

O-979-22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION 3392501
IN THE NAME OF VOILA PURE LIMITED FOR A SERIES OF FOUR
TRADE MARKS:

Voila pure

Voila Pure

Voilà pure

Voilà Pure

AND

AN APPLICATION FOR INVALIDATION UNDER NO 504113
BY BRAINWAVE MARKETING LIMITED

Background and pleadings

1. On 16 April 2019, Voila Pure Limited (the proprietor) applied for trademark 3392501 (a series of four trade marks) shown on the cover page of this decision. It was subsequently registered on 12 July 2019 for:¹

Class 3

Abrasive bands; Abrasive boards for use on fingernails; Abrasive cloth; Abrasive compounds; Abrasive emery paper; Abrasive emery paper for use on fingernails; Abrasive granules; Abrasive paper; Abrasive paper for use on the fingernails; Abrasive paper [sandpaper]; Abrasive paste; Abrasive preparations; Abrasive preparations for polishing; Abrasive preparations for use on the body; Abrasive preparations for vehicle care; Abrasive rolls; Abrasive sand; Abrasive sanding sponges; Abrasive sheets; Abrasive strips; Abrasives; Adhesive removers; Adhesives for affixing artificial eyelashes; Adhesives for affixing artificial fingernails; Adhesives for affixing false eyebrows; Adhesives for affixing false eyelashes; Adhesives for affixing false hair; Adhesives for affixing false nails; Adhesives for artificial nails; Adhesives for cosmetic purposes; Adhesives for cosmetic use; Adhesives for false eyelashes, hair and nails; Adhesives for fixing false nails; After shave lotions; After sun creams; After sun moisturisers; Aftershave; After-shave; Aftershave balm; Aftershave balms; After-shave balms; Aftershave creams; After-shave creams; Aftershave emulsions; After-shave emulsions; After-shave gel; Aftershave gels; Aftershave lotions; After-shave lotions; Aftershave milk; Aftershave moisturising cream; Aftershave preparations; After-shave preparations; Aftershaves; After-sun creams; After-sun lotions; After-sun lotions [for cosmetic use]; After-sun milk; After-sun milk [cosmetics]; After-sun milk for cosmetic use; After-sun milks; After-sun milks [cosmetics]; After-sun oils [cosmetics]; After-sun preparations for cosmetic use; Age retardant gel; Age retardant lotion; Age spot reducing creams; Agents for removing wax; Air

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

(Canned pressurized -) for cleaning and dusting purposes; Air fragrance preparations; Air fragrance reed diffusers; Air fragrancing preparations; Alcoholic solvents being cleaning preparations; Alkali (Volatile -) [ammonia] detergent; All-purpose cotton buds for personal use ;Almond milk for cosmetic purposes; Almond oil; Almond soap; Almond soaps; Aloe soap; Aloe soaps; Aloe vera gel for cosmetic purposes; Aloe vera preparations for cosmetic purposes; Alum blocks for shaving; Alum stones [astringents];Amber [perfume];Ambergris; Amla oil for cosmetic purposes; Ammonia for cleaning purposes; Ammonia [volatile alkali] [detergent];Ammonia [volatile alkali] detergent; Animal grooming preparations; Anti-ageing creams; Anti-ageing creams [for cosmetic use];Anti-ageing moisturiser; Anti-ageing serum; Anti-aging cream; Anti-aging creams; Anti-aging creams [for cosmetic use];Anti-aging moisturizers.

2. BrainWave Marketing Limited (the applicant) seeks invalidation of the registration under the provisions of section 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under section 5(3) of the Act. The applicant relies on the following trade mark:

Mark details and relevant dates	Goods relied upon
<p>TM: 3276324</p> <p>ViolaSkin</p> <p>Filed: 11 December 2017 Registered: 16 March 2018</p>	<p>Class 3</p> <p>Abraders; Abrasive bands; Abrasive boards for use on fingernails; Abrasive cloth; Abrasive compounds; Abrasive emery paper; Abrasive emery paper for use on fingernails; Abrasive granules; Abrasive paper; Abrasive paper for use on the fingernails; Abrasive paper [sandpaper];Abrasive paste; Abrasive preparations; Abrasive preparations for polishing; Abrasive preparations for use on the body; Abrasive preparations for vehicle care; Abrasive rolls; Abrasive sand; Abrasive sanding sponges; Abrasive sheets; Abrasive strips; Abrasives; Adhesive removers;</p>

	<p>Adhesives for affixing artificial eyelashes; Adhesives for affixing artificial fingernails; Adhesives for affixing false eyebrows; Adhesives for affixing false eyelashes; Adhesives for affixing false hair; Adhesives for artificial nails; Adhesives for cosmetic purposes; Adhesives for cosmetic use; Adhesives for false eyelashes, hair and nails; Adhesives for fixing false nails; After shave lotions; After sun creams; After sun moisturisers; Aftershave; After-shave; Aftershave balm; Aftershave balms; After-shave balms; Aftershave creams; After-shave creams; Aftershave emulsions; After-shave emulsions; After-shave gel; Aftershave gels; After-shave lotions; Aftershave milk; Aftershave moisturising cream; Aftershave preparations; After-shave preparations; Aftershaves; After-sun creams; After-sun lotions; After-sun lotions [for cosmetic use]; After-sun milk; After-sun milk [cosmetics]; After-sun milk for cosmetic use; After-sun milks; After-sun milks [cosmetics]; After-sun oils [cosmetics]; After-sun preparations for cosmetic use; Age retardant gel; Age retardant lotion; Age spot reducing creams; Agents for removing wax; Air (Canned pressurized -) for cleaning and dusting purposes; Air fragrance preparations; Air fragrance reed diffusers; Air fragrancing preparations; Alcoholic solvents being cleaning preparations; Alkali (Volatile -) [ammonia] detergent; All-purpose cotton buds for personal use; Almond milk for cosmetic purposes; Almond oil; Almond soap; Almond soaps; Aloe soap; Aloe vera gel for cosmetic purposes; Aloe vera preparations for cosmetic purposes; Alum stones [astringents]; Amber [perfume]; Ambergris; Ammonia for cleaning purposes; Ammonia [volatile alkali] [detergent]; Ammonia [volatile alkali] detergent; Animal grooming preparations; Anti-ageing creams; Anti-ageing creams [for cosmetic use]; Anti-ageing moisturiser; Anti-ageing serum; Anti-aging cream; Anti-aging creams; Anti-aging creams [for cosmetic use]; Anti-aging moisturizers; Anti-aging moisturizers used</p>
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	<p>as cosmetics; Anti-aging skincare preparations; Anti-freckle creams; Anti-perspirant deodorants; Cosmetics; Cosmetics all for sale in kit form; Cosmetics and cosmetic preparations; Cosmetics containing hyaluronic acid; Cosmetics containing keratin; Cosmetics containing panthenol; Cosmetics for animals; Cosmetics for children; Cosmetics for eye-brows; Cosmetics for eye-lashes; Cosmetics for personal use; Cosmetics for protecting the skin from sunburn; Cosmetics for suntanning; Cosmetics for the treatment of dry skin; Cosmetics for the use on the hair; Cosmetics for use in the treatment of wrinkled skin; Cosmetics for use on the skin; Cosmetics in the form of creams; Cosmetics in the form of eye shadow; Cosmetics in the form of gels; Cosmetics in the form of lotions; Cosmetics in the form of milks; Cosmetics in the form of oils; Cosmetics in the form of powders; Cosmetics in the form of rouge; Cosmetics preparations; After-sun milk [cosmetics];After-sun milks [cosmetics];After-sun oils [cosmetics];Anti-aging moisturizers used as cosmetics; Bath powder [cosmetics];Beauty care cosmetics; Body and facial creams [cosmetics];Body and facial gels [cosmetics];Body care cosmetics; Body creams [cosmetics];Body gels [cosmetics];Cleaning pads impregnated with cosmetics; Colour cosmetics; Colour cosmetics for the eyes; Colour cosmetics for the skin; Decorative cosmetics; Eye cosmetics; Eyebrow cosmetics; Facial creams [cosmetics];Facial gels [cosmetics];Facial wipes impregnated with cosmetics; Fluid creams [cosmetics];Functional cosmetics; Glitter in spray form for use as a cosmetics; Hair cosmetics.</p>
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3. In summary the grounds are that the proprietor's use of its mark for goods identical or related to the applicant's goods in class 3 will take unfair advantage of the applicant's reputation in its Viola Skin trade mark.

4. The proprietor filed a counterstatement denying the grounds raised by the applicant.

5. Both parties filed evidence and a skeleton argument. A hearing took place by video conference at which the proprietor was represented by Michelle Ward, of Indelible IP. The applicant was represented by Mr Osman Ali of the applicant.

6. I make this decision having taken full account of all the papers before me and the submissions made by both parties at the hearing.

7. 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.

The registered proprietor's evidence

8. This is provided by Graham Bowers, a founder of the proprietor and Michelle Ward, of the proprietor's representative. Their evidence includes prints from the UK trade mark register, dictionary definitions and prints from Amazon UK. For reasons that will become apparent, I do not intend to consider this evidence any further.

The applicant's evidence

9. The applicant's evidence is provided by two witness statements by Ehsaan Ali, the manager of the applicant. His first statement is dated 11 March 2022 and has five exhibits attached (EX1-EX5). The second is dated 24 August 2022 and has eight exhibits attached (EA1-EA8). I will return to this evidence later in this decision.

DECISION

10. Section 5(3) of the Act states:

“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”.

11. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (CJEU): Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. 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; *General 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) 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*.

(g) 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*.

(h) 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 on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) 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*.

12. In *General Motors*,² the CJEU held that:

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

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

13. The applicant relies upon its UK trade mark, ‘Viola Skin’.

14. The conditions of section 5(3) are cumulative. First, the applicant must satisfy me that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must establish 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 mark(s) 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 three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar although the

² Case C-375/97

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 applicant's evidence

15. For the sake of clarity, when I refer to Mr Ali in the remainder of this decision, I refer to the filer of the applicant's evidence, Mr Ehsaan Ali. The applicant's representative at the hearing before me was Mr Osman Ali, to whom I will refer by his full name.

16. Much of the applicant's evidence relates to matters outside the applicant's reputation and before dealing with the substantive issues I will, briefly, explain why much of what has been filed is not helpful to the decision I have to make in this case.

White label goods

17. The proprietor made reference to the applicant's product being a white label product.³ The applicant replied and filed evidence on that point. The section 5(3) ground claimed by the applicant requires it to show evidence that it has sold goods in class 3 under its trade mark relied on, to a sufficient degree to establish its reputation. Whether or not and to what extent the applicant manufactures the product it sells under its brand is not relevant and I will say no more about this evidence.

Plagiarism/copying

18. Mr Ali provides several prints from Amazon UK which he states show that the proprietor has copied the applicant's description and packaging for its product. He also provides prints showing the applicant's product description appeared on Amazon more than two years before the proprietor's product description. The applicant claims the proprietor knew of the applicant and is copying its brand. The applicant has not made any claim to copyright (under section 5(4)(b) of the Act) nor has it claimed that the proprietor has acted in bad faith (under section 3(6) of the Act) and I will not consider this evidence further.

³ A product manufactured by one undertaking and packaged and sold by other undertakings under other brand names.

Search result prints from Amazon

19. Mr Ali's evidence is taken entirely from Amazon UK. I will refer to other parts of that evidence shortly, but with regard to search results returned showing both parties' goods in a returned list of goods,⁴ I do not find the evidence helpful. Mr Ali is one of the parties involved in this dispute. He has, no doubt, also searched for the registered proprietor's goods on a number of occasions. Search results that he has returned which show both sides' goods high in the list of results are, due to the search algorithms used, unsurprising. Mr Ali's personal search algorithm is highly unlikely to be the same as that of a member of the relevant public and I do not find this evidence helpful. I will say no more about this evidence.

Evidence of reputation

20. In support of its claim to a reputation, the applicant provides a screen shot which it states is taken from Amazon UK. It is presented on a plain white, undated page and looks to be a written description of a product, which is not shown. The product to which the page relates is described as a 'serum', the brand and manufacturer is identified as, 'ViolaSkin' and the date the product was first available is 11 May 2017.⁵ A 'Best sellers rank' appears in this exhibit which shows the applicant's face serum product to be '412 in beauty No 1 in face night cream serums & fluids and 8 in face serums'.

21. The applicant also provides a screenshot from Amazon UK which shows the applicant's ViolaSkin product has 4.2 out of 5 stars from 12,603 reviews.⁶ This has been cut from an Amazon page and presented on a plain white page which is not dated.

⁴ See exhibits EX2 and EX3.

⁵ See exhibit EX1.

⁶ See exhibit EX4.

22. At the hearing Mr Osman Ali drew my attention to the number of reviews received by the applicant and its ranking on Amazon marketplace. He was keen to point out that only a product with a high reputation would attract so many reviews.⁷

23. Mr Ali provides prints from Amazon UK (undated) which show the date the applicant's Viola Skin serum was first available on Amazon and concludes that the applicant's product was available 1 year, 11 months and 5 days before the proprietor filed its registration.

24. Mr Ali has provided cropped screenshots from the applicant's Instagram and Facebook front pages, to show the number of followers it has.⁸ These are taken from the top of a social media page and do not include any posts by the applicant or its followers.

25. The evidence I refer to in paragraphs 20-24 is the sum total of material that could be said to relate to the applicant's claim to reputation, and I do not find any of it helpful in showing the applicant to have the necessary reputation. I will explain why.

26. Whilst it may well be the case that the applicant has a large number of reviews on Amazon and is highly ranked in a number of categories, the exhibits are not dated via an archive service and were likely printed in preparation for the applicant's witness statement which was signed in March 2022. The relevant date for these proceedings (by which the applicant must show its reputation existed in its class 3 goods) is 16 April 2019 – almost three years before these screenshots were likely printed. Accordingly, I have no idea what the position was at the relevant date.

27. Furthermore, a page showing a number of reviews, even a fairly high number, does nothing to assist me in assessing the level of custom for the applicant's goods. This is especially so when I cannot see the goods to which the reviews relate, and no actual

⁷ Mr Ali gave additional oral submission regarding the percentage of customers on Amazon who leave reviews. As I explained at the hearing, this information is new and was not contained in the applicant's evidence, so I will not give it consideration.

⁸ See exhibits EX5, EA7 and EA8.

reviews have been provided. I have no indication of where customers are based, when products were purchased, or which products were purchased.

28. The prints from social media pages have not been provided via an archive site and do not include any posts which are dated, within the exhibits provided. They do not show any products, comments, marketing or promotional posts. These pages were printed considerably later than the relevant date of 16 April 2019⁹ and Mr Ali states that they relate to the applicant's followers worldwide. No products are shown, there is no evidence of sales made to customers or marketing of the applicant's goods and I cannot conclude the proportion of relevant consumers in the UK.

29. The applicant's witness and its representative at the hearing were both keen to point out the applicant's international sales and international customer base. This means that it is highly likely that the purchases contributing to the applicant's overall product rankings, product reviews and the followers on its social media platforms are highly likely to include consumers outside the UK and, without further explanation, I cannot be sure to what extent that is the case.

30. Finally, I note that the prints taken from the applicant's Amazon page relate only to a vitamin C face serum, for which I cannot conclude the level of sales at the relevant date or the number of UK customers. There is no evidence at all relating to any other goods in class 3.

31. As outlined above, for an invalidation under section 5(3) to get off the ground it is first necessary for the applicant to show that it has the necessary reputation. I must be satisfied that the ViolaSkin trade mark for which protection is sought is known by a significant part of the relevant public, in this case consumers of goods in class 3.

32. I have some sympathy with the applicant who has a business and clearly believes that it has a reputation for the sale of goods in class 3 under its trade mark. Unfortunately, it has been unable to discharge the burden upon it to file evidence to

⁹ In the case of evidence attached to the applicant's second statement, the pages were printed in August 2022 just before the date of Mr Ali's second statement, as confirmed in that statement.

show me that this is in fact the case. I find that the application fails at the first hurdle for want of evidence to show the necessary reputation.

CONCLUSION

33. The invalidation fails under sections 47(2)(a) and 5(3) of the Act.

COSTS

34. The proprietor has been successful and is entitled to a contribution towards its costs. Awards of costs in tribunal proceedings are governed by Tribunal Practice Notice 2 of 2016. I bear in mind that the applicant's evidence was not extensive, and the proprietor's evidence was largely unnecessary. I award costs as follows:

Considering the other side's statement and preparing and filing a counterstatement:	£200
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Considering and commenting on the other side's evidence:	£300
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35. I therefore order BrainWave Marketing Limited to pay Voila Pure Limited the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of November 2022

**Al Skilton
For the Registrar,
The Comptroller-General**