

O-734-21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3528738

BY HMN24 LTD

TO REGISTER THE FOLLOWING TRADE MARK:

**Meta HMN**

IN CLASSES 5 AND 29

AND

OPPOSITION THERETO UNDER NO. 421942

BY CECIL LESLIE

## BACKGROUND AND PLEADINGS

1. On 1 September 2020, HMN24 LTD (“the applicant”) filed trade mark application number UK00003528738 for the mark **Meta HMN** (“the contested mark”). The application was accepted and published for opposition purposes on 30 October 2020, in respect of the following goods:

Class 5 Dairy and Plant Protein based (Whey, plant and collagen) powdered drink mix with added vitamins and minerals to be added to water or milk.

Class 29 Dairy and Plant Protein based (Whey, plant and collagen) powdered drink mix with added vitamins and minerals to be added to water or milk.

2. On 3 November 2020, Cecil Leslie (“the opponent”) filed an opposition against the application in full under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its oppositions based upon sections 5(2)(b) and 5(3), the opponent relies upon the following registrations:

(i) UK trade mark (“UKTM”) no. 3437264 (as a series of two)<sup>1</sup>

**metasuperfoods**

**meta-superfoods**

Filing date 17 October 2019

Registration date 17 January 2020

The opponent is relying on all the goods for which the UKTM is registered:

Class 3 Non-medicated preparations for the skin, scalp and body; shampoos; sanitary preparations for personal hygiene; cleaning, polishing, scouring and abrasive preparations for the skin, scalp

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<sup>1</sup> The opponent listed META SUPERFOODS as a third series in the mark, but this is not included in the registration.

and body; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 5 Nutritional dietary supplements; medicated soaps.

(ii) UKTM no. 3434853 (as a series of two)<sup>2</sup>

**metasuperfoods**

**meta-superfoods**

Filing date 8 October 2019

Registration date 17 January 2020

The opponent is relying on all the goods for which the UKTM is registered:

Class 29 Edible oils and fats; meat extracts, eggs, milk and milk products.

Class 30 Preserved, cooked, dried herbs and vegetables.

4. The marks relied upon by the opponent qualify as earlier marks. They were registered less than five years before the date of application for the contested mark and so they are not subject to the proof of use provisions in section 6A of the Act.

5. Under section 5(2)(b), the opponent claims that the marks at issue are identical or similar and that the respective goods are identical or similar, resulting in a likelihood of confusion.

6. Under section 5(3), the opponent claims a reputation in respect of all the goods for which its marks are registered. The opponent claims that use of the contested mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's marks.

7. The applicant filed a defence and counterstatement denying the grounds of opposition. Although the counterstatement is far from perfect, it seems palpably clear

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<sup>2</sup> As above.

to me that the applicant intended to defend the opposition in its entirety, and that is the basis on which I will proceed.

8. Only the opponent filed evidence. Neither party requested an oral hearing, nor did they file written submissions in lieu. The applicant is represented by Brandsmiths SL Limited;<sup>3</sup> the opponent represents itself.

## **PRELIMINARY ISSUE**

9. In its counterstatement, the applicant made the following submission:

“The opposition seeks to claim ownership and a monopoly over the word “META” in class 5 and 29.

This cannot be the case based on the simple fact that there are registrations incorporating the word “META” which predate the opposition mark in the same class as “metasuperfoods”, meta-superfoods and meta superfoods including but not limited to META DIET and META CARE, both of which cover the same products as the opposition mark. The registry allowed “metasuperfoods” to register without suggestion of confusion therefore the same rationale should follow for META HMN.”

10. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere

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<sup>3</sup> Prior to the filing of a Form TM33 in March 2021 the applicant was unrepresented.

fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

11. Accordingly, the state of the register is not evidence of how many of such trade marks are effectively used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks.

## **EVIDENCE**

12. The opponent filed evidence in the form of the witness statement of Cecil Leslie, the Director of MetaSuperfoods Ltd. The witness statement is accompanied by six exhibits (MS1 – MS6).

13. It is explained in the witness statement that the earlier marks have been used since October 2019 and, since December 2019, have been used on multiple websites in Europe and worldwide for a wide variety of supplements, health foods and nutrition related products.

14. Exhibit MS1 contains one undated screenshot from an unknown website. Three products sold by “Metasuperfoods” are visible, all of which are described as “Sea Moss and Bladderwrack” capsules. The prices of the products vary from £13.99 to £26.00 and were first available on 5 November 2019. The seller is ranked as number one in “Kelp Herbal Supplements”. The three products have a total of 739 four- and five-star reviews, but no purchases are evident from the exhibit.

15. Exhibit MS2 contains an undated advert on an unknown website. The advert shows “METASUPERFOODS Irish Sea Moss Gel” at a price of £9.98, with 134 four-

and five-star reviews. The witness statement explains adverts like this “regularly appear in national press and publications”.<sup>4</sup>

16. Exhibit MS3 is undated but is said to show the opponent’s goods available from November 2019 to November 2020.<sup>5</sup> There are eight images of products, the packaging of which shows “METASUPERFOOD” AND “METASUPERFOODS.COM”. The products include “SEA MOSS AND BLADDERWRACK” capsules and powder of varying weights; “DANDELION AND BURDOCK” capsules; and “Organic Turmeric...” capsules. Only four prices are noticeable, which vary from £14.49 to £44.99. There are no reviews or purchasing options visible.

17. Exhibit MS4 is described in the witness statement as an article which appeared in “national newspapers and magazines and online website platforms”.<sup>6</sup> The article appears to be in a printed newspaper, but it is not clear which. A date at the top of the article begins “2<sup>ND</sup> NOVE-“ but the remainder, including the year, is missing. The article shows the website WWW.METASUPERFOODS.COM and advertises sea moss and bladderwrack capsules and dandelion and burdock capsules. METASUPERFOODS is referred to as the “UK’S #1 SEA MOSS & BLADDERWRACK SUPPLEMENTS SUPPLIER”.

18. Exhibit MS5 contains a graph intended to evidence the opponent’s advertising spend between 1 January 2021 and 17 March 2021, which totals £23,743.51.

19. Exhibit MS6 is described in the witness statement as “a selection of invoices dated within the relevant period which show sales of goods under our trade mark.”<sup>7</sup> What is actually contained is a spreadsheet titled “MSF Income Sheet Q1 2020”. There are 23 invoices listed between January and March, presumably in the year 2020, given the file name. The income of the 23 invoices totals £429.79, but I cannot discern what the goods are.

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<sup>4</sup> Paragraph 2.

<sup>5</sup> Paragraph 3.

<sup>6</sup> Paragraph 4.

<sup>7</sup> Paragraph 6.

20. Turnover figures provided in the witness statement are £3,000 for the years 2019/2020 and £80,000 for the years 2020/2021.

21. That concludes my summary of the evidence, insofar as I consider it necessary.

## **DECISION**

### **Section 5(2)(b)**

22. Section 5(2)(b) of the Act states that:

“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.”

### **Relevant law**

23. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

24. 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.

### 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**

25. In *Gérard Meric v Office for Harmonisation in the Internal Market* (“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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

26. The applicant’s goods are essentially fortified powders to be added to water or milk to create a drink. To my mind, these fall within the scope of the opponent’s “nutritional dietary supplements”. The goods are identical in accordance with *Meric*.

## **The average consumer and the nature of the purchasing act**

27. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

28. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

29. 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. 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.”

30. The relevant goods are those for which I have found identity, which can all be considered as supplements, the average consumer of which is a member of the general public. The goods are likely to be purchased on a fairly regular basis and are, on the whole, inexpensive, though I bear in mind that prices will undoubtedly vary. Since the goods are intended to supplement a normal diet, the average consumer will consider factors such as the ingredients and the health benefits. I am of the view that a medium degree of attention will be paid to the purchase.

31. The goods are likely to be purchased by self-selection from the shelves of supermarkets or pharmacies or from the websites of such undertakings. Therefore,

visual considerations are likely to dominate the selection process. However, given that such goods may also be the subject of oral recommendations/advice, I do not discount an aural element to the purchase.

**Comparison of marks**

32. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

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

34. The trade marks to be compared are as follows:

Earlier marks	Contested mark
<p style="text-align: center;">metasuperfoods meta-superfoods</p>	<p style="text-align: center;">Meta HMN</p>

### Overall impression

35. The earlier marks consist of the word “metasuperfoods” in lower case in a standard font, with one mark in the series separating “meta” and “superfoods” with a hyphen. The marks are likely to be seen as the two words “meta” and “superfoods” conjoined; the overall impression of the marks lies in those two words, but since “superfoods” is allusive for the goods sold under the marks, it is “meta” which is the dominant element.

36. The contested mark consists of the words “Meta” in sentence case and the letters “HMN” in capital letters, both in a standard font. The overall impression of the mark lies in the two elements, which are equally dominant in the mark.

### Visual comparison

37. Visually, the similarity between the marks rests in the letters m-e-t-a. The fact that both marks contain multiple additional letters (the opponent’s 10 letters – “superfoods” and the applicant’s three letters – “HMN”) creates a visual difference, particularly that the contested mark is visually much shorter than the earlier marks. I consider there to be a low degree of visual similarity.

### Aural comparison

38. Despite “superfoods” being allusive for the goods, I consider the earlier marks will be articulated in their entirety – the five syllables forming metasuperfoods. The contested mark will be expressed as the word “meta” followed by the three letters “HMN”. I consider there to be a medium degree of aural similarity given the two identical syllables at the beginning of the marks.

### Conceptual comparison

39. The word “meta” is not an invented one, but used on its own is unlikely to have a clear meaning to consumers. However, it is often used as a prefix meaning to involve

change<sup>8</sup> and forms part of many common dictionary words, such as ‘metamorphic’ and ‘metabolic’. In the health industry and where supplements are concerned, use of the word “meta” may create an association in the mind of consumers with the words ‘metabolic’ or ‘metabolism’, which relate to the processes involved in turning food into energy.<sup>9</sup>

40. In the earlier marks where “meta” is combined with “superfoods”, the concept is likely to be foods or supplements intended to speed up the consumer’s metabolism. Although “superfoods” is likely to be seen as allusive, I bear in mind that the assessment of conceptual similarity requires considering the signs as a whole and disregarding the degree of distinctive character.<sup>10</sup> Where consumers do not make a link between “meta” and ‘metabolic’, the concept will be that of “superfoods” alone: foods with specific nutritional benefits.

41. For the contested mark, the addition to the word “meta” of the letters “HMN”, which have no meaning in relation to the goods, make the concept of the mark more ambiguous. Whilst some consumers may still connect “meta” with ‘metabolic’ or ‘metabolism’, I consider it more likely that no immediate concept will be grasped by consumers.

42. For those consumers who think of ‘metabolism’ when faced with “meta” in either mark, there will be a medium degree of conceptual similarity. For those who do not, the marks are conceptually dissimilar.

### **Distinctive character of the earlier marks**

43. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

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<sup>8</sup> [www.dictionary.cambridge.org/dictionary/english/meta](http://www.dictionary.cambridge.org/dictionary/english/meta)

<sup>9</sup> [www.dictionary.cambridge.org/dictionary/english/metabolism](http://www.dictionary.cambridge.org/dictionary/english/metabolism)

<sup>10</sup> See *Perfetti Van Melle Benelux BV v OHIM*, T-491/13, at paragraph 108.

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

45. I will begin by assessing the inherent distinctive character of the earlier marks. As I have previously mentioned, the word “meta” combined with “superfoods”, used on the opponent’s goods, is likely to be recognised as a reference to ‘metabolism’. Even when it is not, I do not consider it to be an invented word. “Superfoods” is allusive to some degree for the goods in the opponent’s specification. I find the earlier marks to be inherently distinctive to an average degree.

46. I turn now to the question of whether the distinctive character of the marks has been enhanced through use. The opponent's evidence is largely undated and the only evidence of sales is from a three-month period, showing a total income of just over £400. Whilst the witness statement refers to a turnover of £80,000 in 2020/2021, that narrative evidence is not supported by documentary evidence. There is also no mention of the market share of the opponent's goods. Overall, I do not consider the opponent's evidence to support a finding that the distinctive character of the earlier marks has been enhanced through use.

### **Likelihood of confusion**

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

48. I have found the marks to be visually similar to a low degree, aurally similar to a medium degree and either conceptually neutral or conceptually similar to a medium degree (depending on the consumer's understanding of "meta"). I have found the earlier marks to have an average degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will purchase the goods predominantly by visual means, though I do not discount an aural

element to the purchase. I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the goods to be identical.

49. Taking all of this into account, particularly the addition of the letters “HMN” in the contested mark, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other. I do not think it likely that the presence of the letters “HMN” will be overlooked by the average consumer and, consequently, do not consider there to be a likelihood of direct confusion. Despite its allusive nature, the same applies to the word “superfoods” in the earlier marks, which will not go unnoticed.

50. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>11</sup>

“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 recognised 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

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<sup>11</sup> BL O/375/10.



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).”

51. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>12</sup>

52. In order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will see in “Meta HMN” and “metasuperfoods” or “meta-superfoods” an element common between the marks, leading them to the conclusion that “meta” in the context of the contested mark means it is a brand of the owner of the earlier marks. Aurally, it is true that I found a medium degree of similarity between the marks, however, I have found that the purchasing process will be a primarily visual one and that the average consumer will notice the letters “HMN” in the contested mark and the word “superfoods” in the earlier marks. Even for consumers who do not see a clear meaning in “meta”, it is not such an uncommon word that consumers would consider only one undertaking would use it, neither are the additional elements in the marks logical with a re-branding or a brand extension. I do not envisage a scenario, either falling into one of the three categories listed above or otherwise, whereby consumers see the word “meta” in both marks and assume the undertakings are linked. Even for identical goods, I do not consider there to be a likelihood of indirect confusion.

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<sup>12</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82].

53. The opposition has failed under section 5(2)(b).

### **Section 5(3)**

54. Section 5(3) states that:

“5(3) A trade mark which -

(a) 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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

55. As noted above, the opponent’s marks qualify as earlier trade marks by virtue of their filing dates.

56. I bear in mind the relevant case law set out in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Addidas-Salomon, Case C-487/07, L’Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora*.

57. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the applicant’s mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that

the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the date of the application i.e. 1 September 2020.

## **Reputation**

58. 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 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.”

59. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take into account all of the evidence including the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment

made by the undertaking in promoting it. The earlier marks are UKTMs and the opponent must, therefore, establish a reputation in the UK.

60. I have summarised the opponent's evidence above and do not propose to reproduce it here. The opponent states that it spent £23,743.51 on advertising between 1 January 2021 and 17 March 2021. This is not an insignificant amount, but only covers a period of less than three months. The opponent states that turnover for the goods relied upon was £3,000 for the years 2019/2020 and £80,000 for 2020/2021 but has only evidenced sales of (unknown) goods during a three-month period, totalling approximately £400. This amounts to modest figures and a short duration of use. There is no evidence demonstrating where in the UK the goods were sold in order for me to understand the geographical extent of the use and no evidence as to the market share held by the trade marks. The evidence showing reviews of the opponent's goods is undated and does not indicate where those goods were available and on which website/s the reviews were left. An assessment of reputation is a multi-factorial one and taking all the factors together, I am not satisfied that the opponent has demonstrated a reputation in the UK.

61. The opposition based upon section 5(3) of the Act is dismissed.

## **CONCLUSION**

62. The opposition has failed in its entirety. The application will proceed to registration for all the goods applied for.

## **COSTS**

63. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. I assess these as follows:

Preparing a statement and considering the other side's statement	£200
Considering the other side's evidence	£200

**Total**

**£400**

64. I therefore order Cecil Leslie to pay HMN24 LTD the sum of £400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 5th day of October 2021**

**E VENABLES**

**For the Registrar**