use does not need to be quantitively significant in order to be genuine. Proof of use is required to be shown in the EU for the period up to IP completion day (being 31 December 2020). In addition, I note that use of a mark in an area of the EU corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods being limited to that area of the European Union.[4]

27. There are some clear deficiencies in the evidence provided by the opponent. There is a lack of evidence in relation to the distribution of marketing and advertising evidence. However, as noted above genuine use requires a global assessment of the evidence as a whole. The evidence has demonstrated sales of the opponent's goods to consumers throughout the UK. These customers are situated in the North East, North West, South East and South West of England as well as Scotland (including the outer islands). The figures in relation to unit sales from the opponent's goods are far from overwhelming. Despite this, 6,203 units of face masks were sold during the relevant period to UK customers; these constitute a genuine attempt to create a market for the opponent's goods under their mark. I note that the cost per face mask is low. Further, I note that the sales are not simply attributable to a one-off sale but, instead, the opponent has demonstrated a consistent and repeated pattern of sales to various customers throughout the relevant period. Taking into consideration the above, I am of the view that the opponent has attempted to create and maintain a market for their goods under their mark. Therefore, I am satisfied that the opponent has demonstrated genuine use of its mark during the relevant period in the UK.

Fair specification

28. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

[4] The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM,* 57

"244. As I described in Maier v Asos, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark."

29. I note that the opponent's mark is registered for the following goods:

Class 3: *Face packs; Facial cleansers [cosmetic]; cleaning masks for the face; facial scrubs [cosmetic]; lotions for face and body care, liquid soaps for hands and face.*

30. As mentioned previously, the opponent stated the relevant goods in the opponent's specification are face packs and that the evidence provided pertains to the use of face masks in the opponent's mark (which I have stated previously is viewed to be a term interchangeable with face packs). Therefore, it is unsurprising that I do not consider that any use has been shown for "*facial cleansers [cosmetic]", "facial scrubs [cosmetic]"* and *"lotions for face and body care, liquid soaps for hands and face"* in the opponent's specification. Whilst the evidence specifically demonstrates products bearing the name 'face masks', as mentioned above, I consider the term to be interchangeable. Therefore, I consider that a fair representation of the goods is *"face packs"* and *"cleaning masks for the face".*

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

31. 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."

Section 5A of the Act is as follows:

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

32. 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 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 impression created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

33. The goods to be compared are as follows:

The applicant's goods	**The opponent's goods**
Class 3: *Face masks*	Class 3: *Face packs; cleaning masks for the face.*

34. As mentioned above in paragraph 30, I consider that the terms face packs and face masks are interchangeable terms. Therefore, whilst "face masks" is worded differently from "face packs" in the opponent's specification, I consider the goods to be identical.

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

35. As the law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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."

36. I consider the parties' goods to be consumer items aimed at members of the general public at large. There will be some face masks that will be inexpensive and frequently purchased, however, there will also be some more expensive face masks that may contain high-value ingredients, which are purchased fairly infrequently. The purchase will be overwhelmingly visual, with consumers self-selecting the goods from the shelves of physical retail stores or from their online equivalents. However, I do not ignore the potential for an aural aspect of the purchasing process, owing to conversations with retail assistants. Consumers will consider the fragrance, ingredients and suitability for their skin and needs when purchasing the goods. On the whole, no more than a medium degree of attention will be paid to the purchase, regardless of the cost of the goods.

COMPARISON OF THE MARKS

The applicant's mark	The opponent's mark
MERAKHI	MERAKI

37. It is clear from *Sabel BV 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 trade marks must be assessed by reference to all the overall impressions created by the trade marks, bearing in mind their distinctive and dominant

components. 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."

38. 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.

39. The applicant's mark consists of the word mark 'MERAKHI' presented in standard typeface and upper case. The opponent's mark consists of the word mark 'MERAKI' presented in standard typeface and upper case. There are no other elements that contribute to the overall impression of either mark.

40. Visually, the opponent's mark is made up of 6 letters and the applicant's mark is made up of 7 letters. The marks coincide with the letters M-E-R-A-K and I. The only point of difference is the letter 'H' which appears as the penultimate letter in the applicant's mark. Therefore, I consider the marks to be visually similar to a high degree.

41. Aurally, both marks will be pronounced 'MER-RAH-KEY'. There is no difference in how they will be pronounced, therefore, I consider the marks to be aurally identical.

42. Conceptually, the applicant submits that its mark 'MERAHKI' is a name. From my own knowledge I am aware that 'Merahki' is a name of Greek origin. Whilst I am of the view that members of the Greek community may view this mark as a name, I do not consider that a significant proportion of average consumers will identify that the mark is a name. Rather, I consider that it will be viewed as an invented word that will be attributed no obvious meaning. In relation to the opponent's mark, I consider that

the same reasoning applies. In this circumstance, given that no obvious meaning will be attributed to either mark, I find the marks to be conceptually neutral.

DISTINCTIVE CHARACTER OF THE OPPONENT'S MARK

43. 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 1-2779, 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)."

44. 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 a high inherent distinctive character, such as invented words which have no allusive qualities.

45. The opponent has not pleaded that its mark has acquired enhanced distinctive character through use. However, that does not preclude a finding of enhanced distinctive character and I will consider the evidence in support of such a claim.

46. The opponent's mark consists of the word 'MERAKI'. As mentioned above, I am of the view that the opponent's mark will be viewed as an invented term. The mark is neither allusive nor descriptive for any of the goods for which it is registered. Taking all of the above into account, I find the mark to be inherently distinctive to a high degree.

47. I shall now consider whether the inherent distinctive character has been enhanced through the use made of the mark. For the present circumstances, it is use in the UK that is relevant. While I found the evidence was enough to prove use, as there is no *de minimis* level, the assessment of enhanced distinctiveness requires sufficient use for the capacity of the mark to identify the goods as originating from a particular undertaking. This is a higher test and, in my view, the evidence falls short of what would be required to pass this test. As mentioned previously, the opponent did not provide turnover figures, rather they provided the number of units sold. These figures are low, although I accept that the goods are fairly cheap. For example, the face mask on the danishcollection.co.uk is shown as costing £6.[5] I recognise that the opponent has provided evidence of the user base in the UK and that the user base is widespread as it demonstrates sales throughout the UK. Further, I am mindful that the opponent has not demonstrated expenditure on marketing to promote the market across the UK. I note that the user base evidence does not suggest that use of the mark has been intensive. In addition, the opponent has provided no evidence of the proportion of the relevant class of persons who, because of the mark, identify its goods as originating from a particular undertaking nor has it provided any evidence of the market share of the opponent's mark. Taking this all into account, it is my view that the opponent's evidence falls short of what would be required to show that the degree of inherent distinctive character has been enhanced through use which, in any case, remains high.

LIKELIHOOD OF CONFUSION

[5] Exhibit 1

48. 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 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 or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful of 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 he has retained in his mind.

49. I have found the marks to be visually similar to a high degree, aurally identical and conceptually neutral. I have found the opponent's mark to have a high degree of inherent distinctive character. I have found the average consumer to be the general public and that the goods are likely to be selected visually, although I do not discount an aural component. I have found the goods to be identical. I have found the degree of attention paid during the purchasing process to be medium.

50. I consider that the difference between the marks is insufficient to avoid confusion, taking into account the principle of imperfect recollection. I am of the view that the average consumer will overlook or misremember the difference between the marks given that the only point of difference is the presence/absence of the letter 'H' which appears as the penultimate letter in the applicant's mark. In addition, I have found the goods to be identical and the marks to be visually similar to a high degree and aurally identical. Therefore, it is likely that the marks will be misremembered or mistakenly recalled as each other. I find that there is a likelihood of direct confusion between the marks.

CONCLUSION

51. The opposition succeeds. As the opponent only opposed one of the goods in the applicant's specification, part of the application will still proceed to registration. The opposition succeeds in relation to the following goods, for which the application is refused:

Class 3: *Face masks.*

52. The application can proceed to registration in respect of the following goods and services:

Class 14: *Parts and fittings for jewellery; jewellery products; items of jewellery; jewellery items.*

Class 25: *Clothing; knitwear [clothing];jackets [clothing];ready-to-wear clothing; clothing layettes; clothes; gloves as clothing; gloves [clothing]; parts of clothing, footwear and headgear; embroidered clothing; windproof clothing; rainproof clothing; jackets (stuff -) [clothing]; ready-made clothing; bottoms [clothing]; sports clothing; water-resistant clothing; men's clothing; beanie hats; hats; face masks [fashion wear] .*

Class 26: *Clothing (Fastenings for -); fastenings for clothing.*

Class 35: *Retail services connected with the sale of clothing and clothing accessories; retail services in relation to clothing accessories; wholesale services relating to automobile accessories; retail services in relation to fashion accessories.*

class 42: *Design of clothing, footwear and headgear; designing of clothing; design of clothing; design of clothing accessories.*

COSTS

53. In relation to the goods opposed by the opponent, the opponent has been entirely successful in its opposition and is entitled to costs. As the application was filed after 1 February 2023, the new costs scale outlined in Tribunal Practice Notice 1/2023 has been applied. In the circumstances, I award the opponent the sum of £950 as a contribution towards the costs of the proceedings.

The sum is calculated as follows:

Filing a notice of opposition and considering the other side's statement	£250
Preparing and filing evidence	£600
Official Fee	£100
Total	**£950**

54. I therefore order Mico Howles to pay Society of Lifestyles ApS a.k.a House Doctor ApS the sum of £950. This sum is to 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 12th day of August 2024

A KLASS
For the Registrar