o/0841/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003838015

BY VARGAS MARCAS E PARTICIPAÇÕES LTDA

TO REGISTER THE TRADE MARK:

IN CLASSES 3 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 438698

BY NORWEX HOLDING AS

BACKGROUND AND PLEADINGS

1. On 11 October 2022, VARGAS MARCAS E PARTICIPAÇÕES LTDA ("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 21 October 2022. The applicant seeks registration for the following goods and services:

Class 3 Hair products, namely, shampoos, conditioners, styling gels, hair sprays, hair lacquers, hair bleaching preparations, hair colouring preparations, depilatory preparations; deodorants for personal use; cosmetics, namely, lipstick, foundation, blush, eye shadow, mascara, eyeliner, lipstick liner; skin care products, namely, cleansers, toners, moisturizers, eye creams, makeup remover, beauty masks; fragrance products, namely, cologne, eau de toilette, perfume; shaving products, namely, after shave, shaving cream, shaving gel, shaving lotion.

Class 35 Marketing, importation and exportation of cosmetics.

2. The application was opposed by Norwex Holding AS ("the opponent") on 20 January 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act ("the Act"), and the opponent relies upon the following marks:

NORWEX

Comparable UK trade mark (EU) registration no. UK00912885109
Filing date 19 May 2014.
Registration date 08 October 2014.
("the First Earlier Mark")

NORWEX

Comparable UK trade mark (EU) registration no. UK00912769287

Filing date 7 April 2014.
Registration date 23 December 2015.
("the Second Earlier Mark")

NORWEX

Comparable UK trade mark (EU) registration no. UK00903607819
Filing date 12 January 2004.
Registration date 26 April 2005.
("the Third Earlier Mark")

3. 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.

4. The opponent relies upon some of its goods and services, contained within Annex 1 of this decision.

5. The opponent claims there is a likelihood of confusion because of the similarity of the marks, the high level of inherent distinctiveness of the earlier marks, and the identity/close similarity of the goods and services.

6. The applicant filed a counterstatement denying the claims made and put all three earlier marks to proof of use.

7. A hearing took place before me on 5 June 2024. The applicant was represented by Debra Lewis of Hoffmann Eitle PartmbB. Albeit not present at the hearing, and no submissions in lieu were filed, the opponent is represented by Venner Shipley LLP. I make this decision having taken full account of all the papers, referring to them below as necessary.

RELEVANCE OF EU LAW

8. 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

9. The opponent's evidence consists of the witness statement of Erik Haugen dated 17 August 2023. Mr Haugen is the General Counsel of Norwex Malta Ltd, a position he has held since January 2021. Mr Haugen's statement is accompanied by 6 exhibits (EH1-EH6).

10. The applicant's evidence consists of the witness statement of Debra Lewis dated 17 October 2023. Ms Lewis is a registered Trade mark Attorney, and her statement is accompanied by 9 exhibits (DDL1-DDL9).

11. Whilst I do not propose to summarise the opponent's and applicant's evidence and submissions here, I have taken them all into consideration and will refer to them below where necessary.

DECISION

Section 5(2)(b)

12. 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."

13. The opponent's marks qualify as earlier marks in accordance with section 6(1)(aa) as their filing dates are earlier than the filing date of the applicants' 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

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

15. 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."

16. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks are the five years ending on the filing date of the applicants' mark, i.e. 12 October 2017 to 11 October 2022. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the entirety of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant.

17. 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

18. I note the following from the opponent's evidence:

a) **Exhibit EH1** contains a licence agreement between Norwex Malta Ltd and the applicant dated "1 Mars 2018". The agreement lists the Third Earlier Mark (and its classes 3, 21 and 24) as an intellectual property right that Norwex Malta Limited has exclusive use of. It also states that a licence agreement between the parties was first entered into on 7 December 2011, which was replaced by an agreement dated 12 June 2012, 1 October 2014 and 1 January 2016.

    a. Under 1.1 of the licence agreement it states that *"subject to the terms and conditions set forth in this Agreement, Licensor hereby grants a Licensee an exclusive, royalty-bearing, nontransferable license in the IP, to use the IP exclusively for Licensee's business".*

b) I note that Mr Haugen has not clarified whether 1.1 above was also contained within the 2012, 2014 and 2016 agreements.

c) At paragraph 3 of his witness statement, Mr Haugen says that Norwex Malta Limited has been using the NORWEX mark in the UK and EU, especially the Baltic States, Ireland and Germany.

d) During the relevant period, the following value of NORWEX products have been sold under the above licence agreement:

Country	2017(€)	2018(€)	2019(€)	2020(€)
Estonia	271,356	222,065	267,424	364,789
Latvia	238,701	239,419	286,581	453,603
Lithuania	326,868	368,485	292,823	526,436

e) Norwex Malta Limited's website is www.norwex.eu and exhibited at **EH2** are "sample pages" from it. I note that these screenshots are undated, however, they have a copyright date of 2023. Moreover, next to the copyright date it says "Norwex United Kingdom/Norwex Norge AS All Rights Reserved".

f) In Mr Haugen's witness statement, he says that **Exhibit EH3** contains pages from Norwex Malta Limited's catalogues for 2017 to 2021 "for the United Kingdom". I note that at the bottom of the 2019, 2020 and 2021 catalogues, it shows the following reference to Norwex UK Ltd and Norwex Ireland Ltd:

g) I note that the catalogues in **exhibit EH3** contain a variety of household and personal care items, which is supported by sample of invoices from "Norwex

UK Ltd" contained within **exhibit EH4**. As the opponent is relying upon its class 3 personal care items, I have only cross-referenced these types of goods from the catalogues to the London, UK invoices and note the following:

Invoice date	Invoice number	Goods description and item number	Photo of the goods and their cost (£)
27/11/2017 01/11/2018 02/11/2018	IN30021302 IN30023120 IN30023121	Shower gel 200ml (403160) Shower gel 500ml (403161)	**Shower Gel** Derivatives from Fruit Sugar, Sweet Pineapple, Coconut and Lemon provide a light, citrus scent and gently cleanse the skin, while Aloe Vera nourishes and moisturises. The gel's gentle foaming action delights everyone, from the youngest to the oldest members of the family. *Produced on shared equipment that processes nuts.* Size: 200 ml Item #: 403160 **£13.99 €16.99** **Family Size** 500 ml Item #: 403161 **£23.99 €29.49**
02/11/2018	IN30023121	Family bodylotion bio-pineapple (403115)	**Body Lotion** Natural botanicals like Coconut Oil, Grape Seed Oil, Organic Aloe Vera, Organic Sweet Almond Oil, Organic Shea Butter and Vitamin E combine to nourish and moisturise the skin, leaving it silky smooth, conditioned and soft. Pineapple and Lemon Peel extracts create a pleasant, light scent and further protect and soften. Great for the whole family! *Contains nut-derived ingredients.* Size: 200 ml Item #: 403155 **£15.99 €19.49** **Family Size** 500 ml Item #: 403156 **£31.99 €39.99**
02/11/2018 03/11/2018	IN30023121 IN30023122	Hand cream sheabutter & grape seed oil (403150)	**Hand Cream** Natural emollients from Grape Seed Oil, Coconut Oil, Shea Butter and other botanicals penetrate deeply to soften and condition rough, dry hands. Vitamin E and Organic Aloe Vera help protect, nourish and moisturise. *Contains nut-derived ingredients.* Size: 75 ml Item #: 403150 **£11.99 €14.99**
03/11/2018 19/06/2020	IN30023122 IN30023737	Naturally timeless day cream (403081) Naturally timeless night cream (403086) Naturally timeless radiant eye cream (403096)	**Naturally Timeless Radiant Eye Cream** A unique ingredient extracted from the Persian Silk Tree *(Albizia)* helps reduce the visible appearance of dark circles, fine lines and under-eye puffiness. Apple Stem Cells, Multi-Peptides and plant-based moisturisers combine to help hydrate the delicate tissue under the eyes, leaving them more youthful-looking and radiant with just a drop. *Produced on shared equipment that processes nuts.* Size: 15 ml Item #: 403096 **£23.99 €29.49** **Naturally Timeless Day Cream** Help diminish the appearance of aging with this daily age-defying moisturiser formulated to provide intense hydration and improve elasticity. Apple Stem Cells, precious plant oils and Shea Butter defend against wrinkles, seal in moisture and boost your skin's radiance. *Contains nut-derived ingredients.* Size: 50 ml Item #: 403081 **£46.99 €58.99**

13/08/2019	IN30023415	Naturally Timeless Set (NTS1)	**Naturally Timeless Set** SAVE 10% (1) Facial Serum (1) Day Cream (1) Anti-Gravity Night Cream (1) Radiant Eye Cream Item #: NTS1 **£148.99 €185.99** Retail price: £165.96 €206.46
19/06/2020	IN30023737	Naturally timeless firming facial serum (403091)	**Naturally Timeless Firming Facial Serum** Look more radiant, revitalised and glowing. This nourishing, plant-powered serum enriched with Apple Stem Cells, Multi-Peptides and Sea Algae visibly firms and smoothes skin for a more youthful appearance. *Produced on shared equipment that processes nuts.* Size: 50 ml Item #: 403091 **£47.99 €58.99**
19/06/2020	IN30023737	Body balm organic (403170) Peppermint foaming hand soap (403195, 403197)	NEW IN MARCH **Body Balm** Quickly glide away chapped, dry skin on heels, elbows, hands and knees. Our Body Balm blends rich, USDA certified organic ingredients to quickly help hydrate, rejuvenate and restore rough, cracked skin. With its citrusy, minty aroma, this soothing, super-emollient balm feels and smells so wonderful, you'll want one for home, work and travel! Size: 77 g Item #: 403170 **£19.99 / €20.99** **Peppermint Foaming Hand Wash** Transform an everyday task into something exhilarating! Let the invigorating peppermint aroma of our Foaming Hand Wash awaken your senses as the rich, natural ingredients leave your skin feeling soft and silky smooth. Peppermint, Coconut and Apple extracts combine to thoroughly cleanse hands, while Panthenol, Allantoin and Aloe provide extra moisture! Perfect for the bathroom as well as the kitchen. Vegan (no animal-derived ingredients) and free of SLS, SLES, parabens, pthalates, gluten and artificial dyes and fragrances. *Produced on shared equipment that processes nuts.* Size: 250 ml Item #: 403195 **£12.99 €15.99** **Peppermint Foaming Hand Wash Refill** Size: 946 ml Item #: 403196 **£22.99 €29.49**
03/11/2018 21/05/21	IN30023122 616018	Deodorant stick (403602) (600249)	NEW **Deodorant Stick** Our Deodorant Stick uses a gentle blend of essential oils and natural ingredients like Aloe Vera, Tea Tree and Sage to help soothe skin. Combats odour-causing bacteria, giving you the long-lasting freshness you need to feel confident all day. This powerful deodorant is the perfect alternative to traditional antiperspirants that may contain triclosan, phthalates, synthetic preservatives and other harmful chemicals. Size: 50 ml Item #: 403602 **£17.99 / €19.99** **Deodorant Stick** Sustainable bio-enzymes neutralise odour-causing bacteria and give you all-day freshness and confidence! With a gentle blend of essential oils, Aloe Vera, Tea Tree and Sage to soothe skin, our Deodorant Stick is the perfect, powerful alternative to traditional antiperspirants containing triclosan, phthalates, synthetic preservatives and other harmful chemicals. *Contains nut-derived ingredients (coconut, palm nut).* Size: 50 ml 600249 **£16.99 / €19.99**
19/06/2020	IN30023737	Lysere hand lotion (600237) Shampoo (600300) Conditioner (600305)	**Lysere™ Hand Lotion** Bring long-lasting comfort and supple softness to rough, dry hands with our luxurious Macadamia Seed Oil and Vitamin E blend. Rich in antioxidants, it's ultra-hydrating, nourishing and non-greasy, plus it absorbs quickly for smoother, more beautiful hands now. *Contains nut-derived ingredients (macadamia nut, palm nut, coconut).* Size: 59 ml 600237 **£12.99 / €14.99** **Lysere Daily Hair Shampoo** Gently invigorating, plant-derived ingredients including Guar Bean and Pro-Vitamin B5 soften and clean your hair, while a special blend of essential oils leaves it fresh-smelling. Natural extracts of Sugar Cane and Orange Fruit cleanse away daily build-up, promoting healthier hair and scalp, while Bilberry Extract adds powerful antioxidant protection. *Contains nut-derived ingredients (coconut).* Size: 355 ml 600300 **£23.99 / €27.99** **Lysere Daily Hair Conditioner** Pro-Vitamin B5, Meadowfoam Oil and Sunflower Seed Oil help soften and condition your hair, while Sugar Maple Extract helps to smooth hair cuticles and Bilberry Extract adds a healthy sheen. A special blend of essential oils leaves your hair fresh-smelling. *Contains nut-derived ingredients (palm nut, coconut).* Size: 355 ml 600305 **£23.99 / €27.99**

h) Regardless of whether the mark is clearly affixed to the product within the brochure, all of the front pages of the brochures use the following mark:

i) Mr Haugen states that Norwex Malta limited sells its products through its website and via consultants, whereby they "use their personal networks to arrange parties, usually hosted by a friend or family member, and that these parties the company's products are demonstrated" by the consultants.

j) **Exhibit EH5** contains a sample of 4 invoices from "Norwex Baltic SIA". Mr Haugen states that these invoices show Norwex goods which have been sent to Ireland, Latvia, Lithuania and Estonia. Whilst the invoices are not presented in English, I note that the column labelled as "code" clearly shows a product code, which I have cross-referenced with the forementioned catalogues. I therefore note that the only two invoice examples which contain the opponent's personal care goods are as follows:

Invoice date	**Invoice number**	**Goods description and item number**	**Photo**
29/01/2018	022204	Deodorant stick (403602)	NEW Deodorant Stick Our Deodorant Stick uses a gentle blend of essential oils and natural ingredients like Aloe Vera, Tea Tree and Sage to help soothe skin. Combats odour-causing bacteria, giving you the long-lasting freshness you need to feel confident all day. This powerful deodorant is the perfect alternative to traditional antiperspirants that may contain triclosan, phthalates, synthetic preservatives and other harmful chemicals. Size: 50 ml Item #: 403602 £17.99 / €19.99 Norwex

05/06/2019	020418	Crystal deodorant (403600)	

k) **Exhibit EH6** contains screenshots from the opponent’s Norwex Facebook page, dated between 2017 to 2022, promoting various skincare, hair care and body wash goods affixed with the above mark. However, I have not been provided with any evidence of how many followers this page has, or what proportion of followers pertain to the EU and UK. I also note that, as highlighted by Ms Lewis at the hearing, many of the posts contain “US” and “CA” (USA and Canada) website links, which I assume are likely to be links for the products contained within the posts. Therefore I do not consider that this evidence assists the opponent.

Form of the mark

19. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

> “31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestle, the ‘use’ of a mark, in its literal sense, generally encompasses both its

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

20. The First, Second and Third Earlier Marks as registered are: NORWEX

21. Where the earlier marks have been used as registered (such as on the invoices etc.) this will clearly be use upon which the opponent can rely. However, the evidence I have outlined above includes instances of the following variant:

22. The variant consists of the word "Norwex" presented in a blue standard font. However, I note that the letter "O" is presented in a slanted angle, with a green coloured house device presented inside of it (with the chimney being a green leaf, and the centre of the house being a green and blue leaf/teardrop device). Whilst I note that the variant consists of the house device, I consider that the word "Norwex" is clearly visible and still continues to indicate origin within the composite mark. It is therefore an acceptable variant of the First, Second and Third Earlier Marks.

Assessment of genuine use

23. As I have found the variant mark used in the evidence to be acceptable, 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.[1]

24. 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".

25. The evidence provided by the opponent is not without its limitations. At the hearing, Ms Lewis drew my attention to the different Norwex names which are used throughout the evidence, and, for the sake of completeness I note the following:

1. The opponent is Norwex Holding AS.
2. Mr Haugen is the General Counsel for Norwex Malta Ltd.
3. In his witness statement, Mr Haugen confirms that "Norwex Malta Ltd is under the control of Norwex holding AS and uses the NORWEX trade mark for sales of a variety of products under a licence from Norwex Holding AS".

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[1] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

4. **Exhibit EH1** contains an exclusive licence agreement between Norwex Holding AS and Norwex Malta Ltd. The only mark that is not redacted within this agreement is the Third Earlier Mark.
5. **Exhibit EH2** contains screenshots from Norwex Malta Limited's website www.norwex.eu which at the bottom refers to "Norwex United Kingdom/Norwex Norge AS All Rights Reserved".
6. **Exhibit EH3** contains catalogues which say "Norwex UK Ltd" and "Norwex Ireland Ltd" at the bottom of them.
7. **Exhibit EH4** contains sample invoices from Norwex UK Ltd.
8. **Exhibit EH5** contains sample invoices from Norwex Baltic SIA.

26. At the hearing, Ms Lewis submitted that:

> "In the absence of any other information, we can only assume that Norwex Holding AS is the parent company and it has several subsidiaries. They appear to have been formed in different jurisdictions for the purposes of carrying out business in those jurisdictions. We have Norwex Malta Limited, which seems to have been formed for the purposes of carrying out business in Malta, or possibly other parts of the EU, we have Norwex UK Limited, which has been formed for the purposes of carrying out business in the UK presumably, and we have Norwex Baltic SIA, which appears to carry out business in the Baltic states. All of these companies are completely separate. Although they are owned by the same parent company, the relationship between these three subsidiary companies is at arm's length. The fact that they have the same parent company does not mean that one of these companies can control another of these sister companies. They are completely separate legal entities, they are completely independent from each other, they have their own rights, their own responsibilities, their own assets, their own liabilities. In the absence of any kind of contract directly between the subsidiaries, it cannot be inferred that the assets of one of these companies can be used by a sister company over which it has absolutely no control and no connection and no common board members, and none of this has been shown."

27. Ms Lewis went on to submit that Mr Haugen does not claim to be an employee or director of the opponent and therefore his statement and knowledge is limited to the activities of Norwex Malta Ltd only. At the hearing she also submitted that "there is nothing in any of the documents that indicates that he is entitled to give evidence on behalf of the parent company" and the evidence does not mention his relationship with any "other companies in the Norwex group, [i.e.] the sister companies". Ms Lewis argued that "there is no other evidence filed to show any kind of connection between the sister companies of the group", and that the companies Norwex Baltic SIA and Norwex UK Limited "are not mentioned elsewhere in his witness statement" and therefore "we have no idea who these companies are in relation to […] Norwex Malta Limited, and there is no evidence to suggest that Norwex Malta Limited has any kind of control over Norwex UK Limited or Norwex Baltic SIA".

28. I agree with Ms Lewis that from the evidence before me, the applicant appears to be a parent company, with its subsidiaries being Norwex UK, Ireland, Baltic SIA and Malta. These companies are all clearly connected by the "Norwex" name, and the brochure and website evidence also connects them as it is clear that Norwex Malta is using and distributing brochures in the UK which reference its sister UK and Ireland companies. Mr Haugen is the General Counsel for Norwex Malta and has provided sales figures which only pertain to those made via the exclusive licence between Norwex Malta and Norwex Holdings AS. Whilst Mr Haugen has also provided invoices from Norwex UK Limited and Norwex Baltic SA, it is reasonable to infer that all of the aforementioned Norwex companies are related, because, if they were not, Mr Haugen is highly unlikely to have been able to obtain such evidence. Therefore, Mr Haugen is clearly in the position to collate all of this evidence on behalf of the applicant.

29. At the hearing, Ms Lewis also commented on the exclusive licence, and stated that it could be inferred that "all three marks were supposed to be put under the exclusive control of Norwex Malta Limited" and therefore they were in no position to permit its other subsidiaries to use the marks. Of course, this is an inference, and based upon the evidence before me, which has not been subject to cross examination,[2] it is clear

[2] At paragraph 42 of the judgement of *Supreme Court in TUI v Griffiths* [2023] UKSC 48, it endorsed the general rule set in out in Phipson on Evidence (20th ed. Paragraph 12) being that: *"In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases…"*

that the exclusive licence within **exhibit EH1** is only in relation to the Third Earlier Mark. There is nothing to suggest that the redacted information included the remaining marks, and there is nothing within the narrative evidence to suggest this also. On this basis, I will proceed with the rest of my decision that the First and Second Earlier Marks were free for any of the subsidiary companies to use (because they were not bound by an exclusive licence).

30. As noted above, the opponent has provided evidence of sales figures made to the EU countries Estonia, Latvia and Lithuania, from 2017 to 2020, under the above licence agreement. I note that these figures in total amount to €3,858,550.00. I consider that whilst this is not significantly high, it is a notable amount, considering that the goods the opponent sell include lower-costing personal care items (see the table at paragraph 18(g) for example prices). However, I note that the sales figures are not broken down by individual items, and they will include the sale of its household goods which are not being relied upon in this opposition (this is on the basis that the licence agreement lists the Third Earlier Mark's classes as 3, 21 and 24). Therefore, I am unable to determine the specific turnover just for the class 3 personal care items. Nonetheless, I have been provided with extensive brochure evidence, and sample invoices for the EU and UK, from 2017 to 2020, which shows that these goods were sold during the relevant period. Therefore, taking all of the above into account, I am satisfied that the First and Third Earlier Marks have been put to genuine use in the EU and UK for some of its class 3 goods, and I am satisfied that the Second Earlier Mark has been put to genuine use in the EU and UK for some of its class 35 services.

Fair Specification

31. I must now consider whether, or the extent to which, the evidence shows use of the goods and services 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."

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].
>
> vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].
>
> vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

33. As noted above, the opponent is relying upon some of its goods and services, that being class 3 goods and class 35 services contained within Annex 1 to this decision. Therefore, whilst the opponent has provided evidence of sales of a variety of household items, none of these goods are being relied upon for this opposition.

34. It is clear from the invoices to the UK and EU that the opponent has sold deodorants, soaps, shampoo and conditioner, all of which are terms that appear in the First Earlier Mark's specification. I also note that the terms deodorants and soaps appears in the Third Earlier Mark's specification. It is also clear that the opponent has sold body balms, day creams, night creams, eye creams and serums (both individually and as a set- see Naturally Timeless Set NTS1). I therefore consider that the opponent has shown use of the term "preparations for the care of the skin" in the First Earlier Mark and shown use of the term "moisturising creams" in the Third Earlier Mark.

35. The invoices also show the sale of body lotions, hand creams and shower gels. I therefore consider that the term "creams, lotions, gels, serums, milks, oils, powders, foams and mousses for use on the skin, scalp and body" in the First Earlier Mark needs to be narrowed down to "creams, lotions and gels for use on the skin and body" only (which I consider to be an appropriate sub-category).

36. For the opponent's remaining class 3 goods under the First and Third Earlier Mark, I do not consider there to be sufficient use in relation to these goods and therefore the opponent is not able to rely upon them.

37. Consequently, I consider a fair specification for the First Earlier Mark to be:

Class 3 Soaps, deodorants; preparations for the care of the skin; shampoos; conditioners.

38. I consider a fair specification for the Third Earlier Mark to be:

Class 3 Soaps, deodorants; moisturising creams.

39. On the basis that that opponent has been selling day/night creams, eye creams, face serums, body lotions, and hand creams via its website, brochure and consultants, I consider that they have been providing a retail service selling goods which are applied to the user's skin for the purpose of beautifying and enhancement. I consider that these goods would be classified as cosmetics, and therefore the term "retail services connected with the sale of soaps, perfumery, essential oils, cosmetics, hair lotions" in the Second Earlier Mark needs to be narrowed down to reflect the opponent's retail services of the aforementioned goods only, which all are preparations for the care of the skin, (which I consider to be an appropriate sub-categories). For the remaining class 35 terms, the opponent has not shown any use.

40. I therefore consider a fair specification for the opponent's Second Earlier Mark to be:

Class 35 Retail services connected with the sale of preparations for the care of the skin.

Section 5(2)(b) - case law

41. In making this decision, I bear in mind the following principles 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:

(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 and services

42. The competing goods and services are as follows:

Opponent's goods	**Applicant's goods and services**
First Earlier Mark Class 3 Soaps, deodorants; preparations for the care of the skin; shampoos; conditioners. **Second Earlier Mark** Class 35 Retail services connected with the sale of preparations for the care of the skin. **Third Earlier Mark** Class 3 Soaps, deodorants; moisturising creams.	Class 3 Hair products, namely, shampoos, conditioners, styling gels, hair sprays, hair lacquers, hair bleaching preparations, hair colouring preparations, depilatory preparations; deodorants for personal use; cosmetics, namely, lipstick, foundation, blush, eye shadow, mascara, eyeliner, lipstick liner; skin care products, namely, cleansers, toners, moisturizers, eye creams, makeup remover, beauty masks; fragrance products, namely, cologne, eau de toilette, perfume; shaving products, namely, after shave, shaving cream, shaving gel, shaving lotion. Class 35

	Marketing, importation and exportation of cosmetics.

43. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

44. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for

instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the GC stated that "complementary" means:

> "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

47. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted, as the Appointed Person, *in Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

> Whilst on the other hand: "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Whilst on the other hand:

> "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

<u>Class 3</u>

Deodorants for personal use.

48. While expressed slightly differently, the applicant's above goods are self-evidently identical to "deodorants" in the First and Third Earlier Mark's specifications.

Hair products, namely, shampoos, conditioners […].

49. While expressed slightly differently, the applicant's above goods are self-evidently identical to "shampoos" and "conditioners" in the First Earlier Marks's specification.

Skin care products, namely, cleansers, toners, moisturizers, eye creams, makeup remover, beauty masks.

50. The applicant's above goods fall within the broader category of "preparations for the care of the skin" in the First Earlier Mark's specification. They are identical on the principle outlined *Meric.*

Shaving products, namely, […] shaving lotion.

51. The applicant's above goods are used as part of the process to remove hair by shaving, which will be conducted as part of a personal care routine. I note that shaving lotion will be applied to the skin prior to, or after shaving. I also consider that the First Earlier Marks "preparations for the care of the skin" would include goods such as body

lotions which are applied to the skin as part of a personal care routine and could be used for shaving. I therefore consider that the goods overlap in their nature, purpose and method of use, as well as being potentially in competition as the user could choose either to achieve the same result. I also consider that the goods will be sold in the same aisle of beauty retail outlets, pharmacies or supermarkets. Consequently, the goods are similar to at least a medium degree.

Cosmetics, namely, lipstick, foundation, blush, eye shadow, mascara, eyeliner, lipstick liner.

52. The applicant's above goods are similar to the First Earlier Marks "preparations for the care of the skin" and the Third Earlier Marks "moisturising creams". All of these class 3 goods are applied to the user's skin, improving the appearance of it, for the purpose of beautifying and enhancement. For example, a moisturising cream and foundation will both be applied to the user's face to improve its complexion. Therefore the goods overlap in purpose. I note that the applicant's cosmetics are also very similar in nature to the opponent's goods, which can all appear in a liquid or cream form. However, I appreciate that the applicant's goods can also come in other forms such as powders and pencils. Whilst the goods are clearly not in competition nor complementary, they will be used together (including my example of moisturiser and foundation), as part of the user's cosmetic routine. The goods will also overlap in distribution channels, being sold in close proximity in beauty retail outlets, pharmacies or supermarkets. I therefore consider that the goods are similar to a medium degree.

Hair products, namely, […] styling gels, hair sprays, hair lacquers, hair bleaching preparations, hair colouring preparations, […].

53. I consider that the applicant's above goods are similar to "shampoo" and "conditioner" in the First Earlier Mark's specification. All of the goods would be sold by the same hair care undertakings, overlapping in trade channels, and all of the goods would be sold in the same aisle of beauty retail outlets and supermarkets. I also consider that there would be an overlap in overall purpose, as they are all used to improve the appearance of the user's hair. However, the goods will not overlap in

nature, and they are neither in competition nor complementary. I therefore find the goods similar to a medium degree.

Fragrance products, namely, cologne, eau de toilette, perfume.

54. The applicant's above goods are similar to the First Earlier Mark's "preparations for the care of the skin" which would include body lotions and hand creams. I consider that albeit the goods differ in nature, method of use and purpose, and they are neither in competition nor complementarity, there may be an overlap in trade channels as these goods can be sold alongside each other as a set/gift set. Therefore as they are produced by the same undertaking, they overlap in trade channels. The goods can also be fragranced with the same scents and would be bought by the same user. I consider that the goods are similar, but to between a low and medium degree.

Hair products, namely, […] depilatory preparations.

55. The applicant's above goods would include hair removal products such as hair removal cream and wax strips. Whilst "shampoo" and "conditioner" in the First Earlier Mark's specification are types of hair products, they are used for significantly different purposes to the applicant's above goods (removal vs cleaning). The goods will also differ in nature and method of use, and whilst the goods may be sold in beauty retail outlets and supermarkets, they would not be located in the same aisle. The goods are neither in competition nor complementary and therefore they are dissimilar.

56. For the sake of completeness, I note that hair removal cream will overlap to some extent in nature with "moisturising creams" in the Third Earlier Mark's specification. I also note that whilst these goods will be sold in beauty retail outlets, pharmacies or supermarkets, they will not be sold in close proximity. Moreover, the goods clearly do not overlap in purpose or method of use, as the applicant's hair removal cream is temporarily applied to the user's skin, and scraped away with the hair, whereas moisturising creams sink into the user's skin. They are clearly neither in competition nor complementary. Therefore, taking all of the above into account, I consider that these goods are dissimilar.

Shaving products, namely, after shave, shaving cream, shaving gel, […].

57. The applicant's above goods are placed on the skin either before or after shaving. Whilst is it arguable that the shaving cream, for example, will overlap in nature with the opponent's "moisturising creams" in the Third Earlier Mark's specification, the purpose and method of use of the goods differ. Moreover, the nature of after shave and shaving gel also differs to the opponent's "moisturising creams". The goods are neither in competition nor complementary. Whilst there may be an overlap in distribution channels and user, being sold in beauty retail outlets, pharmacies or supermarkets, these goods will not be sold in close proximity. Taking all of the above into account, I find that the goods are dissimilar.

<u>Class 35</u>

[…], importation and exportation of cosmetics.

58. I do not consider that the opponent's "retail services connected with the sale of preparations for the care of the skin" are similar to the applicant's above services. Without any evidence or submissions before me, I do not consider that the services overlap in nature, purpose or method of use. Whilst the importation of cosmetics may facilitate and allow retail services to sell cosmetics (including, for example, preparations for the care of the skin), the average consumer would not believe that the services originate from the same undertaking. The applicant's services would be provided by specialist importation and exportation companies, whereas the opponent's services would be provided by retailers and retail stores. The services are clearly neither in competition nor complementary. Taking the above into account, I find that the services are dissimilar.

Marketing, […] of cosmetics.

59. I do not consider that the opponent's "retail services connected with the sale of preparations for the care of the skin" are similar to the applicant's above services. Whilst a retailer that sells cosmetics (including preparations for the care of the skin) may market or use in-house marketing tools/social media to market its cosmetic goods

and retail services, the retailer itself does not provide a marketing service that falls within class 35 because it does not provide marketing as a service to third party undertakings. Therefore, applicant's "marketing of cosmetics" would be provided by specialist marketing companies, which provide marketing for third parties,[3] whereas the opponent's services would be provided by retailers and retail stores. The services clearly do not overlap in nature, purpose or method of use as the applicant's services are marketing whereas the opponent's services are retail. Therefore the services are clearly neither in competition nor complementary, and I find that the services are dissimilar.

60. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the goods and services that I have found to be dissimilar.[4]

61. The opposition under section 5(2)(b) fails for the following goods and services:

Class 3	Hair products, namely, depilatory preparations; shaving products, namely, after shave, shaving cream, shaving gel.
Class 35	Marketing, importation and exportation of cosmetics.

62. I note that as I have found no similarity with the Second Earlier Mark's services, the opponent cannot rely upon it for the remainder of this decision.

The average consumer and the nature of the purchasing act

63. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

[3] I rely on the application of *Avnet Incorporated v Isoact Limited* [1998] FSR 16, paragraph 18, which was applied by Mr Justic Holgate in *Extreme E Ltd v Extreme Networks Ltd* [2024] EWHC 319 (Ch) (12 February 2024) at paragraphs 26 and 32 to 33.
[4] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J (as he then was) 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."

64. The average consumer for the goods will be members of the general public, however, I do not discount that it could also include a professional user such as a hairdresser or beautician. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, aesthetic, scent and the suitability for their specific needs. Therefore, the level of attention paid during the purchasing process will be medium.

65. The goods are likely to be obtained by self-selection from the shelves of a (beauty) retail outlet, or online equivalent. I also note that cosmetics can be on display with tester products, for the user to test and use in store. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. 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.

Comparison of the trade marks

66. 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."

67. 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.

68. The respective trade marks are shown below:

Opponent's trade marks	**Applicant's trade mark**
NORWEX **(First and Third Earlier Mark)**	novex

69. The opponent's First and Third Earlier Marks consist of the word "NORWEX". There are no other elements to contribute to the overall impression which lies in the word itself.

70. The applicant's mark consists of the word "novex" presented in a standard black typeface, presented in front of a paint stroke "X" device. I bear in mind that the eye is naturally drawn to the element of the mark that can be read, and therefore, the word

“novex” plays a greater role in the overall impression of the mark, with the “X” background device playing a lesser role.

71. Visually, the marks all contain the letters N, O, E and X. These act as visual points of similarity. However, the First and Third Earlier Marks contain the letters R and W in the middle of the marks, and the applicant’s mark contains the letter V in the middle of its mark. The applicant’s mark also consists of the background X device. Whilst these act as visual points of difference, I acknowledge that the letters W and V share some visual similarity (that being the first two diagonal lines which meet at a point at the bottom), and the background X device plays a lesser role in the overall impression (albeit not negligible). On this basis, I consider that the marks are visually similar to between a medium and high degree.

72. Aurally, I consider that the First and Third Earlier Marks are likely to be pronounced as NOR-WEX and the applicant’s mark is likely to be pronounced as NO-VEX. Whilst Ms Lewis submitted that the syllables “NO” and “NOR” and “VEX” and “WEX” do not sound remotely similar, I disagree. The marks clearly share the beginning “NO” aural element in the first syllable, and the “WEX” and “VEX” ending syllables are aurally highly similar, pertaining to the W and V having a similar sound when articulated next to the “EX” element. Therefore, taking the above into account, I consider that the marks are aurally similar to between a medium and high degree.

73. Conceptually, the opponent submits that “neither mark has any obvious meaning in the English language, and therefore there is no conceptual comparison between the marks”. At the hearing, Ms Lewis submitted that the First and Third Earlier Marks brings to mind Norway (which is supported by the catalogue evidence contained in **exhibit EH3** which mentions and includes pictures of Norway) and the applicant’s mark brings to mind the idea of something new. Ms Lewis submits that this is on the basis that the letters “NORW” at the beginning of the First and Third Earlier Marks predominantly relates to Norway, supported by a dictionary extract exhibited in **DLL1.** However, aside from the words Norway and Norwegian, I note that there are other NORW words in this exhibit which do not relate to Norway including norward, nor-west, nor-wester, and Norwich. Ms Lewis also states that, “by contrast, English words which start with “NOVE” predominantly relate to something “new” which derives from

Latin. I note that this is supported by **exhibit DLL2**, however, the extract is from “Wiktionary”, a platform that allows entries to be updated by the public. Therefore I consider that the information from Wikipedia/Wiktionary should be approached with a certain degree of caution.

74. I acknowledge that the opponent’s catalogue evidence does make reference to Norway throughout, including that the opponent was founded in Norway. However, for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[5] On this basis, the catalogue evidence cannot be taken into consideration for the conceptual assessment, and I find that the evidence contained in **exhibits DDL1** and **DDL2** unconvincing. Firstly, I do not consider that the NORW element at the beginning of the First and Third Earlier Marks would convey to the consumer the concept of Norway. The average consumer also does not dissect the mark and therefore reads it as a whole. Consequently, I consider that the average consumer will see the word NORWEX as an invented word with no conceptual meaning. Secondly, I do not consider that the NOVE element at the beginning of the applicant’s mark would be recognised by the average consumer as the Latin word “new”. A significant proportion of UK average consumers would not know Latin, nor dissect this element out of the word NOVEX. I agree with the opponent that NOVEX will also be seen as an invented word with no conceptual meaning. The paint stroke background “X” device will also not convey any meaning within the applicant’s mark. Thus, the parties’ marks are conceptually neutral.

Distinctive character of the earlier trade mark

75. 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

[5] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

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)."

76. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and 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.

77. I will begin with the inherent distinctiveness of the opponent's First and Third Earlier Marks. As highlighted above, I consider that the word NORWEX will be perceived by the average consumer as an invented word with no conceptual meaning. On this basis, the marks are inherently distinctive to a high degree.

78. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market, and whilst I have been provided with sample UK invoices, I do not have any UK turnover, advertising or market share figures. I therefore do not consider the evidence sufficient to establish enhanced distinctiveness.

Likelihood of confusion

79. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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

- I have found the marks to be visually and aurally similar to between a medium and high degree.
- I have found the marks to be conceptually neutral.
- I have found the First and Third Earlier Marks to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods to be members of the general public and professionals such as hairdressers and beauticians, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to range from being identical to similar to between a low and medium degree.

81. Taking all of the above factors into account, bearing in mind that the average consumer rarely has a chance to make direct comparisons between trade marks and, instead, will encounter them in different settings at different times, and therefore must rely upon the imperfect picture of them retained in its mind, I consider that the marks are likely to be mistakenly recalled or misremembered as each other. This is particularly the case given the between a medium and high degree of visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the between a medium and high degree of aural similarity between the marks will have the same result. I consider that the background paint stroke "X" device in the applicant's mark would be easily overlooked by the average consumer, especially as it plays a lesser role in the overall impression of the mark. I also consider that because the marks share the letters N, O, E and X, with the difference between the marks being the letters in the middle of the words (RW vs V), these will be easily overlooked or misremembered as each other, especially as the letter W in the First and Third Earlier Marks, and the letter V in the applicant's mark, share some visual similarities. Moreover, both marks will be perceived as invented words with no conceptual meaning. This results in the First and Third Earlier Marks being inherently distinctive to a high degree, and, in the absence of any conceptual hook in any of the marks, consumers will not have a strong conceptual message to assist in differentiating between them. This results in a likelihood of direct confusion, even on the goods that are similar to between a low and medium degree, due to the effect of the interdependency principle.

CONCLUSION

82. The opposition is partially successful in respect of the following goods for which the application is refused:

Class 3 Hair products, namely, shampoos, conditioners, styling gels, hair sprays, hair lacquers, hair bleaching preparations, hair colouring preparations, deodorants for personal use; cosmetics, namely, lipstick, foundation, blush, eye shadow, mascara, eyeliner, lipstick liner; skin care products, namely, cleansers, toners, moisturizers, eye creams, makeup remover,

beauty masks; fragrance products, namely, cologne, eau de toilette, perfume; shaving products, namely, shaving lotion.

83. The application can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

Class 3 Hair products, namely, depilatory preparations; shaving products, namely, after shave, shaving cream, shaving gel.

Class 35 Marketing, importation and exportation of cosmetics.

COSTS

84. As both parties have achieved what I regard as a roughly equal measure of success, I would have directed that both parties should bear their own costs.

85. However, on 6 February 2024, the opponent requested a hearing, and its appointment was confirmed by the Registry in its official letter dated 14 March 2024. The letter also stipulated that the parties' skeleton arguments should be received by Monday 3 June 2024 by 14:00.

86. On 30 May 2024, the opponent emailed the Registry notifying them that they were in negotiations with the applicant, and that they were expecting to conclude negotiations "by tomorrow" (1 June 2024), to which they will also confirm the opponent's contact details for the hearing "if it is still going ahead". However, it was not until 14:00 on 3 June 2024 that the Registry received an email from the opponent stating that they will not be represented at the hearing nor filing any skeleton arguments.

87. On the basis that the opponent requested the hearing, and at the latest possible opportunity decided that they would not be in attendance, I will be awarding costs to the applicant who had already submitted their skeleton arguments and attended the hearing. Therefore, based upon the scale published in Tribunal Practice Notice

2/2016, I award the applicant **£400** as a contribution towards the costs of preparation for and attendance at the hearing, reflecting their partial success of the opposition.

Dated this 30th day of August 2024

L FAYTER
For the Registrar

ANNEX 1

The First Earlier Mark

Class 3

Soaps; perfumery; essential oils; deodorants, anti-perspirants; preparations for the care of the skin, scalp and body; preparations for use in the bath; creams, lotions, gels, serums, milks, oils, powders, foams and mousses for use on the skin, scalp and body; preparations for toning the body; shampoos, conditioners, creams, lotions, gels, serums, milks, oils, powders, foams, mousses, sprays and waxes for the care and beauty of the hair; hair waving and hair-setting preparations; medicated shampoos and hair lotions for the care and beauty of the hair; cosmetics, cosmetic kits; toilet preparations; cleaning preparations for personal use; fragrance sprays for the body.

The Second Earlier Mark

Class 35

Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; provision of business information; retail services connected with the sale of soaps, perfumery, essential oils, cosmetics, hair lotions; providing on-line ordering services in the field of cleaning products; providing technical assistance in the establishment of and/or operation of independent direct sales businesses; business information services in the nature of providing information on business opportunities related to independent direct sales businesses.

The Third Earlier Mark

Class 3

Soaps, deodorants; moisturising creams, cosmetic kits.