

O/0916/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3945891
IN THE NAME OF MDM DIGITAL GROUP LIMITED
TO REGISTER AS A TRADE MARK**

RONAVO

IN CLASSES 10 AND 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 443770
BY SHENZHEN LINGJIU E-COMMERCE CO. LTD.**

BACKGROUND AND PLEADINGS

1. On 15 August 2023, MDM Digital Group Limited (“the applicant”) applied to register the trade mark “RONAVO” in the United Kingdom. The application was accepted and published for opposition purposes on 1 September 2023, in respect of the following goods:

Class 10: *Scrapers (Tongue -); Tongue scrapers; Oral irrigators; Tongue depressors.*

Class 21: *Tongue brushes; Tongue cleaning brushes; Dental cleaning articles; Oral care kits comprising toothbrushes and floss; Oral irrigators, other than for use in dentistry; Cosmetic, hygiene and beauty care utensils.*

2. The application is opposed by Shenzhen Lingjiu E-Commerce Co. Ltd.¹ (“the opponent”). The opposition was filed on 23 October 2023 and is based upon section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its alleged earlier rights in the unregistered sign “RONAVO”. The opponent claims to have been selling “*tongue scrapers*” and “*oral hygiene tools*” under this sign throughout the UK since 8 April 2020.

3. The opponent claims that since the opponent’s sign “RONAVO” is identical to the applied-for mark, use of the sign by the applicant in respect of the applied-for goods would misrepresent to the public that they are the goods of the opponent. Therefore, it submits that “there is a risk of damage to the opponent’s goodwill in its mark, as well as a risk of financial damage to its business”.

4. The applicant filed a defence and counterstatement denying the claims made.

¹ I note that the opposition was originally filed in the name of “Sunsea Tech Limited”. It was confirmed in an email sent from Marcin Ociepka on 22 April 2024 that this name was entered as the name of the opponent on the Form TM7 in error. The name of the opponent has accordingly been amended to Shenzhen Lingjiu E-Commerce Co. Ltd., which is as it appears throughout the original counterstatement attached to the Form TM7.

5. Only the opponent filed evidence in these proceedings. Neither party filed written submissions during the evidence rounds or subsequently, and no hearing was requested. This decision is taken following careful consideration of the papers on file.

6. In these proceedings, the opponent is represented by Marcin Ociepka and the applicant is unrepresented.

THE EVIDENCE

7. The opponent filed evidence in the form of the witness statement of Huang Shihan, dated 31 May 2024, which is accompanied by twelve exhibits. Huang Shihan is the President of the opponent, being a Chinese limited liability company.

8. I have taken the evidence into account in reaching my decision and will refer to it in the decision to the extent I consider necessary.

DECISION

9. 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.

Section 5(4)(a)

10. Section 5(4)(a) states as follows:

“5(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.”

11. Subsection (4A) of section 5 of the Act states:

“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.”

12. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and iii) damage. 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).”

13. 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.”

Relevant date

14. A claim for passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems v Multisys Computers Limited*, BL O-410-11,² Mr Daniel Alexander QC (as he then was), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

“148. ... 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.”

15. There is no indication by the applicant that it has used its mark prior to its application. As such, all factors should be assessed as at the date of application, being 15 August 2023 (“the relevant date”).

² At [43].

Goodwill

16. The first hurdle for the opponent is to show that it had the requisite goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“224. 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.”

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

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

officer that it is not shown on the balance of probabilities that passing off will occur.”

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

“8. Those 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.”

19. The opponent seeks to provide evidence of goodwill through the witness statement and accompanying exhibits. In the witness statement, Huang Shihan describes the opponent's business in the following terms:

“3. (The company) was originally registered in the United States in 2018 and filed on Amazon Mall for global sales. As a professional manufacturer and supplier it offers a wide variety of goods, such as tongue scrapers and oral hygiene products, as well as nail clippers.

4. The goods of Shenzhen Lingjiu E-Commerce Co. Ltd. are marketed under "RONAVO" brand all around the world, in particular in the United Kingdom, as evidenced by the documents attached to this Witness Statement.

5. ... The company started selling RONAVO in the UK already in 2018, mainly nail clippers, but in 2019 added tongue scraping products sold under the RONAVO brand, which includes up to 17 different tongue scraping products available on Amazon UK.”

20. At point 6 of the witness statement, Huang Shihan describes the volume of sales of goods bearing the sign “RONAVO” to the UK as a whole as being “in big numbers”. At point 12, Huang Shihan states that “the following [12a) to 12k)] are links to ... at amazon.co.uk...”. Point 12 i) provides turnover figures as follows:

- 2021 Jan 1 – 2021 Dec 31 Income: 250,354.39 GBP
- 2022 Jan 1 – 2022 Dec 31 Income: 172,993.87 GBP
- 2023 Jan 1 – 2023 Dec 31 Income: 314,939.05 GBP

These figures are verified in exhibit 10, which comprises printouts of the account activity summary showing gross income in GBP for each of the above years, for example:

Exhibit 10

amazon services [™] europe seller central		Display name: Legal name:	RONAVOUKSTORE Shenzhen LingJiu dianzishangwuyouxiangongsi	Page 1 of 1
Account activity from Jan 1, 2022 00:00 GMT to Dec 31, 2022 23:59 GMT			All amounts in GBP, unless specified	
Summaries		Can include Amazon Marketplace, Fulfillment by Amazon (FBA), and Amazon Webstore transactions		
				Totals
Income	Sales, credits, and refunds			172,993.87
Expenses	Fees, including Amazon service fees, selling fees, FBA fees, and delivery			-104,077.67
Tax	Net taxes collected on product sales and services			120.92
Transfers	Deposits and withdrawals			-68,151.87

I note that exhibit 10 is headed as “amazon services europe”, (as opposed to “amazon services UK”) for “RONAVOUKSTORE”, being the operating name of the opponent on Amazon UK platform³, and that the income value is given in pounds sterling. Together with the information provided in the witness statement, I take it that these figures relate solely to income generated through the UK platform, rather than through Europe-wide sales.

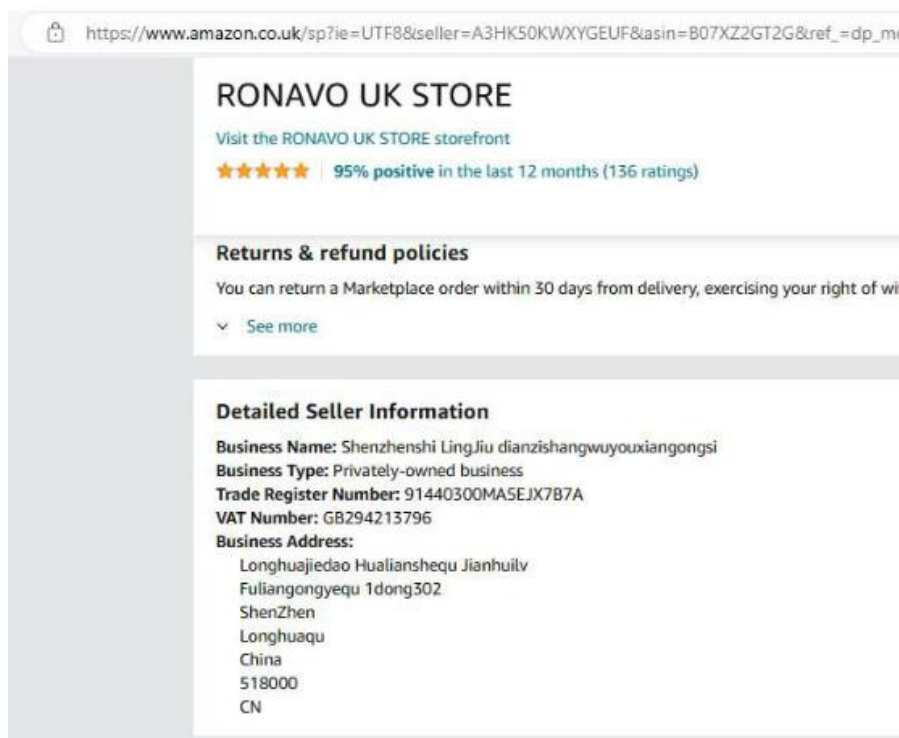
21. At point 9 of the witness statement, Huang Shihan states that the costs incurred to promote brand exposure of the RONAVO tongue scraper have amounted to £95,247.43 since May 2022. I take this to reflect the position at the time the witness statement was prepared, which was signed on 31 May 2024. However, there is no

³ As clarified at points 7 and 8 of the witness statement.

evidence to show how, or to who the brand was promoted, or how much of the spend was incurred up to and including the relevant date of 15 August 2023.

22. The exhibits support that the opponent offers its goods for sale via the online platform at Amazon.co.uk. Exhibit 1 is a printout showing detailed seller information for the opponent on the Amazon UK platform, as well as customer reviews and ratings for visitors to the RONAVO UK STORE. These are shown as 95% positive from 136 ratings in a twelve-month period, which I take to be the twelve-month period prior to the search date of 23 May 2024:

Exhibit 1



23. Examples of RONAVO branded goods being offered via the UK Amazon online platform have been provided at exhibits 2 - 6 and include tongue scrapers, toenail clippers and cuticle cutters, all of which are priced in pounds sterling. While I note that the delivery destination in each of these exhibits is shown as Poland, I do not consider this to detract from the goods being targeted towards the UK consumer, and there is no suggestion that the goods were actually shipped to customers in that location. The examples below clearly show the goods alongside the relevant RONAVO branded

packaging, and in the case of exhibit 6, the sign is also evident on the goods themselves:

Exhibit 2

Professional Retainer Cleaning Tablets

Dental Care + Tongue Cleaners

RONAVO Tongue Scraper with Travel Cases for Adults & Kids, Easy to Use, Stainless Steel (Medical Grade), Fights Bad Breath, Healthy Oral Care, Tongue Cleaners for Small Mouth(2 Pack)

Visit the RONAVO Store
4.4 ★★★★★ - 8,148 ratings | Search this page

£9.99 (£4.50 / count)

Save 30% on any 4 qualifying items > | Terms

Colour: **Medium Tongue Scraper(silver)**

£15.99 (£15.99 / count)	£15.49 (£15.49 / count)
£15.49 (£15.49 / count)	£9.49 (£4.75 / count)
£8.99 (£4.50 / count)	£8.99 (£4.50 / count)
£9.49 (£4.75 / count)	£9.99 (£4.99 / count)
£8.49 (£4.25 / count)	£8.99 (£4.50 / count)

• **(Reduce Bad Breath)** The tongue scraper is not only suitable for adults, but also suitable for children. This tongue scraper...

£9.99 (£4.50 / count)
E3.50 delivery **Wednesday, 5 June** Details
Deliver to Poland
In stock
Quantity: 1
Add to Basket
Buy Now

Dispatches from Amazon
Sold by RONAVO UK STORE
Returns Returnable within 30 days of receipt
Payment Secure transaction
Add gift options
Add to List

Exhibit 3

SURFOU Cordless Water Flosser for Teeth

26% off Limited time deal £19.99 £26.99

Dental Care + Tongue Cleaners

RONAVO Copper Tongue Scraper for Adults (2 Pack), 100% Pure Copper, Naturally Anti-Microbial, Banishes Bad Breath and Maintains Oral Hygiene, Tongue Cleaner with Travel Case, Easy to Use and Clean

Visit the RONAVO Store
4.4 ★★★★★ - 340 ratings | Search this page
100+ bought in past month

£9.99 (£9.99 / count)

Size: **2 Copper Tongue Scraper U-Shape**

U-Shape Stainless Steel Tongue Scraper £9.99 (£4.50 / count)	Copper Set of 1 £6.99 (£6.99 / count)
2 Copper Tongue Scraper U-Shape £9.99 (£9.99 / count)	Spoon Shaped Tongue Scraper £9.49 (£9.49 / count)

• **[Pure Copper Tongue Scraper]** : The tongue scraper is an oral care product that combines Ayurvedic ideas and techniques. Ayurveda recommends using copper dental tools to improve taste and oral health. Copper has natural cleaning properties that help make tongue scraping more effective and prevent various oral

£9.99 (£9.99 / count)
E3.59 delivery **Monday, 3 Jun**
Order within 4 hrs 41 mins. Details
Deliver to Poland
In stock
Quantity: 1
Add to Basket
Buy Now

Dispatches from Amazon
Sold by RONAVO UK ST
Returns Returnable with days of receipt
Payment Secure transaction
Add gift options
Add to List

Exhibit 5

amazon.co.uk Deliver to Poland Beauty Search Amazon.co.uk

Home & Garden Electronics Fashion Beauty Pet Supplies PC & Video Games Toys & Games PC Health & Personal Care Car & Motorbike Baby Shopper Toolkit Sell on Amazon Subscribe & Save

MANM Nail Clippers for Thick Nails, 16mm Wide Low Opening Toenail Clippers with Sharp Curved Blade and Nail File, Heavy Duty Stainless Steel Fingernail Clippers Nail Cutter for Men Seniors Elderly

Manicare & Pedicure Tools & Accessories Nail Clippers

Toenail Clippers for Thick Nails - Heavy Duty Professional Thick & Ingrown Toe Nail Clipper for Men & Elderly, Large Toenail Scissors for Seniors/Mens/Women, Long Handle Safety Strong RONAVO(Black)

Visit the RONAVO Store
4.6 3,069 ratings | Search this page
500+ bought in past month

Price: **£13.99** (€13.99 / count)
Voucher: Apply 5% voucher Shop items » | Terms
Save 5% on any 4 qualifying items » | Terms
Colour Name: **Black (for Thick Toenail)**

£13.99 (€13.99 / count) £14.99 (€14.99 / count) £13.99 (€13.99 / count) £14.99 (€14.99 / count)

Colour: Black (for Thick Toenail)
Brand: RONAVO
Material: Metal
Blade edge: Curved
Blade material: Stainless Steel
Target audience: Mother / Father, Elderly/ Arthritis, Diabetic / Thick Nail, Men

One-time purchase: £13.99 (€13.99 / count)
£3.74 delivery **Wednesday, 5 June**. Details
Deliver to Poland
In stock
Quantity: 1
Add to Basket
Buy Now

Dispatches from Amazon
Sold by RONAVO UK STORE
Returns: Returnable within 30 days of receipt
Payment: Secure transaction
Add gift options

Subscribe & Save: £13.99 (€13.99 / count)
£3.74 delivery **Wednesday, 5 June**
Dispatches from Amazon
Sold by RONAVO UK STORE

Exhibit 6

amazon.co.uk Deliver to Poland Beauty Search Amazon.co.uk

Home & Garden Electronics Fashion Beauty Pet Supplies PC & Video Games Toys & Games PC Health & Personal Care Car & Motorbike Baby Shopper Toolkit Sell on Amazon Subscribe & Save

NALISINC LONDON Nail treatments enriched with premium ingredients £16.00

Manicare & Pedicure Tools & Accessories Cuticle Tools Cuticle Pushers

Cuticle Cutter with Cuticle Pusher - RONAVO Cuticle Trimmer Cuticle Nippers Professional Stainless Steel Cuticle Scissors and Cutter Clippers Durable Pedicure Manicure Tools for Fingernails Toenails

Visit the RONAVO Store
4.7 3,450 ratings | Search this page

£8.99 (€8.99 / count)
Style Name: **Set (L)**

£8.99 (€8.99 / count) £8.99 (€8.99 / count) £4.59 (€4.59 / count)

Colour: Multicolor
Material: Stainless Steel, Metal
Brand: RONAVO
Blade material: Stainless Steel
Style: Set (L)

About this item

- [Premium Polished Stainless Steel] Our newly upgraded nail cuticle scissors with cuticle pusher and cutter are made of 100% high quality stainless steel. RONAVO professional 4 in 1 cuticle remover tool are premium metal cuticle cut and retain sharpness for a very long period of time.

£8.99 (€8.99 / count)
£3.73 delivery **Wednesday, 5 June**. Details
Deliver to Poland
Only 11 left in stock.
Quantity: 1
Add to Basket
Buy Now

Dispatches from Amazon
Sold by RONAVO UK STORE
Returns: Returnable within 30 days of receipt
Payment: Secure transaction
Add gift options
Add to List

NALISINC LONDON Nail treatments work best with



I note that the only date shown on these exhibits is 28 May 2024, being three days prior to that of the witness statement, and which I assume to be when the evidence was compiled. I note that this means that the exhibits are therefore dated more than eight months after the relevant date, although I accept that in some circumstances, evidence can “cast light backwards”.⁴ The same general principles made in the *Red Bull* case can be applied in these proceedings, i.e. I must consider whether the evidence provided to support goodwill which falls after the relevant date accurately reflects the position at that date.

24. Exhibit 8 supports the assertion at point 5 of the witness statement that tongue scrapers were first sold under the RONA VO on Amazon UK in 2019:

Status	Image	SKU Condition	Listing ID	Product Name ASIN	Date Created Status Changed Date	Available	Inbound	Unfulfillable	Reserved	Estimated fee per unit sold	Price + Shipping Pricing status
Active		SR-3CZP-DDOC New	0917V1Y5500	RONAVO Tongue Scraper with Travel Cases for Adults & Kids. Easy to Use, Stainless Steel (Medical Grade). Fights Bad Breath, Healthy Oral Care, Tongue Cleaners for Small Kids. B07XZ2G726	17/09/2019 10:02:12 10/01/2022 00:41:20	502	0	0	0	£2.25 Includes £1.52 FBA Fee	8.99 +1 Featured Offer: £8.99 + Lowest price

⁴ *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

25. At point 12 j) of the witness statement, Huang Shihan describes exhibit 11 as printouts of sales documents relating to the products sold under the RONAVO brand in the UK via the Amazon platform. He states that the data shows the number of products ordered, the dates of the orders and the names of the goods ordered, together with the Amazon Order ID and relevant identification codes. They are said to relate to December 2022, April 2023 and January 2024, the latter date coming after the relevant date. I note that the exhibit comprises some 180 pages, with multiple entries per page. The listed goods under the Merchant SKU are predominantly “tongue scrapers”, although there are also other goods, such as ‘lunch bags’ listed. It is clear from this exhibit that the opponent has had customers in the UK during the relevant period:

Customer Shipment Date	Merchant SKU	FNSKU	ASIN	FC	Quantity	Amazon Order Id	Currency	Product Amount	Shipping Amount	Gift Amount	Shipment To City	Shipment To State	Shipment To Postal Code
2022-12-31T15:51:06+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	BRS2	1	206-4443554-1107511	GBP	7,49	0	0	LONDON	--	NW8 9DT
2022-12-31T14:48:04+00:00	SR-3CZP-DDOC	X0012XHUVT	B07XZ2GT2G	BRS2	1	206-8510650-1611503	GBP	7,5	0	0	BROMLEY	--	BR1 4QP
2022-12-31T14:38:21+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LCY2	1	203-3132583-3245955	GBP	7,49	0	0	Ashford	Surrey	KT21 2NL
2022-12-31T14:22:49+00:00	CU-V15M-K6MU	X000U0HKM9	B078SSJ5LF	MME2	1	204-4136027-8216327	GBP	11,66	0	0	Pontefract	West Yorkshire	WF8 4PZ
2022-12-31T14:22:11+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	BRS2	1	206-2300729-8765106	GBP	7,49	0	0	CHESTER	Broxbourne	EN8 0FF
2022-12-31T14:12:31+00:00	lunch bags 1	X000ZYIGNH	B07PGNB83R	EMA2	1	203-3598880-0535554	GBP	12,49	0	0	LIVERPOOL	--	L14 9NG
2022-12-31T14:03:55+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LTN4	1	202-1225874-8848340	GBP	7,49	0	0	LONDON	--	N7 0AH
2022-12-31T13:45:38+00:00	CU-V15M-K6MU	X000U0HKM9	B078SSJ5LF	BRS2	1	026-1331201-5952352	GBP	11,66	3,74	0	SOUTHALL	--	UB2 4NL
2022-12-31T13:45:22+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LCY2	1	204-2507009-3762763	GBP	7,49	0	0	LONDON	--	SE17 3JW
2022-12-31T13:44:48+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LCY3	1	206-8909283-6648319	GBP	7,49	0	0	CROYDON	--	CR0 0EW
2022-12-31T13:37:52+00:00	ingrown nails set red	X001K4P9DB	B09YVBYQX8	BRS1	1	203-6559813-0284352	GBP	12,49	0	0	Reading	Berkshire	RG31 7AD
2022-12-31T13:37:09+00:00	thick nails set black	X001K4P0KN	B09YV9BNRB	BRS2	1	204-1735205-1149968	GBP	12,49	0	0	LONDON	--	SW18 2BP
2022-12-31T13:13:03+00:00	lunch bags 1	X000ZYIGNH	B07PGNB83R	LCY2	1	026-4232136-4623500	GBP	12,49	1,24	0	COVENTRY	Warwickshire	CV7 9BQ
2022-12-31T12:11:55+00:00	lunch bags 5	X0019ERIB3	B08LMTYSQ3	EMA1	1	203-1251844-8365125	GBP	12,49	1,24	0	ABERDARE	M Glam	CF44 0GW

For ease, I have further reproduced the document divided into two sections:

Customer Shipment Date	Merchant SKU	FNSKU	ASIN	FC	Quantity
2022-12-31T15:51:06+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	BRS2	1
2022-12-31T14:48:04+00:00	SR-3CZP-DDOC	X0012XHUVT	B07XZ2GT2G	BRS2	1
2022-12-31T14:38:21+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LCY2	1
2022-12-31T14:22:49+00:00	CU-V15M-K6MU	X000U0HKM9	B078SSJ5LF	MME2	1
2022-12-31T14:22:11+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	BRS2	1
2022-12-31T14:12:31+00:00	lunch bags 1	X000ZYIGNH	B07PGNB83R	EMA2	1
2022-12-31T14:03:55+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LTN4	1
2022-12-31T13:45:38+00:00	CU-V15M-K6MU	X000U0HKM9	B078SSJ5LF	BRS2	1
2022-12-31T13:45:22+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LCY2	1
2022-12-31T13:44:48+00:00	Tongue Scraper 3	X00164EWTH	B086W2GPNT	LCY3	1
2022-12-31T13:37:52+00:00	ingrown nails set red	X001K4P9DB	B09YVBYQX8	BRS1	1
2022-12-31T13:37:09+00:00	thick nails set black	X001K4P0KN	B09YV9BNRB	BRS2	1
2022-12-31T13:13:03+00:00	lunch bags 1	X000ZYIGNH	B07PGNB83R	LCY2	1
2022-12-31T12:11:55+00:00	lunch bags 5	X0019ERIB3	B08LMTYSQ3	EMA1	1

Amazon Order Id	Currency	Product Amount	Shipping Amount	Gift Amount	Shipment To City	Shipment To State	Shipment To Postal Code
206-4443554-1107511	GBP	7,49		0	0 LONDON	--	NW8 9DT
206-8510650-1611503	GBP	7,5		0	0 BROMLEY	--	BR1 4QP
203-3132583-3245955	GBP	7,49		0	0 Ashtead	Surrey	KT21 2NL
204-4136027-8216327	GBP	11,66		0	0 Pontefract	West Yorkshire	WF8 4PZ
206-2300729-8765106	GBP	7,49		0	0 CHESHUNT	Broxbourne	EN8 0FF
203-3598880-0535554	GBP	12,49		0	0 LIVERPOOL	--	L14 9NG
202-1225874-8848340	GBP	7,49		0	0 LONDON	--	N7 0AH
026-1331201-5952352	GBP	11,66	3,74		0 SOUTHALL	--	UB2 4NL
204-2507009-3762763	GBP	7,49		0	0 LONDON	--	SE17 3JW
206-6909283-6648319	GBP	7,49		0	0 CROYDON	--	CR0 0EW
203-6559813-0284352	GBP	12,49		0	0 Reading	Berkshire	RG31 7AD
204-1735205-1149968	GBP	12,49		0	0 LONDON	--	SW18 2BP
026-4232136-4623500	GBP	12,49	1,24		0 COVENTRY	Warwickshire	CV7 9BQ
203-1251844-8365125	GBP	12,49	1,24		0 ABERDARE	M Glam	CF44 0GW

26. While the evidence gives examples of toenail clippers and cuticle cutters, I note that the opponent is only relying on “*tongue scrapers*” and “*oral hygiene tools*”. While tongue scrapers are encompassed by the broader term oral hygiene tools, I do not consider either toenail clippers or cuticle cutters to be encompassed by the term “*oral hygiene tools*”, which to my mind would only relate tools used in direct relation to the mouth. Therefore the evidence provided goes beyond the scope of the goods for which the opponent claims use of the sign.

27. The use shown is not extensive, but I bear in mind that a small business may still be protected by the law of passing off,⁵ albeit that the law does not protect a goodwill of trivial extent.⁶ As Mr Thomas Mitcheson QC, (as he then was) sitting as the Appointed Person, concluded in *Smart Planet Technologies, Inc. v Rajinda Sharma*:⁷

“...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.”

28. When assessing whether the evidence has demonstrated that a protectable goodwill has been established, I place particular weight on the turnover figures provided for the three consecutive years from January 2021 to December 2023, as shown above under paragraph 20. From the evidence provided in the witness

⁵ *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

⁶ *Hart v Relentless Records* [2002] EWHC 1984 (Ch).

⁷ BL O/304/20.

statement, I infer that these figures relate to sales made within the UK market, although I acknowledge that the relevant date falls in August 2023, and that figures specific to the first eight months only of this final period have been given. Further, the exhibits show that the sign was used on the goods and that they were offered for sale to the UK public via the Amazon UK platform, with exhibits 10 and 11 corroborating the account activity of the opponent prior to the relevant date.

29. Although the evidence does not show if the opponent receives repeat sales from customers via the Amazon platform, to my mind, the goods are not of the type that would inevitably necessitate a repeat order.

30. I remind myself that goodwill is attached to the business, and that the sign relied upon must be distinctive of that goodwill. While the majority of the exhibits which show the sign being used are dated after the relevant date, it seems clear to me that “RONAVO” has been used on the goods since 2019, and therefore prior to the 15 August 2023. In spite of its shortcomings, taking the evidence as a whole, I consider that the opponent has done enough for me to find protectable goodwill in the sign “RONAVO”, in the UK, at the relevant date, in relation to use of the goods claimed in the pleaded case, being “*tongue scrapers*” and “*oral hygiene tools*”. The use shown is such that goodwill rests in the word itself, rather than in any particular presentation. I am therefore satisfied that the opponent had sufficient goodwill in its business at the relevant date and that the sign RONA VO was associated with that goodwill.

Misrepresentation and Damage

31. The relevant test for misrepresentation can be found in *Neutrogena Corporation and Another v Golden Limited and Another*,⁸ in which Morritt L.J. stated that:

“47. There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is:

⁸ [1996] RPC 473.

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?’

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

32. With regard to the number of members of the relevant public who must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos* in which Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the ‘substantial number’ of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

33. I note that in the counterstatement, the applicant states that it conducted “a comprehensive due diligence search before applying for the RONAVO trademark”, and that it filed the application to register the mark “in good faith”. Although an intention to misrepresent would be a highly relevant factor,⁹ it is not a prerequisite. Misrepresentation can be found in innocent circumstances.

⁹ *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] RPC 39 (HOL).

34. The requirements for damage in passing off cases are described in *Harrods Limited v Harrodian School Limited*,¹⁰ by Millett L.J., as follows:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the Lego case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

35. With regard to proof of damage, I bear in mind the decision in *W.S. Foster & Son Limited v Brooks Brothers UK Limited*,¹¹ in which Iain Purvis QC (as he then was), sitting as a Deputy Judge, stated:

“Damage

55. Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred*

¹⁰ [1996] RPC 697 (CA).

¹¹ [2013] EWPC 18 (PCC).

McAlpine [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

36. With the exception of *Cosmetic, hygiene and beauty care utensils* in class 21, the applicant’s goods as listed under paragraph 2 of this decision, being tongue scrapers and other articles used in the application of oral hygiene, are identical to the opponent’s goods for which I have found protectable goodwill, being “*tongue scrapers*” and “*oral hygiene tools*”. As far as the applicant’s *Cosmetic, hygiene and beauty care utensils* are concerned, the parties operate in a common field of activity, i.e. the beauty and hygiene business. The respective goods would reach the UK market through the same channels of trade, where they would be found in close proximity to each other. It would not be unreasonable for the relevant public to also expect such goods, bearing an identical sign, to come from the same or an associated undertaking as those of the opponent. Accordingly, I consider that if such goods bearing the same sign “RONAVO” were provided by the applicant, this is likely to result in misrepresentation and damage.

37. Having found goodwill, it follows that any use of the name “RONOVO” by the applicant, being identical to the sign relied upon by the opponent, for goods within the same or similar fields of activity, would mislead a substantial number of its actual or potential customers into purchasing those goods, believing they were the opponent’s. This would inevitably damage the opponent’s goodwill through the loss of sales to the applicant. Misrepresentation and damage, such as diversion of trade and/or injurious association¹², is easily foreseeable.

38. The Opponent’s claim under section 5(4)(a) succeeds in its entirety.

CONCLUSION

39. The consequence of the above is that, subject to any successful appeal, the application by MDM Digital Group Limited is refused registration.

¹² See *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA).

COSTS

40. The opponent has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 1/2023. Applying the guidance in that TPN, I consider the following to be fair:

Official fee:	£200
Preparing a notice of opposition, and considering the counterstatement:	£300
Preparing and filing evidence:	£600
Total:	£1,100

41. I therefore order MDM Digital Group Limited to pay Shenzhen Lingjiu E-Commerce Co. Ltd. the sum of £1,100. 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 30th day of September 2025

Suzanne Hitchings
For the Registrar,
the Comptroller-General