O/0971/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 4073407
IN THE NAME OF ABDULWAHED BIN SHABIB DISTRIBUTION
FOR THE TRADE MARK

IN CLASSES 3, 18 AND 25

AND

THE OPPOSITION THERETO UNDER NUMBER 450245
BY JNTL CONSUMER HEALTH I (SWITZERLAND) GMBH

Background and pleadings

1. Abdulwahed Bin Shabib Distribution ("the applicant") filed an application for the trade mark shown on the cover page of this decision (number 4073407) on 9 July 2024 ("the relevant date") for the following goods:

Class 3: *After-shave lotions; air fragrance reed diffusers; body glitter; cosmetic preparations for skin care; cosmetics; eau de cologne; eyebrow cosmetics; eyebrow pencils; hair dyes/hair colorants; lip glosses; lipsticks; make-up; make-up palettes containing cosmetics; make-up powder; mascara; micellar water; nail care preparations; nail varnish/nail polish; nail varnish removers/nail polish removers; perfumery; perfumes; petroleum jelly for cosmetic purposes; serums for cosmetic purposes; sunscreen preparations; tissues impregnated with make-up removing preparations.*

Class 18: *Backpacks for carrying infants; bags [envelopes, pouches] of leather, for packaging; bags for campers; bags for climbers; bags for sports; bags; beach bags; briefcases; garment bags for travel; handbags; luggage tags/baggage tags; rucksacks/backpacks; school bags/school satchels; sling bags for carrying infants; slings for carrying infants; suitcase handles; suitcase packing organizers/luggage organizers; suitcases; suitcases with wheels; toilet bags, not fitted; tool bags, empty; travelling bags; travelling sets (leatherware); travelling trunks; trunks (luggage).*

Class 25: *Clothing; coats; dresses; dressing gowns; headbands [clothing]; headscarves/headscarfs; hoods [clothing]; jackets [clothing]; jumper dresses/pinafore dresses; knitwear [clothing]; leggings [leg warmers]/leg warmers; leggings [trousers]; petticoats; pyjamas/pajamas; ready-made clothing; ready-made linings [parts of clothing]; scarves/scarfs; shirts; short-sleeves shirts; stuff jackets [clothing]; suits; sweaters/jumpers [pullovers]/pullovers; tee-shirts; trousers/pants (am.); waistcoats/vests.*

2. JNTL Consumer Health I (Switzerland) GmbH ("the opponent") opposes the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").

The opponent relies upon the following three earlier trade mark registrations for both grounds:

(i) 916015547

OGX

Filing date: 9 November 2016; registration date: 9 March 2017

Class 3: *Hair care preparations; hair care products, namely, shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and non-medicated repair treatments, skin and facial lotions and moisturizers, skin and facial cleansers, body scrubs, body oils, body wash and body soap, sunscreen preparations.*

(ii) 912152617

Filing date: 18 September 2013; registration date: 1 May 2014

Class 3: *Hair care preparations; Hair care products, namely shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and repair treatments.*

(iii) 4034144

Filing date: 3 April 2024; registration date 28 June 2024

Class 3: *Hair care preparations; hair care products, namely, shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and non-medicated repair treatments, non-medicated hair care treatments for cosmetic purposes, skin lotions and moisturizers, skin cleansers, body scrubs, body oils, body wash and body soap.*

3. Under section 5(2)(b) of the Act, the opponent claims that the applicant's class 3 goods are identical or closely similar to the opponent's goods and that the marks are similar, leading to a likelihood of confusion. The opponent claims that its marks are wholly contained within FOGX and that the single letter difference is subtle and insufficient to avoid confusion. In relation to earlier marks (i) and (ii), the stylised X is replicated, which is striking and unusual. Further, the small animal device is likely to attract much less attention than the word element, FOGX.

4. Under section 5(3) of the Act, the opponent claims a reputation in its marks for the goods relied upon, such that the relevant public will believe that the applicant's goods come from the opponent or an undertaking economically connected to the opponent. There will also be unfair advantage because the contested mark will benefit from the opponent's investment in promoting its marks by free-riding on their repute. The positive image of the earlier marks will be transferred to the applicant's goods. If the applicant's goods are of inferior quality, this could cause damage to the reputation of the opponent's marks. The third type of damage claimed is that the use of the applicant's mark would dilute the distinctive character of the opponent's marks and consumers would accordingly be less able to rely on the opponent's marks as identifiers of quality and trust, thereby affecting the economic behaviour of the relevant public.

5. Earlier marks (i) and (ii) are subject to the provisions of section 6A of the Act because they had been registered for five years or more at the application date of the contested mark. The opponent has made a statement that the earlier marks have been put to genuine use for the goods relied upon.

6. The applicant filed a defence and counterstatement, denying the grounds of opposition and putting the opponent to proof that it has used earlier marks (i) and (ii), and proof of reputation for all the earlier marks.

7. The opponent is represented by D Young & Co LLP and the applicant by Lincoln IP. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu of attendance at the hearing. The only engagement in these proceedings made by the applicant has been the filing of the defence and counterstatement. I make this decision after careful consideration of all the papers on file, referring to them as necessary.

Proof of use

8. Section 6A of the Act states:

> "(1) This section applies where
>
> > (a) an application for registration of a trade mark has been published,
> >
> > (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
> >
> > (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

9. As earlier marks (i) and (ii), subject to the proof of use provisions, are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant.[1] It reads:

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

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or International Registration designating the EU ("IR(EU)"). Earlier mark (i) and (ii) were originally protected in the UK as EUTMs. They are now comparable marks which are recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing and registration dates.

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

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

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

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

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

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

10. The relevant period for proof of genuine use is the five years ending on the application date of the contested application: 10 July 2019 to 9 July 2024. The onus is on the opponent, as the proprietor of the earlier marks, to show genuine use because Section 100 of the Act states:

"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."

11. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:[2]

[2] 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.

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

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

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at

[13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or

preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

Evidence

12. The opponent's evidence comes from Richard Hendry, who states:[3]

"I am Senior Commercial Director for Vogue International EMEA, at JNTL and have held this position since 2014. JNTL is a subsidiary of Kenvue Inc. Kenvue formalised its separation from the Johnson & Johnson family of companies on 23 August 2023, becoming an independent company. JNTL is the entity that owns the global trademark rights of many Kenvue consumer brands, including OGX. Vogue International LLC, an affiliate of JNTL and a subsidiary of Kenvue, is the developer of OGX hair and personal care products. Vogue International LLC and the OGX brand were acquired by JNTL in 2016."

13. Mr Hendry states that OGX products use natural ingredients to bring salon-quality hair care and personal products to consumers. The marks were first used in the UK in 2014 and were initially sold in Tesco, Superdrug and Boots. Exhibit 1 comprises Wayback Machine internet archive prints from the OGX website, ogxbeauty.com, between 2019 and 2024, showing use of OGX and the stylised versions in relation to shampoo, conditioner, hair styling products, hair oils and body scrub products. I note that the print for 21 March 2020 spells colour as 'color', so it is not clear to me that this is a UK rather than a US-facing website. However, Exhibit 2 comprises internet archive prints from the UK website of Amazon, and from the websites of Boots and

[3] Witness statement dated 14 March 2025 and exhibits.

Waitrose, within the relevant period. The latter two only show use of OGX, whilst the Amazon print shows use of OGX and earlier mark (ii). Exhibit 3 contains screenshots from the independent consumer website Price Runner, showing use of OGX and the stylised versions in relation to shampoo, hair masks, hair oil, conditioner, hair styling products and body wash in UK prices. However, there are no dates. This exhibit also contains screenshots from Price Spy, with UK prices, but the prints pre-date the relevant period for proving proof of use (they are from 2014, 2015 and 2017.)

14. Exhibit 4 shows photographs of what Mr Hendry states to be shelves of OGX products, although the images of the products are too small for me to be able to see the marks themselves in the first image. However, all the bottles look like the bottles in exhibits 1 to 3 and in the remainder of this exhibit, on which I can see earlier marks (ii) and (iii). Mr Hendry states that the first three images were all taken in 2023. The fourth and fifth images are from Superdrug in Windsor and Waitrose in Bracknell, but Mr Hendry does not state when these images were photographed.

15. Invoices which include OGX products are shown in Exhibit 5 from between 2020 and May 2024 to customers with UK addresses.[4] The opponent has not highlighted if any of the abbreviated individual items listed in the 49 pages of invoices are for anything other than hair care products. From my review of the product descriptions in the invoices, the items are all for hair care.

16. Mr Hendry provides net trade sales and marketing figures:

Year	Net Trade Sales (£)	Marketing expenditure (£)
2018	14,899,000	2,126,000
2019	16,579,000	1,408,000
2020	19,955,000	2,574,000
2021	17,115,000	1,190,000
2022	19,295,000	2,281,000
2023	19,584,000	1,284,000
2024[5]	22,359,000	5,200,000

[4] I have discounted the invoices which are dated after the filing date of the application.
[5] I have only taken half of this figure as indicative of sales and expenditure prior to the application date, which was roughly half-way through 2024.

17. Mr Hendry provides data from Statista, which he describes as the independent data survey company, to evidence brand awareness of OGX in the UK.[6] The exhibit appears to comprise survey results. No permission has been sought to file this exhibit, as per the requirements of Tribunal Practice Notice 2/2012 ("TPN") which stipulates the criteria to be satisfied for survey evidence, following the head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293. I will, therefore, not take into account the exhibit or the references to it in Mr Hendry's witness statement.

18. In terms of advertising and promotion, Mr Hendry provides a selection of Instagram posts which he states demonstrate "the types of advertising of OGX products that have been viewed by UK customers between 2015 and 2024".[7] Some of the Instagram posts are said to be paid advertisements or collaborations with celebrities, such as Demi Lovato, Vogue Williams and Giovanna Fletcher. Others are said to be paid advertisements and collaborations with social media influencers. I note that there is a US spelling of 'colorful' on a post headed "yammy_xox and ogxbeautyuk but that may indicate the origin of the influencer, rather than the audience for the post. Other posts are all headed "ogxbeautyuk", with the name of the influencer, and some (but not all) are within the relevant period.

19. Mr Hendry states that Exhibit 8 comprises stills taken from a television campaign for OGX products that was broadcast in the UK during the relevant period. I note that the date of the Instagram posts showing the stills is 5 July 2024, four days before the application was filed. The stills show earlier mark (iii) in relation to hair care. Mr Hendry states that the advertisement ran for 5 months, but does not say from what date. He does explain that the advertisement was also seen during the Girls Aloud UK stadium tour in June 2024 (in two stadiums in Scotland, on three dates).[8] Exhibit 10 comprises a marketing summary about the reach of the advertisement at the concerts, which was estimated to be 300,000 people at 21 UK arena shows. No dates are given other than that the tour took place in 2024. It may be the case, therefore,

[6] Exhibit 6.
[7] Exhibit 7.
[8] The advertisement is provided as electronic Exhibit 9, which I have viewed.

that the concerts in Scotland pre-date the relevant date and the remainder took place after the relevant date.

20. Exhibit 11 contains screenshots from the opponent's UK-specific Instagram page, ogxbeautyuk between 2020 and 2024. As at the date of Mr Hendry's witness statement, there were 1,609 posts and 40,500 followers; however, these figures post-date the relevant date. The screenshots all fall within the relevant period and show earlier marks (ii) and (iii) in relation to hair care products. The exhibit also contains screenshots of an advertisement on YouTube, first shown on 7 March 2024. Earlier mark (iii) is used. Mr Hendry states that the advertisement has received over 1.1 million views, but I treat this figure cautiously given that the advertisement was first shown only four months prior to the relevant date and Mr Hendry's statement was made on 14 March 2025, eight months after the relevant date.

21. Exhibit 12 comprises copies of articles published in print and in online UK publications. Three of the articles were published after the relevant period, and another before it, but the other 12 were published during the relevant period. The articles feature in *British Vogue*, *Closer*, *Cosmopolitan*, *Good Housekeeping*, the *Independent*, *ELLE*, *The Standard*, *Woman & Home* and *Marie Claire*. Several of them are about the best hair care products; such as *Good Housekeeping*'s "15 best shampoos for oily hair, tried and tested 2024", in which one of the opponent's shampoos scored 82/100 (which shows earlier mark (ii)), available from Boots.[9] In an article in the *Independent*, dated 16 May 2024, one of the opponent's shampoos came out as the best sulphate-free shampoo for all hair types, available from Amazon.co.uk. It shows earlier mark (iii). A shampoo was the best organic shampoo for dry hair in *Elle*, published on 22 May 2024 and showing earlier mark (ii). Another of the opponent's shampoos was the best shine-boosting shampoo in the *Marie Claire UK Hair Awards 2023* (article published 19 April 2023), showing earlier mark (ii) and available at Superdrug. Mr Hendry gives a summary at Exhibit 14 of the magazine awards and shortlist positions given to the opponent for its OGX hair care products, featuring some of the publications already mentioned in this paragraph, along with *Women's Health*, *Glamour*, *Top Sante*, *Get the Gloss*, *Prima*, *Runners World*, *Men's*

[9] Dated 26 February 2020.

Health, *The Express*, *Sheeluxe*, *Red* and *Hair Magazine*. The opponent's OGX hair care products won multiple awards in *Cosmopolitan*, *Marie Claire*, *Woman & Home*, *Glamour* and *Women's Health*.

22. There is a mixture of use of all three earlier marks; of course, earlier mark (iii) is not subject to proof of use. The distinctive part of earlier mark (iii) is the letter component, which is the same as earlier mark (ii). Use of earlier mark (iii) qualifies as use of earlier mark (ii).[10] There is use of the plain letter version (earlier mark (i)) but, in any event, use of earlier marks (ii) and (iii) qualifies as use of earlier mark (i), which covers the stylised versions of the letters.[11] The marks have changed ownership over the years, but the explanation given by Mr Hendry, quoted in paragraph 12 of this decision, is satisfactory in terms of showing use of the mark with the consent of the various proprietors. The applicant has also not challenged the evidence in that regard.

23. Although some of the evidence suffers from the shortcomings outlined above, there remains enough solid evidence to show that the opponent has made genuine use of its marks. The turnover and marketing figures are large, and there has been a substantial amount of exposure of the marks in the mainstream British press. However, there has only been use in relation to hair care goods. There has been next to no use in relation to body care products, which are a separate category to hair care products. I find that, in relation to earlier mark (i), a fair specification of goods is:[12]

> *Hair care preparations; hair care products, namely, shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and non-medicated repair treatments.*

24. Earlier mark (ii) is registered only for hair care products, and I find that the opponent can rely upon the entire class 3 specification, as pleaded:

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[10] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, CJEU.
[11] *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, sitting as the Appointed Person.
[12] *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834.

Hair care preparations; Hair care products, namely shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and repair treatments.

25. Of course, the opponent can rely upon the entirety of its class 3 goods for section 5(2)(b) in relation to earlier mark (iii), which is not subject to the use provisions of section 6A of the Act.

Section 5(2)(b) of the Act

26. Section 5(2)(b) states:

> "5. (2) A trade mark shall not be registered if because –
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

27. Section 5A states:

> "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."[13]

28. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the Court of Justice of

[13] This section also applies to the ground raised under section 5(3) of the Act.

the European Union ("CJEU") in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods

29. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

> “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.”

30. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

31. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, the General Court ("GC") stated that complementary means:[14]

> "82 … there is a close connection between [the goods], 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…".[15]

32. 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."

[14] Case T-325/06, the General Court.

[15] In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

33. The goods for comparison are:

Earlier marks	Application
Earlier mark (i) Class 3: *Hair care preparations; hair care products, namely, shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and non-medicated repair treatments.* Earlier mark (ii) Class 3: *Hair care preparations; Hair care products, namely shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and repair treatments.* Earlier mark (iii) Class 3: *Hair care preparations; hair care products, namely, shampoos, conditioners, gels, mousses, sprays, lotions, serums, dressings, emollients, nourishers, oils, relaxers and non-medicated repair treatments, non-medicated hair care treatments for cosmetic purposes, skin lotions and moisturizers, skin cleansers, body scrubs, body oils, body wash and body soap.*	Class 3: *After-shave lotions; air fragrance reed diffusers; body glitter; cosmetic preparations for skin care; cosmetics; eau de cologne; eyebrow cosmetics; eyebrow pencils; hair dyes/hair colorants; lip glosses; lipsticks; make-up; make-up palettes containing cosmetics; make-up powder; mascara; micellar water; nail care preparations; nail varnish/nail polish; nail varnish removers/nail polish removers; perfumery; perfumes; petroleum jelly for cosmetic purposes; serums for cosmetic purposes; sunscreen preparations; tissues impregnated with make-up removing preparations.*

34. The specifications (following the proof of use assessment) of earlier marks (i) and (ii) are essentially the same. These goods also appear in the specification for earlier mark (iii), which additionally has cover for certain skin and body care products.

35. The law requires that goods and services be considered identical where one party's description of its goods and services encompasses the specific goods and services covered by the other party's description (and vice versa): *Gérard Meric v OHIM*.[16] This means that the applicant's *hair dyes/hair colorants* are identical to the opponents' hair care preparations in all three earlier marks. The applicant's *after-shave lotions* and *cosmetic preparations for skin care* are also identical on this basis to the opponent's skin lotions and moisturizers, and the applicant's *tissues impregnated with make-up removing preparations* are identical to the opponent's skin cleansers.

36. In *La Mer Technology, Inc v OHIM,* Case T-418/03, the GC stated that soaps may be classified as cosmetics when they are deemed "to have cosmetic properties such as beautifying the skin or when they are perfumed", finding the same applied to bath additives.[17] The court went on to find:

> "110. As regards the assessment of the similarity of the goods in question, it must be stated, as the Board of Appeal correctly noted in paragraph 33 of the contested decision, that 'cosmetics' in the Community trade mark application include 'cosmetics of a marine product base', so that they are identical.
>
> 111. So far as concerns 'soaps, perfumery, essential oils, hair lotions, dentifrices, toiletries' in the Community trade mark application, it should be stated that they share hygiene and cosmetic properties. The cosmetic products of the earlier mark may also be used for hygiene purposes. As was stated in paragraphs 77 to 84 above, soaps and bath additives are used not only for cleaning the skin but also for making the skin more beautiful and claim therefore to have cosmetic properties. On that point, in paragraph 33 of the contested

[16] Case T-33/05, General Court.
[17] Paragraph 78

decision the Board of Appeal correctly noted that beautification is not obtained only by the use of traditional means, such as make-up or other cosmetics, but also through the use of products which, although they may be hygienic, serve beauty purposes as well: for example, soap that is composed in a manner whereby there is only a minimum of skin dehydration, thus leading to a more beautiful skin or dentifrices that, in addition to cleaning teeth, also make them whiter.

112. Moreover, those products may be sold in the same sales outlets and be directed at an identical category of consumers. In addition, quite often the manufacturers of those products are the same.

113. Finally, the applicant itself concedes, in its complaint alleging that the Board of Appeal ought to have made an additional distinction between the goods, that besides the cosmetics which are identical, all the other products are, to differing degrees, similar to those bearing the earlier mark.

114. The Board of Appeal was therefore right to take the view, in paragraph 33 of the contested decision, that 'soaps, perfumery, essential oils, hair lotions, dentifrices, toiletries' under the Community trade mark and 'cosmetics of a marine product base' under the earlier mark are very similar."

37. If I am wrong that the applicant's *cosmetic preparations for skin care* and *tissues impregnated with make-up removing preparations* are identical to the opponent's goods, I nevertheless find as follows. The application covers *cosmetic preparations for skin care*; *cosmetics*; *micellar water*; *petroleum jelly for cosmetic purposes; serums for cosmetic purposes*; *sunscreen preparations* and *tissues impregnated with make-up removing preparations* which are at least very similar to the opponent's hair care preparations, skin lotions and moisturisers and skin cleansers. They all serve beautification purposes and are frequently sold in the same stores (such as Boots and Superdrug, which sell the opponent's goods) and on adjacent shelving, in the same area of shops and supermarkets. Some of the goods may be sold both in liquid or in solid form, such as soaps, shampoos, conditioners and sunscreen preparations.

38. Apart from *make-up* itself, the following goods in the application may all be considered as items of make-up: *body glitter; eyebrow cosmetics; eyebrow pencils; lip glosses; lipsticks; make-up palettes containing cosmetics; make-up powder; mascara; nail care preparations* and *nail varnish/nail polish*. Although makeup is a cosmetic, and hair products and skin care preparations are very similar to cosmetics or have cosmetic properties, that does not mean that the opponent's hair care products, skin care preparations and the applicant's makeup are necessarily similar.[18] In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation of specifications:

> "In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use".

39. In my view, the ordinary and natural meaning to the UK consumer of the term make-up covers goods which add colour, decoration or definition to facial features and/or to the body. The nature of such goods is generally different to hair care products and skin care preparations. The purpose of the parties' goods can be said to be beautification of the user, although the method by how that is achieved is different. They are not in competition, and there is no complementarity. Both parties' goods are sold in the personal care section of supermarkets and they are found in retailers such as Superdrug and Boots. However, the parties' goods generally have their own discrete areas within such stores. Make-up in large retail stores has its own area, sometimes with assistants dedicated to the various brands of make-up, and

[18] See *Novartis AG v OHIM*, Case T-444/12, GC, in which the court stated that specific goods within broad categories may be not similar to one another.

some make-up brands have their own stores, selling only make-up. I find that there is a low degree of similarity between the goods covered by the earlier marks and the applicant's goods listed at the start of this paragraph.

40. The applicant's *nail varnish removers/nail polish removers* are similar to a low to medium degree with the opponent's *skin lotions and moisturizers, skin cleansers*. Although the applicant's goods are specifically for removing nail varnish/polish, such goods frequently have cleansing and moisturising properties. They may all be in liquid form or in the form of impregnated pads or wipes. They are not in competition or complementary but they are sold on nearby shelves to the opponent's products in supermarkets and retail stores. The applicant's goods are similar to a low degree with the opponent's hair care goods, again all for use in improving the appearance of the person as part of a beauty and personal care regime and being available in the same shops and general areas of supermarkets. However, they treat different parts of the body and are not in competition, nor are they complementary goods.

41. The applicant's *eau de cologne; perfumery; perfumes* are also for personal hygiene care. These goods may be sold as part of a set with e.g. skin lotions and moisturizers, body wash and body soap, all with the same fragrance, although that does not make them complementary in the sense of *Boston*. I find there is a low degree of similarity between the applicant's goods listed at the start of this paragraph and the opponent's skin lotions and moisturizers, skin cleansers, body scrubs, body oils, body wash and body soap. However, I do not see that there is any similarity with the opponent's hair care goods which serve an entirely different purpose, are not sold nearby to one another, have a different method of use, do not generally appear in sets sharing the same fragrance, and are not complementary and not in competition. If I am wrong about that, any similarity must be very low.

42. The applicant's *air fragrance reed diffusers* are for fragrancing the home, rather than for personal use. There may be some degree of similarity if they are the same scent as e.g. the opponent's skin lotions and moisturizers, skin cleansers, body scrubs, body oils, body wash and body soap, but there is no evidence before me that it is common to find such goods sharing fragrances. They do not share any common

characteristics with hair care goods. Consequently, I find that they are dissimilar to the opponent's goods.

Average consumer and the purchasing process

43. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the goods at issue and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."[19] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*. In *Lidl Great Britain Limited & anor v Tesco Stores Limited & anor* [2024] EWCA Civ 262, Lord Justice Arnold explained:

> "16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and consumers.
>
> 17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as age, gender, ethnicity and social group.
>
> 18. Thirdly, assessment from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling

[19] *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).

courts and tribunals to determine such issues so far as possible without the need for evidence. ....

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind."[20]

44. The average consumer is a member of the general public and also a professional user. The goods are likely to be purchased reasonably frequently and may be relatively expensive or relatively inexpensive (typically, cologne is more expensive than shampoo and body washes). I bear in mind, though, that the latter does not mean that the goods will necessarily only require a low level of attention during purchase. Consumers will look to ensure that personal care products are suitable for them and that they like the scent. Professional users, e.g. hairdressers and beauticians, are likely to pay attention to the products they use on their customers. I find that the level of attention will be at least normal. The purchase will be overwhelmingly visual, although I do not ignore the potential for an aural aspect to the purchasing process; for example, stores commonly provide assistance in relation to personal care goods.

<u>Comparison of marks</u>

45. *Sabel BV v. Puma AG* explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

[20] Approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc and anor* [2025] UKSC 25, at paragraph 30.

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

46. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

47. I will focus on earlier marks (ii) and (iii) since they are the closest to the application: earlier mark (ii) has the same specification as earlier mark (i) (after the proof of use assessment); and earlier mark (iii) has the widest specification. The marks to be compared are:

Opponent's marks	Applicant's mark
(ii) (iii)	

48. Earlier mark (ii) comprises a single element made up of the letters OGX. The letter 'x' is heavily stylised, extending across to the left-hand side of the tail of the letter 'g', which gives it dominance in the overall impression. The same element is also present in earlier mark (iii), albeit on an ovaloid background. Although the background is not negligible, it is the OGX element which dominates the overall impression and, within that element, the eye is drawn particularly to the stylised 'x', as for earlier mark (ii).

49. The applicant's mark comprises a word element, fogx, and a device of a fox peering from the right-hand side of a black square. These elements are co-dominant. The eye is drawn equally to the device, at the beginning of the mark, and the large, stylised letter 'x' at the end of the word element.

59. Visually, the marks coincide in the letters OGX, in the same sequential order. This, notably, includes the exact same rendition of the stylised letter 'x'. Balancing the similarities and the differences, earlier mark (ii) is visually similar to the applicant's mark to a medium degree and earlier mark (iii) slightly less so because of the ovaloid background, although the difference is marginal.

60. The earlier marks will both be pronounced as three separate letters, O/G/X. The device in the applicant's mark will not be articulated because it is more usual to refer to marks with word or letter elements by those elements, rather than describing the device.[21] The applicant's mark is more likely to be articulated as four separate letters, F/O/G/X, rather than FOG-X, although I accept that is possible (as submitted by the applicant). I think it unlikely that anyone would attempt to pronounce the letters as a single word, because it is very difficult to articulate the GX letters, other than separately.

61. The earlier marks do not have a concept, consisting of three, seemingly, random letters.[22] The device in the applicant's mark creates the concept of a fox. Even though the word element is not the word Fox, the presence of the fox device at the beginning of the mark will mean that the word element will be strongly evocative of the word FOX, particularly with the stylised and very noticeable letter 'x'. It is my view that the word element is more likely to be approximated to the known word FOX than it is to the word FOG with an 'x' at the end of it. In any event, whether the concept of the applicant's mark is FOX or FOG, the marks are not conceptually similar.

[21] See the GC in Case T-424/10, *Dosenbach-Oschner AG v OHIM*, paragraph 46.
[22] Mr Hendry states that the opponent's goods were originally branded as Organix, and that is where the letters came from, but I think it unlikely that the average consumer would appreciate that derivation.

Distinctiveness of the earlier mark

62. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier marks has been enhanced (i.e. more distinctiveness has been acquired) through the use made of them. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased.[23]

63. Neither of the earlier marks describes or alludes to the opponent's goods or to any characteristic thereof. That said, they consist or contain three letters which will be seen only as letters and not as an invented word. This means that the earlier marks do not have the highest level of inherent distinctive character. I assess it as medium.

64. Distinctive character is a measure of how strongly an earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

> "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)."

[23] *Sabel BV v Puma AG,* Case C-251/95.

65. Mr Hendry states that "OGX products hold a dominant position within the UK hair care market."[24] He does not provide market share figures to substantiate this assertion. Nevertheless, I am satisfied that the level of sales and marketing, the sale of goods bearing the marks by major UK retailers, and the exposure the marks have been given in major UK consumer publications and awards is sufficient to find that the distinctive character of the earlier marks had been enhanced at the relevant date to a relatively high degree in relation to the goods for which I found that there had been genuine use; i.e. hair care goods.

Likelihood of confusion

66. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the goods range from identical to similar to a low degree, and dissimilar (air fragrance reed diffusers).

67. There are two types of confusion, direct and indirect.[25] Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind. My finding is that there is no likelihood of direct confusion because the device at the beginning of the applicant's marks, and the presence of the letter F at the start of the word element in the applicant's mark, are differences which are unlikely to be overlooked and the marks thereby confused.

68. I also find that there is no likelihood of indirect confusion. This type of confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

[24] Paragraph 14 of his witness statement.
[25] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

“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).”

69. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others.*[26]

70. I bear in mind that the stylised letters OGX in the applicant's mark are the exact replica of the letters in the earlier marks. The applicant denies, in its counterstatement, that the extension of the letter 'x' is striking or unusual, as claimed by the opponent. I have already found that the stylised letter 'x' is the dominant part of earlier marks (ii) and (iii) and that the eye will be drawn to it, as well as to the fox device, in the applicant's mark. I find that the extended 'x' is striking. It is also striking that both parties' marks contain the letters OGX, culminating in the same stylised 'x'.

71. However, a common element, even one such as this, does not automatically lead to indirect confusion. This is despite the fact that the earlier marks are relatively highly distinctive through their use, that the goods not subject to a high degree of attention during purchase, and that some of them are identical. These would normally be factors in favour of the opponent. Having given careful consideration to the matter, I cannot conclude that the presence of a fox, which has no relevance or meaning in relation to the goods, reinforced by the composition of the word element FOGX, will lead average consumers to believe that the later mark is a brand variation or extension of the earlier marks (or vice versa) or that the goods have been in some way endorsed or licensed by the opponent, or that the parties are collaborating. The nature of the differences between the marks do not lend themselves to such a conclusion. There must be a belief in an economic connection and I do not think that such a belief is likely.[27]

72. The section 5(2)(b) ground fails.

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[26] *Ibid.*

[27] Mr Iain Purvis KC, sitting as the Appointed Person, in *Vault IP Limited v Mark Kingsley-Williams* at paragraph 15, case BL O/0353/24.

Section 5(3) of the Act

73. 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.
>
> (3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

74. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42*.*

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

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

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier

mark; *L'Oreal v Bellure NV,* paragraph 40*.* The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

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

75. I will again focus on earlier marks (ii) and (iii). The parties' marks are similar. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. For the reasons given earlier in this decision, there is a qualifying reputation in respect of the opponent's hair care goods, but not the goods for use elsewhere on the body.

76. The strength of the reputation is a factor in whether the relevant public will make a link between the marks. I find that the opponent enjoys a substantial reputation. Another factor is how distinctive the mark is; as found earlier in this decision, the earlier marks are factually distinctive for hair care goods to a relatively high degree. The sales figures at the relevant date were in the many £millions. These are not high cost goods, which means that the number of items sold is substantial.

77. A further factor in the consideration as to whether a link will arise is the similarity between the goods. Some in class 3 are identical and some are similar to a low degree. These are factors in the opponent's favour. Even in relation to air fragrance reed diffusers, these are goods which are not so very far removed. The parties' goods are the sort of items which will be given as gifts and fragrance will be a feature of many

of them, although not sufficiently so to cause a finding of similarity based on the authorities cited earlier in this decision. The applicant's goods in class 25 are not similar to the opponent's goods. The majority of the applicant's class 18 goods are also not similar to the opponent's goods, subject to my findings below.

78. I found earlier that the differences between the marks means that they are not likely to be confused directly or indirectly, and I also commented upon the common OGX stylisation as being striking. The use of the extended 'x', when the earlier marks are distinctive and have a substantial reputation, means that although the relevant public (the general public and hair care professionals) will not confuse the marks, the earlier marks will be brought to mind by the later mark in relation to all of the applicant's class 3 goods.[28] A link will also be formed in the minds of the relevant public in relation to the applicant's *toilet bags, not fitted* because these are goods also not so very far removed from the opponent's toiletries in class 3. Again, it is not uncommon to find gift sets containing toiletries and a toilet bag and the separate goods are often located in the same area on supermarkets and larger retailers. The applicant's *bags; travelling bags* and *travelling sets (leatherware)* cover toilet bags. Therefore, I find that a link would also be made in respect of these goods. However, the much greater distance between the remainder of the applicant's class 18 goods, its class 25 goods and the opponent's goods means that there will be no link made with the earlier marks by the applicant's customers.

79. Having ruled out confusion, I nevertheless find that the applicant's mark would take unfair advantage of the opponent's marks for the goods for which I have found a link. The goods are either similar or not very far removed and the marks share the same striking component. The applicant will benefit from the instant familiarity with the earlier marks and get a marketing leg-up without having to do as much groundwork as would normally be required for a new mark. Viewed objectively, it is a reasonable inference that the applicant could not have arrived at such a striking similarity without having intended to influence the economic behaviour of its customers by creating a link with the earlier marks.

[28] It is settled case law that the level of similarity required for the "link" is lower than that required for a likelihood of confusion: *Intra-Presse SAS v OHIM*, joined cases C-581/13P & C-582/13P, EU:C:2014:2387.

80. Furthermore, the applicant will benefit from the power of attraction and image transfer from the opponent's mark. The image of a trusted brand which has won awards and been the subject of consistently good reviews in articles in consumer publications will be transferred to the applicant's mark and enable the applicant to obtain a marketing advantage. This is unfair, since it has not had to do its own marketing to achieve the result, but has instead piggy-backed on the reputation of the earlier marks and the marketing efforts of the opponent. The reputation of the earlier marks will cause consumers to have expectations about the later mark which they would not otherwise have had, without the applicant having to do its own marketing to create those expectations.[29] Such a finding can be made if that is the objective effect of the later mark, even if there is no proof that the applicant intended to take unfair advantage of the earlier mark's reputation.[30]

81. The section 5(3) ground partially succeeds.

Overall outcome

82. The opposition partially succeeds under section 5(3) of the Act. The application is refused in respect of the following goods:

Class 3: *After-shave lotions; air fragrance reed diffusers; body glitter; cosmetic preparations for skin care; cosmetics; eau de cologne; eyebrow cosmetics; eyebrow pencils; hair dyes/hair colorants; lip glosses; lipsticks; make-up; make-up palettes containing cosmetics; make-up powder; mascara; micellar water; nail care preparations; nail varnish/nail polish; nail varnish removers/nail polish removers; perfumery; perfumes; petroleum jelly for cosmetic purposes; serums for cosmetic purposes; sunscreen preparations; tissues impregnated with make-up removing preparations.*

Class 18: *Bags; toilet bags, not fitted; travelling bags; travelling sets (leatherware).*

[29] *L'Oreal v Bellure* and *Delta Air Lines, Inc v Marriot Worldwide Corporation* [2023] EWHC 283 (Ch)
[30] *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) *and Monster Energy Company v Red Bull GmbH* [2022] EWHC 2155 (Ch).

83. The application may proceed to registration for the following goods:

Class 18: *Backpacks for carrying infants; bags [envelopes, pouches] of leather, for packaging; bags for campers; bags for climbers; bags for sports; beach bags; briefcases; garment bags for travel; handbags; luggage tags/baggage tags; rucksacks/backpacks; school bags/school satchels; sling bags for carrying infants; slings for carrying infants; suitcase handles; suitcase packing organizers/luggage organizers; suitcases; suitcases with wheels; tool bags, empty; travelling trunks; trunks (luggage).*

Class 25: *Clothing; coats; dresses; dressing gowns; headbands [clothing]; headscarves/headscarfs; hoods [clothing]; jackets [clothing]; jumper dresses/pinafore dresses; knitwear [clothing]; leggings [leg warmers]/leg warmers; leggings [trousers]; petticoats; pyjamas/pajamas; ready-made clothing; ready-made linings [parts of clothing]; scarves/scarfs; shirts; short-sleeves shirts; stuff jackets [clothing]; suits; sweaters/jumpers [pullovers]/pullovers; tee-shirts; trousers/pants (am.); waistcoats/vests.*

Costs

84. The applicant has been a little more successful than the opponent, having retained more goods than it has lost. It is entitled to a contribution towards its costs, based upon the scale of costs published in Tribunal Practice Notice 1/2023, reduced by 30% to take into account the extent of the opponent's success. The amount for evidence is below the scale minimum because the applicant filed no evidence. The breakdown of the award of costs is as follows:

Considering the notice of opposition and preparing the counterstatement	£400
Considering the opponent's evidence	£300
30% reduction	-£210

Total	£490

85. I order JNTL Consumer Health I (Switzerland) GmbH to pay to Abdulwahed Bin Shabib Distribution the sum of £490. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of October 2025

Judi Pike
For the Registrar