

O/0817/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

REGISTRATION NO. UK00003166146

IN THE NAME OF QINGDAO ECOPURE FILTER CO., LTD

AND (I) A REVOCATION FOR NON-USE THERETO UNDER NO. 506149

AND (II) AN APPLICATION FOR DECLARATION OF INVALIDITY THERETO

UNDER NO. 506796

BY WATERDROP MICRODRINK GMBH

AND

REGISTRATIONS NOS. UK00917881798 AND UK00003696880

IN THE NAME OF WATERDROP MICRODRINK GMBH

AND APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO

UNDER NO. 505859 AND 505857

BY QINGDAO ECOPURE FILTER CO., LTD

AND

APPLICATIONS NOS. UK00003845931 AND UK00003867136

IN THE NAME OF QINGDAO ECOPURE FILTER CO., LTD

AND OPPOSITIONS THERETO UNDER NOS. 440448 AND 441523

BY WATERDROP MICRODRINK GMBH

BACKGROUND AND PLEADINGS

1. This decision deals with six consolidated actions between Qinqdao Ecopure Filter Co., Ltd (Quindao) and Waterdrop Microdrink GmbH (WMG). Both own UK trade marks for the brand name 'WATERDROP'.

2. The consolidated proceedings include invalidity, revocation for non-use and opposition matters all relating to trade marks consisting of the single word 'WATERDROP', though one of marks at issue contains other figurative and verbal elements. To avoid any confusion, I shall anticipate that WMG owns two trade mark registrations for the identical word 'WATERDROP' covering goods in class 32 (i.e. UK00914996888 and UK00003696880); however, only the latter is subject to proof of use in one of the proceedings at issue.

3. I will set out initially the background to each of the proceedings. However, since the issues were narrowed down during the course of the hearing, the relevant matters I have to decide are now as follows:

First set of proceedings: revocation for non-use under no. 506149 against Quindao's trade mark registration no. UK00003166146.

4. This action concerns a revocation for non-use brought by WMG against Quindao's trade mark registration no. UK00003166146. The details of Quindao's trade mark are as follows:

UK00003166146

Waterdrop

Filing date: 24 May 2016

Registration date: 26 August 2016

Class 11: Water filters; Air filtering installations.

5. On 26 May 2023, WMG applied to revoke Quindao's trade mark in full based on Section 46(1)(a) of the Trade Marks Act ("the Act") on the basis of non-use within the period of 5 years following the date of the registration, namely 27 August 2016 to 26 August 2021 ("the relevant period"). Revocation is therefore sought from 27 August 2021.

6. Initially, WMG also contended that any use of this mark made by Quindao is not relevant because the assignment of 21 December 2021 - which transferred the ownership of this mark from the original proprietor to Quindao - is void for want of consideration. However, this issue is no longer pursued,¹ and I will say no more about it.

7. Quindao filed a counterstatement denying the claims and stating that the mark has been put to genuine use within the five years preceding 31 May 2023. Notably, this would be between 1 June 2018 and 31 May 2023 with the first three years which partially overlap with the relevant period of 27 August 2016 to 26 August 2021.

8. Further, in its skeleton argument, WMG conceded that there has been genuine use by Quindao in respect of "water filters" but maintained that the revocation action should succeed in relation to "air filtering installations". Given WMG's concession, the one outstanding matter that I have to deal with is whether there has been genuine use of the UK00003166146 mark in relation to "air filtering installations".

Second set of proceedings: application for invalidity under no. 506796 against Quindao's trade mark registration no. UK00003166146 (i.e. the same mark subject to the revocation for non-use detailed above).

9. In addition to the revocation for non-use, on 14 December 2023 WMG applied to invalidate Quindao's trade mark registration no. UK00003166146 in full, on the basis

¹ See paragraph 10 of WMG's skeleton argument and Annex 1 to WMG's skeleton argument.

of Section 47 and Section 5(2)(a) and (b) of the Act based on its earlier trade mark no. UK00914996888, the details of which are shown below:

UK00914996888

WATERDROP

Filing date: 13 January 2016

Registration date: 28 April 2016

This mark is registered for various goods in classes 5, 32 and 33 but WMG relies on the following goods only:

Class 32: *Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages.*

10. WMG argues that the respective goods are similar because they are “*all used in connection with the preparation and/or consumption of other beverages*”, that the marks are similar, and that as such there exists a likelihood of confusion including a likelihood of association between the marks.

11. Quindao filed a counterstatement wherein it: (a) admitted the identity of the marks (but denied similarity), (b) denied that the goods are similar and (c) denied any likelihood of confusion and (d) put WMG to proof of use in relation to all of the goods relied upon. In particular, in relation to the similarity of the goods, Quindao argued as follows:

“The Class 11 goods in the mark at issue are entirely related to filters, namely water filters and air filters. Both of these goods are therefore mechanical components for filtering. In contrast, the Class 32 goods relied upon by [WMG] are all additives that can be used to prepare a flavoured beverage. The goods therefore have an entirely different nature.”

Additionally, the goods in [WMG] mark are all for flavouring beverages, while the goods in [Qingdao's mark] are for filtering. Thus, the purpose of the goods is also entirely different. In fact, if a filter were used in conjunction with the flavouring goods, the filter would inherently work to remove the added flavouring.

The trade channels for the goods are also different, as a consumer would expect to purchase additives for preparing drinks from a supermarket in the food and drinks department, along with other food and drink products. In contrast, air and water filters are generally found in homeware or kitchen appliance shops, or the homeware or kitchen appliance departments in supermarkets.

Finally, the goods are not complementary to one another, in that one is not essential or important for the use of the other such that a consumer may think that responsibility for both lies with the same commercial undertaking. In fact, as mentioned above, the goods are inherently non-complementary.”

12. In its skeleton argument, WMG restricted the invalidity attack to “*water filters*” only, conditional upon the revocation for non-use succeeding in relation to “*air filtering installations*”. Further, Qingdao conceded that WMG made genuine use of its trade mark UK00914996888 in relation to *Preparations for making beverages; Pastilles for flavouring beverages* (the registered term is *Pastilles for effervescing beverages*) and *Powders for the preparation of beverages* (in class 32) but only insofar as they cover goods used for flavouring. I shall return later to this concession.

13. Based on the above, the remaining issues in these proceedings are: (1) if WMG has put its earlier mark to genuine use during the relevant period of five years ending with the date of the application for invalidity, i.e. 14 December 2018 to 14 December 2023, in relation to the claimed goods for which Qingdao did not concede genuine use, namely *Essences for making beverages* and *Pastilles for effervescing beverages* (insofar as they might be broader than the conceded *Pastilles for flavouring beverages*); (2) whether Qingdao’s concession as to genuine use being restricted to goods which are used for flavouring is consistent with the core and natural meaning

of the registered terms, or whether the meaning of the registered terms and the use shown justify a wider fair specification; (3) whether the earlier goods (in relation to which genuine use is established) are similar to “*water filters*” (and also to “*air filtering installations*” if the latter survives the revocation for non-use);² and (4) whether there is a likelihood of confusion.

Third set of proceedings: application for invalidation under no. 505859 against WMG’s trade mark no. UK00917881798.

14. This dispute concerns an application for partial invalidity brought by Qingdao against WMG’s trade mark registration no. UK00917881798. The details of WMG’s trade mark are as follows:

UK00917881798



Filing date: 29 March 2018

Registration date: 01 August 2018

Class 5: *Vitamin supplements; Vitamin tablets; Vitamin preparations; Vitamin drinks; Effervescent vitamin tablets.*

Class 21: *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels.*

Class 30: *Flavourings, other than essential oils, for beverages; Flavourings for beverages.*

² See page 3 of the transcript

Class 32: *Beverages containing vitamins; Soft drinks; Preparations for making beverages; Essences for making beverages; Powders for the preparation of beverages; Pastilles for effervescing beverages.*

15. Qingdao's application for invalidity was filed on 24 February 2023, it is based on Section 5(2)(b) of the Act and is directed against some of the registered goods, namely those in class 21 (i.e. *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels*) which I have highlighted by underlining in the table above.

16. In this invalidity action, Qingdao relies upon all of the registered goods of its earlier trade mark registration no. UK00003166146 (i.e. the mark which is subject to the revocation and invalidity actions set out above). It argues that the respective goods are similar, that the marks are similar, and that as such there exists a likelihood of confusion including a likelihood of association between the marks. In particular, in relation to the similarity of the goods, Quindao argued as follows:

“The goods in Class 21 of the mark in question are similar to those in the earlier mark. Water filters, as referred to in the earlier mark, often include a container such as a pitcher or a decanter to hold the filtered water. The filtered water is then generally used for drinking. Thus, the average consumer would understand that the water filter of the earlier mark would be likely to contain a decanter, bottle, or flask, as listed within Class 21 of the mark in question. Further, the water filter of the earlier mark and decanters, glasses, tumblers and drinking vessels have the same nature (namely containers for drinking water) and purpose (namely to hold drinking water). The goods also have the same end user. Further, the high similarity between the dominant and distinctive parts of the two marks offsets any differences in the goods listed. As such, there exists a likelihood of confusion on the part of the public and so this class should be revoked in its entirety.”

17. For the sake of completeness, I should say that on 06 March 2023 an official letter was sent to Qingdao asking it to review its answer in the Form TM26(1) to Q3; the answer provided incorrectly stated, in fact, that the earlier mark (which had completed its registration process on 26 August 2016) had been registered for 5 years or more

prior to UK00917881798 being filed (29 March 2018). Nonetheless, the mark is still subject to one proof of use³ by virtue of having been registered for 5 years or more before the application for invalidity was filed. The relevant period for proof of use in this case is 24 February 2018 to 24 February 2023 (in the revocation for non-use against the same mark UK00003166146 the relevant period for proof of use is only partially overlapping being it 27 August 2016 to 26 August 2021).

18. WMG filed a counterstatement denying the claim made and putting Qingdao to proof of use in relation to *water filters* only (but not in relation to *Air filtering installations* which are also relied upon by Qingdao). Although in its original counterstatement WMG raised the same assignment issue which I have discussed above, as it will be recalled, this is no longer pursued. As regards the similarity of the goods, WMG stated as follows:

“[Qingdao] wrongly seeks to conflate water filters with vessels adapted to contain water which would be regarded by members of the relevant public, namely consumers of bottled water and other beverages as being entirely unrelated and distinct. In general, water filters are functional engineering components with a specific application and are often installed as part of a plumbing system connected to domestic appliances such as a sink and as such are distinct from goods for which the proprietor’s mark is registered, and so would not result in a likelihood of confusion arising in the minds of consumers.”

Fourth set of proceedings: application for invalidation under no. 505857 against WMG’s trade mark no. UK00003696880

19. Along with the above invalidity action, on the same date of 24 February 2023, Qingdao brought another application for partial invalidity against another trade mark in the name of WMG. The attacked registration in these proceedings is UK00003696880, the details of which are below:

³ Had the earlier mark been registered for five years or more at the date the challenged mark was filed then POU would also be required in the five years ending on the application date of the challenged mark.

UK00003696880

WATERDROP

Filing date: 17 September 2021

Registration date: 29 July 2022

Class 5: *Vitamin supplements; Vitamin tablets; Vitamin preparations; Effervescent vitamin tablets; Vitamin drinks.*

Class 6: *Sealing caps of metal; Closures of metal; Bottle closures of metal.*

Class 9: *Optical and/or electromagnetic and/or electric equipment for determining the fill level of a container integrated in closures for containers (including screw closures); Communications equipment (in particular featuring a data interface featuring short-range radio transmission) for data exchange with a smartphone, tablet, PC or the like integrated in closures for containers (including screw closures); Mobile Apps.*

Class 11: *Water filters; Water filtering units; Membranes for the filtration of water; Water filtering apparatus for domestic use; Water conditioning units; Water treatment apparatus for water softening; Chilled purified water dispensers; Equipment for generating electromagnetic radiation for disinfecting containers and/or for disinfecting container content; UVC spotlights for the purification of a liquid; Generators for ultraviolet radiation (UVC); Water purification units; Water disinfection apparatus.*

Class 21: *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels; Bottles; Glass flasks [containers]; Heat-insulated containers for beverages; Insulating flasks; Tea cups; Teapots; Tea services [tableware]; Tea caddies.*

Class 32: Beverages containing vitamins; Non-alcoholic beverages; Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages.

20. Qingdao's invalidity application is based on Sections 5(1), 5(2)(a), 5(3) and 5(4)(a)⁴ with Qingdao relying upon its earlier trade mark registration no. UK00003166146 (i.e. the mark that is subject to the revocation and invalidity actions set out above). Whilst under Section 5(3) Qingdao claims reputation in relation to *water filters* only, under Section 5(1) and 5(2) it relied upon all of the goods for which the mark is registered, namely *water filters* and *air filtering installations*; likewise, under Section 5(4)(a) it claims to own goodwill in relation to both *water filters* and *air filtering installations*.

21. Under Section 5(1) and 5(2)(a) the invalidity is directed against the goods in classes 11 and 21 (highlighted in underlying), whilst under Section 5(3) and 5(4)(a) the attack is broadened to include the goods in classes 6 and 9 (highlighted in both underlying and bold) with the exception of *Mobile Apps* that is not objected.

22. Under Section 5(1) and 5(2)(a) Qingdao argues the similarity of the respective goods in the following terms:

“Class 11 of the mark in question covers various goods, which are identical to the goods in Class 11 of the earlier mark, such as “water filters”, “Water filtering units” and “water filtering apparatus for domestic use”. The rest of the goods in Class 11 are highly similar to the goods in the earlier mark, as they all relate to water filtration, purification or treatment. Thus, these goods have the same nature and purpose as the “water filters” in the earlier mark, as well as the same trade channels and end users. Further, the identity of the two marks offsets any differences in the goods listed. As such, there exists a likelihood of confusion on the part of the public and so this class should be revoked in its entirety. The goods in Class 21 of the mark in question are similar to those in the earlier mark. Water filters, as referred to in the earlier mark, often include a container such as a pitcher or a decanter to hold the filtered water. The filtered water is

⁴ The Section 5(3) and 5(4)(a) were added later

then generally used for drinking. Thus, the average consumer would understand that the water filter of the earlier mark would be likely to contain a decanter, bottle, or flask, as listed within Class 21 of the mark in question. Further, the water filter of the earlier mark and decanters, glasses, tumblers, drinking vessels, bottles, glass flasks, heat-insulated containers for beverages, insulating flasks, tea cups, teapots, tea services and tea caddies have the same nature (namely containers for drinking water) and purpose (namely to hold drinking water). The goods also have the same end user. Further, the identity of the two marks offsets any differences in the goods listed. As such, there exists a likelihood of confusion on the part of the public and so this class should be revoked in its entirety.”

23. In addition, under Section 5(3) Qingdao states:

“Containers for beverages and closures therefore (Classes 6 and 21) are used with and/or are parts of the means for producing beverages (water filters). Further, the goods in Classes 9 and 11 relate to means for producing beverages that are even closer (and in some cases identical) to the goods of the earlier mark.”

24. Under Section 5(4)(a), Qingdao claims to have used the sign ‘Waterdrop’ since 2015 throughout the UK in relation to *water filters* and *air filtering installations* and to have acquired a significant goodwill under the sign.

25. WMG filed a counter statement denying the claim made and putting Qingdao to proof of use in relation to *water filters* only (but not in relation to *Air filtering installations* which are also relied upon by Qingdao). As regards the similarity of the goods, WMG states as follows:

“The Applicant wrongly seeks to conflate water filters with vessels adapted to contain water which would be regarded by members of the relevant public, namely consumers of bottled water and other beverages as being entirely unrelated and distinct. In general, water filters are functional engineering components with a specific application and are often installed as part of a

plumbing system connected to domestic appliances such as a sink and as such are distinct from goods for which the Proprietor's mark is registered, and so would not result in a likelihood of confusion arising in the minds of consumers.[...]

It is further denied that the goods in Classes 6 and 21 identified by the Applicant' ... are used with/or are parts of the means for producing beverages ...'. Such items are merely vessels or a means of providing a closure for such vessels for the purposes of enabling the user to drink or otherwise consume the contents of the vessel at his or her convenience. There is no proper or understandable basis for the assertion that such goods are involved in or are otherwise connected with the production of beverages. Moreover, the goods in Class 9, in any event, are not, properly understood, connected with the production of beverages but instead are concerned with the use of information technology to monitor consumer consumption.

Similarly, the goods in Class 11 do not relate to beverage production but relate to post- production means of purification and/or disinfection. It is denied that the public would form the link necessary for Section 5(3) given the distinct differences between the Proprietor's goods in Classes 6,9 and 21, and the majority of the goods in Class 11, and the goods of the Applicant's mark”.

26. Although in its original counterstatement WMG raised the same assignment issue which I have discussed above, as it will be recalled, this is no longer pursued.

Fifth set of proceedings: opposition under no. 440448 against Quindao's application to register trade mark no. UK00003845931

27. On 26 April 2023, WMG filed two oppositions against two trade marks applications in the name of Quindao. The details of the first trade mark application are as follows:

UK00003845931

Waterdrop

Filing date: 04 November 2022

Publication date: 27 January 2023

Class 2: *Anti-rust preparations; Antirust agent coating for vehicles; Colorants for beverages; food dyes; toner for printers and photocopiers; Tattooing ink; anti-corrosive preparations; pigments; printing ink; Cartridges filled with toner for computer print-out apparatus; paints; colophony.*

Class 3: *Cleaning preparations; Automotive cleaning preparations; windshield cleaning liquids; Wheel Cleaner; Carpet cleaners; polishing wax; Foam cleaning preparations; Vehicle cleaning preparations; soap; stain removers; polishing preparations; grinding preparations; essential oils; cosmetics; breath freshening sprays; Aromatherapy preparations; deodorants for human beings or for animals; air fragrancing preparations.*

Class 6: *Nozzles of metal; Pressure Washer Spray Nozzle; Turbo Nozzle; Adjustable nozzle; jets of metal; water-pipe valves of metal; water-pipes of metal; junctions of metal for pipes; Metal joints for rotary pipes; Garden Hose Adapter; Manual Hose Reel; Metal containers for carbon dioxide made entirely or mainly of ordinary metals or their alloys; Metal pipe fittings; Steel cylinders for compressed gas; containers of metal for compressed gas or liquid air; Steel cylinders for liquid air; winding spools of metal, non-mechanical, for flexible hoses; reels of metal, non-mechanical, for flexible hoses; cask stands of metal; Water tanks of metal for household purposes; Metal beverage cans; props of metal; ironmongery; hardware of metal, small; Metal junctions for pipes; Elbows of metal for pipes; branching pipes of metal; Common metal pipes and fittings; trellis of metal; Nails; Metallic containers; soldering wire of metal; mooring bollards of metal; identification bracelets of metal; wind-driven bird-repelling devices made of metal; tree protectors of metal; traps for wild animals; monuments of bronze for tombs; common metals, unwrought or semi-*

wrought; rails of metal; wire gauze; cable joints of metal, non-electric; cattle chains; accordion doors of metal; locks of metal, other than electric; safes, electronic; wire stretchers [tension links]; bins of metal; signboards of metal; works of art of common metal; ores of metal.

Class 7: *Electric car washers; washing apparatus; High pressure washers; Undercarriage Cleaner; High-pressure pumps for washing appliances and installations; Floor polishing machines; Car vacuum cleaners; Machines and apparatus for wax-polishing, electric; spotless car washing system; washing installations for vehicles; Agricultural machines; Machinery and appliances for fishing and animal husbandry; Machinery and components for the food industry; Brewing machines; Electric kitchen tools; washing machines [laundry]; steam condensers [parts of machines]; pumps; valves; Gas compressors; blowing machines; Hydraulic tools; Pneumatic tools [machines]; Heat exchangers [parts of machines]; aerating pumps for aquaria; Wave-making pumps for aquariums; Packaging machines for food; dyeing machines; Tea processing machines; mixing machines; wrapping machines; dishwashers; industrial machinery for pharmacy processing; stamping machines; Electric hand drills; hair cutting machines for animals; saw benches [parts of machines]; Paper diaper manufacturing machines; porcelain enamel manufacturing engine; Briquetting machines; glass-working machines; electromechanical machines for chemical industry; Rolling mills for metalworking; belt conveyors; foundry machines; Fuel and air mixture regulators being parts of internal combustion engines; Needle making machines; Wire forming machines; optics cold processing equipment; painting machines; filters for cleaning cooling air, for engines; water heaters [parts of machines]; labellers [machines]; Compressors; disintegrators; Pressing machines; papermaking machines; machines for the textile industry; Embossing machines; bicycle assembling machines; industrial inkjet printing machines; cord making machines; machinery for bulb making; Injection plastic molding machines; Fertilizer manufacturing machines; rinsing machines; drilling rigs; trimming machines; fittings for engine boilers; wind driven power equipment; Buttonholing machines; industrial installation for static electricity; alternators; bearings [parts of machines]; Welding machines, gas-operated; electroplating machines; apparatus for aerating water; spin driers [not*

heated]; filtering machines; Hydraulic boosters (machine components); welding machines, electric; tobacco processing machines; Electric sewing machines; Casting machines for ceramics; Cutters being powered by mains electricity or batteries.

Class 8: *Guns [hand tools]; Extension bars for hand tools; Pressure Washer Extension Wand; pressure washer Gun; Car washing machine gun rod butt; side arms, other than firearms; hobby knives [scalpels]; metal band stretchers [hand tools]; agricultural implements, hand-operated; table cutlery [knives, forks and spoons]; Knives; screw-thread cutters [hand tools]; garden tools, hand-operated; razor blades; nail clippers, electric or non-electric; hand tools, hand-operated; Electric hair clippers for animals [hand instruments]; harpoons; knife handles; livestock marking tools; Knives for skinning animals; handles for hand-operated hand tools; scythe handles; Spanners.*

Class 9: *Computer application software for mobile phones; Equipment for treating water to be purified, i.e. flow and fill control units and flow metering units (Brita) for domestic or industrial use; The water test kit includes water test instruments, as well as accessories for lead, nitrate, pH, water hardness, chlorine, copper, iron, bacteria and pesticide chemical tests, which are sold as a unit for monitoring and detecting pollutants; Downloadable software; wireless switch system for controlling distribution of filtered water through faucets; Ice machine water quality monitoring system controller, namely, for monitoring the ph value and solid level of the water controller; Electronic leak detector for detecting leaks in vacuum and closed containers; Leak detection apparatus; Vacuum measuring instruments; time recording apparatus; Counters; water meters; Pressure gauges; wires, electric; materials for electricity mains [wires, cables]; Power Cord ; power adapters; Quantity indicators; Infrared detectors; safety life jackets; batteries; Chargers; electronic tags for goods; pedometers; apparatus to check stamping mail; cash registers; mechanisms for coin-operated apparatus; Electronic terminals for generating lottery tickets; Facial recognition software; Copying machines; scales; Rulers [measuring instruments]; blinkers [signalling lights]; aerials; microphones; screens [photography]; measuring apparatus; laboratory robots; dynamometers; satellites*

for scientific purposes; binoculars; polysilicon; integrated circuits; conductors, electric; cell switches [electricity]; video screens; Remote controllers; optical fibers [fibres] [light conducting filaments]; power station automatization equipment; lightning conductors; ionization apparatus not for the treatment of air or water; fire extinguishers; radiological apparatus for industrial purposes; protective helmets; theft prevention installations, electric; eyeglasses; accumulators, electric, for vehicles; animated cartoons; electronic collars to train animals; Water testing instrumentation for monitoring and detecting contamination; Pressure controller for water filter.

Class 16: *Plastic food storage bags for household use; Bags for microwave cooking.*

Class 17: *Non-metallic flexible pipes; Pressure hoses (Non-metallic -); PU tubing; Air, water and material conveying pipes; junctions, not of metal, for pipes; fittings, not of metal, for rigid pipes; Non-metal elbows for pipes; rings of rubber; water-tight rings; Sealing gasket; artificial resins, semi-processed; semi-processed synthetic resins; watering hose; hoses of textile material; canvas hose pipes; latex [rubber]; stuffing rings; plastic filaments for 3D printing; Organic glass, semi-processed; electronic control photic plastic film; flexible hoses, not of metal; asbestos; Insulating materials for insulation against heat; waterproof packings; Strip seal (for cigarette) ; floating anti-pollution barriers; Seals (Non-metallic -) for floating roof storage tanks; fittings, not of metal, for flexible pipes; Plastic hose, pipe and tubing couplings for use in industrial and medical products and fluid handling systems; Pipe fittings [junctions] (non-metallic -) parts of rigid water pipes; valves of rubber; nonmetal pipe fittings in the nature of pipe reducers of rubber or plastic; non-metal valve flange adaptors; plastic support for water filtration equipment; watering hoses; Flexible pipes not of metal.*

Class 20: *Racks [furniture]; trestles [furniture]; Non metal bucket; furniture; packaging containers of plastic; Steps [ladders], not of metal; Mirrors; rattan; identity plates, not of metal; decorations of plastic for foodstuffs; nesting boxes for household pets; identification bracelets, not of metal; furniture fittings, not of metal; pillows; curtain tie-backs.*

Class 21: *Pet feeding and drinking bowls; Household and kitchen appliances (non electric) for preparing bubble drinks; portable beverage dispensers; coffee filters, non-electric; Insulating sleeves for beverage cans; Beverage coolers [containers]; Reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; all-purpose portable household containers; Foam Cannon/can; car washing mitts; polishing gloves; Rags for cleaning; Dusting cloths; Cleaning cloth; chamois leather for cleaning; mops; Cleaning sponges; buckets; Insert Grit Trap; Brushes for cleaning cars; Portable beverage container holders; Storage tins; Drinking cups; Kettles [non-electric]; ceramics for household purposes; Works of art made of crystal; drinking vessels; perfume burners; combs; brushes; toothbrushes; toothpicks; cosmetic utensils; thermally insulated containers for food; crystal [glassware]; drinking troughs; indoor aquaria; fly swatters; pet feeding bowls; pet feeding bowls, automatic; Feeding vessels for pets; Animal-activated livestock waterers; Animal-activated animal feeders; Automatic pet feeders; portable, non-mechanized pet drinking device for feeding water to a pet; Pet drinking bowls; Cages for pets; automatic litter boxes for pets.*

28. The opposition was initially brought under Sections 5(1), 5(2)(a), 5(3), 5(4)(a) and 3(6), however, in its skeleton argument, WMG withdrew its claims under Sections 5(3), 5(4)(a) and 3(6). Consequently, the only outstanding issues are those under Section 5(1), 5(2)(a). Under those grounds, the opposition is directed at the underlined goods in class 21 (namely, *Insulating sleeves for beverage cans; Reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; Drinking cups; ceramics for household purposes; drinking vessels*) with WMG relying on its earlier trade mark number UK00003696880 (which is subject to invalidity no. 505857) and all of the goods in classes 5, 6, 9, 11, 21 and 32 for which that mark is registered. The earlier mark in these proceedings is not subject to proof of use, as it had not been registered for five years or more at the date when the contested mark was filed (i.e. the earlier mark was registered on 29 July 2022 whereas the contested mark was filed on 04 November 2022).

29. As regards the similarity of the goods, WMG argues that the goods are self-evidently identical or similar as they are all used in connection with the preparation and/or consumption of water and other beverages.

30. Qingdao filed a counterstatement denying the claim made. As regards the similarity of the goods, Qingdao states as follows:

“...in contrast to the opponent’s claim under Section 5(2)(a), the goods “insulating sleeves for beverage cans” are not similar to those listed in the earlier application. All of the relevant goods listed in the earlier application are containers for liquids, such as drinking vessels and bottles. Thus, insulating sleeves have an entirely different nature and intended use compared to the goods in the earlier mark. In view of these differences, the use of the mark on these goods would not create a likelihood of confusion in the minds of the average consumers.”

Sixth set of proceedings: opposition under no. 441523 against Quindao’s application to register trade mark no. UK00003867136

31. The second opposition was brought against Quindao’s trade mark application no. UK00003867136, the details of which are shown below:

UK00003867136

WATERDROP

Filing date: 12 January 2023

Class 7: Apparatus for aerating water; Machines for the production of soda water and sparkling beverages; beverage preparation machines, electromechanical; food preparation machines, electromechanical; mixing machines; juice extractors, electric; apparatus for aerating beverages; bottle filling machines; mills for

household purposes, other than hand-operated; blenders, electric, for household purposes.

32. On 23 June 2023, WMG opposed the application based upon Section 5(2)(a), 5(3) and 5(4)(a), however, as above, the claims under Sections 5(3), 5(4)(a) have been withdrawn.

33. Under Section 5(2)(a), WMG relies upon the same earlier mark UK00003696880 which is relied upon in the other opposition and some of the goods in class 32 covered by it, namely *Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages*. The opposition is directed against the underlined goods, namely *Apparatus for aerating water; Machines for the production of soda water and sparkling beverages; beverage preparation machines, electromechanical; apparatus for aerating beverages*.⁵ The earlier mark in these proceedings is not subject to proof of use, as it had not been registered for five years or more at the date when the contested mark was filed (i.e. the earlier mark was registered on 29 July 2022 whereas the contested mark was filed on 12 January 2023).

34. As regards the similarity of the goods, WMG argues that the goods are self-evidently identical or similar as they are all used in connection with the preparation and/or consumption of water and other beverages.

35. Qingdao filed a counterstatement denying the claim made. As regards the similarity of the goods, Qingdao states as follows:

“The opponent argues that the Class 32 goods in their earlier mark are similar to the Class 7 goods of the present application. However, this is not the case as the Class 7 goods are entirely related to mechanical and/or electric apparatus for preparing beverages. In contrast, the Class 32 goods relied upon by the opponent are all additives that can be used to prepare a beverage.

⁵ Initially the opposition was also directed against *juice extractors, electric and bottle filling machines*, however, these are no longer objected.

The goods therefore have an entirely different nature. Additionally, the goods in the earlier mark are all for flavouring beverages, while the goods in the present application are for aerating or extracting beverages. Thus, the purpose of the goods is also entirely different.

The trade channels for the goods are also different, as a consumer would expect to purchase additives for preparing drinks from a supermarket, along with other food and drink products. In contrast, machinery for making beverages is generally found in homeware or kitchen appliance shops.

The fact that all of the goods are in some way related to beverages, as argued by the opponent, is not sufficient to demonstrate any similarity. Thus, the goods are not similar and so there cannot be likelihood of confusion in the mind of the average consumer, as required under Section 5(2)(a).”

Representation

36. WMG is represented by Simmons & Simmons LLP. Qingdao is represented by Brand Murray Fuller LLP. Both parties filed evidence during the evidence rounds. A hearing was requested which was heard before me on 29 January 2025, via video conference. Ms Jessica Fuller of Brand Murray Fuller LLP appeared for Qingdao and Mr Darren Meale of Simmons & Simmons appeared for WMG.

Evidence

37. Qingdao filed evidence in chief in the form of:

- i. The witness statement of Shengda (Aiden) Zhang dated 15 December 2023 which is accompanied by 14 exhibits (SZ1 to SZ14). Mr Zhang is the Senior Vice President of Qingdao, a position he has held since 2018. His evidence goes to the use of the mark ‘WATERDROP’ by Qingdao.

- ii. The witness statement of Xin Wen dated 15 December 2023 which is accompanied by 4 exhibits (XW1 to XW4). Mr Wen provides a translation of exhibits SZ11 and SZ12 to Mr Zhang's witness statement.

In addition to this evidence, Qingdao filed two lots of submissions, one dated 29 November 2023 and the other dated 1 May 2024.

38. WMG filed evidence in chief in the form of:

- iii. The witness statement of Thomas Henry Murray dated 28 November 2023 which is accompanied by one exhibit (THM-1). Mr Murray is the Chief Marketing Officer of WMG, a position he has held since 2022. His evidence goes to the use of the mark 'WATERDROP' by WMG.

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

Relevance of EU Law

40. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

The Parties' Concessions

41. During the course of the hearing, both parties made concessions as to the use of each other marks.

42. As it will be recalled, Mr Meale, on behalf of WMG, conceded that Qingdao made genuine use of its trade mark registration no. UK00003166146 in relation to *water filters* in class 11.

43. On the other side, Ms Fuller, on behalf of Qingdao, conceded that WMG made genuine use of its trade mark UK00914996888 in relation to *Preparations for making beverages; Pastilles for flavouring beverages* (the registered term is *Pastilles for effervescing beverages*) and *Powders for the preparation of beverages* in class 32. Whilst making such concession, Ms Fuller also argued that the use made by WMG is restricted to goods which are used for flavouring; in this connection, she strongly rejected Mr Meale's proposition that the registered terms would cover goods which are used to kill bacteria and filter water and argued that such goods would belong to class 1 (as opposed to class 32) and that the fact that such an argument was never raised as an issue (either in the pleadings or prior to the hearing), means that it is not an arguable point and WMG is prevented from raising it at such a late stage of the proceedings.

44. Before I move on to the issues I need to decide, I pause to comment on the implications from the parties' concessions.

45. Proof of use of Qingdao's trade mark registration no. UK00003166146 is relevant in three actions, namely:

(1) CA000506149: This is the revocation for non-use brought by WMG against Quindao's trade mark registration no. UK00003166146. As it will be recalled, WMG's concession that Qingdao made genuine use of UK00003166146 in relation to *water filters* in class 11 means that the one outstanding matter that I have to deal with in these proceedings is whether there has been genuine use of UK00003166146 in relation to "*air filtering installations*".

(2) CA000505859 and CA000505857: Quindao's trade mark registration no. UK00003166146 is relied upon in the two invalidity actions brought by Quindao against WMG's two trade marks nos. UK00003696880 and UK00917881798. In both actions Quindao relies upon all of the goods for which UK00003166146

is registered, namely *water filters* and *air filtering installations*. Since WMG has subsequently conceded that there has been genuine use of UK00003166146 in relation to *water filters* and did initially elect not to put Quindao to proof of use in relation to *air filtering installations*, it follows that Quindao can rely upon both *water filters* and *air filtering installations* (for the latter, reliance is conditional upon the outcome of the revocation for non-use) without me carrying out the assessment of the evidence filed to demonstrate genuine use. Nevertheless, I still need to consider the matter of reputation (in relation to *water filters*) and goodwill (in relation to *water filters* and *air filtering installations*) in CA000505857.

46. For the sake of completeness, I should say that WMG's concession that Qingdao made genuine use of its trade mark registration no. UK00003166146 in relation to *water filters* in class 11 is not restricted to any time period. Consequently, I take the view that the concession applies to all the proceedings in which the question of genuine use is relevant, regardless of the difference in the relevant periods.

47. Proof of use of WMG's trade mark registration no. UK00914996888 is relevant in one set of proceedings, namely CA000506796. In such proceedings, WMG relies upon *Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages*. As I anticipated above, Qingdao's concession that WMG made genuine use of its trade mark UK00914996888 in relation to *Preparations for making beverages; Pastilles for flavouring beverages* and *Powders for the preparation of beverages* insofar as they relate to flavouring means that, in theory, I still need to consider two matters, namely (a) the question of proof of use for *Essences for making beverages* and *Pastilles for effervescing beverages* (insofar as they might be broader than the conceded *Pastilles for flavouring beverages*) and (b) the question of what the registered goods cover (i.e. whether Qingdao is right in saying that (1) the registered goods do not cover water purification and (2) if the registered goods cover water purification, WMG has not proven use for that).

My approach

48. Since Quindao's trade mark registration no. UK00003166146 is relied upon in the two invalidities brought by Quindao against WMG's trade marks nos. UK00003696880 and UK00917881798, I will start with the revocation for non-use and the invalidity against UK00003166146. I will subsequently consider the two invalidities against WMG's trade marks nos. UK00003696880 and UK00917881798 (whereby UK00003166146 is relied upon), and then move on to the oppositions whereby UK00003696880 is relied upon. Hence, the order in which I will deal with the six consolidated proceedings reflects the way I presented them above.

DECISION

First set of proceedings: revocation for non-use under no. 506149 against Quindao's trade mark registration no. UK00003166146.

49. Quindao's trade mark registration no. UK00003166146 has a very restricted specification, covering only two terms, namely *Water filters* and *Air filtering installations*. As it will be recalled, WMG has conceded genuine use in relation to *Water filters*. Hence, as I have said, the one outstanding matter that I have to deal with is whether there has been genuine use of UK00003166146 in relation to "*air filtering installations*".

50. Section 46(1)(a) of the Act states:

"46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) [...]

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

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

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

52. 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 Bunderversvereinigung 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].”

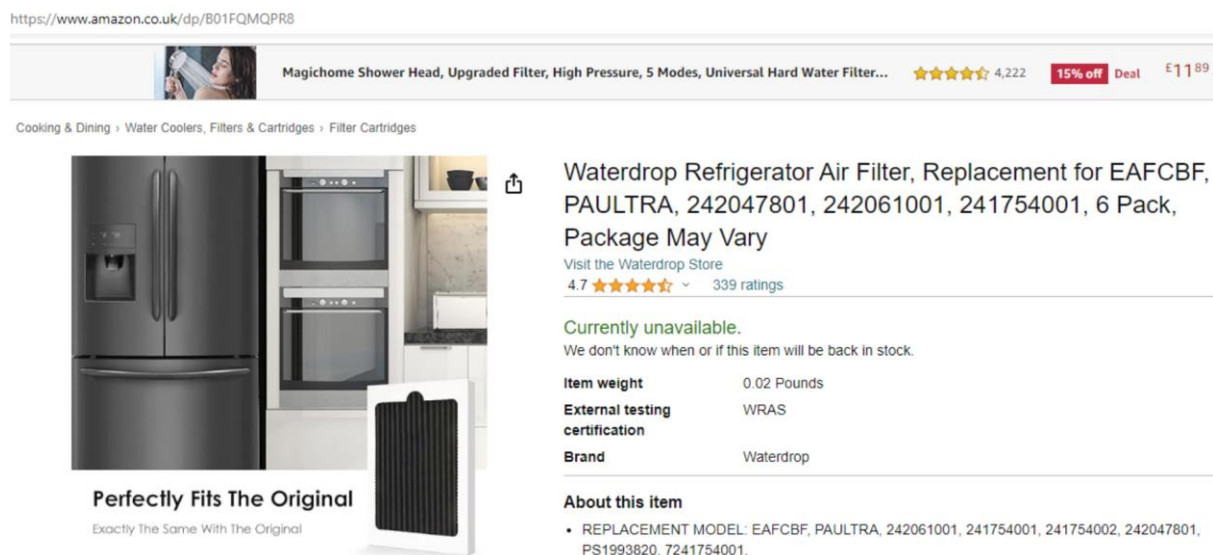
53. In her skeleton argument, Ms Fuller addressed the point of genuine use in relation to “*air filtering installations*” as follows:

“As outlined in our submissions dated 29 November 2023, [Quindao] has been using the mark WATERDROP extensively in the UK between 2018 and 2022 in relation to water filters of both the countertop and undersink type. The website for selling air filters also went live before 26 February 2023 and so was live more than three months before the cancellation action against this trade mark was filed (see paragraph 20 of the witness statement of Shengda (Aiden) Zhang).”

54. During the course of her oral submissions, Ms Fuller expanded on the point as follows (my emphasis):

“In relation to air filters I think just a brief summary on use. So, as shown in SZ2, which is at tab number 9, this is the UK Amazon link which is activated before the relevant date so it went live it was available for customers to see on Amazon, if you searched for goods on Amazon this link would show up and while yes, the screenshot is dated after the relevant date this is equivalent to the link that went live. Sales are not required in order for genuine commercialisation and an active Amazon link can create an outlet in the market for the goods and services that bear that mark and therefore this creation of an outlet in the market amounts to a genuine commercial use, so therefore while I agree it is not substantial and no sales were made, this supports that there was a genuine commercial [use] for air filters before the relevant date”.

55. So, there is an admission that no sales of *air filters* were made in the UK during the relevant period and prior to the application for revocation being made. The evidence to which Ms Fuller refers is not clear, but I agree with Mr Meale that it is likely to consist of the image below:



56. In his oral submissions, Mr Meale commented on that evidence as follows:

“You have an Amazon screenshot that is actually dated November 2023 so after the relevant period [...], I think, and we just have refrigerator air filter with a picture of a fridge and then it says "currently unavailable". Beyond that we do

not really have any information to suggest it has been sold and I think they are saying they have not sold it. Their evidence is they have sold it in the US, and they have got an empty listing for it on Amazon, but they have not made any sales. I think in those circumstances that is just not enough. That is not going to discharge the burden of proof in any way. It might do if it was in the US, but it does not do in the UK. So, I think the position on that is fairly simple.”

57. This takes me back to Mr Zhang’s evidence which states as follows:⁶

“The use of the trade mark Waterdrop for air filtering installations in the United Kingdom has been planned since the trade mark application was filed and sales are already established in the US market. The sales links for those goods in the US are shown in Exhibit SZ13.

A link on the Amazon site for an air filter was activated before 26 February 2023. [Qingdao] did not know that the cancellation action against UK0003166146 was going to be filed at the point that the product was launched.”

58. First, Mr Meale is right in saying that the relevant territory for proof of use is the UK, UK0003166146 being a UK trade mark. Consequently, the position here is that any alleged sales made in the USA does not count for proof of use.

59. Second, Ms Fuller’s prepositions that the existence of an Amazon link is sufficient, *per se*, to create an outlet in the market for the goods concerned is simply wrong in law. In this connection, Ms Fuller did not rely on any authority in support of her submission.

60. Contrary Ms Fuller’s arguments, it is well-established that in order to demonstrate genuine use, the evidence submitted must show that the owner has seriously tried to acquire a commercial position in the relevant market. The trade mark has to be used for goods or services *“already marketed or about to be marketed and for which*

⁶ Paragraphs 19 - 20

preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns” (see C-40/01, *Minimax*, EU:C:2003:145, § 37). Whilst the fact that the commercial volume achieved under a mark might not be high may be offset by evidence of extensive or very regular use, and vice versa (see T-203/02, *Vitafruit*, EU:T:2004:225, § 42), generally speaking there would be some level of sales involved; however, in this case there is no evidence of sale at all. For example, in *Jumpman* BL O/222/16, Mr Daniel Alexander QC, as the Appointed Person, upheld the registrar’s decision to reject the sale of 55k pairs of training shoes through one shop in Bulgaria over 16 months as insufficient to show genuine use of the EU trade mark in the European Union within the relevant 5 year period. In that case, although there were sales, their volume was deemed insufficient. This confirms that proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark*” is not genuine use. Accordingly, whilst the absence of sales is not fatal,⁷ it would be very hard to demonstrate that there has been “*commercial exploitation of the mark*” without any sales.

61. With regards to the Amazon link, there is no evidence of the link being active during the relevant period. Further, even I were to take Qingdao's evidence on this point at face value, the link produced in evidence indicates that the product was not available in the UK and does not say whether (or when) it would be available: this does not amount to an offer for sale to UK consumers. Lastly, it is well-established that advertising through a website, without more, is rarely sufficient for genuine use. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ held that the judge below could not be criticised for having given evidence of advertising use on a website little weight. He said:

“126. [...] There is no doubt that advertising constitutes use of a trade mark, but it is clear from the case law of the CJEU and the GCEU that advertising alone will rarely be sufficient to constitute genuine use of a trade mark, although it can do in some cases. (In particular, advertising and offers for sale to consumers

⁷ See for example, *Polfarmex S.A. v EUIPO*, Case T-677/19, EU:T:2020:424

within the relevant territory may suffice where the goods or services are supplied outside the territory: see Case T-768/20 *Standard International Management LLC v European Union Intellectual Property Office* [EU:T:2022:458] at [33]-[44]). This must be particularly so when the advertising consists solely of a website (even if the website is targeted at the relevant territory). In the present case the judge took such evidence as there was of advertising into account. In the case of the website, however, easyGroup did not adduce any evidence as to the numbers of site visitors (let alone visitors from the UK or EU) or the numbers of page views. In those circumstances the judge cannot be faulted for having given the existence of the website little weight.”

62. Accordingly, even if I were to take the evidence of the Amazon link into account and assume that the link was active during the relevant period, ignoring that the product was actually unavailable in the UK, and take such evidence as there was advertising of the contested mark in relation to “*air filtering installations*”, that would be insufficient to establish genuine use.

63. Last of all, Qingdao has not pleaded a defence of “*proper reasons for non-use*” and has not provided any evidence of circumstances unconnected with the trade mark proprietor that have prevented it from selling or marketing the relevant goods in the UK.⁸

64. Thus, I conclude that Qingdao has failed to establish genuine use of the trade mark no. UK00003166146 during the relevant period in the UK in relation to *Air filtering installations*.

65. The mark UK00003166146 is therefore revoked for *Air filtering installations* with effects from 27 August 2021. However, following WMG’s concession that the mark has been put to genuine use for *Water filters*, the mark remains registered in relation to these goods.

⁸ *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05

Second set of proceedings: application for invalidity under no. 506796 against Quindao's trade mark registration no. UK00003166146 (i.e. the same mark subject to the revocation for non-use detailed above).

66. As I have explained above, although the partial revocation of Quindao's trade mark registration no. UK00003166146 has been successful, the mark will not be cancelled *ab initio* but will be partially revoked with effect from 27 August 2021.

67. Admittedly, this means that the mark UK00003166146 remains validly registered for *Air filtering installations* prior to 27 August 2021 and that Quindao can continue to rely on these goods to invalidate or oppose other trade marks which were filed between 25 May 2016 (i.e. the filing date of UK00003166146) and 26 August 2021 (i.e. the day before the revocation takes effect). In those circumstances, UK00003166146 would, in fact, be a validly registered earlier mark, the protection for *Air filtering installations* running from the filing date up to the date before the revocation takes effect. This is something that WMG might have overlooked. Nevertheless, as Mr Meale restricted the invalidity attack to "*water filters*" conditional upon the revocation for non-use succeeding in relation to "*air filtering installations*", and since the revocation for non-use has been successful for "*air filtering installations*", I will limit my assessment of the present invalidity to "*water filters*".

Section 5(2)(a) and (b)

68. Section 5(2)(a) and (b) of the Act have application in invalidation proceedings pursuant to Section 47 of the Act. Section 47 reads as follows:

"47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) ...

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which

the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

69. Section 5(2)(a) and (b) read as follows:

“5(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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”.

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

70. 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.”

Proof of use

71. The mark relied upon by WMG in this invalidity is trade mark UK00914996888 which is an earlier mark by virtue of having a filing date (i.e. 3 January 2016) that is earlier than the filing date of the contested mark (i.e. 4 May 2016). As it will be recalled, the goods relied upon by WMG are *Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages* and WMG has been put to proof of use for these goods.

72. I have already spoken about Quindao’s concession that WMG has made genuine use of its earlier trade mark UK00914996888 in relation to *Preparations for making beverages; Pastilles for flavouring beverages* (the registered term is *Pastilles for effervescing beverages*) and *Powders for the preparation of beverages* (in class 32) but only insofar as they cover goods used for flavouring. At the hearing, Mr Meale

argued that Ms Fuller was prevented from raising the aforementioned caveat because she had already accepted genuine use, however, as it is recorded in the transcript, at the beginning of the hearing, Ms Fuller stated:

“we are happy to admit proof of use by [WMG] in relation to the majority of their goods. However, there are a few caveats around the breadth and definition of the "Preparations for making beverages" and the "Powders for the preparation of beverages", which are arguments that were raised for the first time in [Mr Meale's] skeleton which we received on Monday.”

73. In other words, the caveat that WMG's goods were restricted to flavouring goods was developed by Ms Fuller in response to Mr Meale's argument that WMG's goods include goods used to purify water. Since Ms Fuller's caveat was put forward in response to an argument disclosed by Mr Meale for the first time in his skeleton argument, I can see nothing wrong with its timing.

74. I have also mentioned that the main point on which the parties disagree is what the registered terms cover. Mr Maele, on one hand, argues that "*preparations for making beverages*" and "*powders for the preparation of beverages*" will include preparation powders for the purification of water or beverages. Ms Fuller, on the other hand, strongly objected to Mr Maele's argument contending that his interpretation stretches the meaning of the words too far.

75. Significantly, Mr Meale said that there is no mention of flavourings in the specification, that the term "*preparations*" is not limited to flavourings or nutritional additives, and that any substance that improves water "*logically falls within the registered terms*". This argument was summarised by Mr Maele at the hearing as follows: "*preparations for beverages is going to include making beverage potable so including purifying it*" and it is the basis for Mr Maele's subsequent submission that WMG's goods can be used to purify water similarly to Quindao's *water filters*. Whilst I am not sure that I have properly understood the point, Mr Meale also relied on paragraph 66 and 81 of Ms Fuller's skeleton argument insofar as it says that filter, filtration, purification and treatment are all the same or similar, which he argued, would be inconsistent with the argument that filtration and purifying are different. I cannot see

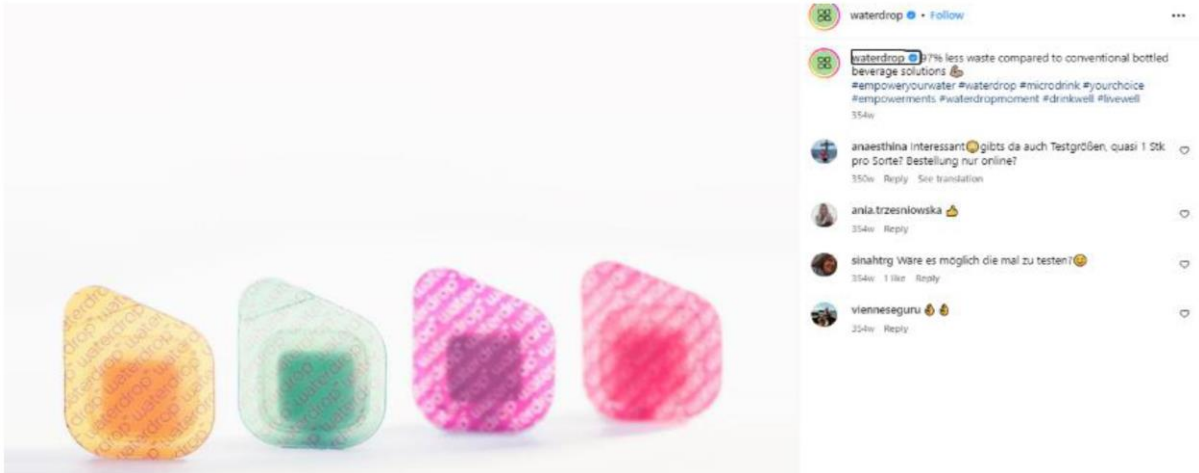
how the argument that filtration and purification are similar can assist WMG. Ms Fuller's position on genuine use was clearly that the registered specification does not cover goods that can be used to purify water and that even if it did, that would be a subcategory of goods for which there is no evidence of use.

76. In my view, the best way to resolve the question is to look at the evidence filed in order to determine what are the goods in relation to which WMG has used the mark, and then frame a fair specification bearing in mind the width of the goods protected, their natural and core meaning, as well as the nature of the goods for which use is shown. Further, as Quindao has accepted genuine use, I will focus on the evidence regarding the nature of the goods marketed (rather than the extent of the use shown) which is as follows.

77. Mr Murray says that Quindao's mission is to is to *"motivate people to drink more water and lead a healthier and more sustainable lifestyle, which [they] aim to achieve through the combination of [their] core products to support people in drinking more water and offering alternatives to the traditional pre-filled, single use plastic beverage industry."* Mr Murray also says that *"primarily, [WMG] produces natural additives in the form of soluble cubes"* which are known as *"Drops' and/or 'Microdrinks"*. The function of these goods is to *"improve the taste of water, without any sugar and whether sourced directly from a tap or elsewhere, as well as providing a vector for the introduction of vitamins and other functionalities like electrolytes into the water before it is consumed"*.

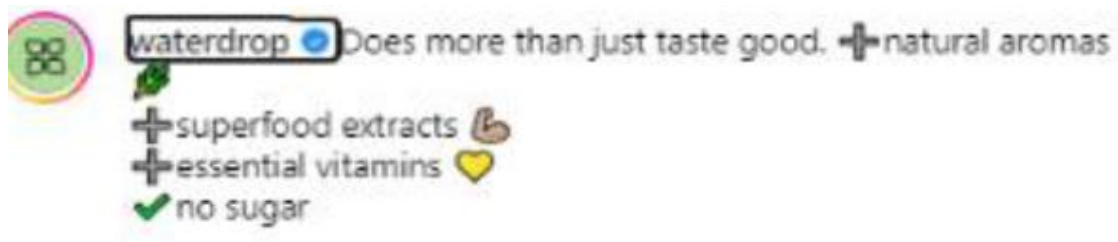
78. Mr Murray explains that in 2015 he started to work on an idea which he had had to make effervescent small cubes, consisting of compressed fruit and plant extracts, which are then dissolved in water for drinking. The purpose of the cubes was intended to enrich water with a variety of flavours so as to enable consumers to create their own choice of water-based beverage anywhere and anytime. In addition, the use of the cubes was expected to reduce consumers' reliance on beverages contained in unsustainable single use plastic bottles. Microdrinks were also to be a healthy alternative to sugared drinks, which had been dominating the beverage market. The combination of cubes and water was termed 'Microdrinks'. Examples of the product being advertised on social media are shown below:

Instagram:





79. Notably, the product is presented as containing superfood extracts, essential vitamins and no sugar:



80. Along with the cubes, WMG sold a range of sustainable bottles (as an alternative to the usage of plastic bottles) for use by customers from which to consume the drink once it had been prepared. Both products (bottles + Microdrinks) were sold under the brand 'WATERDROP'.

81. Mr Murray also refers to WMG selling an "Empowerment Box" having different flavours of Microdrinks in it, as shown in the image below:






82. At paragraph 39 of his witness statement, Mr Murray describes WMG’s range of products as follows (my emphasis):

“As I have explained above, WM’s current core product portfolio comprises two main elements. First, there are the ‘Microdrinks’ i.e. the effervescent cubes which are dissolved in water to make it more appealing and also to add health benefits by the inclusion of vitamins, minerals, natural caffeine and electrolytes. The Microdrink portfolio is being continuously expanded and improved to include subcategories such as ‘microlytes’ (electrolytes), ‘microteas’ (for use in hot water) and ‘microenergy’ (using caffeine as a mild stimulant).

Secondly, WM has developed a range of aesthetically appealing yet sustainable glass and steel bottles from which to consume our Microdrinks and which are sold with a range of accessories such as sleeves, bags, brushes, straws etc....”

83. An extract from one of WMG’s internal surveys from 2022 states as follows:

What motivates our customers to buy

-  **Drink More Water & Taste**
Our customers actively want to drink more water but need more than that. By adding real taste of natural fruits & plants to pure water, we encourage them to stay hydrated.
-  **Soft drink & sugar replacement – Enjoying sugar-free beverages**
Reducing their daily sugar intake to live healthier lives is vital for our core customers. All our products are zero sugar, making our beverages tasty, enjoyable without any sugar crash or calorie intake.
-  **Functionality (Caffeine & Coffee Replacement, Vitamins, Electrolytes)**
With waterdrop®, a glass of water turns into a sugar-free beverage full of key vitamins and natural fruit extracts. By choosing Microenergy our customers have the opportunity to not only replace energy drinks, but also to reduce their coffee intake.

84. Lastly, another survey shows that 78% of consumers see WMG’s products as “*an alternative to soft drinks*” and 63% as “*rich in vitamins*” with Mr Murray concluding that WMG’s “*customers are attracted by the ability to modify the taste of the water they drink as well as the associated benefits of reduced sugar intake and other nutritional additives such as vitamins and also minimizing the impact on the environment of single use plastics.*”

Fair specification

85. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

86. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, 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 subcategories.

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.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range

of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

87. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

88. Further, the purpose or intended use of a product is vital in determining whether goods are a coherent subcategory. In *Polfarmex S.A. v EUIPO*, Case T-677/19, EU:T:2020:424, the General Court said:

“116. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service at issue is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services (judgments of 13 February 2007, *RESPICUR*, T-256/04, EU:T:2007:46, paragraph 29, and of 16 May 2013, *Aleris v OHIM – Carefusion 303 (ALARIS)*, T-353/12, not published, EU:T:2013:257, paragraph 22). In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, *August Storck v EUIPO – Chiquita Brands (Fruitfuls)*, T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited).”

89. The products in relation to which WMG has used the mark ‘WATERDROP’ are soluble effervescent cubes consisting of compressed fruit and plant extracts, which are dissolved in water for drinking. They are sold in different flavours and are designed to enhance the taste of water without adding any sugar whilst enriching it with vitamins, minerals, natural caffeine and electrolytes – the latter have no purifying function but

are simply salts and minerals, such as sodium, potassium, chloride and bicarbonate. Further, WMG's goods are used by consumers to create their own choice of water-based beverage and are marketed as a healthy alternative to sugared drinks providing a beneficial intake of vitamins and minerals.

90. First, it is obvious that the purpose or intended use of WMG's products is to add flavour, vitamins and minerals to water and to make it more appealing to consumers as a healthier alternative to soft drinks which are rich in sugar. There is no reference in the evidence to WMG's products being designed to filter or purify water or remove undesirable chemicals or contaminants from water in order to produce water that is fit for human consumption.

91. Second, as Ms Fuller correctly pointed out, water-purifying chemicals and agents are in class 1, not in class 32, the latter covering *Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages*. Lastly, the word 'beverages' in the registered terms *Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages* means any type of drink except water (Oxford online dictionary) as you do not need preparations, essences, pastilles or powder to make water.

92. In light of the above, I reject Mr Meale's submissions that the registered goods in class 32 would include preparations, essences, pastilles and powders for improving the taste of water (or drinks) by purification. I am not even clear whether such goods exists, but if they do (1) they would fall in class 1 not 32 and (2) if I was wrong and they are covered by the registered terms in class 32, they would have a different purpose from that of the flavouring goods for which use is shown and would constitute an independent subcategory for which there is no use and upon which WMG could not rely.

93. Accordingly, bearing in mind Ms Fuller's concession and the nature of the goods in relation to which use has been shown, I consider a fair specification to be:

Class 32: *Preparations for making flavoured water; Essences for making flavoured water; Powders for making flavoured water.*

94. Turning to the term *Pastilles for effervescing beverages*, Ms Fuller stated:

“This could relate to the pastilles that effervesce when they meet the beverages, so thinking of things like soluble paracetamol or those dissolvable vitamin C tablets that you get, or it could refer to pastilles that create effervescent beverages. And it is important to note that there that has been no use in relation to pastilles that create an effervescent beverage”

95. I agree that there is no evidence that WMG’s goods are used to create an effervescent effect. However, contrary to Ms Fuller’s submission, I think that the registered goods only cover pastilles for creating effervescing beverages, upon which (there being no use), the opponent is unable to rely.

The case-law

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

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

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

98. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

99. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

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

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

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

101. Whilst on the other hand:

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

102. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

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

103. The competing goods and are as follows:

Qingdao’s contested goods	WMG’s earlier goods
Class 11: <i>Water filters.</i>	Class 32: <i>Preparations for making flavoured water; Essences for making flavoured water; Powders for making flavoured water.</i>

104. The fact that the competing goods do not belong to the same class is not determinative as Section 60A of the Act states that goods (and services) are not to be regarded as being dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

105. WMG’s main argument as regards the similarity of the goods (as set out in the invalidity application) was that the respective goods are similar because they are “*all used in connection with the preparation and/or consumption of other beverages*”. As it will be recalled, at the hearing Mr Meale put a different slant on the argument presented to me, by saying that:

- a) “*Preparations for making beverages*” and “*powders for the preparation of beverages*” will include preparations, powders or tablets for the purification of water. In this connection, Mr Meale argued that these are well-known products and that they are clearly included within the ordinary and natural meaning of the terms registered.

- b) It did not matter that WMG had not used its mark for this type of its class 32 goods, as this is not a case in which it is possible to identify a subcategory which is capable of being viewed independently.
- c) "*Water filters*" include chemicals as well as mechanical water filters.

106. Ms Fuller, on behalf of Quindao, denied such claims arguing that its water filters and air filters (in class 11) are mechanical components for filtering and have no similarity with WMG's goods (in class 32) which are all additives that can be used to prepare a flavoured beverage and have an entirely different nature.

107. As it will be recalled, I have already rejected Mr Meale's arguments at points (a) and (b). I also reject point (c) since the contested water filters are in class 11 and the class heading for class 11 is restricted to "*Apparatus and installations for lighting, heating, cooling, steam generating, cooking, drying, ventilating, water supply and sanitary*" with the explanatory note clarifying that the class includes mainly environmental control apparatus and installations, in particular, for the purposes of lighting, cooking, cooling and sanitizing. In this connection, *Altecnic Ltd's Trade Mark Application* the Court of Appeal decided that "*the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.*" Lastly, I am fortified in reaching this view by the dictionary definition of "water filter" which refers to "*a device for removing unwanted substances such as bacteria or harmful chemicals from drinking water*" (Cambridge online dictionary); following from this, I reject Mr Meale's submission that WMG's goods in class 32 include substances which are mixed with water to purify it.

108. Before I turn to comparison of the goods, I also remind myself of the observations made by Lord Kitchin in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, about the proper approach to considering terms in specifications:

"365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible

meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

109. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. 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.”

110. Further, in his skeleton argument, Mr Meale himself referred to the decision in *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch) where Mr Iain Purvis, KC (sitting as a deputy High Court judge) warned against considering the similarity of goods at too high a level of generality:

“...As Mr Harbottle pointed out in argument, the overall purpose of considering similarity should not be forgotten. That purpose is to identify similarities which

might be relevant to the question of likelihood of confusion. It seems to me the greater the level of generality at which some similarity under Canon factors can be found (ie both goods are 'sold in large department stores' or both goods are 'used by ordinary people') the less relevant could it be to any question of confusion, and any assessment of similarity of goods should take that into account."

111. Once Mr Meale's argument that water purification preparations achieve the same outcome as water filters (i.e. they clean and filter the water) is taken out of the picture (because water purification preparations either do not fall within the registered terms in class 32 and/or are not goods for which WMG's mark has been used and upon which WMG can rely), what I am left with is the original argument that the competing goods (i.e. water filters *versus* preparations for making flavoured water) are both used in connection with the preparation and/or consumption of beverages. That is too high a level of generality to constitute a concrete basis for concluding that the goods are similar.

112. Whilst it is possible that the goods are used by the same users, insofar as the water is purified using Qingdao's *water filters* before being mixed with WMG's *preparations for making flavoured water*, the goods have a different nature and purpose, Qingdao's *water filters* being apparatus or devices for purifying water, WMG's goods being soluble substances which are dissolved in water to add flavour. The goods have different methods of use and are not fungible or in competition. They do not share trade channels, are not produced by the same manufacturers and are not complementary 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.

113. For the sake of completeness, I should say that *Air filtering installations* would be even further removed from WMG's goods if the invalidity action was still pursued against them.

114. Based on the above, I conclude that the competing goods are dissimilar.

115. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

116. Some similarity of goods is therefore essential for a likelihood of confusion to be established. Since I have concluded that the goods are dissimilar, the invalidity based on Section 5(2)(a) and (b) fails at the first hurdle.

117. Having the invalidity under no. under no. 506796 failed, it follows that the mark UK00003166146 remains registered to the extent that it survived the revocation for non-use.

Third set of proceedings: application for invalidation under no. 505859 against WMG’s trade mark no. UK00917881798.

118. This application for invalidity is directed against some of the goods covered by WMG’s trade mark registration no. UK00917881798, namely *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels* in class 21. In this invalidity, Qingdao relies on its earlier trade mark registration no. UK00003166146 (i.e. the mark which is subject to the revocation and invalidity actions set out above) and all of the goods covered by it, namely *water filters* and *air filtering installations* in class 11. The filing date of WMG’s contested mark is 29 March 2018, which is prior to Qingdao’s UK00003166146 being revoked for non-use in relation to *air filtering installations*. Notwithstanding Qingdao can continue to rely on those goods (the goods being effectively registered at the filing date of WMG’s contested mark of 29 March 2018 - i.e. the relevant date - and WMG not having requested proof of use for these goods), both parties agreed that Qingdao’s strongest case remains that based on *water filters*.

119. This invalidity is based on one single ground, being it Section 5(2)(b) of the Act. I have already set out the relevant legislation and case-law which I do not need to repeat here. The first issue I need to deal with is the similarity of the goods. It is to this question that I now turn.

120. The competing goods are as follows:

WMG's contested goods	Qingdao's earlier goods
Class 21: <i>Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels</i>	Class 11: <i>Water filters; Air filtering installations.</i>

121. In her skeleton argument, Ms Fuller reiterated the point made in the statement of grounds that the goods are similar because water filters often include a container such as a pitcher or decanter to hold the filtered water, which is then used for drinking. In support of her statement, Ms Fuller referred to the evidence at page 5 of SZ1, page 4 of SZ2 and pages 2 and 3 of SZ3.

122. She further stated that the average consumer would understand the term “*water filter*” to cover both the engineering components that are installed as part of a plumbing system and the jug/pitcher water filters of the type shown at Exhibit SZ14. She then argued that the goods have the same use (i.e. to hold drinking water), end-user (i.e. an individual looking for a container to hold drinking water in the household), nature (i.e. containers for drinking water) and trade channels (i.e. in homeware or kitchen shops, or in the homeware or kitchen appliance departments in the same section of supermarkets). Further, she stated that the contested “*decanter*” may cover the earlier “*water filters*” because jug water filters are a type of decanter, though she did not argue identity but “*a very high degree of similarity*” between the goods. Lastly, Ms Fuller referred to SZ10, which she claimed shows evidence of confusion on the part of a consumer stating as follows:

“SZ10 is a screenshot of a review on a product by Waterdrop Microdrink, which states that they are familiar with Waterdrop as they own one of their water pitchers and are aware of their water filtration systems. The review states that

since selling water pitchers and filtration systems, “Waterdrop” have moved to selling “Microdrink effervescent drink cubes with a companion steel water bottle”. It is clear that this review relates to the water bottle, “accompanied by” the flavour cubes. This is therefore a clear reference to Qingdao’s products in Class 11 (namely water filters, both the jug type and the water filtration systems) that the customer has confused with products belonging to WMG, specifically the water bottle sold on Amazon, which is accompanied by drink cubes.”

123. Before I turn Mr Meale’s submission, it is worth looking at what the evidence relied upon by Ms Fuller establishes.

124. SZ1 and SZ2 show goods described as water filter jugs and water filter pitchers as shown below:

Water Filter Jugs (10)

Featured



Waterdrop Chubby Water Filter Jug with 360 Days Filter
★★★★★ 4 reviews
£61.00



Waterdrop Electric Instant Water Filter Jug, 15-cup (3.5 L) Filtration Capacity /...
★★★★★ 1 review
£70.00



Waterdrop Chubby Water Filter Jugs and Cartridges with 1x90 Days Filter
★★★★★ 3 reviews
NSF 42 & 372 Certified*
£29.99



Waterdrop Lucid Water Filter Jug with 1x90 Days Filter



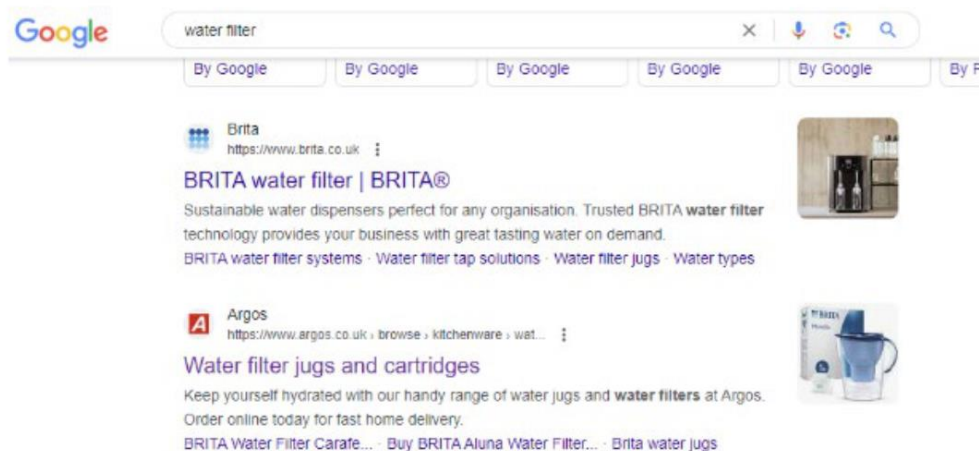
Waterdrop Elfin Fridge Water Filter Jug with one Filter



Waterdrop Pitcher & Dispenser Replacement Filters



125. Similarly, SZ3 shows the offer on the UK eBay website of goods described as water filter jugs under the brand 'WATERDROP', whereas SZ14 shows the results of a Google search for "water filter" which returned water filter jugs offered under other brands:



126. As it can be seen, the jugs and pitchers shown in this evidence incorporate a filter to purify the water.

127. Finally, SZ10 is a customer review of a free product published on Amazon. It is dated October 2022, and it is from the USA. It states as follows:

“I am familiar with Waterdrop, as I own one of their water pitchers. Since then, they have branched out into water filtration systems and now, Microdrink effervescent drink cubes with a companion steel water bottle”

128. I accept that the registered term *water filters* would include water filtration jugs; this is confirmed by a search I have conducted on the UKIPO classification tool (which returns *water filtration jugs* as a subcategory of water filters in class 11).⁹ However, the evidence of confusion, to which Ms Fuller referred, is less persuasive. This is for two reasons. First, the evidence of confusion relates to goods which are different from those I must compare here. The customer providing the review seems in fact to think that Qingdao’s water pitchers and water filtration systems originate from the entity providing WMG’s effervescent drink cubes sold together with a companion steel water bottle. However, the goods at issue here are water filters (in class 11) versus *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels* in class 21 and effervescent drink cubes are not at issue. Admittedly, the review also mentions a steel water bottle, but even if I were to (a) accept that the contested *drinking vessels* is sufficiently broad to include any container specifically designed for holding liquids that are intended for consumption, including a reusable bottle made of metal, and (b) ignore some of the points raised by Mr Meale (i.e. about the evidence of confusion relating to the USA and being given in relation to free goods), evidence of confusion in the marketplace is not listed among the criteria set out in *Canon* which are relevant for determining whether the goods are similar. In this connection, neither the identity of the marks, nor the reputation and distinctiveness of a registered trade mark (all of which might contribute to consumers being confused) might increase the similarity of the goods as those factors can be factored in only once the requirement that the goods are similar has been established.

129. Mr Meale, on the other hand, argued that putting a water filter into a jug does not transform a jug into a filter because, he said, the good is still a jug designed to hold liquids but now it has the added capability of filtering. To stress his point, Mr Meale, equated the jug/water filter example to that of smart phone which has a camera but remains a phone and does not become a camera. Likewise, he argued that if you put

⁹ <https://www.search-uk-trade-mark-classes.service.gov.uk/searchclasses>.

an air-conditioning unit into a car, it is not right to then describe the car as an air-conditioner even if you can sit in it to cool down. He stated:

“If that were the case you could register a trade mark for cars and it would [have] an incredible scope because anything that is ever put into a car -- chairs, radios, GPSs -- would then basically be considered to be identical because it would overlap with those items and that is not how the classification system works....”

130. Mr Meale also criticised Qingdao’s submission that a jug water filter is a type of decanter arguing that there is no evidence of what a decanter is, though he asked me to take judicial notice of the fact that it is a sort of container that is used for wine. Further, he strongly denied that a decanter and a water filter are the same thing.

131. As regards the similarity of the goods, Mr Meale, stated that the goods are dissimilar because they have different uses, nature and purposes, WMG’s goods in class 21 being passive containers primarily used for serving or consuming beverages, Qingdao’s water filters being devices used to remove unwanted elements and purify the water. Mr Meale also argued that the goods are neither complementary nor in competition relying on two decisions of the EUIPO Opposition Division. The first decision was issued in opposition no. B3126009 *Yetu Coolers v Arkas*. In that decision, the EUIPO found that the applied-for goods class 11, namely *apparatus, equipment and installations for air-conditioning and ventilation, namely air-conditioning units, regulation and protection fittings for water devices; fans (parts of air-conditioning installations); filters as parts of household or industrial installations, filters for air conditioning; air filtering installations, ventilation apparatus and installations used in air-conditioning systems, air conditioning installations; germicidal lamps for purifying air, humidifiers, air cooling apparatus; air conditioning apparatus, fans being parts for air conditioning installations, coils being parts of cooling installations, kitchen extractor hoods and ventilation hoods, heat exchangers, other than parts of machines, taps [cocks, spigots] [faucets (am.)] for pipes* were dissimilar to the opponent’s goods in class 21 which included *Portable coolers; beverage ware; cups; drinking glasses; tumblers; jugs; mugs; temperature retaining vessels; vacuum container for hot or cold food and drink; beer growlers; insulated food and drink containers; drink holders; stainless steel drink holders; stainless steel tumblers; stainless steel drinking glasses;*

stainless steel beverageware; insulating sleeve holder for beverage cups, bottles, and cans. The examiner found that the goods differ in nature, purpose and method of use, are neither complementary nor in competition and are not usually sold through the same outlets and it is unlikely that they have the same manufacturers.

132. The second decision was issued in opposition no. B3179120 *Onest GmbH v Arkas Sp. Z O.O.* In that decision the Opposition Division found dissimilarity between the earlier goods in class 21, namely *Glasses [receptacles]; frying pans; decanters; cooking pot sets; kitchen utensils; cooking pots; cooking utensils, non-electric; kitchen containers; sheets of glass, other than for building; porcelain ware; bowls [basins]; dishes; soap holders; tableware, other than knives, forks and spoons; cups; trays for household purposes; pots; drinking glasses; drinking vessels* and the applied-for goods in class 11, namely *Cooling, freezing, air conditioning and ventilating apparatus, devices and installations; cooling appliances and installations; refrigerating apparatus; ice machines and apparatus; ice storage apparatus; stationary refrigerators and portable refrigerators; coolboxes; electric wine chillers; cooling installations for liquids; air filtering installations; air-conditioning installations; refrigerated showcases; germicidal lamps for purifying air; refrigerators; cool boxes, electric; portable refrigerators; humidifiers refrigerating containers; refrigerating cabinets; beverage urns, electric; cooling apparatus; air cooling apparatus; beverage cooling apparatus; airconditioning apparatus; range hoods; ventilation hoods; freezers.* It stated as follows:

*“The contested goods fall under the broad categories of cooling, freezing, air conditioning and ventilating apparatus, **devices and sterilization, disinfection and decontamination equipment.** The opponent’s goods fall under the broad categories of cosmetics (Class 3); luggage, bags, wallets and other carriers (Class 18); furniture (Class 20); tableware, cookware and containers (Class 21) and clothing and footwear (Class 25). As such, the nature, purpose and methods of use of the goods at issue differ. The relevant public and distribution channels do not usually coincide and they are neither in competition nor complementary. Therefore, they are dissimilar.”*

133. Ms Fuller resisted Mr Meale's argument saying that the goods in those decisions are different to those at issue here because they mostly relate to air conditioning and cooling apparatus and that even *filters as parts of household or industrial installations* would not cover the jug type of water filters upon which Qingdao relies.

134. As I have said, I am satisfied that Ms Fuller is right in saying that the earlier *water filter* in class 11 include water filter jugs; as the evidence shows they use replaceable cartridges to purify the water. The way those water filters work is that you fill the jug from the tap, and the water passes through the filter, drip by drip. Once filtered, the water remains in the jug and can be poured in a glass for drinking.

135. WMG's goods in class 21 include *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels*.

136. I shall start with decanters. Cambridge online dictionary defines a decanter as "*a decorative glass container for wine and other alcoholic drinks, with a part that fits into the top for closing it*". Hence, a decanter is only used for alcoholic drinks. Contrary to Ms Fuller's submissions, a decanter is not used for storing or serving water and she has not provided any dictionary definition or evidence which support her argument. A jug is defined as "*a container for holding liquids that has a handle and a shaped opening at the top for pouring*". The word "pitcher" is mainly used in the US to mean a jug (Collins online dictionary). Whilst the evidence of water filter jugs also refers to water filter pitchers, the product on offer is the same, the change of words from jug to pitcher more likely to being down to the use of an Americanism for goods targeting the US market. Accordingly, I am not persuaded by Ms Fuller's attempt to mix decanters and jugs by saying that Qingdao's water filter jugs will be understood by the average consumer as a "*container such as a pitcher or decanter that holds water by a household consumer after it has been filtered which is then used for drinking*" which she argued is "*very similar to decanters*".

137. So, the first difference between water filter jugs and decanters is that the latter are used to store and serve alcoholic drinks, whereas the former are used to filter, store and serve water. Whilst I accept that water filter jugs can be made of glass like decanters, and that they can both be used to store and serve liquids, the goods have

fundamentally a different nature, purpose and method of use. Water filter jugs use replaceable cartridges or some other forms of filter to remove contaminants and impurities from water and make it drinkable; they are normally kept in the fridge. Conversely, decanters are used to store and serve alcoholic drinks and are normally kept outside the fridge. The goods are neither complementary nor in competition and are not usually produced by the same manufacturers. This is because the production of water filter jugs and decanters requires different types of expertise and the goods target different segments of the market; for example, water filter jugs use filtration systems and technologies (the main attraction of the product being the functionality and/or effectiveness of the filtration system), whilst decanters are normally made of crystal or glass, and are purchased as a gift for someone or by those who seek to elevate their alcohol drinking experience (the main attraction of the product being the quality of the crystal or the aesthetic of the product). Consequently, whilst it is not impossible that someone who purchases a water filter might also purchase a decanter, the goods naturally target different consumers. Lastly, whilst the goods can all be sold in shops selling household goods, they are unlikely to be found in close proximity to each other. Bearing in mind all of the above, I conclude there is no meaningful similarity between the goods and that decanters and water filters are dissimilar.

138. The remaining goods are *Glasses [drinking vessels]; Tumblers; Drinking vessels*. A tumbler is defined as “a drinking container that does not have a handle or a stem”. Other drinking vessels would include items such as mugs and cups. Accordingly, the goods are all used to hold beverages or liquids for consumption and drinking. They are one step removed from the earlier water filter jugs which are used for filtering and pouring water (as opposed to drinking). These goods are dissimilar.

139. Based on the above, I conclude the competing goods are dissimilar.¹⁰

140. Some similarity of goods is therefore essential for a likelihood of confusion to be established. Since I have concluded that the goods are dissimilar, the invalidity based on Section 5(2)(b) fails at the first hurdle.

¹⁰ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

141. As the invalidity under no. 505859 has failed, it follows that WMG's trade mark no. UK00917881798 remains registered as it stands.

Fourth set of proceedings: application for invalidation under no. 505857 against WMG's trade mark no. UK00003696880

142. This invalidity is based upon Sections 5(1) and 5(2)(a), as well as 5(3) and 5(4)(a).

Section 5(1) and 5(2)(a)

143. Section 5(1) is as follows:

“(1)A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

144. I have already set out Section 5(2)(a) above.

145. The relevant date in this invalidity is 17 September 2021. This is after the revocation date of 27 August 2021 which means that Qingdao cannot rely on *Air filtering installations*. Under Section 5(1) and 5(2)(a) the invalidity is directed against the goods in classes 11 and 21, the relevant comparison being as follows:

WMG's contested goods	Qingdao's earlier goods
Class 11: <i>Water filters; Water filtering units; Membranes for the filtration of water; Water filtering apparatus for domestic use; Water conditioning units; Water treatment apparatus for water softening; Chilled purified water dispensers; Equipment for generating electromagnetic radiation for disinfecting containers and/or for</i>	Class 11: <i>Water filters.</i>

disinfecting container content; UVC spotlights for the purification of a liquid; Generators for ultraviolet radiation (UVC); Water purification units; Water disinfection apparatus.

Class 21: *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels; Bottles; Glass flasks [containers]; Heat-insulated containers for beverages; Insulating flasks; Tea cups; Teapots; Tea services [tableware]; Tea caddies.*

146. In his skeleton argument, Mr Meale, on behalf of WMG, stated that he accepted that a number of goods in the competing class 11 specifications are identical and that there is a high-level of similarity between the earlier "*water filters*" and the contested items which purify and disinfect water by various methods. During the course of his oral submissions, Mr Meale further confirmed that WMG accepted that "*class 11 is identical*"¹¹ because the competing goods are all types of water filtering goods and WMG did not wish to take any point on the issue. Mr Meale also accepted that the competing marks are identical, that there is double identity of both the marks and the goods in class 11,¹² and that the application for invalidity should succeed for the registered goods in class 11. Accordingly, the present invalidity is successful under Section 5(1) in relation to the contested goods in class 11.

147. Earlier in this decision, I have found that there is no similarity between *water filters* in class 11 and *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels* in class 21. I apply the same finding here. Accordingly, the present invalidity fails in relation to these goods.

¹¹ Page 21 of the transcript

¹² See page 22 of the transcript where Mr Meale says: "Where that leaves us on assessment of likelihood of confusion we have got double identity in class 11 so we do lose out there."

148. This leaves *Bottles; Glass flasks [containers]; Heat-insulated containers for beverages; Insulating flasks; Tea cups; Teapots; Tea services [tableware]; Tea caddies* in class 21. These are all type of drinking vessels, which means that it would be easy for me to reject Ms Fuller’s submission that the goods are similar by applying the same reasons as those I have applied in relation to *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels*. However, Ms Fuller put forward additional arguments in relation to these goods which I need to deal with, namely that water filters are a type of bottle or flask and that water filter can heat filtered water. She stated (my emphasis):

“The similarities are even greater in relation to “ Bottles; Glass flasks [containers]” in Class 21 of UK00003696880, as the average consumer would understand the jug water filter to include one of these components, in addition to the filtration elements. In fact, the jug water filter are a type of bottle or flask. These goods are therefore highly similar to those in UK00003166146. Additionally, the arguments outlined in paragraphs 54 to 61 above apply equally to these goods.

These arguments also apply in relation to “tea cups; teapots; tea services [tableware]; tea caddies”, as listed within Class 21 of UK00003696880, as they have the same use (namely to hold drinking water), end user (namely users wanting household drinking water), nature (namely containers for drinking water) and trade channels (namely in homeware or kitchen shops, or in the homeware or kitchen appliance departments in supermarkets).

“Heat-insulated containers for beverages; insulating flasks” in Class 21 of UK00003696880 are also similar as water filters can heat the filtered water, so can themselves be heat-insulated containers for beverages (see page 3 of SZ1). Additionally, the arguments outlined in paragraphs 54 to 61 above apply equally to these goods.”

149. Paragraphs 54 to 61 include the argument that the goods are similar because water filters often include a container such as a pitcher or decanter, as well as the arguments set out at paragraphs 121-122 above, which I am not going to repeat here. For the same reasons as those I have outlined at paragraphs 134-138, I reject the

same arguments here. Further, as Mr Meale correctly pointed out, water filter jugs are not a type of bottle or flask, because a jug is not a bottle, nor is it a flask, the dictionary definitions of the three terms (and related images) describing different goods:¹³



Jug: a container for holding liquids that has a handle and a shaped opening at the top for pouring.



Bottle: a container for liquids, usually made of glass or plastic, with a narrow neck.

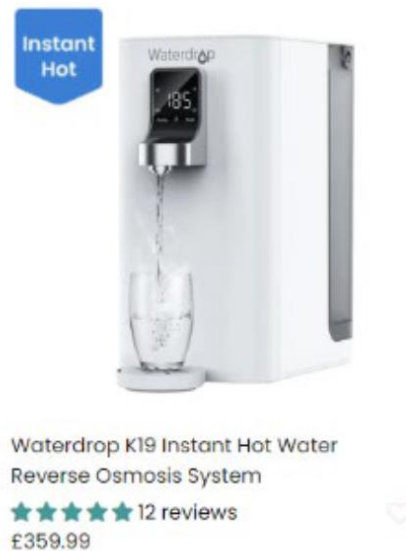


Flask: a special container that keeps drinks hot or cold.

150. Lastly, as Mr Meale correctly observed, there is no evidence that water filter can heat water. The evidence to which Ms Fuller refers at SZ1 shows the following goods:

¹³ Cambridge online dictionary

Portable Reverse Osmosis (



151. First, the item shown in this evidence is not described as a water filter; it is a hot water dispenser, though it might be possible that it incorporates a filtering system. Consequently, it cannot be said that water filter includes hot water dispensers with a filtering system. Accordingly, I reject the argument that both set of goods can be heat-insulated containers for beverages.

152. Having rejected Ms Fuller's additional arguments, I conclude that the contested goods in class 21 are dissimilar to *water filters*. Accordingly, bearing in mind what I have said about the similarity between the goods being a requirement for likelihood of confusion, the present invalidity fails in relation to these goods.

153. In addition, as I have concluded at paragraph 146, given the double identity of both the marks and the goods in class 11,¹⁴ the invalidity under no. 505857 against WMG's trade mark no. UK00003696880 is successful under Sections 5(1) in relation to the contested goods in class 11. Hence, the outcome of this invalidity action is that it is successful in relation to the contested goods in class 11 and fails in relation to the contested goods in class 21.

¹⁴ See the concession mentioned at footnote 12

Section 5(3) and 5(4)(a)

154. Section 5(3) and 5(4)(a) of the Act has application in invalidation proceedings pursuant to Section 47 of the Act. I have already reproduced Section 47 above.

Section 5(3)

155. Section 5(3) states:

“(3) A trade mark which-
is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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”.

156. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must 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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

157. In *Spirit Energy Limited v Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for Section 5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of Section 5(3).

158. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of Section 10(3). The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7 such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

159. Further examples of insufficient reputation are *Supreme Petfoods Limited v Henry Bell & Co (Grantham) Limited*, [2015] EWHC 256 (Ch) and *Jadebay and Anor v Clarke-Coles Limited* [2017] EWHC 1400 (IPEC).

160. Qingdao claims it enjoyed a reputation in relation to water filters as of 17 September 2021 (the filing date of WMG's UK00003696880) in the UK. Mr Meale argued that the evidence filed is not sufficient to establish reputation stating as follows:

“...it is submitted that the evidenced adduced by Q cannot possibly meet the threshold of a reputation. No evidence has been provided of the market or of Q's share of it. There is little insight into intensity and duration of the use. Indeed, beyond the purported UK sales figures and the largely undated screenshots of products purportedly for sale in the UK, Q adduces no evidence whatsoever of its reputation in the UK. Almost all of the very thin material available appears to be directed at the US. Even if were directed at the UK, a couple of product reviews and a sponsored article falls significantly short of the threshold for a reputation. The Red Dot Award advances matters very little in light of the lack of evidence of its relationship with the UK market.”

161. Mr Zhang says that in the period October 2018 to December 2022, the turnover achieved with the Waterdrop water filters on the Amazon and Ebay websites in the UK amounted to over USD 15,000,000, in detail as follows:

Year	Sales (USD) on Amazon	Sales (USD) on Ebay)
2018	25,791	
2019	667,650	
2020	2,506,570	
2021	5,491,560	165,689
2022	6,445,932	221,611

162. The sales figures for 2022 are outside the relevant date and cannot be taken into account. Further, the sales figures for 2021 are not broken down by month and so it is not clear what proportion of the nearly 5.5million (USD) sales was generated prior to

the relevant date of 17 September 2021. Even proceeding on the assumption that the sales were equally spread across the year, by splitting the yearly sales for 2021 over 12 months and then multiplying the monthly sales for 8.5 (as the relevant date is in the middle of September 2021) that would equate to about 3.8million (USD). That would bring the total sales for the period prior to the relevant date to about 7million (USD) which converted in pound sterling (at the current rate) would be nearly £5.2million over a period of 4 years.

163. Mr Zhang also says that the sale figures relate to three types of goods, namely countertop, undersink and outdoor, with the top selling product being countertop. Admittedly the evidence shows that the term 'countertop' does not invariably refer to products which can be described as 'water filters'; I say this because the evidence shows use of the word 'countertop' in relation to both an electric water filter product and a type of instant hot water dispenser as shown below:



Waterdrop Instant Hot Water
Dispensers Countertop with RO...
£299.99



164. Although I consider that hot water dispensers are outside the natural meaning of water filters, the sales figures are said to relate specifically to water filters and in his witness statement, Mr Zhang provides separate sales figures for water jugs and countertop dispensers.

165. It is true that nearly £5.2million worth of sales over a period of 4 years in relation to one category of goods is not insignificant. However, it is not clear how many products were sold. Nevertheless, the evidence indicates that the costs of 'WATERDROP' undersink and countertop water filters ranges from £70 to hundreds of pounds with the costs of reverse osmosis water filters (these appear to be placed under the sink so I think would fall within the category of undersink) being in the region of £300. Applying an average cost of £100, Qingdao's sales figures would equate to a total of 52,000 items sold, however, again this is an assumption. But even proceedings on the basis of such an assumption, as Mr Meale correctly pointed out, there is no evidence of market share, and I have no way of knowing whether Qingdao's sales mean that its mark was known by a significant part of the public concerned by water filters.

166. The rest of the evidence does not really assist as there are no specific UK marketing figures. In this connection, the evidence about the various Amazon

campaigns which are said were run between 2018 and 2020 is not easily readable and does not say anything about how the mark was promoted. In this connection, I reiterate the point that the evidence shows use of the mark 'WATERDROP' for goods other than water filters, such as, for example, hot water dispensers, and that some of the evidence of marketing campaigns identify the products by a code (e.g WD-PT-04W-Exact) without being possible to know what product the code corresponds to (whether it was a water filter or another product sold by Qingdao). In addition, where the marketing spend relates to identifiable products (which are all water filters) is very low and amounts to approximately £900. Moreover, as Mr Meale correctly observed, Mr Zhang's evidence about Qingdao winning the Red Dot Design Award in 2019 (Exhibit SZS) which is described as one of *"the world's largest design competitions that has become established internationally"* does not say that the award is a UK awards or that it reflects the position Qingdao had acquired on the UK market. Lastly, Qingdao seems to have sold its goods only on two platforms, namely Amazon and eBay, and there is no evidence of the mark being promoted outside these two platforms.

167. Bearing in mind all of the above, I find that although Qingdao has genuinely used the mark 'WATERDROP' in the UK for water filters, it has failed to establish that it had a protectable reputation in the UK at the relevant date.

168. The invalidity based on Section 5(3) fails at the first hurdle.

Section 5(4)(a)

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

170. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

171. Under this ground, Qingdao opposes the same goods in classes 11 and 21 which are opposed under Sections 5(1) and 5(2)(a). In addition, Qingdao also opposes the remaining goods in classes 6 and 9.

172. I agree with Mr Meale that in relation to the goods in classes 11 and 21, having WMG accepted genuine use in relation to water filters, and proceedings on the basis that this also means that Qingdao has established goodwill in relation to water filters, the outcome cannot be different from that reached under Sections 5(1) and 5(2)(a) as invalidity under this ground will proceed on the basis of the same conflict in terms of marks and goods. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

173. Although this was an infringement case, the principles apply equally under Section 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the

same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

174. Accordingly, the invalidity based on Section 5(4)(a) follows the outcome of that based on Section 5(1) and 5(2)(a) for the contested goods in classes 11 and 21.

175. This leaves the goods in classes 6 and 9. Ms Fuller stated that the goods in class 6 are similar to the earlier water filters because “*water filters would be understood to need some form of sealing means or closure, so that the filtered water would not be contaminated. Thus, sealing caps and closures, as in Class 6, would be understood to be a component part of water filters.*” As regards the goods in class 9, Ms Fuller stated: “*Class 9, these relate to equipment for determining the fill level of a container and for data exchange with a smartphone or the like, both integrated in closures for containers. A closure on a water filter could have such equipment, to ensure that the correct level of water is filtered or to exchange other information about said filtered water.*”

176. At the hearing Mr Meale addressed the point very briefly by saying that Ms Fuller’s argument “*sounds completely high level and very vague*” although he did not expand on it. Whilst there is evidence of water filter jugs incorporating a lid, the lid appears to be made of plastic and it is part of the water filter jug, not something that would be sold separately. Consequently, the example put forward by Ms Fuller does not actually reflect the nature of the contested goods in class 6 which are *Sealing caps of metal; Closures of metal; Bottle closures of metal*. The goods have a different nature, purpose and method of use, are neither complementary nor in competition. They are not distributed through the same channels and do not target the same users. These goods are dissimilar.

177. Lastly, the contested goods in class 9 are *Optical and/or electromagnetic and/or electric equipment for determining the fill level of a container integrated in closures for containers (including screw closures); Communications equipment (in particular featuring a data interface featuring short-range radio transmission) for data exchange with a smartphone, tablet, PC or the like integrated in closures for containers (including screw closures)*. It suffices to say that there is no evidence such goods in class 9 are part of or used in conjunction with water filters. The goods have a different nature, purpose and method of use, are neither complementary nor in competition. They are not distributed through the same channels and do not target the same users. These goods are dissimilar.

178. Having concluded that the contested goods in classes 6 and 9 are dissimilar, I will now consider the requirements for passing off where there is no common field of activity. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the

plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

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

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

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

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

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

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

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

179. Bearing in mind the above guidance, it is my view that the absence of any overlap between the contested goods in classes 6 and 9 and the goods associated with Qingdao's goodwill in class 11 and the moderate level of goodwill enjoyed by Qingdao means that there cannot be any misrepresentation or damage to Qingdao's business from WMG offering completely different categories of products under an identical mark. The invalidity under Section 5(4)(a) also fails in relation to the goods in classes 6 and 9.

180. Overall, the application for invalidation under no. 505857 against WMG's trade mark no. UK00003696880 succeeds in relation to the following goods and the registration will be invalidated in respect of all of them:

Class 11: Water filters; Water filtering units; Membranes for the filtration of water; Water filtering apparatus for domestic use; Water conditioning units;

Water treatment apparatus for water softening; Chilled purified water dispensers; Equipment for generating electromagnetic radiation for disinfecting containers and/or for disinfecting container content; UVC spotlights for the purification of a liquid; Generators for ultraviolet radiation (UVC); Water purification units; Water disinfection apparatus.

181. However, WMG's trade mark no. UK00003696880 will remain registered for the following goods (either because they were not objected or because the invalidity has failed in relation to them):

Class 5: *Vitamin supplements; Vitamin tablets; Vitamin preparations; Effervescent vitamin tablets; Vitamin drinks.*

Class 6: *Sealing caps of metal; Closures of metal; Bottle closures of metal.*

Class 9: *Optical and/or electromagnetic and/or electric equipment for determining the fill level of a container integrated in closures for containers (including screw closures); Communications equipment (in particular featuring a data interface featuring short-range radio transmission) for data exchange with a smartphone, tablet, PC or the like integrated in closures for containers (including screw closures); Mobile Apps.*

Class 21: *Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels; Bottles; Glass flasks [containers]; Heat-insulated containers for beverages; Insulating flasks; Tea cups; Teapots; Tea services [tableware]; Tea caddies.*

Class 32: *Beverages containing vitamins; Non-alcoholic beverages; Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages.*

Fifth set of proceedings: opposition under no. 440448 against Quindao's application to register trade mark no. UK00003845931

182. In this opposition WMG withdrew its Sections 5(3), 5(4)(a) and 3(6) claims and maintains the opposition under Sections 5(1) and 5(2)(a) against the following goods:

Class 21: *Insulating sleeves for beverage cans; Reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; Drinking cups; ceramics for household purposes; drinking vessels.*

183. As it will be recalled WMG relies on its earlier trade mark no. UK00003696880 (which is subject to invalidity no. 505857) and all of the goods in classes 5, 6, 9, 11, 21 and 32 for which that mark is registered. However, following the outcome of invalidity no. 505857, UK00003696880 is no longer protected for the goods in class 11, these goods having been cancelled *ab initio* from the registration. Having said that, this is not going to make any difference to the outcome of this opposition as Mr Meale rightly focused on WMG's goods in class 21 saying that he only needed to rely on those goods. The relevant comparison of goods is therefore as follows:

Quindao's contested goods	WMG's earlier goods
Class 21: <i>Insulating sleeves for beverage cans; Reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; Drinking cups; ceramics for household purposes; drinking vessels.</i>	Class 21: <i>Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels; Bottles; Glass flasks [containers]; Heat-insulated containers for beverages; Insulating flasks; Tea cups; Teapots; Tea services [tableware]; Tea caddies.</i>

184. The contested *Reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; Drinking cups; ceramics for household purposes; drinking vessels* are (or include) types of drinking vessels and as such are encompassed by WMG's *Drinking vessels* and are identical on the principle outlined in *Meric*. These goods are identical.

185. This leaves *Insulating sleeves for beverage cans*.

186. Mr Meale argues that those goods are similar to *Heat-insulated containers for beverages; Insulating flasks* because they share the same purpose, i.e. insulating. Since beverage cans are normally refrigerated, the contested *Insulating sleeves for beverage cans* must refer to sleeves made of insulated textile material used for holding cold cans to avoid the discomfort of cold. Therefore, I agree with Ms Fuller that these goods are cooler sleeves that go round a can because warm drinks are not sold in cans, and I am not sure that cans containing food can be heated in microwaves. Conversely, the earlier *Heat-insulated containers for beverages; Insulating flasks* are containers and flasks typically made from high-quality materials such as stainless steel which are designed to maintain the temperature of liquids for extended periods. The purpose and nature of the goods is different, as it is their method of use. The goods are not complementary, because they are not indispensable or important for the use of the other; in this connection, I am not persuaded by the example given by Mr Meale of something that can be put on the top of a wine cooler or a cover to a hot water bottle. In these examples, the goods are used together, whereas here you do not put an insulating sleeve for beverage cans around a heat-insulated containers for beverages or an insulating flask. In addition, the goods are not in competition, and although they may target the same consumers insofar as they can be bought by members of the general public, this is not sufficient to conclude that they are similar. Likewise, the goods are unlikely to be produced by the same manufacturers or even if they may be sold in the same shops or supermarkets, they are unlikely to be found in close proximity to each other. Lastly, it has not been argued (and there is no evidence) that *Insulating flasks* are used to keep beverages cold, but even if that argument had been put forward, the purpose of the goods would still be different as insulating sleeves for beverage cans are used to avoid cold and wet hands, whereas insulating flasks would be purchased to keep drinks cold. Accordingly, I find that *Insulating sleeves for beverage cans* are dissimilar.

187. Both marks are word-only marks consisting of the single word 'WATERDROP'. Although one the mark is presented in lower case and the other in upper case letters, registration of a word mark protects the word itself and covers use in all possible cases, fonts and typefaces. Hence, the marks are identical. Further, in its pleading Quindao

did not deny the identity of the marks. Having found that, with the exception of one term in the contested specification, the goods are identical, and the identity of the marks having been established, I conclude that there is double identity under Section 5(1) and the opposition succeeds under this ground to that extent.

188. However, since the similarity of the goods is a requirement for likelihood of confusion under Section 5(2), the opposition fails against the goods which I found to be dissimilar.

189. Accordingly, the opposition is successful against the following goods which will not be registered:

Class 21: *Reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; Drinking cups; ceramics for household purposes; drinking vessels.*

190. The opposition fails in relation to the following goods which can proceed to registration:

Class 21: *Insulating sleeves for beverage cans.*

Sixth set of proceedings: opposition under no. 441523 against Quindao's application to register trade mark no. UK00003867136.

191. In this opposition WMG withdrew its Sections 5(3), 5(4)(a) and 3(6) claims but maintains the opposition under Section 5(2)(a) against the following goods:

Class 7: *Apparatus for aerating water; Machines for the production of soda water and sparkling beverages; beverage preparation machines, electromechanical; apparatus for aerating beverages.*

192. Under Section 5(2)(a), WMG relies upon the same earlier mark UK00003696880 which is relied upon in the other opposition and some of the goods in class 32 covered by it, namely *Preparations for making beverages; Essences for making beverages;*

Pastilles for effervescing beverages; Powders for the preparation of beverages. Contrary to the other proceedings in which WMG relies on identically registered goods under the trade mark no. UK00914996888, here the earlier mark is not subject to proof of use, which means that WMG can rely on the full width of the registered terms.

193. The relevant comparison of goods in this opposition is as follows:

Quindao's contested goods	WMG's earlier goods
<p>Class 7: <i>Apparatus for aerating water; Machines for the production of soda water and sparkling beverages; beverage preparation machines, electromechanical; apparatus for aerating beverages.</i></p>	<p>Class 32: <i>Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages.</i></p>

194. In his skeleton argument, Mr Meale argues the similarity of the goods by saying that the contested *beverage preparation machines, electromechanical and machines for the production of soda water and sparkling beverages* in class 7 are closely related to the earlier *preparations for making beverages* in class 32 because they are two sides of the same coin, both used to make the same final product and it is likely that the class 32 goods are put into the class 7 goods to make the beverages. Further, he argues that applying the *Canon* factors (a) the users and uses coincide as both sets of items are aimed at the creation and enhancement of beverages, the class 32 goods providing the chemical or physical means necessary to flavour, colour or otherwise prepare the beverages, the class 7 goods offering the mechanical means to produce, particularly effervesce, those beverages; (b) the goods are complementary similarly to the relationship between coffee machines and coffee pods or capsules; alternatively, it is possible that the goods would compete in circumstances where they can be used without the other; (c) the goods share trade channels as they are likely to be distributed through similar trade channels, including kitchenware stores, specialty beverage shops, online retailers, and possibly supermarkets; however, Meale also accepted that in supermarkets, the goods might not always be found on the same shelf but could

be located in the same aisle or section dedicated to beverage preparation and kitchen appliances.

195. In addition, Mr Meale argued, the contested *apparatus for aerating water* and *apparatus for aerating beverages* are highly similar to all of the earlier terms in class 32, including *Pastilles for effervescing beverages*. In particular, while conceding that the nature of the goods is different as one category comprises consumable goods and the other consists of mechanical devices, Mr Meale argued that both are tangible goods used in the physical process of beverage preparation. He also argued that the goods can be either in competition or complementary, as the use of one can enhance or necessitate the use of the other.

196. In support of his argument, Mr Meale relied upon a decision of the EUIPO dated 8 June 2015 in cancellation no 10014C *Meneau v Sparkling Drinks Systems Innovation Center International Sas*, in which the cancellation applicant relied upon goods in class 32 including "*Mineral and aerated waters and other non-alcoholic beverages; sodas, lemonades; syrups, concentrated syrups derived or not from organic farming and preparations, liquid or not, to prepare drinks*" to invalidate "*Aerated beverage making machines, mineral water making machines*" in Class 7. As Mr Meale pointed out, in that decision the examiner concluded that there was a degree of similarity between the goods stating as follows:

"The contested goods in this Class are apparatus that can be used by end consumers at home to prepare sparkling beverages using water and a specific preparation. The earlier mark is protected for, among others, syrups, concentrated syrups derived or not from organic farming and preparations, liquid or not, to prepare drinks. Such preparations include the syrups and powders used in the contested machines to make the drinks. These goods are highly complementary, one cannot be used without the other. They are sold together, the preparations are to be found in the same outlets as the machines or next to each other in the supermarkets, and they are directed at the same consumers. It is normal that these goods are produced by the same entities, as the producer of the machine sometimes also offers specific preparations to be used in its machines only. Moreover, the applicant provided website printouts

showing the closeness of the markets of sparkling beverages and the 'home carbonation' machines. Consequently, these contested goods and the goods of the earlier mark are similar."

197. Ms Fuller, on her part, disagreed by saying that the fact that all of the goods are in some way related to beverages is not sufficient to demonstrate any similarity because the uses, users, nature and trade channels for the goods are different and the goods are not normally produced by the same manufacturers. She also stated that machines for the production of soda water do not require additives, because they just make fizzy water. Further, she kept referring to the goods for which genuine use has been shown, namely preparation for flavouring beverages, however, as I have explained earlier, the mark relied upon in this opposition is not subject to proof of use which means that WMG is not limited by the use made. Lastly, Ms Fuller argued that the EUIPO decision relied upon by Mr Meale was based on evidence filed in that case and there is no evidence here that the goods must be used together or are found in close proximity in shops or supermarkets.

198. I agree with Ms Fuller that the decision of the EUIPO was based on evidence showing the closeness of the markets of sparkling beverages and home carbonation machines. However, that evidence is absent in this case, and it is not clear what that evidence shows.

199. The main problem with Mr Meale's submission is that although it is possible that *Apparatus for aerating water; apparatus for aerating beverages* might require the use of chemicals or other preparations, there is no evidence of it. For what I know, aerated water is water to which air or oxygen have been added, and machines for making aerated water are likely, in my view, to mechanically introduce air into the water without using any additives or preparations. On that basis, I find that the nature, purpose and method of use of the goods is different, the goods are neither complementary nor do they share trade channels. Whilst it is possible that WMG's *Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages* might be mixed with aerated water produced using Quindao's machines, this does not create neither complementarity nor competition, the coincidence of users being a too high a level to justify a finding of

similarity. Admittedly, the term *pastilles for effervescing beverages* must include pastilles used to make beverages fizzy and effervescent. However, first I am not convinced that aerated water is the same as an effervescing water made using *pastilles for effervescing beverages*, and second, it seems to me that any competition is very limited due to the completely different nature of the goods (i.e. machines versus effervescing pastilles). Further, there is no evidence of manufacturers offering both *Apparatus for aerating water; apparatus for aerating beverages* and *pastilles for effervescing beverages* and there is no evidence of the goods being used together; in this connection it would have been helpful for WMG to produce evidence showing, for example, that *pastilles for effervescing beverages* are used with *apparatus for aerating water; apparatus for aerating beverages* to produce aerated water. However, no such evidence has been produced. These goods are dissimilar. Since I have concluded that the goods are dissimilar, the opposition based on Section 5(2)(a) fails at the first hurdle.

200. This leaves *machines for the production of soda water and sparkling beverages and beverage preparation machines, electromechanical*.

201. In relation to *beverage preparation machines, electromechanical*, I accept that they are sufficiently broad to include machines that make beverages using WMG's preparations. Hence, whilst the nature, purpose and method of use of the goods might differ, they are complementary 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. Further, the goods are likely to be distributed through the same trade channels and manufactured by the same producers. Overall, I consider the goods to be similar to a low to medium degree.

202. Lastly, *machines for the production of soda water and sparkling beverages*. I found this to be one of the trickiest comparisons. Ms Fuller argued that these goods do not require additives and should be considered together with the apparatus for aerating water because "*if you are just making fizzy water you are explicitly not using any additives because you are just making water*". Conversely, Mr Meale argued that these goods are closely related to at least "preparations for making beverages" and

are “are two sides of the same coin”. In this connection, he argued that they can both be used to make the same product or, more likely, they will use those class 32 goods in the class 7 goods to make beverages. Collins online dictionary describe soda water as “*an effervescent beverage made by charging water with carbon dioxide under pressure*” indicating that the product is made using an additive, i.e. carbon dioxide and mechanical pressure. On that basis, I think the same reasons as those I set out above apply, on the basis that WMG’s preparations are sufficiently broad to include carbon dioxide for making soda water using Quindao’s machines in class 7. Overall, I consider the goods to be similar to a low to medium degree.

203. As I found that there is a degree of similarity between some of the goods concerned, namely *Machines for the production of soda water and sparkling beverages; beverage preparation machines, electromechanical*, I will now proceed to consider the likelihood of confusion in relation to them.

Comparison of marks

204. Both parties in this opposition have accepted that the marks are identical.

Average consumer

205. As the case 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.”

206. The average consumer of the parties’ goods is a member of the general public.

207. The purchasing process for the goods is likely to be predominantly visual, with the goods being selected from retail environments or their online equivalent. However, as word-of-mouth recommendations may also play a part, I do not discount that there will also be an aural component to the purchase.

208. In respect of the level of attention paid, I am of the view that it will be medium, neither higher nor lower than the norm.

Distinctive character of earlier mark

209. 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

210. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

211. The earlier mark consists of the word ‘WATERDROP’. Mr Meale accepted that no one had taken a point on the distinctive character of the marks and that his view was that they were going to be an average. Ms Fuller said that she admitted, *inter alia*, the point on distinctiveness. Hence, I will proceed on the basis that the earlier mark is distinctive to a medium degree.

Likelihood of confusion

212. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

213. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *“The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”*.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

214. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.

215. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

216. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

217. Earlier in this decision I found that:

- The marks are identical.
- The goods are similar to a low to medium degree.
- The goods will be selected visually with an average degree of attention.
- The earlier mark is distinctive to a medium degree.

218. Bearing in mind all of the above I consider that notwithstanding the lower-than-average degree of similarity between the goods, the identity of the marks and the average degree of distinctiveness of the earlier mark are sufficient for the average consumer to be directly confused into thinking that the later goods and the earlier goods are produced by the same undertaking under the same mark. There is a likelihood of confusion.

219. Accordingly, the opposition is successful against the following goods which will not be registered:

Class 7: Machines for the production of soda water and sparkling beverages; beverage preparation machines, electromechanical.

220. The opposition fails in relation to the following goods which can proceed to registration:

Class 7: Apparatus for aerating water; apparatus for aerating beverages.

OVERALL OUTCOME

Proceedings	Outcome
<p>Revocation for non-use under no. 506149 against Quindao's trade mark registration no. UK00003166146.</p>	<p>The mark UK00003166146 is revoked for <i>Air filtering installations</i> with effects from 27 August 2021. However, the mark remains registered in relation to water filters.</p> <p>Both parties partially successful.</p>
<p>Application for invalidity under no. 506796 against Quindao's trade mark registration no. UK00003166146</p>	<p>The invalidity under no. 506796 fails. It follows that the mark UK00003166146 remains registered to the extent that it survived the revocation for non-use.</p> <p>Quindao successful in defending the registration.</p>
<p>Application for invalidation under no. 505859 against WMG's trade mark no. UK00917881798.</p>	<p>The invalidity under no. 505859 fails. It follows that the trade mark no. UK00917881798 remains registered as it stands.</p> <p>WMG successful in defending the registration.</p>

Application for invalidation under no. 505857 against WMG's trade mark no. UK00003696880.

The invalidity no. 505857 succeeds in relation to the following goods and the registration will be invalidated in respect of all of them:

Class 11: *Water filters; Water filtering units; Membranes for the filtration of water; Water filtering apparatus for domestic use; Water conditioning units; Water treatment apparatus for water softening; Chilled purified water dispensers; Equipment for generating electromagnetic radiation for disinfecting containers and/or for disinfecting container content; UVC spotlights for the purification of a liquid; Generators for ultraviolet radiation (UVC); Water purification units; Water disinfection apparatus.*

However, the trade mark no. UK00003696880 will remain registered for the following goods (either because they were not objected or because the invalidity has failed in relation to them):

Class 5: *Vitamin supplements; Vitamin tablets; Vitamin preparations; Effervescent vitamin tablets; Vitamin drinks.*

Class 6: *Sealing caps of metal; Closures of metal; Bottle closures of metal.*

	<p>Class 9: <i>Optical and/or electromagnetic and/or electric equipment for determining the fill level of a container integrated in closures for containers (including screw closures); Communications equipment (in particular featuring a data interface featuring short-range radio transmission) for data exchange with a smartphone, tablet, PC or the like integrated in closures for containers (including screw closures); Mobile Apps.</i></p> <p>Class 21: <i>Decanters; Glasses [drinking vessels]; Tumblers; Drinking vessels; Bottles; Glass flasks [containers]; Heat-insulated containers for beverages; Insulating flasks; Tea cups; Teapots; Tea services [tableware]; Tea caddies.</i></p> <p>Class 32: <i>Beverages containing vitamins; Non-alcoholic beverages; Preparations for making beverages; Essences for making beverages; Pastilles for effervescing beverages; Powders for the preparation of beverages.</i></p> <p>Both parties partially successful.</p>
<p>Opposition under no. 440448 against Quindao's application to register trade mark no. UK00003845931.</p>	<p>The opposition is successful against the following goods which will not be registered:</p>

	<p>Class 21: <i>Reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; Drinking cups; ceramics for household purposes; drinking vessels.</i></p> <p>The opposition fails in relation to the following goods which can proceed to registration (along with all of the goods that were not opposed):</p> <p>Class 21: <i>Insulating sleeves for beverage cans.</i></p> <p>Both parties partially successful.</p>
<p>Opposition under no. 441523 against Quindao's application to register trade mark no. UK00003867136.</p>	<p>The opposition is successful against the following goods which will not be registered:</p> <p>Class 7: <i>Machines for the production of soda water and sparkling beverages; beverage preparation machines, electromechanical.</i></p> <p>The opposition fails in relation to the following goods which can proceed to registration:</p> <p>Class 7: <i>Apparatus for aerating water; apparatus for aerating beverages.</i></p> <p>Both parties partially successful.</p>

COSTS

221. Each party has achieved a measure of success, so I order that each party bear their own costs.

Dated this 5th day of September 2025

TERESA PINTO

For the Registrar