BL O/0984/25

THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,695,820 IN THE NAME OF PETER KERTELS

AND IN THE MATTER OF THE OPPOSITION UNDER NO 432,420 IN THE NAME OF W STERNOFF LLC

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF ARRAN COOPER (O/385/25) DATED 25 APRIL 2025

DECISION

Introduction

1. This is an appeal from the decision of Arran Cooper, for the Registrar, dated 25 April 2025 (O/385/25). W Sternoff LLC unsuccessfully opposed the trade mark application of Peter Kertels (No 3,695,820) under sections 5(2) and (3) of the Trade Marks Act 1994.

2. Peter Kertels applied to register the word mark EROS BODYGLIDE in Classes 3, 5, 10 and 35. The application was opposed by W Steroff LLC based on five earlier trade marks. The first mark is for BODY GLIDE (No 900,357,376), the second, BODYGLIDE (No 900,559.138), the third BODYGLIDE (No 903,984,549), the fourth FOOTGLIDE (No 905,333,943) and the fifth mark SKINGLIDE (No 910,761,369).

3. All of these marks, except SKINGLIDE, required genuine use of the mark to be established during the relevant period, that is between 12 April 2012 to 11 April 2017. The Hearing Officer found that use had not been established in relation to any of these marks and, in respect of SKINGLIDE, he found that there was no likelihood of confusion between it and EROS BODYGLIDE.

Standard of appeal

4. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that the Hearing Officer has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer's findings were rationally insupportable. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch), [24] and further explained in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8, [49] and *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc* [2025] UKSC 25, [93] and [94].

5. When considering this appeal, and applying these principles, it is important to remember the high bar set.

Grounds of appeal

6. A little over a month before the hearing, the Appellant applied to amend its Grounds of Appeal. The purpose of such grounds was explained by Mr Iain Purvis QC, sitting as an Appointed Person, in *Greybox* (O/106/20), [9]:

> When compiling Grounds of Appeal, it is important for Appellants to have this in mind. The Grounds should identify errors of principle which would provide a proper foundation for the Appointed Person to overturn the Decision.

7. He also indicated that identifying a series of grounds of appeal which is little more than a list of every point where the Appellant disagrees with the Hearing Officer is inappropriate (*Greybox*, [7] and [8]). He revisited the matter recently in *LACD* (O/725/25) where he said at [35]:

> …It is not permissible to argue on Appeal that a Hearing Officer made an error of law or principle sufficient to undermine the Decision unless that error has been identified in the Grounds of Appeal. No such arguments can be permitted because it would be manifestly unfair on the Respondent who has prepared for the Hearing (or perhaps decided they do not need to attend the Hearing) on the basis of the case set out in the Grounds. If the Appellant decides in the course of preparing the Appeal that it needs to be argued on the basis of errors of law or principle not identified in the Grounds of Appeal, then the right course is to apply to amend the Grounds. There is no guarantee that such an application will succeed, but obviously the earlier it is made the better.

8. I entirely agree with the points Mr Purvis makes. It is important for an Appellant to set out clearly the Grounds of Appeal that are being relied upon, but these should not become merely a list of points where there is disagreement.

9. In light of *LACD*, the Appellant applied to amend (that is, elucidate) its Grounds of Appeal so as to make it clear precisely what was being challenged. One would usually expect clarity in the original grounds of appeal, but if this is not the case it is far better that an application to amend is made well in advance of the hearing than to leave the matter to the day of the Hearing (when it is likely to be rejected).

10. As there is no deadline for the filing of a Respondent's Notice in appeals before the Appointed Person and the filing of further evidence is strictly controlled, it will often be the case that where an application to amend is made a month ahead of the hearing, such as here, there is unlikely to be prejudice caused to the Respondent. Indeed, in most cases the Respondent only has to draft a skeleton argument or written submissions, which have to be filed a few days before the Hearing, and these are unlikely to have been prepared a month in advance of any hearing.

11. Accordingly, I allowed the Appellant's application to amend its Grounds of Appeal because, while the amendments were extensive, they clarified the scope of the challenge to the Hearing Officer's decision.

Grounds

12. The Appellant relies on three grounds of appeal. The first ground of appeal (which has various elements) is that the Hearing Officer erred in his conclusion that the marks BODY GLIDE/BODYGLIDE had not been used. This second ground is that the

Hearing Officer misapplied the principle from C-120/04 *Medion AG v Thomson Multimedia Sales* [2005] ECR I-8551 relating to whether the element BODYGLIDE had independent distinctive character in the mark EROS BODYGLIDE. The third ground of appeal relates to the Hearing Officer's assessment of the similarity of the goods covered by EROS BODYGLIDE and SKINGLIDE.

Ground 1: Proof of use

13. The Appellant has limited its claim of genuine use to the marks BODYGLIDE and BODY GLIDE and in relation to the goods "an applicant and coating for superficial epidermal anti-chafing balm' in Class 3. The Appellant's first ground of appeal has five elements, but two strands. One strand complains that the Hearing Officer adopted the wrong approach to assessing the evidence of use. The other strand comprises allegations that he did not properly consider particular evidence. I will begin by considering the criticisms of his approach before turning to the evidence itself.

Hearing Officer's general approach was overly forensic and stringent

14. Ms Knott submits that the Hearing Officer was overly forensic and stringent in assessing whether there had been genuine use. It is worth noting that trade mark litigation has two conflicting approaches to evidence. On the one hand, in relation to the issue of whether marks are similar or if there is a likelihood of confusion, little or no evidence is required, it having been accepted long ago and at the highest level that the judge (or now, Hearing Officer) can make the decision over whether there would be confusion based on the judge's own experience: *Spalding v Gamage* (1915) 32 RPC 273 at 286-7.

15. On the other hand, in relation to proof of use (and distinctiveness or reputation) the assessment of the evidence is by its nature forensic and stringent. As Daniel Alexander QC, both sitting as a deputy High Court judge and as an Appointed Person, has emphasised, it is important to ensure that when proving use the registered proprietor has dotted all the i's and crossed all of the t's in its evidence: *Abanka DD v Abanca Corporacion Bancaria SA* [2017] EWHC 2428 (Ch), [88]; *Gerry Weber International Ag V Guccio Gucci Spa* [2015] RPC 9, [1]. Any evidence not meeting this high standard can properly be disregarded by the tribunal.

16. Mr Alexander further stated in *Awareness Limited v Plymouth City Council* (O/236/13), [22]:

> The burden lies on the registered proprietor to prove use...it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

17. Indeed, as the requirement to prove use is to establish and maintain an exclusive right it is appropriate that any evidence of use is proved strictly. But as Mr Alexander says if a mark has been used it should be *easy* to prove use even if the test is strict.

Consideration of the totality of the evidence

18. Ms Knott's second criticism of the Hearing Officer's approach was that he failed to consider the evidence holistically. She referred me to T-415/09 *New Yorker SHK Jeans v OHMI*, EU:T:2011:550, [53] (citations omitted):

> Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned…. However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts…

19. This passage was considered in *100% Capri* (O/357/14), [15] where Amanda Michaels, as the Appointed Person, accepted the Hearing Officer's view of the effect of this decision:

> He understood the General Courts judgment as showing that documents which would be insufficient to prove genuine use if unsupported by other evidence might show sufficient use if explained or supported by clear evidence.

20. The Hearing Officer in *100% Capri* seems to have explained the effect of *New Yorker* very well. There is no accumulation of evidence (however vast) which can establish use of a mark if individually each piece of evidence does not establish use. But it may be that two pieces of evidence, each of which do not establish use alone, when read together do establish that the mark has been put to genuine use. Accordingly, the assessment of whether genuine use has been made of a mark is forensic and does need to be stringent, but as I pointed out in *RASTA PASTA* (O/750/21), [17]:

> …the assessment of use is always fact dependent. There is no one size fits all and there is no checklist of evidence which can be applied by a Hearing Officer. A tribunal's expectations will depend on a host of things including: the goods or services in question; whether the use was by the proprietor or a licensee; the passage of time since the end of the period of non-use being considered; and, ultimately, the evidence that can reasonably be expected to be in the possession or control of a party during the proceedings to establish whether the use of the mark was genuine.

Documents outside the relevant period

21. Ms Knott's next criticism is that the Hearing Officer was too firm in rejecting evidence dated outside the relevant period (in particular some consumer comments on a website from January 2012). She submits that such evidence can establish use of the mark within the relevant period (which started on 12 April 2012). She relies on T-689/19 *Euroapotheca UAB v EUIPO*, EU:T:2020:320, [46]:

> …Indeed, as maintained by EUIPO, the invoices dated September and November 2016 and January and February 2017 post-date the relevant period only by a few weeks or a few months. It is possible to take account of matters only just after the period defined as relevant by the applicable regulation since that enables the scope of use of the registered mark and the actual intentions of the holder during the latter period to be borne out or more accurately assessed. Provided that there is proof of use which relates to the relevant period, as in the present case,

> the documents from only just outside that period, far from being irrelevant, can be taken into account and evaluated together with the rest of the evidence, since they can offer proof of real and genuine commercial exploitation of the mark…

22. The indirect origin of this proposition is the Court of Justice's order in C-259/02 *La Mer Technology* [2004] ECR I-1159, [31]:

> …the Directive does not expressly preclude in assessing the genuineness of use during the relevant period, account being taken, where appropriate, of any circumstances subsequent to that filing. Such circumstances may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time.

23. Accordingly, evidence outside the relevant period can be used to bolster or explain evidence of use dating from within the relevant period, but it cannot in itself be used to establish genuine use. Furthermore, as Mr Alexander made clear in *Awareness,* it should be *easy* for a registered proprietor to establish genuine use during the relevant period. So, where there is a reasonable amount of direct evidence of use of the mark outside the relevant period, but no direct evidence within that period, it does raise the question: Why not?

The evidence in this case

24. Ms Knott, in light of one or more of these general criticisms, submits that the evidence filed by the Appellant should have been sufficient to establish genuine use. I will look at the relevant types of evidence in turn.

Sales figures

25. The Appellant criticises the Hearing Officer for highlighting that any sales figures for 2012 and 2017 may or may not fall within the relevant period: Decision, [37] and [38]. It is clear that where sales figures are provided for a year and the relevant period begins or ends in the middle of that year then it cannot be assumed that all the sales for that year fall within the relevant period. However, in this case, the sales figures are identified in years which were entirely within the relevant period (2013, 2014, 2015 and 2016). The difficulty I have with the Appellant's submission is that I do not think the Hearing Officer made very much of the sales in 2012 and 2017 being partially outside the relevant period. His criticism of the sales figures was that they did not divide between sales made under the mark BODYGLIDE and FOOTGLIDE (and other brands): Decision, [51].

26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or

service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.

28. In this case, Mr Sternoff makes it clear that the sales figures are "across the full range of Body Glide products" (Witness Statement, [51]). This evidence in itself means that the global figures do not establish use.

Web traffic

29. The Appellant provided evidence of web-visits between 2013 and 2017 from the United Kingdom (a total of 87,948) and the rest of the EU (a total of 74,372). The Hearing Officer notes that there is no indication of whether these are unique visits, whether the websites made sales to the United Kingdom, or whether any sales are actually made: Decision, [31].

30. Ms Knott submits that the website evidence should not be dismissed because there is no evidence the visits were all unique. She says that it is reasonable to infer that there were a lot of unique visits in this number. While I accept it would be wrong to disregard the evidence entirely on the grounds that there is no evidence of unique visits, I think the Hearing Officer was right to highlight the fact that this figure was not provided.

31. However, more problematically for the Appellant, a visit to the website of a foreign company does not in itself suggest use in the United Kingdom (or EU). It is necessary to show that the website was trying to attract customers from the relevant territory: targeting, as it is commonly called.

32. It has long been established that accessing a website is not sufficient to amount to infringement (see C-324/09 *L'Oréal v eBay*, EU:C:2011:474) and likewise showing that a person from the relevant territory has accessed a website which uses the mark is not enough to establish use of the mark in the relevant territory unless there is also evidence that the website is targeting customers in that territory.

33. Ms Knott suggests that there is targeting because the evidence highlights that shipping was free for US customers and so, she says, it can be inferred that non-US customers were being targeted as well.

34. The difficulty with this submission is that even if that inference were made it is a long way from suggesting that customers are being targeted all over the world or that they were targeted in the relevant territory. Indeed, I can take notice of the fact that as a cosmetic product its sale would be regulated in many parts of the world (including the UK and EU: see Regulation (EC) No 1223/2009 on cosmetic products) which strongly suggests against an inference of global targeting being appropriate.

Company agreements

35. In his Witness Statement (at [39]), Mr Sternoff mentions that there were agreements with "manufacturer representatives" and "wholesale distribution companies" in

Brighton, London, Southport, and Bristol. The Hearing Officer notes these agreements but says he has no idea of their reach or range: Decision, [24].

36. Ms Knott submits that because this evidence was unchallenged it must be accepted at face value. It has long been established that a "bare assertion" that a mark has been used is not sufficient for genuine use: *Moo Juice TM* [2005] EWHC 2584 (Ch), [2006] RPC 18. To avoid being a "bare assertion" it must be, according to Richard Arnold QC, sitting as the Appointed Person in *EXTREME TM* [2008] RPC 2 at [31]:

> A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used…

37. The assertion that there are agreements was not disputed by the Hearing Officer, but he cannot be expected to guess at the requirements of those agreements (that is the "when, where and in what manner"). Ms Knott prays in aid the global sales figures made to these distributors. I accept that this evidence shows sales, but they suffer from the same problem as the other global sales figures already considered. Accordingly, like the Hearing Officer, I cannot see how these agreements can help establish use.

Social media

38. The Hearing Officer gave very little weight to the evidence of social media traffic because the 'follower' figures provided were collected six years after the relevant date: Decision, [48]. Ms Knott submits that because there was evidence the social media accounts were created prior to or within the relevant period this is sufficient to make the evidence useful. I disagree. First, as the Hearing Officer highlighted, these were "global accounts" and so it is not clear how many followers come from the relevant territory. Secondly, it is not possible to infer the Appellant had any particular number of followers in the UK or EU at a point six years earlier, whether or not these were working accounts. This evidence was therefore rightly rejected by the Hearing Officer.

Invoices

39. The Appellant filed evidence of numerous invoices having dates throughout the relevant period. Each of these included the "body glide" logo in blue in the top left-hand corner. While these invoices include a variety of products, a large number of the invoiced products were "anti-chafe balm" or "anti-blister and chafing stick". The Hearing Officer discussed this evidence at Decision, [40] and stated that, while they "include the wording 'body glide', there is nothing to suggest how the end consumers would be confronted with this branding in the retail environments."

40. I entirely accept the Hearing Officer's point that these invoices do not indicate how the goods would be encountered in the retail environment, but it does clearly show how the marks are encountered by distributors. The law is clear that the relevant public for genuine use is not confined to the end user (ie the retail environment) and can include professional intermediaries: T-431/15 *Fruit of the Loom, Inc v EUIPO,* EU:T:2016:395, [49]-[50]. The Hearing Officer therefore erred.

41. Turning to the invoices themselves, Ms Knott relies on T-71/13 *Anapurna GmbH v OHIM*, EU:T:2014:105, [48] and [60] where invoices to distributors were discussed:

> It should be observed that the mark at issue is affixed, in large letters and at the top of the page, on each of the invoices …. Those invoices establish therefore a clearly visible connection between the mark at issue and the goods mentioned on the invoices, more than ten of which refer to the sale of bags….
>
> Regarding the applicant's argument that the pictures do not show the mark at issue affixed on the goods and cannot therefore constitute proof of use of the mark in relation to the goods, it is necessary to note …that it is not necessary that the mark at issue be affixed on the goods for there to be genuine use of it in relation to those goods. It suffices that the use of the mark establishes a connection between the mark and the sale of its goods. The presence of the mark at issue on the invoices, articles and advertisements relating to the goods concerned establishes that connection.

42. While these invoices are redacted, they clearly show supplies of "anti-chafe balm" throughout the relevant period to businesses in the United Kingdom, Denmark, Greece, Germany, Ireland and Spain in small, but not negligible, quantities. In light of *Anapurna*, it does not matter whether the goods the invoice record being sold had the BODYGLIDE or BODY GLIDE trade mark affixed to them. There is a clear connection between the trade mark being used on the invoices and the goods recorded on those invoices.

43. Therefore, the invoice evidence is sufficient to suggest that BODY GLIDE has been used in relation to anti-chafe balm during the relevant period. And it is my view that BODYGLIDE would be a variant form of "body glide" for the purposes of section 6A(4)(a) of the Trade Marks Act 1994. Thus, the invoices are likewise sufficient to show use of that mark in relation to those goods as well.

44. I accordingly allow the first ground of appeal and find that there was evidence of genuine use of the two marks.

Ground 2: The *Medion* principle

45. In relation to the second ground of appeal, Ms Knott submits that the "BODYGLIDE" element in the mark "EROS BODYGLIDE" has independent distinctive character. This in turn means, she says, that there is a likelihood of confusion between that mark and the Appellant's mark SKINGLIDE.

46. In C-120/04 *Medion v Thomson Multimedia Sales* [2005] ECR I-8551 and, later, C-591/12P *Bimbo SA v OHIM* ECLI:EU:C:2014:305 the Court of Justice explained that in some composite marks it may be the case that one element has an independent distinctive character. In such a case, that element will be given more attention by consumers and so increase the likelihood of confusion with another mark containing the same or a similar element.

47. The Hearing Officer addressed the *Medion* point at [116]:

> I accept that the applicant's mark does not form a unitary meaning and that 'Eros' will be viewed as a house brand (and therefore, the indicator of origin). However, I do not consider that the word 'Bodyglide' plays an independent distinctive role in the mark as a whole to the point that the Medion principle applies. I say this because the allusive/laudatory nature of the word 'Bodyglide' is such that I do not consider that the applicant's mark would necessarily be viewed

> as a 57 composite mark which consists of two signs in the way described by Whyte and Mackay. Instead, consumers will view the mark as 'Eros' followed by a second word that hints at the goods available under the mark. As a result, I do not consider that the Medion principle applies in the present case. I will, therefore, say no more about it and, instead, proceed to consider confusion in the ordinary ways.

48. Ms Knott criticises the Hearing Officer on the basis that he envisages a "sliding scale" for *Medion* whereas, she submits, it is a binary question: an element of a composite mark has an independent distinctive character or it does not.

49. It is too often the case that the *Medion* principle is given more weight than it bears: see Annette Kur and Martin Senftleben, *European Trade Mark Law: A Commentary* (OUP 2017) at [4.342]; also see *Lion's Gate Entertainment v Telegraph Media* [2019] FSR 16, [8]-[20]. And I am far from sure that it matters whether *Medion* is binary or linear, particularly when distinctiveness assessments are usually linear. However, in this case it clearly does not matter. The Hearing Officer took the view that BODYGLIDE had not crossed the threshold of having independent distinctive character. It does not matter how he got there whether a binary assessment or a linear one. After all, a binary assessment can just be mapped as one point on a linear scale.

50. Accordingly, I reject the second ground of appeal.

Ground 3: Similarity of goods

51. The third ground of appeal was dependent on the second ground of appeal succeeding and so I do not need to consider it further.

Remittal

52. Ms Knott submits that if I find for the Appellant on the first ground of appeal then the matter should be remitted to the registrar to consider whether the opposition can succeed based on the marks BODYGLIDE / BODY GLIDE. As the Respondent did not take part in the appeal it seems to me that this is the only fair way forward.

Conclusion

53. I have allowed the appeal on ground one and find that there has been genuine use of the marks BODY GLIDE and BODYGLIDE in relation to "an applicant and coating for superficial epidermal anti-chafing balm' in Class 3. I remit the matter back to the registrar, to be heard by a different Hearing Officer, to consider the remainder of the Appellant's opposition.

54. The appeal was partially successful and so the Appellant is entitled to a contribution towards its costs. Accordingly, I order that the Respondent do pay £1,000 as a contribution towards the costs of appeal by 4pm on 4 November 2025.

PHILLIP JOHNSON
THE APPOINTED PERSON
21 OCTOBER 2025

Representation:

For the Appellant: Ms Becky Nott (instructed by Barker Brettell)

The Respondent did not take part in the appeal.