

O/1108/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3564916

BY

BEAUTY BUDDY LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 3 and 4



AND OPPOSITION THERETO UNDER NUMBER 425982

BY

MIDHA LTD T/A ARORA

Background and Pleadings

1. On 7 December 2020, Beauty Buddy Ltd (“the Applicant”) applied to register in the UK, the trade mark numbered 3564916, as set out on the front cover page, for goods in classes 3 and 4. It was accepted and published in the Trade Marks Journal on 7 May 2021.

2. On 4 August 2021, Midha Ltd t/a ARORA (“the Opponent”) opposed the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under sections 5(2)(b) and 5(3) the Opponent relies on the following trade mark:

UKTM no. 2657252 (“the earlier mark”)

ARORA

Filed on 21/03/2013 and registered on 06/09/2013 for goods in class 3 namely *cosmetics, body and face creams, varnishes, moisturisers, skin creams, toners, serums, night cream, nourishing cream, oils for the body, oils for the skin, skin care cosmetics, sprays for use on the hair and body, cosmetics for personal use, cosmetics for treatment of dry skin, cosmetics for hair use, cosmetics for treatment of skin conditions, soaps, skin and body exfoliants, cosmetics for wrinkled skin, cosmetics in the form of lotions, gels and oils, essential oils, perfumes, essential oils for use in cosmetics, essential oils preparation of cosmetics, hair cosmetics (hair dyes), spa cosmetics, dentifrices; all being included in class 3.*

4. Under its section 5(2)(b) claim the Opponent contends that the respective goods are similar and the Applicant’s trade mark “ARORA is exactly the same as the earlier mark ARORA and the visual appearance is extremely similar in sound, visual, tone, font and usage causing extreme confusion across consumer products”.

5. Under its section 5(3) claim it pleads that it has been in operation since 1988 and has built a strong trusted brand with its core range of hair, body, wellness and skin care cosmetics as well as owning an award winning clinic in England. It claims to have spent hundreds of thousands of pounds on marketing its products during this time. As a result of this long standing use, it has become well-recognised by the relevant public and therefore use by the Applicant would create confusion with consumers believing

that the two entities are commercially connected or economically linked and that the Applicant's goods are provided by, endorsed by or otherwise connected to the Opponent. This it is claimed would result in the Applicant unfairly benefitting from the power of attraction, prestige and reputation that the Opponent's mark enjoys without it having made the associated investment themselves. Furthermore, it is claimed that the Opponent provides a range of high quality consumer products, focusing on natural essential oils and aromatherapy and that use by the Applicant of a similar sign would result in a real likelihood of detriment to the reputation of the earlier mark including a tarnishing of the earlier mark's image. This it is said would lead to the distinctive character of the earlier mark being diluted and weaken its capacity to distinguish the goods of the Opponent from those of third parties. This in turn would affect the economic behaviour of the relevant public, resulting in loss of sales to the Opponent seriously damaging its business.

6. Under section 5(4)(a) the Opponent relies on its unregistered sign ARORA which is said to have been used throughout the UK and online since 1988 for *cosmetics, beauty, consumer goods across the health, wellness, beauty industry using natural ingredients including aromatherapy, essential oils*. It is said that through its extensive use, the mark has built up substantial goodwill and reputation in the UK and that use of the Applicant's mark would result in damage, by consumers believing that the parties are economically linked. Consequently the Opponent would suffer a loss of business, by consumers purchasing the Applicant's goods in error, thinking they are the Opponent's and/or dilution and blurring of the Opponent's reputation.

7. The Applicant filed a defence and counterstatement denying each and every ground of opposition and putting the Opponent to strict proof of its claims.

8. The Opponent is represented by Serjeants LLP, whereas the Applicant is represented by Murgitroyd & Company. Only the Opponent filed evidence, accompanied by submissions during the evidence rounds. Neither party requested to be heard, however, the Applicant filed submissions in lieu of a hearing. This decision is, therefore, taken following a careful reading of all the papers.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks

Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Evidence

10. The Opponent's evidence consists of the witness statement of Mr Jatinder Midha dated 4 July 2022 accompanied by six exhibits marked JM1-JM6.

11. Mr Midha is the director of the Opponent, a position he has held since August 2002. Mr Midha provides the background to the Opponent and sets out that ARORA was established in 1988 as a business focused on beauty products and services based on natural ingredients and aromatherapy created by hair and beauty specialist Arora Singh. The purpose of his statement is to exhibit a number of documents said to demonstrate the use made of its earlier mark and the Opponent's reputation and goodwill. I will briefly summarise the relevant information below, returning to it in greater detail at the appropriate points later in my decision.

12. Exhibit JM1 consist of screenshots setting out the history of ARORA. It includes

- Magazine and newspaper articles and advertisements accompanied by photographs and promotional material dated at various dates from 1989.
- An undated copy of the company's business plan.
- Various invoices and bank statements.
- Confirmation letter of a mortgage offer to Mr G Singh, covering part borrowing of Baljit Arora Singh t/a Arora Hair Scalp and Beauty Clinic.
- Undated price lists.

13. Exhibit JM2 consists of documents showing the Opponent's Marketing spend and promotion of its mark and business. It is said that a "very small selection of invoices" are produced "across radio, print and digital" media which adds up to a large amount across different time periods, during 1997, 2003, 2001 and 2007. It is said that an average of £10,000 per annum has been spent over the years, adding up to at least £300,000.

- The Opponent produces various invoices, agreements and contracts with third party companies said to show promotion of its mark.

14. Exhibit JM3 consists of photographs of products and undated website screenshots as well as social media extracts. It is said that the Opponent's website is used to sell its products to the general public, consisting of "many different consumer cosmetic and wellness products across hair, skin and beauty, through mail order and online, which anyone can purchase globally".

15. Exhibit JM4 consists of undated photographs of various products bearing the earlier mark as well as an information leaflet regarding a hair growth oil as follows:



16. Undated Images are also produced of the products on display on shelves to include oils, creams and lotions.



17. Exhibit JM5 consist of details of the awards the Opponent has won and includes details of online reviews from customers. Copy of Award certificates are produced relating to ARORA where it is said that the mark is intrinsically linked to the clinic founder and the products. A select number of social media posts are produced.

18. Exhibit JM6 is said to include contact details of its manufacturers and partners. It is said that 'Arora works with many vendors for its products, across packaging, suppliers and designs'. A number of invoices are produced showing a selection of manufacturing contacts and the evolution of the products.

Submissions

19. Whilst the Opponent field submissions during the evidence rounds and the Applicant submissions in lieu of hearing, I do not propose to summarise them here. I have, however, taken each into account and shall refer to them as appropriate later in my decision.

Preliminary issues

20. When the Applicant filed its defence and counterstatement it questioned the identity of the Opponent as recorded and its ability to own a trade mark or bring an opposition. Following this being brought to its attention the Opponent applied to rectify its recorded name to Midha Ltd t/a ARORA which was accepted by the Registry and amended TM7 and TM8 forms were duly filed by the parties. I understand that no further issue was raised in relation to the name of the Opponent which now stands recorded as the correct legal entity.

Status of earlier mark and Proof of use requirements

21. The relevant date for the determination of each ground under sections 5(2)(b) and 5(3) is the filing date of the application, namely 7 December 2020.

22. Given its filing date the Opponent's trade mark qualifies as an earlier mark in accordance with section 6 of the Act. The Opponent claims that it has used its mark in relation to all the goods of its registration. This statement is made because the earlier mark completed its registration procedure more than five years before the date on which the application was filed. Consequently, it is subject to the proof of use provisions under section 6A of the Act, for which the Applicant put the Opponent to

proof. The relevant period for the assessment of genuine use is 8 December 2015 to 7 December 2020.

Proof of use

23. The relevant statutory provisions are set out in section 6A of the Act, which 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), (b) 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

[...]

(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.”

24. Section 100 of the Act states that:

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

25. What constitutes genuine use has been the subject of a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversammlung 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

Genuine Use

Assessment of the evidence

26. Whether the use shown is sufficient for this purpose, will depend on whether there has been real commercial exploitation of the trade mark, in the course of trade,

sufficient to create or maintain a market for the goods at issue during the relevant five-year period. In making the required assessment, I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them;
- e. The geographical extent of the use shown.

27. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not genuine use.¹

28. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having

¹ *Nike Innovate CV v Intermark Simanto (Jumpman)* O/222/16 Daniel Alexander QC (as he then was) sitting as the Appointed Person on appeal.

regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

29. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. (as he was then), as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or

her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

30. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

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

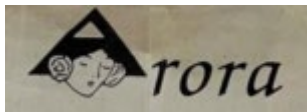
31. And furthermore:

“Any tribunal assessing this evidence would be bound to conclude, especially given the nature of the proprietor in question, the alleged importance of the mark and the fact that the proprietor was represented by legal advisors of repute that a diligent and careful search had been made for relevant documents proving use and this was the best that could be found.”

32. It is clear from the guidance that a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated from the evidence filed. The responsibility is on the appropriate party, in this case the Opponent, to provide sufficiently solid evidence to counter the application, a task which should be relatively easy to accomplish.² An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

Form of the Mark

33. Where the Opponent has used the earlier mark in the form in which it is registered, namely in its word only format, then clearly this will be use upon which the Opponent may rely. The Opponent's evidence, however, also includes the following variation of the mark, displayed on promotional leaflets and labels affixed to the products themselves.



34. Where an additional element is incorporated into a mark, it is settled caselaw that where that additional element does not alter the distinctive character of the mark, this is an acceptable variation.⁴ Despite the addition of the device incorporated within the design of the letter A, the letter is clearly visible and would enable consumers to clearly see the word as registered namely ARORA/Arora. The distinctiveness of the word would be unaffected by the device, which would not impair the mark's ability to indicate trade origin. I find that use of the mark in this form qualifies as acceptable use of the mark.

Genuine use

35. Moving on to the assessment of the evidence itself, from the outset there are difficulties with the Opponent's evidence. Mr Midha has not filed any evidence relating

² *Awareness Limited v Plymouth City Council*, Case BL O/236/13

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, GC Case T-415/09

⁴ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 at [31] to [35]

to turnover figures, nor details as to whether any products have been sold. Very little of the evidence in terms of the invoices, advertisements and promotional material are dated within the relevant five year period, the majority of which are dated in the decades before. Moreover, what has been produced appears to relate to the promotion and marketing of the clinic and the services it provides, rather than the goods themselves. There is no direct evidence of sales to customers of goods.

36. The screenshots of the Opponent's website feature photographs of some toiletries, such as creams, body lotions, hair care products, soaps and scrubs, bearing the mark being offered for sale, however, the screenshots are undated. The mere existence of a website and copies of screen shots in isolation, are of little value evidentially without any supporting information such as an indication as to how many customers viewed the website, over what period, how many products were sold via the website, the volume of custom generated as a result or the extent that the relevant consumer had been exposed to the mark by visiting the website. None of these details have been provided and the little evidence that has, is outside the relevant period.

37. Similarly the references to the domain name registrations held by the Opponent are of limited value since not only are they dated between 2002 and 2010, they, again, tell me nothing as to the extent consumers have visited the sites.

38. Some photographs and images of the Opponent's lotions, oils and creams are also displayed throughout the evidence said to show the use of the goods in situ within the Opponent's clinic, however for the most part I am unable to decipher the details of the labels and whether they refer to the mark as the images are too small. Also almost all are undated and therefore I am unable to determine with any degree of certainty whether they show use within the relevant period.

39. The social media references of the Opponent's Twitter and Instagram accounts under the handle "@arorabeauty" again are limited. Other than the existence of these accounts no details are produced as to any posts, the number of followers the Opponent has on each platform or how its customers interact with them in the form of likes for example.

40. In relation to the awards the Opponent has received, whilst two of these appear to be dated in 2019 and 2020 (within the relevant period) the Clinic Patient Service Awards appear to have been given to honour clinics that provide "outstanding care in

recognition of excellence of patient experience”. These awards not only appear to be industry/trade nominated awards but also they appear to have been given for the provision of services and bear no relevance to the goods. This is further reinforced by the customer reviews referred to. The verified reviews themselves (59 in total) are taken from the Opponent’s website and appear to be of some age dated between ‘four and nine years ago’. Whilst some reviews are dated during the relevant period, for the most part they generally relate to the services given by the beauticians and staff employed at the clinic, rather than for the products themselves. Where products are mentioned within the reviews, such as hair oil, no reference is made to the mark. I am unclear whether the Opponent only exclusively sells/uses its own branded products within the clinic, but if this is the case I have not been told and this is not borne out by the evidence.

41. The manufacturing and supply invoices, whilst voluminous, again are mostly dated years outside the relevant date and are for the supply of bottles and core ingredients rather than the finished products themselves. Those that are dated within the relevant period are in such small quantities that they appear to relate to products used internally by the salon rather than those sold to customers.⁵ The description of products ordered within the invoice dated April 2016, for example, refers to “1.00 200* 10ml bottle; 1.00 1 litre Rosemary and 1.00 1 litre Lavender 40/42” totalling £214. The invoice dated September 2016 appears to be an invoice for a comb, in the sum of £154.20. I accept that some of the invoices appear to be for the printing of bottle labels and leaflets where the quantity is in the thousands, however, the majority of these invoices are dated in 2002 and 2004 and are therefore irrelevant to establishing use within the relevant period.

42. I note that the Mr Midha states that the business runs a training school and teaches at the NHS and produces an invoice addressed to Midha Limited, ARORA ECLIPSE CLINIC rendered by The Leeds Teaching Hospitals for a balance of £411.25. However the invoice is dated 24 June 2008 and again no details are provided as to what the invoice was raised for. If it was for training services the Opponent is not relying on these.

⁵ 28 April 2016 and 6 September 2016

43. The invoices dated 1 February 2019 and 13 March 2019 are in relation to placing full page advertisements in the “Asian Express” for February and March 2019, but no details are provided as to how they appear in print or what is being advertised.

44. The Barclaycard statement dated in 2018 said to demonstrate use, is nothing more than a series of transactions (6 in total) occurring during May 2018. The statement account is under the name “ARORA ELLIPSE CLINIC” but no further explanation is given as to what the transactions relate to, whether they are for the sale of goods or the provision of services. Even if they were for goods, in isolation they are insufficient in quantity to demonstrate use over the total five year period given that there is no other corroborative evidence to show sales. I cannot take these transactions as indicative or illustrative of the level of sales over the requisite period without any other evidence.

45. One sales receipt is produced dated 28 June 2018 showing a list of goods purchased billed and shipped to BA Singh which appears to be the address of the clinic and relate to Mrs Bajinder Arora Singh, the founder. This receipt does not however demonstrate sales of the Opponent’s goods to third parties or ones onwardly sold to consumers, rather they appear to relate to goods used within the salon for the delivery of treatments, such as hairdressing and waxing. In any event, if I am wrong in this regard, there is no reference to the mark within the description of the goods.

46. The Applicant’s criticisms of the references within Mr Midha’s statement to a contract with Superdrug are justified. Given that Superdrug is a major nationwide retailer, were such a contract for the supply of toiletries and cosmetics to exist between the Opponent and Superdrug, then I would have expected order forms, contracts, licensing agreements and substantial turnover figures to have been produced indicative of a commercial partnership of this size. None have been produced. Furthermore, the screenshot of products offered for sale on Superdrug’s website show a different trade mark, which is not in keeping with those referenced by the Opponent in other parts of its evidence. I am not in a position to find with any degree of certainty, therefore, that a relationship exists between the two entities, since the Opponent has not sufficiently demonstrated that it does, by the filing of cogent evidence.

47. It is clear that the Opponent operates a beauty clinic located in and around Leeds/Bradford, offering beauty/cosmetic treatments and services. The difficulty is

that the use demonstrated for the specified goods is limited. What is produced, for the most part, is outside the relevant periods. I have no information in which to ascertain the value and volume of sales. The advertisements appearing in local newspapers/magazines and invoices to radio stations are of limited value given that other than a handful they are all for advertisements placed between 1989 and 2012. No circulation figures are provided or any indication of the readership numbers.

Conclusion

48. Even accounting for the fact that the assessment of genuine use must be a global assessment, taking account of the evidential picture as a whole and not whether each individual piece of evidence demonstrates use by itself, I cannot overlook the fact that the evidence of use is so old that it lacks any real value. No turnover figures or market share figures are provided. Little or no advertising figures within the relevant period are provided and certainly not running into the “hundreds of thousands” as claimed. It may be over the whole duration of the business from 1989 that it has engaged in advertising within the locality, running into thousands of pounds, but the evidence does not support Mr Midha’s claim of hundreds of thousands being expended. No sales figures or details relating to invoices to actual customers having purchased goods are produced, either in the relevant period or otherwise. The consumer of the goods in question are more likely the ordinary member of the general public and the market share in the cosmetic, beauty and toiletries industry is significant. Therefore even if some use could be argued as having been established, from the evidence filed, it is not on a scale that could be regarded as sufficient to meet the requisite standard even accepting that there is no de minimus rule. The scale of the orders of bottles and labels referred to within the evidence, are not significant and are at such low levels that it is impossible for me to infer that regular and consistent sales have been made.

49. The caselaw is clear; the onus is on the Opponent to file sufficiently solid evidence to demonstrate that it has sufficiently created or maintained a share in the market for the goods relied upon. I regard the absence of specific evidence within the relevant period as significant. Taking into account *Awareness Plymouth* and *Gucci*, I am not satisfied that the Opponent has discharged the burden placed upon it, of demonstrating genuine use of its mark, for the goods relied upon, even accepting the relatively low threshold as set out by the caselaw and taking the evidence as a whole.

50. The consequence of my finding of no genuine use, is that the Opponent cannot rely upon its earlier mark for the purposes of its sections 5(2)(b) or 5(3) claims and the opposition under these grounds fail at the first hurdle. Given that the threshold for establishing a reputation under section 5(3), in any event, is much higher than that for genuine use, in so far as the Opponent is required to demonstrate that the scale of use is such that the trademark has become known to a substantial part of the relevant public, as opposed to establishing a genuine commercial interest in the trade mark at large, without first of all establishing genuine use, it follows that the Opponent would also fail the reputation hurdle. The opposition under sections 5(2)(b) and 5(3) of the Act are dismissed accordingly.

Section 5(4)(a)

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

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

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

(aa) [...]

(b) [...]

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

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

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

53. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

54. Thus for a claim under section 5(4)(a) to succeed the Opponent must demonstrate goodwill, misrepresentation and damage.⁶ There is no suggestion within the pleadings that the Applicant has used its mark prior to the application and, therefore, for the purposes of establishing goodwill the relevant date is 7 December 2020. In order to succeed the Opponent must first of all demonstrate that it has goodwill attached to the goods and the sign associated to that goodwill is recognised as distinctive of its business for those goods, by the public. Once this has been established, the Opponent must then establish that there would be a misrepresentation to the public that the goods of the Applicant are those of the Opponent and that it suffers or is likely to suffer damage as a result. I shall consider first whether and to what extent the Opponent has attained goodwill.

Goodwill

55. Goodwill was described as follows in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

⁶ *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341, p. 406

56. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer* (a partnership) [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application* (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

57. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

58. It is well established that the law of passing off does not protect a trivial goodwill.⁷ However a small business which has more than a trivial goodwill can protect signs which are distinctive of that business, under the law of passing off, even though its goodwill and reputation may be small.⁸ From the outset, as I have already indicated, there are difficulties with the Opponent's evidence. Some evidence has been produced that appears to demonstrate it runs a small local business in and around Leeds/Bradford providing beauty and cosmetic services and that during the 90's and 2000's it promoted this business locally via various outlets, particularly through newspaper and radio advertisements. Being a small local business would not in itself have been fatal to its case, given that an earlier right in one area of the UK has been held to be sufficient to prevent an Applicant from acquiring a national mark.⁹ However, the Opponent does not rely on services, rather it relies upon the following goods:

cosmetics, beauty, consumer goods across the health, wellness, beauty industry using natural ingredients including aromatherapy, essential oils

59. The evidence in this regard is limited. It has not provided the type of evidence one would expect to satisfy the establishment of a protectable goodwill in a sign associated with these goods, even to a trivial extent. No evidence of sales, market share, turnover, number of units sold or actual customers is produced. The evidence that is produced goes back some decades and mostly relates to invoices and advertisements relating to the promotion of the clinic itself. It is necessary to demonstrate that there are customers or clients for the goods in question. Some customer reviews are produced, but these are taken from the Opponent's website and the screenshot is undated. Therefore since the reviews are dated 'four and nine years ago' it is difficult to give an accurate timeline as to when the reviews were given. More importantly the majority of the reviews are for the provision of services and the ones that relate to goods make no reference to the sign. The same can be said for the awards bestowed upon the business which are customer service satisfaction awards. The invoices from manufacturers and suppliers are limited and appear to focus on the purchase of stock for internal use for the provision of the beauty services, rather than the external sale

⁷ *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

⁸ *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 and *Stannard v Reay* [1967] FSR 140 (HC).

⁹ *Caspian Pizza Ltd v Shah* [2017] EWCA (Civ) 1874.

of goods to customers.¹⁰ Whilst a handful of invoices/letters are produced showing orders for bottle labels, label mock ups, bottles, caps and leaflets, they are either undated or dated between 2000 and 2011. Some of the letters produced are no more than quotations for the supply of bottles and labels rather than demonstrating actual orders placed. For those that appear to relate to actual orders, the quantities are so small and are of such an age, that by themselves they are insufficient for me to be able to assess without any other cogent evidence, the extent of the goodwill that has been built up in the sign, in relation to these goods.

60. The burden lies with the Opponent to demonstrate that it owned the goodwill in the sign relied upon which distinguishes its business in these goods, as at 7 December 2020. In my view, the Opponent has failed to file cogent evidence sufficient to establish that it has acquired a protectable goodwill in relation to the sign for the goods it relies upon, as at the relevant date. In absence of goodwill there can be no misrepresentation or damage, and therefore the opposition upon section 5(4)(a) also fails.

Conclusion

61. The opposition fails in its entirety. Subject to appeal, the application may proceed to registration for all its goods as applied for, as set out below:

Class 3: Soaps; Perfume; Perfume oils; Perfumery; Perfumery, essential oils; Perfumes; Cosmetics; Cosmetics and cosmetic preparations; Skincare preparations; Soap; Incense; Air fragrance reed diffusers; Air fragrancing preparations; Room fragrances; Room fragrancing preparations; Room fragrancing products; Room perfume sprays; Oils for perfumes and scents; Pot pourri; Toiletries.

Class 4: Candles; Candles in tins; Candles (Perfumed -); Aromatherapy fragrance candles; Fragranced candles; Illuminants; Perfumed candles; Scented candles; Table candles; Tea light candles; Votive candles.

Costs

62. As the Applicant has been successful, it is entitled to a contribution toward its costs. Award of costs are based on the scale as set out in Tribunal Practice Notice 2

¹⁰ Invoice dated 28 June 2018 addressed to BA Singh.

of 2016. I note that the Applicant applied for and agreed a security of costs award in the sum of £2000 and has asked me to make a costs award to the full amount of funds held, which it submits accurately reflects the costs incurred in the proceedings. Costs are, however, generally awarded on a contributory basis in proceedings before the Tribunal and in making the assessment I have taken into account the complexity of the case and the limited documents filed by the parties, which was ultimately determined on the cogency of the evidence filed by the Opponent. On this basis I consider that the award set out below, accurately reflects the work undertaken in accordance with the guidance:

Considering the notice of opposition and preparing a defence and counterstatement: ¹¹	£500
Considering the Opponent's evidence/ submissions and drafting submissions in lieu of hearing:	£700
Total	£1200

63. I order Midha Ltd T/A Arora to pay Beauty Buddy Ltd the sum of £1200 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 15th day of December 2022

Leisa Davies

For the Registrar

¹¹ I take into account that an amended TM7 and TM8 was required to be filed following the query regarding the Opponent's legal title and have awarded an uplift in costs to reflect the additional work.