O/0682/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3691813

IN THE NAME OF ISLAM MOHAMMED

IN RESPECT OF THE TRADE MARK

IN CLASS 5

AND

THE OPPOSITION THERETO UNDER NO. 431547

BY TASTY GREENS LLC

AND

IN THE MATTER OF TRADE MARK REGISTRATION NOS. 3281870, 3427204 & 3427213

IN THE NAME OF TASTY GREENS LLC

IN RESPECT OF THE TRADE MARKS

8GREENS

8 GREENS/8GREENS

IN CLASSES 5, 32 & 44

AND

THE APPLICATIONS FOR INVALIDATION THEREOF UNDER NOS. 505815, 505816 & 505817

BY ISLAM MOHAMMED

Background and pleadings

1. Islam Mohammed ("Mr Mohammed") applied to register the trade mark no. 3691813 for the mark shown on the cover page of this decision in the UK on 8 September 2021. It was accepted and published in the Trade Marks Journal on 3 December 2021 in respect of the following goods:

Class 5: *Food supplements*.

2. On 3 March 2022, Tasty Greens LLC ("TG") opposed the trade mark on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK Trade Marks as set out below:

1. Registration no. 3281870

   8GREENS - priority date 18 October 2017, filing date 11 January 2018, registration date 13 April 2018.

   Goods in class 5 including (amongst others) *dietetic substances adapted for medical use; dissolving or effervescent tablets primarily containing vitamins and herbs to make vitamin enhanced beverages; nutritional supplements in the form of gummies; gummy vitamins.* The full specification of goods relied upon is set out at Annex A.

2. Registration no. 3427204

   8 GREENS/8GREENS (series of two) - filing date 9 September 2019, registration date 29 November 2019.

   Goods and services in classes 5, 32 and 44 including *food supplements* in class 5. The full specification of goods and services relied upon is set out at Annex B.

3. Registration no. 3427213

GREENS / GREENS[1] (series of two) - filing date 9 September 2019, registration date 29 November 2019.

Goods and services in classes 5, 32 and 44 including *food supplements* in class 5. The full specification of goods and services relied upon is set out at Annex C.

3. By virtue of their earlier priority dates and filing dates, the above registrations constitute earlier marks in accordance with section 6 of the Act.

4. TG argues under section 5(2)(b) of the Act that the respective goods and services are identical or similar and that the marks are similar, and that as such there will be a likelihood of confusion including a likelihood of association between the marks. Under section 5(3), TG argues that it enjoys a significant reputation under the earlier marks, and that use of the contested mark by Mr Mohammed would inevitably lead consumers to believe that the marks derive from the same economic undertakings, resulting in an unfair advantage, as well as the potential for detriment via reputational damage and the dilution of the distinctive character of the earlier marks.

5. Mr Mohammed filed a counterstatement denying the claims made and requesting that TG provides proof of its claimed reputation.

6. On 9 February 2023, Mr Mohammed filed three applications to invalidate the earlier marks upon which the TG relies in the above opposition. The applications for invalidation rely on section 47(2)(b) on the basis of section 5(4)(a) of the Act. Mr Mohammed claims to have used the sign 5greens for food supplements in the UK[2] since 2016, and that on this basis he holds goodwill under the sign. Mr Mohammed submits that use of TG's marks in respect of all of the goods and services registered would result in misrepresentation and damage to his goodwill. Mr

[1] Whilst I note only the first mark filed in black is included in the box supplied on the TM7 under both 5(2)(b) and 5(3), both marks are clearly referenced on the continuation sheet supplied in respect of the 5(2)(b) ground.
[2] I note the TM26(I) filed states the region the mark was first used as Manchester, but the attached statement of grounds claims that Mr Mohammed has used the mark extensively throughout the UK.

Mohammed submits the registrations should therefore be declared invalid under section 5(4)(a) of the Act.

7. TG filed a counterstatement denying that Mr Mohammed owns goodwill under the earlier sign and putting him to proof of the same. In the absence of evidence of goodwill, TG denies there will be misrepresentation or damage caused by the use of its registrations.

8. On 18 April 2023, the Tribunal wrote to the parties informing them that all four matters would be consolidated, stating:

> *The Registrar has considered the nature of the claims in all the above opposition cases and hereby directs under Rule 62(1)(g) of the Trade Marks Rules 2008 that they be consolidated. The lead file will be Opposition Number OP000431547 against Trade Mark Application Number UK00003691813. All future correspondence and evidence should be headed up to relate to all cases.*

9. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Only Mr Mohammed filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

10. Both parties have legal representation in these proceedings. Mr Mohammed is represented by Briffa. TG is represented by D Young & Co LLP.

11. 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

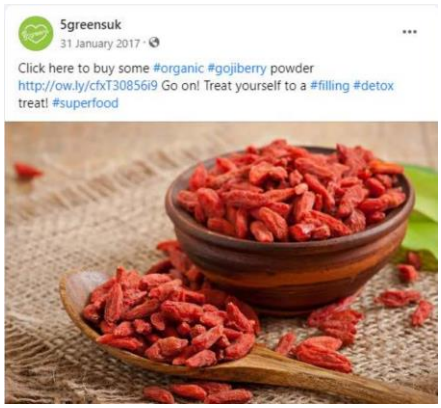
12. The evidence filed in these consolidated proceedings will go to both the opposition and to the three applications for invalidation. However, should Mr Mohammed be

successful in his applications for invalidation of the three earlier marks relied upon within the opposition, the opposition will fall away. I therefore intend to deal with the applications for invalidation prior to dealing with the opposition filed, and I will order my evidence summary accordingly. However, I will keep both matters in mind when considering the evidence which I will summarise thoroughly only once in respect of all matters below.

13. Mr Mohammed filed his evidence in chief in the form of a witness statement in his own name as the owner of the business '5 greens'. The witness statement introduces 11 exhibits, namely Exhibit IM1 – Exhibit IM11. He explains in his statement that he has been trading under his sign since around the beginning of 2016.[3] He submits that TG only officially launched in the UK in October 2020.[4] At Exhibit IM1 he provides an online article from 'The Grocer'. Only the headline of the article is visible, which reads "Wellness brand 8Greens makes UK debut with effervescent tablets". It is dated 8 October 2020. Mr Mohammed states that when filing his application he had never heard of TG's brand.[5] He states he purchased his domain name www.5greens.co.uk in late 2015 and has since the start of his business always used the mark that is the subject of his application.[6] He provides an undated screenshot of the website showing the mark, as well as the 'Registrar data' confirming the domain was registered on 25 November 2015 at Exhibit IM2.

14. At Exhibit IM3 Mr Mohammed provides an undated screenshot showing 5greens has a 4 star review on the website 'Trustpilot' with a total of 75 reviews. Exhibit IM4 provides an undated screenshot showing his Amazon page and website as top results in an internet search for '5 greens'. A Facebook page with the creation date of 4 May 2016 showing a number of posts between November 2016 and February 2017 under '5greens' and  is provided at Exhibit IM5, and includes posts such as below:

[3] See paragraph 6 of the witness statement of Mr Mohammed
[4] See paragraph 7 of the witness statement of Mr Mohammed
[5] See paragraph 8 of the witness statement of Mr Mohammed
[6] See paragraph 12 of the witness statement of Mr Mohammed



15. Instagram posts dating between December 2016 and January 2017 are provided showing goods such as mushroom powder and bee pollen for sale in GBP under the page name 5greensuk and showing the mark 5greens. The products themselves show the trade mark as follows:

16. Similar activity from December 2016 to February 2017 is shown on a Twitter page under the handle '5greensUK' using the marks 5greens and 5greens and displaying products also showing the mark used on the packaging in the image above. In addition,

a number of blog posts from Mr Mohammed's website dating from January and February 2017 and May 2018 are also provided.

17. Mr Mohammed explains he made his first wholesale purchase in 2015,[7] and provides at Exhibit IM6 18 invoices showing purchases by Mr Mohammed and '5greens' to values ranging between (approximately) £300 - £2000. These are dated between December 2015 and January 2017.

18. At Exhibit IM7 Mr Mohammed provides documents showing what he describes as Amazon seller fees for June, July, August and September 2016. These show between approximately £30 and £85 worth of fees being charged to '5greens' on each document. He also provides his income tax statements showing how much tax he has paid for the years ending April 2016, April 2017, April 2018 and April 2019. These refer to tax paid by Mr Mohammed but there is nothing to indicate this is all on the basis of his business under 5greens, and there is no explicit statement from Mr Mohammed confirming as such.

19. At Exhibit IM8 Mr Mohammed provides his business account bank statements for January, June and October 2016. These show two direct credit payments from Amazon UK in the October statement for £131.17 and £153.51, alongside a number of internet bank transfers from other accounts. He also provides an Organic Food Federation Certification payment invoice for February 2016 – February 2017 and an Organic Food Federation Certification running from March 2016 – February 2017. VAT registration documents for 2018 and 2019 are also provided at this exhibit as well as a business lease for April 2017 – April 2018 in the name of Mr Mohammed T/A 5greens.

20. Mr Mohammed provides a dictionary definition for the word 'Greens' at exhibit IM9. He explains he chose to include the number 5 in his sign as a nod to the advice to eat five fruit and vegetables a day, whereas he submits TG chose the number 8 to indicate the number of green ingredients in its products and provides a screenshot of TG's website explaining this at Exhibit IM10. Around 40[8] reviews from the 5Greens Amazon

[7] See paragraph 17 of the witness statement of Mr Mohammed

[8] Whilst there initially appears to be more than 40 reviews provided in this exhibit, some of the pages and reviews have been provided twice.

store are provided at Exhibit IM11. Most of these are five star and they are dated between September 2016 and January 2018.

21. The evidence in chief provided by TG was filed in the form of a witness statement in the name of Marie Newell, CEO of TG since 2021. The statement introduces 16 exhibits, namely Exhibit MN1 to Exhibit MN16. Exhibits 14-16 are subject to a confidentiality order.

22. Ms Newell states 8GREENS was founded in 2016 and was the world's first greens-based company to sell effervescent tablets, and that since 2016 it has been used in connection with TG in the US.[9] She confirms 8GREENS products were launched in the UK in 2020[10] and that the '8GREENS' marks have been used continuously and extensively throughout the UK since then.[11] Exhibit MN1 and MN2 both provide details of the UK trade marks owned by TG.

23. Ms Newell explains that product categories in the 8GREENS range include *Daily Greens*, *8GREENS Skin*, *Effervescent Tablets* and *Chewables*. At Exhibit MN3 Ms Newell provides print outs from the TG website via the web archiving site the Wayback Machine. There are four pages dated November 2020, April 2021, May 2021 and May 2022. They all show the website UK.8greens.com. They show effervescent tablets (and 'chewables' from May 2021) made from 8 'real greens' under the marks 8GREENS and 

. Prices are shown in GBP. Exhibit MN4 provides more web pages from the Wayback Machine. These show customers were able to choose to visit the UK website on 21 May 2020. Exhibit MN5 shows Google Analytics for webpage views between 13 April 2020 and 2023. It shows there have been 361,551 total page views and 280,361 unique page views during this time. It is not easy to determine exactly how may views are from what time period from the graph but these appear to peak in 2020 and the first half of 2021. Ms Newell also confirms third party retailers including, but not limited to, Harrods, Selfridges, QVC UK and Healf sell

[9] See paragraph 5 of the witness statement of Ms Newell
[10] See paragraph 5 of the witness statement of Ms Newell
[11] See paragraph 7 of the witness statement of Ms Newell

8GREENS branded products online and/or in their physical stores.[12] Ms Newell also states 8GREENS products reach 280 million UK customers via Amazon UK,[13] however, it appears from the webpage provided at Exhibit MN6 this refers to the total reach of Amazon UK.

24. Ms Newell states that between January 2021 and September 2021, TG spent over £100,000 on digital advertising.[14] A breakdown of this spend is provided at Exhibit MN7. She does not specify if this was all in relation to 8GREENS products and it is not specified on the breakdown.

25. Exhibit MN8 provides a selection of pages showing print, digital and social media coverage of 8GREENS goods. This appears to be mostly undated or dated from 2022 onwards. Exhibit MN9 provides more press coverage, which includes one UK article from ‘’The Grocer’ dating from 8 October 2020 referring to the ‘8Greens’ UK debut (also provided by Mr Mohammed) and an article from the Mirror UK dating from 21 March 2021. Exhibit MN10 provides newsletter distribution figures for UK customers.[15] These figures build steadily from March 2020 and peak at around 7000 around March 2021. These figures then drop and hover around 2000 until March 2022, at which point they again rise.

26. Ms Newell confirms 8GREENS current social media following and provides excerpts from social media pages at Exhibit MN11. Exhibit MN12 provides worldwide customer testimonials posted on Instagram. Exhibit MN13 provides further Instagram posts showing giveaways and brand collaborations. Many of the posts appear to be targeted at a US audience.

27. Exhibits MN14 – MN16 are subject to a confidentiality order, and as such I will not detail their contents. However, I note these relate to UK sales figures between 2020 and 2022. I have taken note of these sales figures. A number of customer invoices showing sales to the UK dating between 1 August 2020 and 1 April 2021 are provided at Exhibit MN17. Sixteen invoices are provided in total.

[12] See paragraph 12 of the witness statement of Ms Newell
[13] See paragraph 13 of the witness statement of Ms Newell
[14] See paragraph 15 of the witness statement of Ms Newell
[15] See paragraph 19 of the witness statement of Ms Newell

28. Further press articles from 2022 and 2023 are provided at Exhibit MN18, listing 8GREENS in '7 best green powders', 'top 15 collagen supplements' and 'most viral green powder' lists. One article from Forbes (online) describes 8GREENS Lollipops as "[o]ne of the most trendy and popular functional brands in 2022".

29. Mr Mohammed filed a second witness statement in reply to the evidence provided above, introducing a further seven exhibits, namely Exhibit IM12 – Exhibit IM18. This statement mainly seeks to point out flaws in Ms Newell's witness statement, highlighting, for example, that US use is not relevant,[16] that TG are not the first sellers of green-based effervescent tablets *in the UK*,[17] and highlighting that as there are only around 67 million people in the UK, the claim by Ms Newell to have exposure to 270 million UK customers is exaggerated, and in any case this refers to visitors to the Amazon UK home page and not to customers exposed to the 8GREENS brand.[18] He states TG's social media appears to be targeted at the US.[19] He also highlights that articles provided at Exhibit MN18 appear to be aimed at the US.[20] Various exhibits are introduced in respect of these comments, but I do not find it necessary to outline these in detail here. Mr Mohammed's criticisms are noted and I will also conduct my own critical examination of the evidence provided by both parties and its relevance in reaching my decision.

30. I note Mr Mohammed also introduces details of his digital marketing spend in his reply evidence, stating that his company 'Bolt Trading Ltd' has spent significant sums to "drive the brand" and since 2021 this company has spent £425,304.33.[21]

[16] See paragraph 1 and 4 of the second witness statement of Mr Mohammed
[17] See paragraph 2 of the second witness statement of Mr Mohammed
[18] See paragraphs 7-9 of the second witness statement of Mr Mohammed
[19] See paragraph 15 of the second witness statement of Mr Mohammed
[20] See paragraphs 20-21 of the second witness statement of Mr Mohammed
[21] See paragraph 11 of the second witness statement of Mr Mohammed

Applications for the invalidation of registration nos. 3281870, 3427204 and 3427213

Legislation

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

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> >
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

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

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

33. The relevant parts of section 47 state:

> "47. (1) […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) […]
> >
> > (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

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

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

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

35. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

36. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> > 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

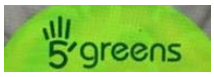
37. The three registrations subject to the applications for invalidation hold the filing (or priority) dates of 18 October 2017 and 9 September 2019 (x2) respectively. There is no evidence of TG's use of its marks prior to these dates in the UK. I therefore consider these to be the relevant dates for assessing if Mr Mohammed held protectable goodwill under his sign.

Goodwill

38. Goodwill is described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 233 as below:

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

39. I will start by considering the position in relation to goodwill at the first relevant date of 18 October 2017. As outlined in the evidence summary above, Mr Mohammed

made his first wholesale purchases in 2015, and began trading under the signs 5greens,  and  in 2016. There are a number of social media posts across Facebook, Instagram and Twitter showing that goods which I consider fall within the category of food supplements were available for sale under the signs prior to the relevant date. Mr Mohammed appears to have been a registered seller on Amazon UK during this time, to have paid a (small) amount in Amazon seller fees, and to have received a very small amount of Amazon credit into his '5 greens' business account before this date. I note there are also a small number of Amazon reviews for his goods under the sign prior to the relevant date. Mr Mohammed also appears to have leased a business premises, been registered for VAT payments and obtained Organic Food Federation Certification in respect of his business under '5 greens' prior to the relevant date. I also note his personal tax returns are provided for this period, but it is not clear whether this tax was paid purely on the basis of the business under the sign and in any case it is not clear what the tax paid translates to in respect of sales of the goods under the sign. Similarly, I note the various bank transfers into the business account, but it is not clear where these transfers came from and if they stem from sales made or elsewhere.

40. It is apparent from the evidence provided and summarised above that Mr Mohammed did, for at least a short period, operate a food supplements business in the UK under the sign prior to the relevant date. However, I note that the evidence omits significant information which would ordinarily prove helpful in establishing goodwill under the sign. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application

(OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

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

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

42. Whilst I note, as set out above, there are no absolute requirements as to the nature of the evidence needed to show goodwill under a sign, in this case I consider that I have not been provided with any information regarding the actual level of sales to UK consumers under the sign prior to the first relevant date, nor have I been given any information regarding advertising spend or investment in promotion prior to this time. From what I can gather from the exhibits provided, the social media exposure appears to be fairly limited, there is no independent press evidence, and there is nothing to indicate the extent to which the wholesale purchases translate into actual UK sales. The product reviews provided are also limited in number. From the evidence provided, and without additional information regarding sales, advertising or press in relation to

the business under the sign, it is not possible to form a complete picture and establish the true extent of the use of the sign and its exposure to the UK consumers prior to the relevant date. Even allowing for the most generous reading of the documents that have been provided, I can only take from the evidence that UK trade under the sign prior to the relevant date was very small.

43. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

> "62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

44. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson Q.C., as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and

at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

45. I do not consider that the extent of the use of the sign prior to the relevant date of 18 October 2017, insofar as it can be established from the evidence provided, is sufficient to generate goodwill at a protectable level. As it is my view that Mr Mohammed has not provided evidence that he held protectable goodwill under the sign at the first relevant date, the application for invalidation of registration number 3281870 based on section 5(4)(a) of the Act must fail.

46. I therefore go on to consider the position in respect of the second and third applications for invalidation, which share the relevant date of 9 September 2019. Unusually, despite the later date, it is my view that Mr Mohammed's position is not improved in these actions. The majority of the evidence provided appears to relate to 2016 and 2017. I note there are a few additional Amazon UK reviews after this time and prior to these relevant dates, as well as the additional VAT registrations and tax returns, and a few additional blog posts on Mr Mohammed's website. However, again I do not consider these to offer much assistance in establishing that there has been more than a very small level of exposure of the sign and very limited sales of goods to UK customers prior to the relevant date.

47. Again, it is my view that Mr Mohammed has not demonstrated in his evidence that he owned protectable goodwill in his business under the sign prior to the relevant date in the two further applications for invalidation filed. The applications for invalidation of the registration numbers 3427204 and 3427213 under section 5(4)(a) of the Act must therefore also fail.

48. As the applications for invalidation of all of the earlier registrations relied upon have failed, TG may rely upon all of these earlier rights in the consolidated opposition proceedings which I will now move on to.

Opposition filed against UK trade mark no. 3691813 based on sections 5(2)(b) & 5(3)

Proof of use

49. As none of the three earlier marks relied upon in these proceedings had been registered for a period of five years or more prior to the filing date of the contested mark, they are not subject to the proof of use provisions in accordance with section 6A of the Act. These earlier marks may therefore continue to be relied upon in the manner set out in TG's pleadings.

Opposition based on section 5(2)(b)

Legislation

50. Section 5(2)(b) of the Act is as follows:

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

51. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

The Principles

52. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods

53. It is obvious that where goods or services share an identical meaning, they will be considered identical. Further, in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court 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 fur 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."

54. With the above in mind, the goods for comparison are as follows:

Earlier goods	**Contested goods**
Earlier registration no. 3281870 Goods in class 5 including (amongst others) *dietetic substances adapted for medical use; dissolving or effervescent tablets primarily containing vitamins and*	Class 5: *Food supplements.*

herbs to make vitamin enhanced beverages; nutritional supplements in the form of gummies; gummy vitamins.	
Earlier registration nos. 3427204 & 3427213 Goods and services in classes 5, 32 and 44 including *food supplements* in class 5	

55. The term *food supplements* is included identically in earlier registration nos. 3427204 & 3427213 and in the contested mark. These goods are self-evidently identical.

56. It is my view that the term *Food supplements* may be construed as meaning substances, for example in the form of a tablet, capsule, powder, or sweet, that will most likely be of a high nutritional value and will be ingested for the purpose of supplementing a person's diet to provide missing or additional nutrients.

57. It is my view that of the goods relied upon under the earlier mark no. 3281870, at least *dissolving or effervescent tablets primarily containing vitamins and herbs to make vitamin enhanced beverages; nutritional supplements in the form of gummies* and *gummy vitamins* will all fall within this definition. As I consider these goods to be encompassed by the term *food supplements* as applied for, I therefore consider these to be identical in accordance with the principles outlined in *Meric*.

Comparison of marks

58. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions

created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in 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."

59. It would be wrong, therefore, to dissect the trade marks artificially, 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.

60. The respective trade marks are shown below:

Earlier trade marks	**Contested trade mark**
8GREENS ("registration '870) 8 GREENS/8GREENS (series of two) ("registration '204") GREENS / GREENS ("registration 213")	5greens

61. Registration '870 above includes the mark '8GREENS'. Registration '204 includes a series of two marks, including '8GREENS' and '8 GREENS'. The overall impression of all of these marks resides in the combination of two elements, those being the number '8' and the word 'GREENS'. It is my view that the consumer will identify these two individual elements in all of these marks regardless of the omission of the single

space between the number and the word in the second mark in the of the series. I therefore consider the addition/omission of the space has minimal impact (if any) on the overall impression of the marks, and for this reason it will not impact my findings when comparing these marks to the contested mark. For efficiency, I will therefore conduct my comparison between these earlier marks and the contested mark together, referring to them collectively as 'the earlier word marks'.

62. Registration '213 above includes a series of two earlier marks, both of which comprise a large bold number '8' above the smaller word 'GREENS'. Adjacent to the number 8 is a very small circle containing '8G' and a half circle below, which may be interpreted as a take on a simple smiley face. I find the bold letter '8' to be the most dominant and distinctive element of the marks, considering both its size and positioning, and the fact that GREENS will be less distinctive in relation to the goods. However, the word GREENS will still have an impact in the overall impression of the marks. The circle feature will have less impact due predominantly to its very small size, but also on the basis that the '8G' inside will likely be considered to stand for '8 GREENS'. Whilst I note one of these marks is filed in black and white and one in green, I consider that fair and notional use of the black and white mark will allow for its use in any standard colour. I therefore find the use of the colour green in the second series mark will not impact the results of the comparison between these marks and the contested mark, and for efficiency I will therefore consider these two series marks together as 'the earlier stylised marks'.

63. The contested mark contains the two main elements '5' and 'greens'. Decoration has been added to the number 5 to make this appear to be part of a human hand device. I find '5 greens' to be the most dominant and distinctive element of the mark, but I consider the decoration added to the number 5 also has a reasonable impact on its overall impression. Whilst I note the stylisation of the lettering (outside of the additions to the number 5) and the use of the two colours of green, it is my view these only make a very small impact on the overall impression of the mark.

Comparison of the marks

The earlier word marks

Visual comparison

64. The earlier word marks coincide with the contested mark by way of the use of the second word ‘greens’. As they are filed as word marks, I keep in mind that fair and notional use of the earlier marks will include their use in both capitals and lowercase letters, and as such the capitalisation of the word ‘greens’ in the earlier mark does not help to differentiate them visually. I also note fair and notional use of the earlier marks allow for their use in the colour green, and so again the colour combination used adds only minimally to the visual differences. I note the marks differ through the use of the number 8 in the earlier word marks and the number 5 in the contested mark, although I consider there are certain visual similarities between the single number 5 and the single number 8. A prominent visual difference lies in the use of the hand motif included and incorporated into the number 5 in the contested mark which is not present in the earlier marks. I note the differences are at the start of the marks where they tend to have more impact on the consumer.[22] Overall, considering the points of visual similarity and difference, I find the earlier word marks to be visually similar to the contested mark to a between a medium and high degree.

Aural comparison

65. Aurally, the earlier word marks will read in the normal way as the two words ‘eight-greens’. The contested mark will read in the normal way as the two words ‘five-greens’. They are the same length, both being two syllables, and coincide through the use of the identical second word and syllable. Again, I note the differences lie at the beginning of the marks. Overall, I consider them to be aurally similar to just below a medium degree.

Conceptual comparison

[22] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

66. I note in his evidence, Mr Mohammed provides a dictionary definition of the word ‘Greens’. This explains:

Definition of 'greens'

greens

Word Frequency

in British English

(gri:nz)

PLURAL NOUN

1. *cookery*
   the edible leaves and stems of certain plants, eaten as a vegetable
   You must eat your greens.
2. freshly cut branches of ornamental trees, shrubs, etc, used as a decoration
3. *vulgar, slang*
   sexual intercourse

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67. It is my view that, in the context of the goods, the consumer would construe the element ‘greens’ as meaning edible green vegetables, as in the first definition above. This is the case for both the contested mark and the earlier word marks. The idea that the consumer should have five fruit and vegetables a day is widely known in the UK, and it is my view that the contested mark will convey to at least a significant portion of consumers the idea of their five daily vegetables, alluding to the fact that the goods may contain these or their nutritional equivalent. The image of the hand holding up five digits reinforces the concept of the number 5 in this respect.

68. Whilst it is my view that the number 8 has no particular relevance to ‘greens’ in the UK, I still consider that the use of it in the earlier word marks will likely be considered in the context of the mark as a whole as a reference to the number of ‘greens’, i.e. as reference to 8 portions or 8 different types of green vegetable, or in the context of the goods, as alluding to their nutritional equivalent.

69. Considering the similarities and the differences, I find the marks conceptually similar to a fairly high degree.

The earlier stylised marks

Visual comparison

70. Visually, the earlier stylised marks and the contested mark coincide through the shared use of the word ‘greens’, although the stylisation of this word differs. Notably,

the use of the hand element in the contested mark, as well as the use of the number 5 as opposed to the number 8 differentiates them visually, in addition to the differences in layout. The earlier marks include the number 8 element in a large font above the word ‘greens’, whereas the number 5 and hand element in the contested mark is roughly the same size and is in line with the rest of the text. One of the stylised marks is filed in green, and one is filed in black (and I consider it may be used in green), meaning the colour combination used in the contested mark does not add considerably to the visual differences. The stylised marks include the additional small circle containing the text 8G and the half circle which is not present in the contested mark, however this does not make a big impact visually due to its small size. Overall, I consider the marks to be visually similar to between a low and medium degree.

Aural comparison

71. Due to its very small size in relation to the marks overall, I do not believe that ‘8G’ in the earlier stylised marks will be verbalised. I therefore find the aural comparison here to be identical to that already conducted with reference to the earlier word marks. The marks are aurally similar to just below a medium degree.

Conceptual comparison

72. I consider these earlier marks contain the same elements 8 and GREENS as the earlier word marks. There is also the additional small circle containing the number and letter ‘8G’ with the half circle below, which may be interpreted by some as a play on a smiley face. As I find ‘8G’ will likely be considered to stand for ‘8 GREENS’, it does not have meaningful impact on the concept of the mark. In addition, even where this element is considered to be a smiley face, I do not find this will considerably alter the overall concept conveyed by the mark, which again I find will be of 8 different green vegetables or 8 portions of green vegetables, or in the context of the goods as alluding to their nutritional equivalent. Overall, for the reasons previously set out in relation to the earlier word marks, I find the earlier stylised marks to be conceptually similar to the contested mark to a fairly high degree.

Average consumer and the purchasing act

73. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

74. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

75. The average consumers of the goods will primarily be members of the general public. In relation to food supplements, they will likely consider the quality, health benefits and nutritional value of the goods prior to making a purchase. On that basis, I find they will pay a medium level of attention when purchasing the same. I consider there will also be a number of professional consumers of the goods, including those purchasing these for the purpose of stocking supermarkets, pharmacists, or health stores, or for example, dieticians purchasing the goods to pass on to their clients. These consumers will likely pay a slightly higher level of attention when purchasing the goods due to the increased liability that comes with passing these goods on to end users, and the impact poor quality goods may have on their respective businesses overall.

76. The purchasing process will likely be primarily visual, with the goods being stocked and on display in retail or wholesale stores, or advertised online. However, I also consider there may be an aural aspect to the purchase, for example where consumers are recommended various supplements by professionals such as dieticians, or by

friends or family. In addition, verbal assistance might be sought from retail staff, and wholesale orders may be placed over the phone. I therefore cannot completely discount the aural considerations in this instance.

Distinctive character of the earlier trade marks

77. 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 C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

78. In the context of the goods, all of the earlier marks relied upon allude to the idea that they may contain 8 different types of green vegetable or 8 portions of green vegetables, or that they may hold their equivalent nutritional value. I do not consider the stylisation of the earlier stylised marks to add significantly to their distinctive character. Overall, I find the inherent level of distinctive character across the earlier marks to be low.

79. TG has filed evidence demonstrating the use of its marks. When considering if the distinctive character of an earlier mark has been enhanced through this use, it is the perception of the UK consumer at the relevant date (that being the filing date of 8 September 2021) that is key.

80. Evidence filed by both parties demonstrates that goods under the earlier marks were launched in the UK in October 2020, when TG launched effervescent tablets under the mark 8Greens. I note the small amount of press evidence covering this launch in the UK. I note access to TG's UK website offering goods under the 8Greens marks predates this launch, dating back to 21 May 2020. Whilst it is not easy from the evidence provided to determine the exact number, I note at its peak there appear to have been multiple thousand monthly page views of TGs UK website showing the mark prior to the relevant date. I note the newsletter distribution figures, as well as the £100,000 spend on digital advertising by TG between January and September 2021. Further, I note the confidential sales figures provided for 2020 and 2021. I also note the list of retailers stocking the goods including well-known, high-end retailers such as Harrods and Selfridges, although it is clear from the sales figures that not all of the retailers mentioned were stocking the goods prior to the relevant date. Whilst I note the press articles which include TG's products under the 8Greens mark in lists of 'best', 'top' or 'most viral', I note these postdate the relevant date. I also note the social media presence, but I agree with Mr Mohammed that much of this appears to be aimed at a US consumer, and the UK following is not clear.

81. I have not been provided with evidence of the size of the UK market for the goods, but it is my view this will likely be relatively large. Whilst it is clear there has been some use of the marks (or at least of the word marks) prior to September 2021, I consider this has been over a short period of time, there is limited press evidence relating to this time, and the sales and advertising figures provided for this period are, whilst healthy, relatively modest. Considering the evidence as a whole, I do not consider it sufficient to show that the distinctiveness of the earlier marks will have been enhanced above the inherent level by virtue of their use and exposure to the UK consumers prior to the relevant date.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

82. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 52 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier marks will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[23] I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

83. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[24]

84. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this

[23] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.
[24] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

85. I consider firstly the likelihood of direct confusion. I note I found the earlier word marks to be the most similar to the contested mark in this instance. If I find no likelihood of confusion based on an earlier word mark, it follows that the opposition will fail on the basis of the earlier stylised marks. Should the opposition succeed on the basis of an earlier word mark, there will be no need to continue with my assessment based on the stylised marks. I will therefore continue with my assessment based on the earlier word mark 8 GREENS under series registration no. 3427204 covering *food supplements* in class 5 only at this stage, as I find it (jointly with the other word marks) presents TG's most favourable position in this opposition.

86. I remind myself that I found the goods covered by the earlier mark and the contested mark to be identical. Further, I found the marks to be visually similar to between a medium and high degree, conceptually similar to a fairly high degree, and aurally similar to just below a medium degree. I found the consumer will generally purchase the goods visually, but that I cannot completely discount the aural comparison. I found the general public will pay a medium degree of attention in respect of these purchases, whilst the level of attention paid by the professional consumer will be slightly higher. I found the earlier mark will hold only a low degree of distinctive character, and that this will not have been enhanced by virtue of its use at the relevant date.

87. Considering all of the factors set out above, it is my view that there will be a likelihood of direct confusion between the marks in this instance, at least in respect of a significant portion of consumers, those being members of the general public. Whilst I note the slight conceptual difference created through the use of 5 vs 8, with '5 a day' being a generally known recommendation, I do not consider this will be enough to remove the likelihood of direct confusion considering the identity of the goods, the medium to high level of visual similarity, and the obvious remaining conceptual commonality. Bearing in mind the consumers imperfect recollection, it is my view that where they are paying a medium level of attention only, consumers are likely to fail to notice or remember the differences between the marks in these circumstances, which is simply the number 5 versus 8 as well as some stylisation to the contested mark.

88. For completeness, I note here that in reaching the conclusion above, I have taken into account the low level of distinctive character held by the earlier mark, and I am mindful that a degree of caution is required before finding a likelihood of confusion on the basis of common elements which are either descriptive or are low in distinctive character.[25] However, I am also alive to the fact that a low level of distinctive character does not preclude a likelihood of confusion,[26] and it is my view that this matter is one where the low level of distinctiveness of the earlier mark does not outweigh the other factors at play.

89. However, in case I am wrong in my finding of direct confusion, I will go on to consider if there will be a likelihood of indirect confusion between the marks. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

> "17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

[25] *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)
[26] *L'Oréal SA v OHIM*, Case C-235/05 P

90. I note that the examples above were intended to be illustrative and are not exhaustive. However, I also note *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which 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 is not a consolation prize 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.

91. Keeping in mind all of the factors previously set out, it is my view that in this instance the marks fall within category (c) as set out in *L.A. Sugar* above. Whilst I bear in mind at all times the low level of distinctive character held by the earlier mark, it is my view that it would be an entirely logical brand extension for a party offering food supplements under the contested mark containing 5 different types or portions of green vegetables or their nutritional equivalent, to extend their range to also offer food supplements containing 8 types or portions of vegetables or their nutritional equivalent under the mark 8 Greens. If consumers notice the differences between the marks, it is my view that a significant portion are likely to believe that the marks nonetheless derive from the same economic undertaking on this basis. I therefore find a likelihood of indirect confusion between the marks.

Opposition based on section 5(3)

Legislation

92. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

93. Section 5(3A) states:

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

94. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

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

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
>
> (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

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

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

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV,* paragraph 40*.* The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oréal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial

> compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure).*

96. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the opponent must prove it holds a reputation for the earlier marks relied upon amongst a significant portion of the public. It must also be established that the marks are similar to the contested mark. If it is found both that the marks are similar and that the earlier marks hold a qualifying reputation it must then be shown that this reputation, combined with the similarity between the marks will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

97. The relevant date for consideration under section 5(3) of the Act is the application date of 8 September 2021.

Reputation

98. 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."

99. I have summarised the key elements of the evidence of use of the mark prior to the relevant date when assessing whether the distinctive character of the earlier marks had been enhanced through use under section 5(2)(b) of the Act. Whilst these are different assessments, I note here again that the sales figures and advertising spend from prior to the relevant date are healthy but relatively modest, there is limited press coverage from that time, and the goods were only launched in the UK 11 months prior to the relevant date. Whilst I was not provided with details of the size of the market for food supplements in the UK, as previously noted I consider this will be relatively large. Considering the sum of the evidence provided, it is my view that it does not suffice to show that a significant part of the public concerned by the goods covered by the marks will have been aware of these at the relevant date. As I do not consider the earlier marks held a qualifying reputation at the relevant date, the opposition based on section 5(3) of the Act must fail.

Final Remarks

100. The applications for the invalidation of the earlier marks failed in their entirety. Subject to any successful appeal, registration nos. 3281870, 3427204 and 3427213 will remain on the register in respect of all of the goods and services currently registered.

101. The opposition based on section 5(2)(b) of the Act has succeeded in its entirety. Subject to any successful appeal, the application will be refused registration in respect of all of the goods applied for.

102. Whilst the opposition based on section 5(3) of the Act has failed, this has no bearing on the final outcome due to the complete success of the opposition based on section 5(2)(b).

COSTS

103. TG has been successful in both matters and is entitled to a contribution towards its costs in these consolidated proceedings. In the circumstances I award TG scale costs in accordance with Tribunal Practice Notice 2/2016[27] and 1/2023[28] to the sum of £1450, as a contribution towards the cost of the proceedings. The sum is calculated as follows:

The opposition	
Official fees for the opposition:	£100[29]
Preparing and filing the TM7 and considering the TM8:	£250
The invalidation	
Considering the TM26(I) and preparing and filing the counterstatement:	£300
The joint proceedings	

[27] This scale is relevant to the opposition proceedings launched prior to the introduction of the updated scale from 1 February 2023.
[28] This scale is relevant to the three applications for invalidation launched after 1 February 2023.
[29] The official fee has been reduced to reflect the success of the 5(2)(b) ground only.

Preparing and filing the evidence and considering the other side's evidence:	£800
Total:	£1450

104. I therefore order Islam Mohammed to pay Tasty Greens LLC the sum of £1450. 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 18th day of July 2024

Rosie Le Breton

For the Registrar

Annex A

Specification relied upon under registration no. 3281870

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; dissolving or effervescent tablets primarily containing vitamins and herbs to make vitamin enhanced beverages; nutritional supplements in the form of gummies; gummy vitamins.

Annex B

Specification relied upon under registration no. 3427204

Class 5: Dietary supplements; dietetic preparations; dietary supplements in tablet form containing collagen; vitamins and vitamin preparations; vitamin supplements; vitamin tablets; gummy vitamins; soluble vitamin tablets; effervescent vitamin tablets; dissolving or effervescent tablets primarily containing vitamins and minerals used to make vitamin enhanced beverages; multi-vitamin preparations; mineral supplements; health food supplements made principally of vitamins and minerals; probiotic supplements; food supplements; meal replacement drinks, powders and bars; digestive enzymes; vitamin enriched foods; nutritional supplements; food supplements; health food supplements; protein dietary supplements; protein powder dietary supplements; powdered nutritional supplement drink mix; liquid nutritional supplements; antioxidants; antioxidant pills; dietary supplemental drinks in the nature of vitamin and mineral beverages; nutritional drink mix for use as a meal supplement; powdered electrolyte replacement drink mix for medical purposes; electrolyte replacement beverages or drinks for medical purposes; medicinal herbs; extracts of medicinal herbs.

Class 32: Mineral and aerated waters and other non-alcoholic drinks; sparkling waters; fruit drinks; fruit juices; smoothies; vegetable juices; vegetable smoothies; protein smoothies; protein drinks; powder for making drinks; non-alcoholic drinks; sparkling juice based beverages; soda beverages; coconut water; cordials; cold pressed juices; raw fruit juices; raw vegetable juices; frozen fruit-based drinks; frozen vegetable based drinks; beverages containing vitamins; beverages containing vitamins; vitamin enhanced beverages; beverages made from powdered vegetables or herbs.

Class 44: Nutrition and dietetic consultancy; nutrition counselling; nutritional guidance; nutritional therapy and advice; providing nutritional information about foods and diet; providing information relating to dietary and nutritional guidance; diet planning and supervision; dietary advice; health assessment surveys; health consultancy; information, advisory and consultancy services in relation to the aforesaid services.

Annex C

Specification relied upon under registration no. 3427213

Class 5: Dietary supplements; dietetic preparations; dietary supplements in tablet form containing collagen; vitamins and vitamin preparations; vitamin supplements; vitamin tablets; gummy vitamins; soluble vitamin tablets; effervescent vitamin tablets; dissolving or effervescent tablets primarily containing vitamins and minerals used to make vitamin enhanced beverages; multi-vitamin preparations; mineral supplements; health food supplements made principally of vitamins and minerals; probiotic supplements; food supplements; meal replacement drinks, powders and bars; digestive enzymes; vitamin enriched foods; nutritional supplements; food supplements; health food supplements; protein dietary supplements; protein powder dietary supplements; powdered nutritional supplement drink mix; liquid nutritional supplements; antioxidants; antioxidant pills; dietary supplemental drinks in the nature of vitamin and mineral beverages; nutritional drink mix for use as a meal supplement; powdered electrolyte replacement drink mix for medical purposes; electrolyte replacement beverages or drinks for medical purposes; medicinal herbs; extracts of medicinal herbs.

Class 32: Mineral and aerated waters and other non-alcoholic drinks; sparkling waters; fruit drinks; fruit juices; smoothies; vegetable juices; vegetable smoothies; protein smoothies; protein drinks; powder for making drinks; non-alcoholic drinks; sparkling juice based beverages; soda beverages; coconut water; cordials; cold pressed juices; raw fruit juices; raw vegetable juices; frozen fruit-based drinks; frozen vegetable based drinks; beverages containing vitamins; beverages containing vitamins; vitamin enhanced beverages; beverages made from powdered vegetables or herbs.

Class 44: Nutrition and dietetic consultancy; nutrition counselling; nutritional guidance; nutritional therapy and advice; providing nutritional information about foods and diet; providing information relating to dietary and nutritional guidance; diet planning and supervision; dietary advice; health assessment surveys; health consultancy; information, advisory and consultancy services in relation to the aforesaid services.