

O-0929-25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3880447

IN THE NAME OF

DAMEIREN (SHENZEN) INDUSTRIAL GROUP CO., LTD.

TO REGISTER THE FOLLOWING TRADE MARK:

Dear Irean

IN CLASSES 3, 4 & 35

AND

OPPOSITION THERETO (UNDER NO. 441742)

BY

DR. IRENA ERIS SPÓLKA ACKYJNA

BACKGROUND

1) On 21 February 2023, Dameiren (Shenzhen) Industrial Group Co., Ltd. ('the applicant') applied to register the trade mark shown on the cover page of this decision. The application is made in respect of various goods and services in classes 3, 4 & 35, which are set out later in this decision, in the table at paragraph 51.

2) The application was published in the Trade Marks Journal on 05 May 2023. The application is opposed by Dr Irena Eris Spółka Akcyjna ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b) & 5(3) of the Trade Marks Act 1994 ('the Act').

3) In support of both grounds, the opponent relies upon the following trade mark registration:

- **UKTM 904117461**

DR IRENA ERIS

Class 3: Cosmetics; creams, emulsions, lotions, gels, skin oils and balsams; soaps; wash and bath preparations; hair cleaning and hair care preparations; perfumery products; perfumes; toilet waters and eau de colognes; essential oils; deodorants and antiperspirants; make-up and make-up removing preparations; lip care and lip make-up preparations; nail care and nail colouring preparations; intime hygiene preparations; suntan preparations and preparations protecting against UV; self-tan preparations; depilatory preparations; make-up powders; after-bath powders; hygienic powders; dentifrices and preparations for oral care; toiletries.

Class 5: Cosmetics for medical use; medicinal creams, emulsions, liquids, gels, oils and balsams, bath salts for medicinal use, medicinal baths.

Class 44: Cosmetic clinic services; beauty salon services.

Filing date: 15 November 2004

Date of entry in register: 21 February 2006

4) It is claimed that the respective goods and services are either identical or highly similar and that the respective marks are similar, such that there exists a likelihood of confusion under section 5(2)(b).

5) Under section 5(3) of the Act, it is claimed that the earlier mark has a reputation in the UK in relation to all the goods and services for which it is registered. It is claimed that use of the contested mark will result in the relevant public believing that the respective marks are used by the same undertaking or that there is an economic connection between the undertakings using the respective marks. I note that this is the full extent of the claim made under Section 5(3) of the Act. There is no other pleaded limb in support of the claim¹.

6) The trade mark relied upon by the opponent is a comparable mark which is an earlier mark, in accordance with section 6 of the Act². As the earlier mark completed its registration procedure more than five years prior to the application date of the contested mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in relation to all of the goods and services relied upon.

7) The applicant filed a counterstatement. It denies the opponent's claims and requests proof of use of the earlier mark.

8) The opponent is represented by Barker Brettell LLP. The applicant is represented by ZWENIP Limited. Only the opponent filed evidence. This consists of a witness statement from Mrs Monika Borys ('Mrs Borys'), dated 08 January 2024, with Exhibits

¹ As per the answer to Q6, and the absence of any answers for Q7-Q9, under the relevant section of the Form TM7.

² Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs and IR (EU) TMs 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)/IR(EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM/EU(IR)TM from which it derives.

MB1 – MB14 thereto. Neither party requested a hearing; both filed written submissions in lieu³.

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.

Proof of use

10) 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.

³ The applicant's submissions are dated 30 July 2024; the opponent's submissions are dated 21 August 2024

(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.”

11) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to

which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequently, the burden lies with the opponent to prove it has made genuine use of its mark.

12) As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union.”

13) 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 Bunderversammlung 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 Marken 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].”

14) As use in the EU is relevant for part of the relevant period, I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (‘CJEU’) noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was

registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

15) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. (as he then was) reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a

clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I

would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

16) The General Court ('GC') restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

17) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

18) In relation to framing a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was), sitting as the Appointed Person, summed up the law on this matter as follows:

“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.”

19) Further, in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal stated, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible

variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

20) The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the contested mark. In the case before me, that period is **20 February 2018 to 21 February 2023**.

21) I have carefully considered all of Mrs Borys’ evidence. I will now summarise the most pertinent parts of it.

22) Mrs Borys is the opponent’s Global Marketing Manager. She states that in 1983, the opponent was a small business offering a single type of cream. Since that time, the opponent’s business has gone from strength to strength, with its product range greatly expanding and has developed an international reputation in the DR IRENA ERIS mark. A list of ‘significant milestones’ in the growth of the business are provided, the most relevant of which are, as follows:

- In 1987, the opponent opened a store in Piaseczno, Poland.
- In 1993, the opponent opened a manufacturing plant in the same location as given above.
- In 1995, the opponent opened its first Dr Irena Eris Cosmetic Institute in Poland.
- In 1997, the opponent opened a 4-star Dr Irena Eris Hotel & Spa in Poland (another was opened in 2006 and another 5-star one in 2014, both also in Poland).
- In 2004, the opponent expanded into the markets of Czech Republic, Slovakia, Hungary, and Great Britain, where the products are sold by the largest network of drugstores, BOOTS.
- In 2007, the first edition of the Dr Irena Eris Ladies’ Gold Tournament which is the most prestigious golf event in Poland for ladies.

- In 2012, the Dr Irena Eris brand was admitted to the group of European members of the prestigious Comité Colbert.
- In 2014, the Dr Irena Eris brand was on the List of the Polish brands having the greatest potential for building a strong polish brand: “25/25 years: Brands for Poland”.
- In 2017, the first Concept Store of Dr Irena Eris was opened in one of the biggest shopping galleries in Warsaw, Poland.
- In 2018, the opponent began selling their products through John Bell & Croyden, a British Company.
- In 2018, the opponent began selling their products through the Spanish perfumery brand, Druni, a leader in online beauty.
- In 2018/2019, the opponent began selling their products through Douglas in Hungary, Croatia and Romania.

23) Mrs Borys states that DR IRENA ERIS has become one of the most recognisable and trusted Polish brands. It is said that this reputation has extended to other European countries, including the UK.

24) Two copies of decisions from the EUIPO issued in opposition proceedings are provided.⁴ In the first decision (Exhibit MB1), it was found that the mark DR IRENA ERIS had a reputation in the EU in relation to cosmetics. Specifically, the decision states: ‘The Opposition Division acknowledges that having proven reputation in, at least, Poland is sufficient to conclude that the earlier EU trade mark has a reputation in the European Union’ (my emphasis). In the second decision (Exhibit MB2) it was found that the mark DR IRENA ERIS ‘gained recognition among the relevant Polish public’ (my emphasis) and therefore a reputation in the EU was established for the same mark for cosmetics in that decision also.

25) A list of the opponent’s worldwide trade mark registrations are provided for variations of the mark DR IRENA ERIS.⁵

⁴ Exhibits MB1 & MB2

⁵ Exhibit MB3

26) Mrs Borys states that the opponent provides a broad range of goods and services including cosmetics, skin care products, make-up, cosmetic/beauty services, hotel services and spa services.

27) A catalogue of the opponent's products is provided which is said to have been in place since 2018. Mrs Borys states that it is updated annually and distributed through retail outlets.⁶ The goods shown in the catalogue are various cosmetic creams and serums (e.g. anti-wrinkle creams, eye-serums, moisturisers), facial cleansers and eye make-up removers. All those goods bear the mark, DR IRENA ERIS. There are also similar products aimed at men which do not bear that mark. Instead, they are branded with the mark, 'PLATINUM MEN'.

28) Mrs Borys provides, what she states is, evidence of sales in the UK.⁷ She also provides undated photographs of store fronts and in-store areas and dated photographs of pop-up shops (from 2018, 2019, 2020 and 2023), all showing use of DR IRENA ERIS in relation to the sale of cosmetics. These are followed by some undated social media posts by John Bell & Croyden advertising the opponent's products. The relevant exhibit also contains various extracts from the UK websites of the following retailers: Debenhams, Natasha Cosmetics, Parfum Dreams, makeup.uk, John Bell & Croyden, and Sephora. All of these show a variety of DR IRENA ERIS cosmetics for sale. It is not clear that any of them come from before the relevant date of 21 February 2023. There are also some customer reviews shown on some of those websites; some come from after the relevant date, there is one which comes from 4 October 2021 and others have the full date obscured in the evidence before me. Finally, there are the results of an undated Google 'shopping' search for 'DR IRENA ERIS' in the UK. The results show various DR IRENA ERIS cosmetics available for sale from third-party UK websites, including those listed earlier in this paragraph along with some others.

⁶ Exhibit MB4

⁷ Exhibit MB5

29) Mrs Borys states that the opponent also has over twenty Dr Irena Eris Skin Care Institutes. Undated extracts are provided from the opponent's website giving details of those institutes.⁸

30) Mrs Borys states that the opponent has made substantial sales of its goods. However, due to the confidential nature of this, the opponent does not want to disclose any sales figures and therefore none are provided.

31) Various invoices are provided.⁹ These are issued to addresses in the UK spanning the period of 2014 – 2023. There are five different customers in total on the invoices. The unit price and total cost on the invoices has been redacted. The mark 'DR IRENA ERIS' is prominently positioned at the top of every invoice. The descriptions of the goods listed in the invoices are various kinds of cosmetics and cleansers of the kind which are shown in the catalogue at exhibit MB4.

32) Mrs Borys states that between 2018 and 2023 the opponent has spent a considerable sum of money advertising the earlier mark in the EU and the UK. However, again, due to, what she states, is the confidential nature of this information, the opponent does not wish to disclose the amounts spent and therefore none are provided.

33) Reports are provided showing, what Mrs Borys states, are the number of views of the opponent's website, <https://sklep.drirenaeris.com>, for the year 2015, the period of 2015 – 2018, 2018 – 2022 and 2023. Mrs Borys highlights that the website received 2,570,619 views in 2015 and 10,119,647 views between 2016 – 2018.¹⁰ This figure appears to be the total views from numerous countries, including those in the EU, the UK and other countries, such as Canada. I note that there are certain figures given in the table on the penultimate page of the exhibit relating to the years 2018 – 2022 which are specific to the UK but the title of each column in the table is in Polish and no translation of that table is provided. Therefore, it is not entirely clear to me what those figures represent. Making the best I can of this information, it seems likely that the

⁸ Exhibit MB6

⁹ Exhibit MB7

¹⁰ Exhibit MB8

figure given in the first column indicates the number of 'users' or 'views'. In respect of the UK, that figure is 12, 215 for the period of 2018 - 2022. The largest figure is in respect of Poland (671, 450) the second largest is for Germany (13, 137).

34) Two historical extracts from the opponent's website are provided using the Wayback Machine.¹¹ These are dated 23 March 2018 and 07 May 2019. The first shows a lipstick and mascara bearing the mark DR IRENA ERIS; the second shows cosmetic creams bearing the same mark. The price of the goods is shown in Polish currency (PLN), although the website is in English.

35) Mrs Borys provides information about sponsorship activities involving the DR IRENA ERIS mark, as follows:¹²

- The Dr Irena Eris Ladies' Golf Cup tournament has been running since 2007 which is said to be the biggest and most prestigious ladies' event of this kind in 'this part of Europe'. An extract from the opponent's website is provided providing details of this event. The extract refers to an upcoming tournament in Poland in May 2023. Mrs Borys also states that the brand is/was also involved in a lot of golf championships i.e. Dr Irena Eris Ladies Tour, Deutsche Bank Polish Masters and Santander Polish Masters.
- In 2018 and 2019, the Dr Irena Eris brand was one of the main sponsors at a golf tournament organised during TFWA in Cannes. The first attendance of the brand at this tournament was in 2016 when the opponent had a cosmetics stand there. Copies of documents entitled 'TFWA daily' from 2016 -2019 are provided showing details of that sponsorship along with invoices relating to the hiring of stands and provision of advertising screens/space. There are also invoices relating to the chartering of yachts.
- Mrs Borys also provides details of other sponsorship activities such as those relating to sailing, fashion shows and charities.¹³ Most of these activities appear to have taken place in Poland. None of them clearly relate to the UK.

¹¹ Exhibit MB9

¹² Exhibit MB10 & MB11

¹³ Paragraphs [51] – [53] of Mrs Borys' witness statement

36) It is stated that DR IRENA ERIS is one of the most valuable Polish brands and has been listed as such in independent rankings published by 'Rzeczpospolita', one of the largest newspapers in Poland. Copies of the relevant extracts from that newspaper from 2014, 2015, 2016 and 2018 are provided.¹⁴

37) Copies of various publications are provided which are said to recognise the DR IRENA ERIS brand's market position and refer to the DR IRENA ERIS products.¹⁵ Some of these appear to be Polish publications. Some are in English but it's not clear what proportion of these relate to the UK. Most of the publications are dated many years prior to the relevant date, including in the period 2006-2008. Most of the articles speak of the success of the Polish brand, DR IRENA ERIS (and its founder by the same name) but there is nothing therein which sheds any light upon its success and market position in the UK.

38) Mrs Borys states that in 2012, Dr Irena Eris was the only Polish brand to be admitted to the group of European members of the Comité Colbert, a committee which brings together exclusive brands (mainly French), such as Boucheron, Cartier, Chanel and Dior.

39) A list of numerous awards is provided spanning 1998 – 2019 recognising the Dr Irena Eris brand in relation to cosmetics. The vast majority of these do not appear to relate to the UK given their foreign titles; most, if not all, of them appear to relate to Poland. There are some which are in English. However, it is not made clear if these pertain to the UK and no supporting documents are exhibited.¹⁶

40) Bearing in mind all of the above and considering the evidence in the round, I am satisfied that the opponent has used the earlier mark, as registered, during the relevant period in relation to various cosmetics, make-up removing preparations and face and body cleansers. Such use has been in the EU (particularly in Poland) in the period leading up to 31 December 2020 and in there has been use in the UK thereafter. In reaching this finding, I have borne in mind that, although the opponent

¹⁴ Exhibit MB12

¹⁵ Exhibits MB13 & MB14

¹⁶ Paragraph [60] of Mrs Borys' witness statement

has opted not to provide any sales or turnover figures, the evidence paints a picture of the earlier mark having been used on a substantial scale in Poland for many years. Further, the invoices addressed to UK customers are sufficient to show that there has been continuous use since 2016 up to the filing date of the contested mark, in the UK (albeit seemingly less substantial than in Poland). The use has been sufficient to create and preserve a market for the aforementioned goods in the relevant sector during the relevant period.

41) I find no genuine use of any of the goods in class 5. There is nothing before me to show that any of the opponent's goods are medicated. There is also insufficient evidence to show genuine use for the services in class 44. Whilst there is some evidence that the opponent has provided 'spa services' and a 'cosmetic institute' the scale of such use is far from clear.

42) Bearing in mind the specification of the earlier mark in class 3, as registered, and the kinds of goods for which genuine use has been demonstrated, I find that a fair specification is 'Cosmetics; make-up removing preparations; cleansers for the face and body' in class 3. I will assess the grounds under section 5(2)(b) and 5(3) of the Act on that basis.

Section 5(2)(b)

43) This section of the Act states:

"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.

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

44) The leading authorities which guide me are from the CJEU: *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

45) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment 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.”

46) Guidance on this issue has also come from Jacob J, where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

47) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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 that the responsibility for those goods lies with the same undertaking..”

48) In *Sanco SA v OHIM* Case T-249/11, the GC found 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 was 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. noted as the Appointed Person in *Sandra Amelia 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.”

49) I also bear in mind that in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch) (*‘YouView’*), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category

of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

50) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05), where the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

51) The goods and services to be compared are:

Opponent's goods	Applicant's goods and services
<p>Class 3: Cosmetics; make-up removing preparations; cleansers for the face and body.</p>	<p>Class 3: Massage candles for cosmetic purposes; Beauty masks; Cosmetic creams; Gel eye patches for cosmetic purposes; Lotions for cosmetic purposes; Make-up; Make-up preparations; Essential oils; Toothpaste; Mouthwashes, not for medical purposes; Bath preparations, not for medical purposes; Hair-conditioners; Shampoos; Perfumery; Facial cleansers; Cotton swabs for</p>

	<p>cosmetic purposes; Sunscreen preparations; Nail varnish; Lip glosses; Cleaning preparations; Polishing preparations; Cosmetics for animals; Air fragrancing preparations; Incense.</p> <p>Class 4: Perfumed candles; Grease for footwear; Methylated spirit; Firewood; Beeswax for use in the manufacture of cosmetics; Dust removing preparations; Electrical energy.</p> <p>Class 35: Import-export agency services; Commercial and industrial management assistance; Advertising; Personnel recruitment; Sales promotion for others; Secretarial services; Sponsorship search; Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Marketing research; Market studies; Accounting; Online advertising on a computer network; Provision of an online marketplace for buyers and sellers of goods and services; Production of advertising films.</p>
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52) Most of the applicant's goods in class 3, with the exception of 'air fragrancing preparations' and 'incense', are all types of cosmetics, make-up removing preparations or cleansers and are therefore identical to the opponent's 'cosmetics' and 'cleansers for the face and body'. For those which are not identical, they are nevertheless highly similar to the same. This is because the respective trade channels and distributors are likely to be the same or overlap significantly and all of the

respective goods share a common purpose of enhancing or protecting the appearance and/or scent of the body.

53) The applicant's 'air fragrancings preparations; Incense' are not obviously similar to any of the opponent's goods. Their respective nature, purpose and methods of use are different (the contested goods are, typically, for fragrancings a room whereas the opponent's goods are for application to the body). They are not in competition or complementary. It is not obvious to me that the respective goods will typically be produced by the same undertakings. Although the users are likely to be the same and the trade channels may overlap to some extent, this is not enough to find similarity between the respective goods. I find that the applicant's 'air fragrancings preparations; Incense' are dissimilar to the opponent's goods.

54) Turning to the applicant's goods in classes 4 and 35, I can see no obvious similarity between any of these goods and services and the opponent's goods having borne in mind their users, purpose, nature, methods of use and typical trade channels. Neither is there any competitive nor complementary relationship in play. The relevant goods and services are dissimilar.

55) As there must be some degree of similarity between the respective goods and services in order for a likelihood of confusion to be found¹⁷, the objection under section 5(2)(b) of the Act must fail at this point against the following goods and services:

Class 3: Air fragrancings preparations; Incense.

Class 4: Perfumed candles; Grease for footwear; Methylated spirit; Firewood; Beeswax for use in the manufacture of cosmetics; Dust removing preparations; Electrical energy.

Class 35: Import-export agency services; Commercial and industrial management assistance; Advertising; Personnel recruitment; Sales promotion for others; Secretarial services; Sponsorship search; Retail services for

¹⁷ *Waterford Wedgewood v OHIM* Case C-398/07

pharmaceutical, veterinary and sanitary preparations and medical supplies; Marketing research; Market studies; Accounting; Online advertising on a computer network; Provision of an online marketplace for buyers and sellers of goods and services; Production of advertising films.

Average consumer and the purchasing process

56) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

57) The average consumer for the relevant goods is the general public. The purchasing act will be primarily visual with all of the goods being sought out on the Internet or from bricks and mortar establishments. That is not to say, though, that the aural aspect should be ignored because the goods may sometimes be the subject of discussions with sales representatives, for example. I would expect the average consumer to take in to account various factors such as colour, scent, suitability for skin type and aesthetic appeal. The level of attention paid during the purchase is likely to be medium.

Comparison of marks

58) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

It would be wrong, therefore, to dissect the marks artificially, although it is necessary to take account of their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

59) The marks to be compared are shown in the table below:

Opponent's mark	Applicant's mark
DR IRENA ERIS	DearIrean

Overall impressions

60) The overall impression of both marks lies in the combination of the words within them¹⁸.

61) Visually, both marks include within them a five-letter word; the first three letters of those words are identical ('Ire'), however, the last two letters, are presented as 'na' in the earlier mark and as 'an' in the later mark. Both marks also begin with the letter, 'D'. However, the letters which follow that letter are different, being 'r' in the earlier mark to create the word 'Dr' and 'ear' in the later mark to create the word 'Dear'. The word 'Eris' in the earlier mark is not present in the later mark. Viewing the marks overall, I find a low degree of visual similarity between them.

62) Aurally, the earlier mark will be pronounced as 'DOC-TOR-EYE-REE-NA-ER-IS' or 'DOC-TOR-I-REE-NA-ER-IS' (the former being where the 'I' in Irena is pronounced in a long fashion as in the word 'eye'; the latter being where it is pronounced in a short fashion, as in the word 'igloo'). The later mark is likely to be pronounced as 'DE-AH-EYE-REE-AN' or 'DE-AH-I-REE-AN'. Whichever way either mark is pronounced, I find that they are aurally dissimilar overall. If I am wrong on that there is only a low degree of aural similarity between them.

63) Conceptually, the earlier mark will be perceived as a doctor with the full name, Irena Eris. In the later mark, the word 'Dear' will immediately be perceived as meaning an affectionate form of address. As such a term is often used when addressing a person, it is likely that the applicant's mark, as a whole, will be perceived as meaning an affectionate address towards a person named 'Irean'. The opponent contends that, as both marks contain similarly spelt names, Irena and Irean, this renders the marks conceptually highly similar overall. I disagree. I do not consider that there is any conceptual similarity between those forenames and, even if there were, the marks, as wholes, would still be conceptually dissimilar. This is due to the clear conceptual differences created by i) the 'doctor' concept on the one hand and the, contrasting,

¹⁸ I note that the opponent appears to agree with this given that it states: 'The dominant and distinctive parts of the marks at issue are the words DR IRENA ERIS and DearIrean', as per its submissions in lieu, part 1.4.

'Dear' concept (a term of affection) on the other, and ii) the presence of a surname, Eris, in the earlier mark which is not present in the later mark. If I wrong about that, any conceptual similarity stemming solely from the respective similarly spelt forenames must be low.

Distinctive character of the earlier mark

64) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion between it and the contested mark (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

65) I will first consider the inherent distinctiveness of 'DR IRENA ERIS', I note that the opponent makes no submissions on this point. Instead, its arguments are focused upon the mark's enhanced distinctiveness which, it says, is high due to the use that has been made of it. As I have already indicated, the earlier mark will evoke the concept of a doctor by the name of Irena Eris. The mark is not descriptive or allusive of the relevant earlier goods. I find that it has a medium degree of inherent distinctiveness.

66) I now turn to the question of whether the inherent distinctiveness of the earlier mark has been enhanced through use, as contended by the opponent. In this regard, I remind myself that it is, of course, the perception of the relevant section of the public in the UK which matters in the instant proceedings.

67) Whilst I accept that Mrs Borys' evidence is sufficient to show that there has been genuine use of the earlier mark in the UK, I find that it is not sufficient to show that the earlier mark also enjoyed enhanced distinctiveness here at the relevant date. I come to this conclusion having regard, in particular, to the lack of total UK sales figures, the lack of UK advertising/marketing spend, the lack of market share data pertaining to the UK and the limited promotional material before me pertaining to the UK. Although the evidence clearly paints a picture of the earlier mark enjoying substantial recognition in certain territories outside of the UK (most notably in Poland), there is insufficient evidence to show that the same applied in the UK at the relevant date. Accordingly, I will proceed on the basis of the earlier mark's inherent degree of distinctiveness which is, as noted above, of a medium degree.

Likelihood of confusion

68) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods/services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to

compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

69) The identity/high degree of similarity between the relevant goods is a strong factor weighing in the opponent's favour. The earlier mark also has a medium degree of inherent distinctiveness. However, there is only a low degree of visual similarity between the marks. This is a particularly important factor given that the purchasing act is likely to be primarily visual. The marks are also aurally dissimilar or, if I am wrong about that, aurally similar to only a low degree. Furthermore, conceptually, the marks are also dissimilar or, if I am wrong, conceptually similar to only a low degree. Weighing all of these factors, I find no likelihood of direct confusion between the marks in respect of any of the goods at issue, on the part of an average consumer paying a medium degree of attention.

70) I will now consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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

71) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

72) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

73) I can see no proper basis for concluding that the consumer is likely to believe that the respective goods covered by the marks at issue come from the same/linked undertaking(s). Clearly, none of the categories identified by Mr Purvis ((a) –(c)) are applicable in the instant case and I cannot identify any other way in which indirect confusion is likely to arise. Even allowing for the possibility of the respective words, 'IRENA' and 'IREAN', being imperfectly recalled as being the same, the respective

marks would still be insufficiently similar overall, particularly conceptually, to lead the consumer to believe that the goods come from the same/linked source(s). **The opposition under Section 5(2)(b) of the Act fails.**

Section 5(3)

74) Section 5(3) of the Act provides, as follows:

“(3) A trade mark which-

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

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

75) The relevant case law can be found in the following judgments of the CJEU: *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited*, 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.*, C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L’Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public: *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: *Intel*, paragraph 42.

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

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

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such

a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oréal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

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

Reputation

76) The first hurdle that the opponent must overcome under section 5(3) of the Act is to show that the earlier mark had a reputation in the UK on the date that the contested mark was filed. The relevant date in these proceedings is, therefore, **21 February 2023**. If the evidence does not establish the existence of such a reputation, the opponent's case must fail. This is because, without a qualifying reputation in the UK, there can be no link made in the consumer's mind between the respective marks and no unfair advantage taken of, or damage caused to, the earlier mark.

77) In *General Motors*, the CJEU gave guidance on what is required to establish the necessary reputation:

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

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

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

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

78) I have already summarised Mrs Borys' evidence of use earlier in this decision when I considered the matter of genuine use. I also referred to it again when I considered whether the distinctiveness of the earlier mark had been enhanced through use from the perspective of the average UK consumer; I found that it had not. Bearing in mind my earlier comments in that regard and, stressing again, that the instant proceedings must be assessed from the perspective of the average consumer in the UK, I find that, although there have clearly been sales in the UK prior to the relevant date (as demonstrated by, for example, the relevant invoices to UK undertakings) there is insufficient evidence to satisfy me that the scale of UK use has been such as to acquire the necessary reputation. In reaching this conclusion, I have borne in mind, in particular, the lack of total UK sales figures, the lack of UK advertising/marketing spend, the lack of market share data pertaining to the UK and the limited promotional material before me pertaining to the UK. Whilst the evidence suggests that the earlier mark has been used substantially in Poland, and no doubt had the requisite reputation there (and by extension in the EU) at the relevant date, the evidence does not indicate that that reputation extended to the UK. Without such a reputation, the necessary link cannot be established in the average UK consumer's mind and there can be no damage. **The opposition under section 5(3) of the Act fails.**

OVERALL OUTCOME

79) **The opposition fails.**

COSTS

80) The applicant has been successful and is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 1/2023, I award the applicant costs on the following basis:

Preparing a statement and considering the other side's statement	£250
Written submissions in lieu of a hearing	£350
Total:	£600

81) I order Dr Irena Eris Spólka Akcyjna to pay Dameiren (Shenzhen) Industrial Group Co., Ltd. the sum of **£600**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of September 2025

Beverley Hedley
For the Registrar