O/0643/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004022088

BY TURKUAZ SAGLIK HİZMETLERİ MEDİKAL TEMİZLİK KİMYASAL

ÜRÜNLER SAN. VE TİC. A.Ş.

TO REGISTER THE TRADE MARK:

KLY

IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 448126

BY RECKITT BENCKISER HEALTH LIMITED

BACKGROUND AND PLEADINGS

1. On 5 March 2024, TURKUAZ SAGLIK HİZMETLERİ MEDİKAL TEMİZLİK KİMYASAL ÜRÜNLER SAN. VE TİC. A.Ş. ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 22 March 2024. The applicant seeks registration for the following goods under the above application:

Class 5 Personal and surgical lubricating jelly.

2. The application was fully opposed by Reckitt Benckiser Health Limited ("the opponent") on 19 June 2024 based upon sections 5(2)(b), 5(3) and 3(6) of the Trade Marks Act ("the Act").

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following marks:

K-Y

UK registration no. UK00002251501
Filing date 6 November 2000; Registration date 27 April 2001.
("The First Earlier Mark")

K-Y

Comparable UK trade mark (EU) registration no. UK00913771456
Filing date 25 February 2015; Registration date 11 June 2015.
(the Second Earlier Mark)

Comparable UK trade mark (EU) registration no. UK00908153355

Filing date 12 March 2009; Registration date 8 March 2010.
(the Third Earlier Mark)

4. I bear in mind that the Second and Third Earlier Marks are comparable (EU) marks. Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

5. Under section 5(2)(b), the opponent relies upon the goods contained in Annex 1 to this decision. The opponent claims that there is a likelihood of confusion because the marks are highly similar and the goods are identical or highly similar.

6. Under section 5(3), the opponent relies upon the goods contained in Annex 1 to this decision. The opponent claims that its marks are "highly reputable" due to their many years of use, and "in the event that consumers are confused or otherwise perceive a link between" the parties' marks, "it is submitted that this would take unfair advantage of" the opponent's reputation. The opponent also claims that if the applicant were to provide "substandard goods" this would be detrimental to the opponent's reputation and it could "devalue the image/reputation" that the earlier marks have acquired amongst the relevant public. The opponent claims that the distinctiveness of the earlier marks could be "detrimentally affected", since the relevant public could cease to associate their use with the goods originating from a single source, and the "later mark would undoubtedly dilute the distinctive character" of the opponent's reputable marks.

7. Under section 3(6), the opponent claims that the application was filed with "dishonest intentions, seeking to imitate the highly reputable K-Y brand, as closely as possible" to benefit from its attractiveness and the applicant is "seeking to freeride upon the reputation of the K-Y brand, for its own benefit". The opponent also claims that this application is "the latest in a long line of malicious actions by the applicant", as there is a "history of disputes" between the parties in the UK. They claim that the applicant has been aware of its earlier mark and other registrations "for almost "15

years”, and the applicant has previously sought to register the “KLY” mark in 2009. In related EUIPO proceedings, the opponent filed “a significant amount of evidence” to demonstrate its reputation and share of the market in the UK, and therefore the opponent claims that the applicant “has greater knowledge as to the full extent [of the] earlier registrations reputation”, and they know “precisely how valuable the K-Y brand is and the damage that their activities will cause in the UK”.

8. The applicant filed a counterstatement denying all of the claims made and put the opponent to proof of use.

9. The opponent is represented by Potter Clarkson LLP and the applicant is represented by RevoMark. The opponent filed evidence in chief. Neither party requested a hearing, however, the opponent filed submissions in lieu. I make this decision having taken full account of all the papers and evidence, and I will refer to them where necessary below.

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

EVIDENCE

11. The opponent’s evidence consists of the witness statement of Laurissa Abdull dated 23 October 2024. Ms Abdull has been in the employment of Reckitt Benckiser Corporate Services Limited since 2019, which is part of the Reckitt group of companies. The opponent is also a part of the Reckitt group of companies. Ms Abdull’s statement is accompanied by 13 exhibits (LA01-LA13).

12. Whilst I do not propose to summarise it here, I have taken all of the evidence into consideration in reaching my decision and will refer to them where necessary below.

DECISION

<u>Section 5(2)(b)</u>

13. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> > (a)…
> >
> > (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."

14. The opponent's marks qualify as earlier marks in accordance with section 6(1)(a) and (aa) of the Act as their filing dates are earlier than the filing date of the applicant's mark. As the opponent's marks have completed their registration process more than five years before the filing date of the mark in issue, they are subject to proof of use pursuant to section 6A of the Act.

Proof of use

15. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant statutory provisions are as follows:

16. Section 6A of the Act states:

> "(1) This section applies where
>
> > (a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five years ending on the filing date of the applicant's mark, i.e. 6 March 2019 to 5 March 2024. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use of the Second and Third Earlier Comparable Marks within the EU is relevant for the part of the period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant. For the First Earlier Mark, only use in the UK is relevant.

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

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

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

Evidence of use

19. At paragraph 9 of her witness statement, Ms Abdull confirms that the opponent acquired the majority of the assets relating to the K-Y brand from Johnson & Johnson in 2014.[1] However, due to concerns raised by the UK Competition and Markets

[1] This is confirmed by paragraph 5 of the report contained in **exhibit LA03**, which states that on 10 March 2014, the parties entered into an Asset Purchase Agreement, whereby Johnson and Johnson agreed to sell the rights, liabilities and assets relating to the K-Y brand globally.

Authority, they made a subsequent investigation into the acquisition, and published a report, dated 12 August 2015, which is enclosed at **exhibit LA03**. It refers to the "anticipated acquisition by Reckitt Benckiser Group plc of the K-Y brand in the UK", which as per paragraph 9 of Ms Adbull's statement, is the parent company of the opponent. The report allowed the acquisition to proceed on the condition that the K-Y brand be licenced to a third party for eight years. At paragraph 11 of her witness statement, Ms Abdull confirms that Reckitt Benckiser (Brands) Limited, also part of the Reckitt group of companies, entered into a licence with Thornton & Ross Limited on 6 June 2016. A redacted copy of this agreement is contained within **exhibit LA04**, which gives Thornton & Ross Limited exclusive use to use the K-Y mark in the UK, and states that all goodwill associated with the use of the brand will vest with Reckitt Benckiser (Brands) Limited (as per clause 9.1). I also note that schedule 1 lists the First and Third Earlier Marks as being covered by the agreement.

20. The report also mandated a year "black out period", that being a short break where neither the licensee or Reckitt Benckiser (Brands) Limited were permitted to market, sell or distribute K-Y branded products. This is confirmed by the witness statement of Mr James Collett, the UK Chief Financial Officer of Thornton & Ross Limited, which is contained in **exhibit LA06**. In this statement, which is dated 25 September 2024, Mr Collett provides the below sales figures made from K-Y branded products, with the 2023 sales figure followed by the wording "6 months to the start of the blackout period". The same sales table is provided at paragraph 15 of Ms Abdull's statement, in which next to the 2023 sales figure is the wording "6 months to June 2023". On this basis, I find that the blackout period would have started in June 2023.

21. As noted above, Thornton & Ross Limited (and Ms Abdull) has provided the following sales figures made by the licensee from K-Y branded products during the relevant period:

Year	**Sales value**
2019	£2.1m
2020	£1.9m
2021	£2.0m
2022	£2.0m
2023	£0.9m

22. At paragraph 18 of her statement, Ms Abdull confirms that K-Y branded goods were “available from the majority (if not all) [of] the leading UK grocery retailers (including Asda, Tesco, Sainsburys and Waitrose). Further, the goods were also available from Boots and Superdrug and from online specialist online shops (e.g. lovehoney.co.uk)”.

23. To support the above, Ms Abdull has provided screenshots in **exhibit LA07** showing “KY Jelly”, “KY Jelly Personal Lubricant” or “KY Jelly Water-Based Lubricant”[2] goods for sale on third party retailer websites including Boots, Waitrose and lovehoney. The screenshots are dated between 14 October 2019 to 18 May 2023, and show the following packaging being used on the lubricant goods:

24. The above packaging on the left matches the packaging contained in Schedule 3 of the “K-Y brand guidelines” contained in the agreement exhibited in **LA04**, which clearly includes the description that the goods “alleviate vaginal dryness” and “K-Y helps ensure lubrication in order to help comfort during sex”.

25. **Exhibit LA08** has been filed to show that K-Y goods have been available for sale on Amazon.co.uk throughout the relevant period. I note the following from this exhibit:

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[2] **Exhibit LA07**. I also note that there are undated screenshots contained within this exhibit from retailers such as Sainsburys, Tesco, ASDA and Superdrug. The Tesco screenshot nevertheless shows reviews from August and June 2022 giving the product 5 stars. The Sainsbury’s screenshot also contains a 5 star review from December 2021 of K-Y Brand Jelly personal Lubricant.

a) “KY Jelly Lubricant” has been available for sale since 31 July 2014.
b) “K-Y Liquid”, that being their “classic water-based personal lubricant”, has been available for sale since 6 March 2012.
c) “KY Jelly Personal Lubricant – Large 82 grams” has been available for sale since 14 November 2006. This screenshot is accompanied by multiple printouts of UK reviews dated between 8 February 2022 to February 2024.

26. I note that within the description of the above third party retailer websites, the opponent’s goods are detailed as follows:

- “lubricants and gels are a must have for your smoothest sex yet. Not just for dryness, sex lubrication products […] help you reach new levels of pleasure.”

- “Personal lubricant. To alleviate vaginal dryness. […] K-Y helps ensure lubrication in order to help comfort during sex by complementing personal moisture.”

- “K-Y Brand Natural Feeling Liquid Personal Lubricant is designed to feel natural and contains gentle ingredients that bring comfort and pleasure to your most intimate moments. […] Apply desired amount of lubricant to your intimate areas. […] may be applied to outside of condom surface to help reduce irritation caused by vaginal dryness.”

27. Ms Abdull has also provided the following sales made in the EU for its K-Y branded goods:

Year	**Sales value**
2019	£4.1m
2020	£4.1m
2021	£4.5m
2022	£4.5m

28. I bear in mind that only the sales made in 2019 and 2020 are relevant in relation to its Second and Third Earlier Marks (as these fall before IP Completion Day).

29. I have also been provided with screenshots from EU retailers (namely in France, Belgium, Germany, Italy and Spain) selling K-Y branded lubricants.[3] The goods are clearly being sold on Amazon, Farmaline, bol and dosfarma. Whilst the screenshots themselves are dated after the relevant period, there are customer reviews that are dated between 3 June 2014 to 9 November 2020. Ms Abdull has also provided EU "Reckitt Benckiser" invoices in **exhibit LA10**.[4] These invoices are dated between 16 July 2019 to 3 November 2020, and clearly show the sale of "KY Jelly Sterile", "KY DE JELLY", "KY FI JELLY", "KY Sterile", "Sensilube KY", "K-Y Gel Lubrificante", "Sensilube KY" Gel". Ms Abdull confirms that these sales were made to France, Finland, Sweden, Netherlands, Portugal and Spain.

<u>Form of the mark</u>

30. The evidence I have outlined above shows the following variants of the opponent's marks:

a) KY Jelly
b) KY Jelly Personal Lubricant
c) KY Jelly Water-Based Lubricant
d)
e)

31. The First and Second Earlier Marks consist of the letters "K" and "Y" connected by a hyphen. I note that the "KY" element in variants 1 to 3 above do not include a hyphen. However, the removal of this element does not change the conceptual nature of the mark, and I find that it therefore does not alter its distinctive character, which resides in the letters "K" and "Y" which are clearly visible and still continues to indicate origin.[5]

[3] **Exhibit LA09**
[4] The invoices are headed as being from: RECKITT BENCKISER HEALTHCARE FRANCE, Reckitt Benckiser Healthcare BV, Reckitt Benckiser Healthcare Lda and Reckitt Benckiser Healthcare S.A.
[5] *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

I note that the additional wording “Jelly”, “Jelly Personal Lubricant” and “Jelly Water-Based Lubricant” is descriptive of the goods nature and use, and therefore again does not alter the distinctive character of the marks. On this basis, variants 1 to 3 are acceptable use of the First and Second Earlier Marks.

32. The Third Earlier Mark consists of the letters “K” and “Y” presented in a standard capitalised typeface, with a diamond shape in between. I note that all of these elements are presented in variants 4 and 5 above.

33. In variant 4, the letters are presented in dark blue, with the diamond presented in red. I find that the use of these colours does not alter the distinctive character of the Third Earlier Mark on the basis that it is not a complex colour arrangement.[6] The distinctive character which resides in the use of the letters “K” and “Y” are presented in the same dark blue colour. I therefore find that variant 4 is acceptable use of this mark. Variant 5 includes the descriptive word “JELLY” presented in light blue. This element also does not alter the distinctive character of the Third Earlier Mark on the basis that it is descriptive of the goods. On this basis, I also find it to be acceptable use of this mark.

34. I will now consider whether the evidence shows that the earlier marks have been genuinely used. 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.[7] As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded 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”.

35. I bear in mind that the opponent made the following observations in its submissions in lieu:

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[6] *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290
[7] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

> "the Applicant did not file any reply evidence.
>
> This means that the Applicant has not denied any of the evidence filed by the Opponent, and has failed to file any evidence that might otherwise counter, contradict or otherwise challenge the Opponent's evidence.
>
> It is submitted that the Registrar should treat the Opponent's evidence as having been admitted by the Applicant or at least taken at face value, in the absence of any reason to undermine its weight or relevance."

36. Indeed, the applicant has not filed any evidence or submissions in reply to the opponent's evidence, which was filed to show that the earlier marks have been used within the relevant period. On this basis, I accept that the applicant has not challenged the validity of it. The opponent's evidence shows that its sister company entered a licencing agreement from 2016 to 2023, whereby its licensee made notable UK sales made from 2019 to 2023, which amounted to £8.9 million. This has been supported with examples of the goods sold on UK third party retailer websites, all of which show that the goods sold during the relevant period were personal lubricants. I have also been provided with EU sales from 2019 and 2020, which amounts to £8.2 million. Alongside these sales, I have been provided with screenshots showing customer reviews from 2019 and 2020 on EU third party retailers selling lubricants using the opponent's marks. Therefore, taking all of the above into account, I am also satisfied that the opponent has shown genuine use of the earlier marks within the relevant period (and that the applicant does not contend this).

<u>Fair Specification</u>

37. I must now consider whether, or the extent to which, the evidence shows use of the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there

has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

38. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

> "244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.
>
> 245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.
>
> 249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

39. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

40. The First Earlier Mark is registered for class 4 "lubricants" and class 5 "vaginal lubricants". I bear in mind that class 4 mainly includes industrial oils and greases, fuels and illuminates. On this basis, I find that "lubricants" in this class would only encompass those not for personal use, whereas the evidence of use above only shows use of personal lubricants. I therefore find that the opponent has not shown use of its class 4 goods, but it has shown use of its class 5 "vaginal lubricants".

41. The Second Earlier Mark is registered for class 5 "hygienic lubricants and disinfectants for use in the area of the vagina, penis and anus", "personal lubricants",

"vaginal moisturizers", and "topical preparations, namely, sprays, gels, liquids and creams for sexual health and / or enhancing sexual arousal". I find that the opponent has shown use of the terms "personal lubricants" and "vaginal moisturizers". I also consider that the opponent's goods are a type of topical preparation, which are applied into a specific body surface, that being the users intimate areas, and that these goods are clearly used for sexual health and/or enhancing sexual arousal. I therefore find that the opponent has also shown use of the term "topical preparations, namely, sprays, gels, liquids and creams for sexual health and / or enhancing sexual arousal". I bear in mind that there is nothing within the opponent's evidence to show that the goods are used to disinfect, and the goods within the evidence are not described as "hygienic lubricants". I therefore find that the opponent has not shown use of the term "hygienic lubricants and disinfectants for use in the area of the vagina, penis and anus".[8]

42. The Third Earlier Mark is registered for the term "lubricants for personal use, vaginal moisturisers, sexual enhancement gels" in class 5. As noted above, the goods sold under its mark are consistently described as personal lubricants. These goods can be used for vaginal dryness, to enhance the users sexual experience and pleasure. On this basis, I find that the opponent has shown use for the entirety of its Third Earlier Mark's class 5 specification. Consequently, I consider a fair specification for the opponent's First, Second and Third Earlier Marks to be:

<u>The First Earlier Mark</u>

Class 5 Vaginal lubricants.

<u>The Second Earlier Mark</u>

Class 5 Personal lubricants; vaginal moisturizers; topical preparations, topical preparations, namely, sprays, gels, liquids and creams for sexual health and / or enhancing sexual arousal.

[8] Nevertheless, I have found above that the opponent has shown use of the broader term "personal lubricants".

<u>The Third Earlier Mark</u>

Class 5	Lubricants for personal use, vaginal moisturisers, sexual enhancement gels.

Section 5(2)(b) - case law

43. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

(i) mere association, in the strict sense that the later mark brings 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; and

(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

44. The parties’ competing goods are as follows:

Opponent’s goods	**Applicant’s goods**
<u>**The First Earlier Mark**</u> <u>Class 5</u> Vaginal lubricants. <u>**The Second Earlier Mark**</u>	<u>Class 5</u> Personal and surgical lubricating jelly.

Class 5 Personal lubricants; vaginal moisturizers; topical preparations, namely, sprays, gels, liquids and creams for sexual health and / or enhancing sexual arousal. **The Third Earlier Mark** Class 5 Lubricants for personal use, vaginal moisturisers, sexual enhancement gels.	

45. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("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."

46. I find that all of the opponent's above "vaginal lubricants", "personal lubricants" and "lubricants for personal use" fall within the broader category of "personal and surgical lubricating jelly" in the applicant's specification. The goods are identical on the principle outlined in *Meric.*

The average consumer and the nature of the purchasing act

47. 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. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*,

[2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
>
> (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
>
> (e) The average consumer's level of attention varies according to the category of goods or services in question; and
>
> (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

48. The average consumer for the goods will be members of the general public, however, I do not discount professional users such a medical professionals. The cost

of the goods is likely to be low and the goods will likely be purchased relatively frequently. The average consumer will take various factors into consideration such the cost, formula and the goods active ingredients to prevent any risk of adverse reactions. Furthermore, I note that these goods are to be used on intimate areas, and therefore, the level of attention paid during the purchasing process will be at least a medium degree.

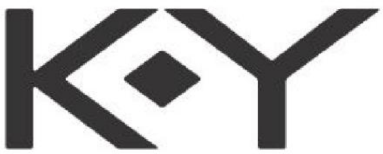
49. The general public are likely to obtain the lubricants by self-selection from the shelves of a range of retail shops such as pharmacies, supermarkets or beauty and health stores and their online equivalents. Alternatively, the goods may be purchased following perusal of advertisements or having viewed an image displayed on a webpage. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative. As for professional users, they will likely obtain their goods from pharmaceutical suppliers. While the professional consumer is likely to view the goods, the aural component is equally important as the goods will be selected after discussions with suppliers.

Comparison of the trade marks

50. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

51. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
K-Y **("The First and Second Earlier Marks")**  **(the Third Earlier Mark)**	KLY

Overall impression

52. The First and Second Earlier Marks consist of the letters "K" and "Y", with a hyphen in between them. I find that the letters "K" and "Y" will play a greater role in the overall impression of the mark, with the hyphen playing a lesser role.

53. The Third Earlier Mark consists of the letters "K" and "Y" presented in a standard capitalised typeface, with a diamond shape in between them. I find that the letters "K" and "Y" will play a greater role in the overall impression of the mark, with the stylisation and diamond playing a lesser role.

54. The applicant's mark consists of the letters "KLY" presented in a standard capitalised dark blue typeface. I find that the letters "KLY" will play a greater role in the overall impression of the mark, with the stylisation and colour playing a lesser role.

Visual Comparison

The First and Second Earlier Marks and the applicant's mark

55. All of the marks begin with the letter "K" and end in the letter "Y". These act as visual points of similarity. However, the middle of First and Second Earlier Marks consist of a hyphen, and the middle of the applicant's mark consists of the letter "L". These act as a visual point of difference. I bear in mind that the applicant' mark is a word mark, and notional and fair use means it can be presented in any standard typeface or colour. I also bear in mind that the parties marks are short. There is no special test which applies to the comparison of short marks, the visual similarities must be assessed in the normal way.[9] However, it is clear that the addition of one letter to a mark which is only two letters long is clearly more significant than an addition of one letter to a longer mark. Therefore, I find that the addition of the second letter "L" in "KLY" does have a more significant impact. Consequently, I find that the marks are visually similar to at least a medium degree.

The Third Earlier Mark and the applicant's mark

56. Both marks begin with the letter "K" and end in the letter "Y". These act as visual points of similarity. However, the middle of the Third Earlier Mark consists of the diamond device, and the middle of the applicant's mark consists of the letter "L". These act as visual points of difference. I also note that the capitalised typefaces slightly differ. Thus, I find that the marks are visually similar to at least a medium degree.

Aural Comparison

The First and Second Earlier Marks and the applicant's mark

57. The First and Second Earlier Marks are likely to be pronounced as KAY-WHY, with the hyphen emphasising the space between these letters. The applicant's mark is likely to be pronounced as KAY-EL-WHY. On the basis that the marks beginning and

[9] *Bosco Brands UK Limited v Robert Bosch GmbH*, Case BL- O/301/20, paragraph 44

ending syllables are aurally identical, I find that, as a whole, the marks are aurally similar to between a medium and high degree.

The Third Earlier Mark and the applicant's mark

58. The diamond element in the Third Earlier Mark will not be articulated. On this basis, I find that the same comparison applies in paragraph 57 above. The parties' marks are aurally similar to between a medium and high degree.

Conceptual Comparison

The First and Second Earlier Marks and the applicant's mark

59. I note that the letters "K" and "Y" in the First and Second Earlier Marks, and the letters "KLY" in the applicant's mark will not be assigned any conceptual meaning, since the letters may stand for any number of word combinations. I also note that letters on their own do not convey a particular concept over and above their existence as letters in the English alphabet. The hyphen in the First and Second Earlier Marks does not contribute to the conceptual message of the mark (it simply emphasises the space between the letters "K" and "Y"), and the stylisation of the applicant's mark also does not contribute to its conceptual message. On the basis that neither mark conjures an immediate concept in the mind of consumers, they are conceptually neutral.

The Third Earlier Mark and the applicant's mark

60. I do not consider that the diamond element evokes any meaning within the Third Earlier Mark. On this basis, the same comparison applies in paragraphs 59 above. I find that the parties' marks are conceptually neutral.

Distinctive character of the earlier trade marks

61. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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 promotion of 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)."

62. 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 services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

63. I will begin by assessing the inherent distinctive character of the opponent's First, Second and Third Earlier Marks.

64. Firstly, as noted above, the letters "K" and "Y" in the opponent's may stand for any number of word combinations, and therefore does not evoke any concept. Secondly, it is important to bear in mind that in *Kunze Folien GmbH v Kartell UK Limited,*[10] Mr

[10] BL O/085/14, paragraph 29

Iain Purvis KC sitting as the Appointed Person, referred with approval to the decision of *Alfa-Beta Vassilopoulos AE v Agro de Bazan,*[11] in which the Board of Appeal stated as follows:

> "As to the distinctive character of the letter combination 'AB' in the earlier marks and of the contested mark, […] it should be noted that letters or letter combinations of two or three letters are inherently weak, given the limited number of letters in the alphabet, the great number of meanings that acronyms and abbreviations may have and the fact that consumers frequently encounter abbreviations and letter combinations of all kinds in everyday life and business as generic abbreviations but not as marks."

65. Thirdly, I find that the hyphen and diamond elements do not contribute to the conceptual message or distinctive character of the opponent's marks. Therefore, whilst the First, Second and Third Earlier Marks are neither allusive nor descriptive of the opponent's goods, they are simply composed of the combination of two letters (K and Y). Marks in the form of simple letter combinations is the type that the average consumer is used to seeing being used by companies and individuals. Therefore, taking all of the above into account, I find that the opponent's First, Second and Third Earlier Marks are inherently distinctive to between a low and medium degree.

66. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

67. In addition to the turnover figures provided in paragraph 21 above, I have also been provided with the following UK sales made in 2016 to 2018 by the licensee via the agreement contained in **exhibit LA03**:

Year	**Sales value**
2016	£2.3m
2017	£2.4m
2018	£2.2m

[11] Case R 82/2011-4 of the Board of Appeal of OHIM (now the EUIPO), paragraph 16

68. I also note that Ms Adbull has drawn my attention to multiple parts of the aforementioned report, including the following:

1. That the opponent (who appears to also own the brand Durex) and the previous owners of K-Y "currently enjoy a combined market share of 60 to 80%".[12]

2. The opponent and previous owners of K-Y have a 15-25% share of the online market.

3. "As both parties supply personal lubricants in the UK, the acquisition will result in the merged entity having a combined share of supply of personal lubricants in the UK in excess of 25%."

4. A study by GroupM Primus in November 2013 found that K-Y Jelly's share of the market was around 30-50% (paragraph 8.40).

5. In a TNS survey conducted, participants were asked what brand they would have chosen if K-Y was no longer available in the place they last purchased the product. 43% of K-Y purchasers said they would have purchased the same product elsewhere (paragraph 8.83).

69. In regard to the combined market share figure above, I find that this is not particularly helpful, as my focus is on the market share held by the brand K-Y. While the figures in paragraph 68(4) are helpful, I note that this is the only market share figure provided, which is over 10 years before the relevant date.

70. Ms Abdull also provides a range of "literature produced by various NHS trusts" in **exhibit LA11**. It is clear that the extracts provided clearly refer to "KY jelly" being recommended for vaginal dryness. While Ms Abdull highlights that there are explicit references to how well the brand is known, I note for example, that this is not always highlighted in a positive way. For example;

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[12] This appears to be one of the reasons why the UK Competition and Markets Authority had to investigate the acquisition, as it could have had an adverse effect on the relevant market. The conclusion to licence the brand first was a remedy to such.

a) “Many people have heard of KY jelly, but this is not a particularly effective lubricant and can cause irritation to the vaginal tissues and may feel gritty.”
b) “Water based lubricant such as KY Jelly lose their lubricating effect quickly and may cause vaginal irritation.”
c) “K-Y Jelly was used as a negative control based on the numerous published accounts of its damaging effects on sperm function […] K-Y Jelly was also found to be detrimental for sperm mobility.”

71. However, some of the literature does indeed recommend KY Jelly for during intercourse if the user is suffering with vaginal dryness. Nevertheless, I note that all of this evidence is undated and therefore I am unable to determine when it was published. I have also not been provided with any information as to how long this literature was used for, or how many UK patients would have read or been exposed to them.

72. I also note that I have not been provided with any marketing expenditure in regard to promoting the K-Y brand. The only evidence provided in regard to marketing is contained in **exhibit LA01** which contains a singular UK advert for K-Y lubricating jelly which Ms Abdull dates as being from the 1990s. However, I have not been provided with any accompanying information such as where this advert would have appeared, or how long it was used for. While the opponent has provided 2 articles from May 2015 in **exhibit LA02**, this third party article evidence only reports on the acquisition of the K-Y brand.

73. I bear in mind that I have been provided notable sales figures from 2016 to 2023, amounting to £15.1 million, which is supported by examples of UK third party retailers selling K-Y lubricants between October 2019 to May 2023. However, I have no supporting UK invoice evidence to show that the sale of these goods were geographically spread across the UK, albeit retailers such as Boots and Waitrose are national chains. Consequently, there is likely to be a geographically wide spread of customers. I have not been provided with any marketing figures or examples of advertising (aside from the 1990 advert), and the opponent has not provided any evidence of its social media presence. While I have been provided with an approximate market share figure from 2013, this figure is over 10 years before the

relevant date, and therefore it is unclear whether this market share increased or decreased whilst the licensee used the brand. I also bear in mind that I have no sales figures from 2013, and therefore, I am unable to determine what figure the market share percentage was calculated from. It is also unclear whether the market figure from paragraph 68(4) specifically pertains to the UK.[13] Therefore, taking all of the above into account, I do not consider the opponent's evidence is sufficient to establish enhanced distinctiveness of its earlier marks.

Likelihood of confusion

74. 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 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.

75. Nevertheless, the standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, as listed in paragraph 43 above.

76. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found all of the marks to be visually similar to at least a medium degree.
- I have found all of the marks to be aurally similar to at least a medium degree.
- I have found all of the marks to be conceptually neutral.
- I have found the First, Second and Third Earlier Marks to be inherently distinctive to between a low and medium degree.

[13] The agreement itself makes many a reference to worldwide sales, for example.

- I have identified the average consumer of the goods to be members of the general public or medical professionals who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical.

77. Taking all of the above into account, even bearing in mind the principle of imperfect recollection and the interdependency principle, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. I do not consider that consumers who are paying at least a medium degree of attention will overlook the letter "L" in the middle of the applicant's mark. This is especially the case as the parties' marks are short, and therefore the differences are more likely to be noticed. I have also found that the earlier marks are inherently distinctive to between a low and medium degree, on the basis that they simply consist of two letters. The average consumer is used to encountering marks consisting of simple letter combinations, such as in this case or when used as initialisms, in respect of a wide range of goods and services. They are, therefore, used to distinguishing such marks from each other. Consequently, I do not consider there to be a likelihood of direct confusion between the parties' marks, even on identical goods.

78. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

79. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion <u>is not a consolation prize</u> for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

80. Mr Purvis QC in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion ‘tends’ to fall in one of them (paragraphs 16 & 17). I also bear in mind that the examples set out by Mr Purvis above are not exhaustive. However, having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer, paying at least a medium degree of attention during the purchasing process would think that the opponent’s marks were connected with the applicant or vice versa, on the basis that they share the letters “K” and “Y”. To extract these letters from the parties’ marks would amount to dissection, when the consumer normally perceives a trade mark as a whole, and does not proceed to analyse its various details. Furthermore, the addition of the letter “L” in the applicant’s mark, or to change the hyphen/diamond element in the middle of the opponent’s marks to the letter “L” (or vice versa) is neither a logical nor natural variant or brand extension of each other. Even if the opponent’s marks are brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Therefore, taking all of the above into account, I consider there is no likelihood of indirect confusion on the parties’ identical goods.

81. The opposition under section 5(2)(b) fails.

Section 5(3)

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

> "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."

83. Section 5(3A) of the Act states:

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

84. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40.*

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

85. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar, and I have discussed their level of similarity in paragraphs 55 to 60 above. Secondly, the opponent must show that its First, Second and Third Earlier Marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have 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 opponent's marks being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. 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.

86. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 5 March 2024.

Reputation

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

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

88. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account 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 undertakings in promoting it."

89. I note that the Second and Third Earlier Marks are comparable UK trade marks (EU). Therefore, I can consider the evidence which pertains to the EU until IP Completion Day (31 December 2020), and the UK, in order to determine its reputation in both territories. However, I also remind myself that a link has to be made in the mind

of the UK relevant public[14] and therefore I will focus on the opponent's UK evidence first.

90. Earlier in my decision, I found that the distinctive character of the First, Second and Third Earlier Marks had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.[15]

91. As noted above, the UK sales figures provided from 2016 to 2023 amount to £15.1 million. I find that these are notable. This is supported by examples of UK third party retailers selling K-Y lubricants between October 2019 to May 2023. However, there are significant deficiencies with the opponent's remaining evidence. I have no UK invoices from before the relevant date to show that the sale of the goods were geographically spread across the UK. However, as noted above, retailers such as Boots and Waitrose are national chains, and on this basis, there is likely to be a wide spread of customers geographically located across the UK. I have not been provided with any marketing figures, and the only example of advertising in the UK is a singular advert from 1990. While I have been provided with an approximate market share figure from 2013, it is firstly unclear whether it pertains to the UK market only, and even if it was, this figure is over 10 years before the relevant date, and therefore it is unclear whether this market share increased or decreased whilst the licensee used the marks. Therefore, the evidence is, for the reasons set out above, insufficient to establish a reputation in the UK.

92. In regard to the EU evidence, I have been provided with sales made in 2019 and 2020 amounting to £8.2 million. This is supported with screenshots of reviews from EU retailers selling the goods, and invoices from 2019 to 2020 addressed to France, Finland, Sweden, Netherlands, Portugal and Spain. However, I bear in mind that all of this evidence only pertains to two years. There is no EU advertising figures provided or examples of advertising. It is unclear whether the approximate market share figure from 2013 pertains to the EU, and if it does, again, this is 10 years before the relevant

[14] *China Construction Bank Corporation v Groupement Des Cartes Bancaires,* (Case BL O/281/14)
[15] *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

date. Therefore, the evidence is, for the reasons set out above, insufficient to establish a reputation in the EU. On this basis, without having found a reputation, the opposition based upon section 5(3) fails.

Section 3(6)

93. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

94. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).
>
> (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its

goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky*

CJEU, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

95. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

96. It is also necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16). The relevant date in this decision is 5 March 2024.

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

97. In its Form TM7, the opponent claims that the application was filed "seeking to imitate the highly reputable K-Y brand, as closely as possible" and that this application

is "the latest in a long line of malicious actions by the applicant, intended to cause harm to the opponent and its reputable K-Y brand". The opponent also highlighted that there is a "history of disputes" between the parties in the UK, which includes the applicant previously seeking to register the "KLY" mark in 2009, and the related EUIPO proceedings between the parties whereby the opponent demonstrated its reputation and share of the market in the UK.

Was that objective for the purposes of which the contested mark could not be properly filed?

98. I bear in mind that the filing of a mark with the knowledge that the opponent owns it, in isolation, may not be compelling because mere knowledge of another party's use of a mark (either in the UK or elsewhere) does not establish bad faith.[16] The applicant may have also reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

99. However, the opponent's argument that this prior knowledge, in combination with a "long line of malicious actions [taken] by the applicant" could be the basis of a bad faith objection, if proven.

100. Therefore, the key question is whether the opponent has satisfied the burden of proving the existence of the applicant's intention to cause harm to the opponent and its brand, which is inconsistent with honest practices.

Was it established that the contested mark was filed in pursuit of that objective?

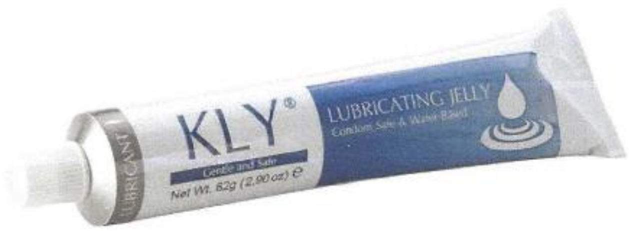
101. In her witness statement, Ms Abdull confirms that the dispute between the parties is not confined to the UK, and that there are proceedings between them in the EU, France, Kenya, Oman, Egypt and Turkey. Ms Abdull states that as of the marks filing date, the applicant had "knowledge regarding the current scale of use of the K-Y brand in the UK, owning to evidence filed in related EU opposition proceedings".[17]

[16] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker Case* C-320/12 and *Lindt, Koton* (paragraph 55).
[17] Paragraph 36 of Ms Abdull's witness statement.

102. Ms Abdull states that the Reckitt Group own over 350 K-Y marks in over 75 different jurisdictions. A summary of this portfolio of marks is contained in **exhibit LA12.** Ms Abdull highlights that the Reckitt Group own 8 K-Y registrations in Turkey dating back to 2002, and that the applicant is also a Turkish entity.

103. In paragraph 35 of her witness statement, Ms Abdull states that the applicant has also had knowledge of the K-Y registrations in the UK since 2010, when the applicant filed for the word mark KLY as an IR. Ms Abdull states that “the UK designation was refused following an opposition” by Johnson & Johnson based upon a likelihood of confusion and reputation. **Exhibit LA13** contains the Form TM7 from these proceedings.

104. Ms Abdull draws my attention to the “get-up” of the applicant’s KLY goods at paragraph 37, which she has shown alongside the K-Y packaging. The goods are shown as follows:



105. Ms Abdull highlights that the applicant “has elected to use a half & half, blue and white colour scheme for its products” which is the same as some of the opponent’s K-Y goods. She also states that the applicant’s goods are already being offered for sale in the UK.[18] In the last paragraph of Ms Abdull’s statement, she says that:

[18] Paragraph 38 of Ms Abdull’s witness statement.

> “Not only has the Applicant filed this application to unfairly exploit the distinctiveness and reputation of the K-Y brand but also to interfere with Reckitt's business activities and to affect its ability to use and register its own mark. A good example of this is that in China, the Applicant relied on its registration for KLY to challenge two applications for K-Y by Reckitt at the end of 2019. They alleged that there was a Likelihood of Confusion in both cases, in direct contradiction of the claims made in its defence in these proceedings.”

106. I note that the above evidence before me is very limited. It is premised on the fact that the applicant has previous knowledge of the opponent’s registrations, and that the parties have engaged in multiple disputes since 2010. Aside from Ms Abdull’s witness statement, the opponent has not provided any exhibited evidence in regard to these disputes, aside from a Form TM7 from May 2010.

107. In regard to the 2019 Chinese applications, I bear in mind that Ms Abdull has not provided any further exhibited evidence to support her statement. Nevertheless, the applicant may have made such comments in relation to a likelihood of confusion, but this was made in the context of Chinese proceedings, which concerned the application of Chinese law in China, rather than these proceedings, which concerns the application of UK law in the UK. Moreover, whilst the opponent states that the applicant has made claims that directly contradict each other in both territories, the opponent has not identified any authority which establishes that a party cannot make arguments in one set of proceedings which (on the face of it) appear to contradict its position in other proceedings (including those in a different territory). I therefore find that this example of the applicant’s behaviour does not provide a justifiable basis for believing that their behaviour fell below honest standards.

108. While in 2010 Ms Abdull states that there was a dispute with the applicant filing an IR designating the UK, which she also says was successful, I bear in mind that I have not been provided with this decision. Therefore, I am unable to determine if the marks were exactly the same (including if they were registered for the same goods or not). I also note that the opposition was filed by the opponent’s predecessor Johnson & Johnson, and therefore the evidence filed inevitably would have been different. Without the decision before me I am unable to ascertain whether or not the

circumstances are different enough that the applicant believed that they were reasonably entitled to apply for their mark over 10 years later.

109. I also bear in mind that while Ms Abdull states that there are disputes between the parties in the EU, France, Kenya, Oman, Egypt and Turkey, she has provided no further information in regard to them. They could, for example, encompass different marks and goods. However, even if they all did pertain to the registration of a KLY mark for class 5 lubricants, this could simply be an indication that the applicant was registering its mark in different territories to protect a right it believes it is entitled to protect. This behaviour therefore is not inconsistent with honest practices.

110. Lastly, in regard to the "get up" of the goods, Ms Abdull has only provided one example within her witness statement of the parties' using blue and white tubular packaging. This item is shown within the Amazon evidence exhibited in **LA08** (referred to in paragraph 25(c) above). However, this is the only item which uses this get up in the exhibited evidence. All of the remaining items use the branding/packaging shown in paragraph 23 above.

111. I note that there are clear differences between the parties' tubular packaging, such as the size of the K-Y and KLY marks, they are presented in swapped colour-ways, and the information on the front of these goods are clearly different. I therefore find that this one example, alongside the above evidence which I have found to have sufficient deficiencies, as a whole, does not show that the applicant intended to cause harm to the opponent and its brand.

112. I bear in mind that an allegation of bad faith is a serious one, and the burden of proof is on the opponent. Therefore, taking all of the above into account, I find that the opponent has failed to establish a prima facie case of bad faith. As such, the application based upon section 3(6) of the Act is dismissed.

CONCLUSION

113. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

114. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of **£300** as a contribution towards the costs of the proceedings, in which they only had to consider the opponent's Notice of opposition and prepared a counterstatement.

115. I therefore order Reckitt Benckiser Health Limited to pay TURKUAZ SAGLIK HİZMETLERİ MEDİKAL TEMİZLİK KİMYASAL ÜRÜNLER SAN. VE TİC. A.Ş. the sum of £300. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 22nd day of July 2026

L FAYTER

For the Registrar

ANNEX 1

First Earlier Mark

Class 4

Lubricants.

Class 5

Vaginal lubricants.

The Second Earlier Mark

Class 5

Hygienic lubricants and disinfectants for use in the area of the vagina, penis and anus; personal lubricants; vaginal moisturizers; topical preparations, namely, sprays, gels, liquids and creams for sexual health and / or enhancing sexual arousal.

The Third Earlier Mark

Class 5

Lubricants for personal use, vaginal moisturisers, sexual enhancement gels.