

O-1116-24

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NOS. 3867945 & 3867948
BY J. & J.G. DICKSON & SON LTD
TO REGISTER

Kashmir
Kashmir Cream
Kashmir Crème

(SERIES OF 3)
AS A TRADE MARK IN CLASS 3

AND

Kashmir

AS A TRADE MARK IN CLASSES 3, 21, 24, 28, 35, 42 & 44

AND OPPOSITION THERETO (UNDER NOS.440471 & 440483)


BY

UNITED TOILETRIES & COSMETICS LTD

Background & pleadings

1. J. & J.G. Dickson & Son Ltd (“the applicant”) applied to register the trade marks set out on the title page on 15 January 2023. Application no. 3867945 (“the ‘945 mark”) was published in the Trade Marks Journal on 27 January 2023 in class 3 for the goods set out in Annex 1 of this decision. Application no. 3867948 (“the ‘948 mark”) was published on 10 February 2023 in classes 3, 21, 24, 28, 35, 42 and 44. The specific goods and services in classes 3 and 35 which are under attack in this opposition are set out in Annex 2 of this decision.

2. United Toiletries & Cosmetics Ltd (“the opponent”) opposed the ‘945 mark in full and the ‘948 mark in part against classes 3 and 35 on 27 April 2023. The applications were opposed under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under 5(2)(b) and 5(3), the opponent relies on the following comparable trade mark registration¹:

UK TM No.900564971	Goods on which the opponent relies
	Class 3: Perfumes; scents; Eau de Toilette; Aftershave; Cologne.
Filing date: 8 July 1997 Registration date: 1 December 1998	

3. Under section 5(4)(a), the opponent relies on the sign KASHMIR which it claims to have used throughout the UK since 1978 for *Perfumes, Scents; Eau De Toilette; Aftershave; Cologne*.

¹ Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all rights holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. The applicant filed two counterstatements in which it denied that its trade marks and its respective goods and services were similar to the opponent's earlier mark. It also put the opponent to strict proof of its claims.

5. Given the relationship between the oppositions, these proceedings were consolidated on 8 June 2023 under Rule 62(1)(g) of the Trade Marks Rules 2008.

6. Both sides have been represented throughout these proceedings. The applicant has been represented by Cloch Solicitors and the opponent by Stobbs.

7. Both sides filed evidence during the proceedings. A hearing was requested, and the matter was heard by me via videoconference on 6 March 2024. Mr Philip Hannay, of Cloch Solicitors, appeared for the applicant and Mr Julius Stobbs, of Stobbs, appeared for the opponent.

8. I make this decision based on a consideration of all the material before me and the submissions presented at the hearing.

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 that predate the UK's withdrawal from the EU.

EVIDENCE

10. The following evidence was filed in these proceedings:

- Opponent's evidence in chief: A witness statement and 4 exhibits dated 8 August 2023 filed in the name of Peter Jackson, founder and creator of Milton-Lloyd Limited ("Milton-Lloyd") on behalf of the opponent. I will discuss the significance of Milton-Lloyd later in this decision.
- Applicant's evidence: A witness statement and 1 exhibit dated 9 August 2023 filed in the name of Philip Hannay of Cloch solicitors, the applicant's legal representative.

- Opponent’s evidence in reply: A witness statement and 2 exhibits dated 28 September 2023 filed in the name of John Weston, a trade mark attorney employed by Stobbs, the opponent’s legal representative.

Relevance of Milton-Lloyd

11. In his witness statement, Mr Jackson stated the following:

“I, Peter Jackson, of Milton-Lloyd Limited, duly authorised representative of United Toiletries and Cosmetics Limited of 42 Norwood High Street, London, SE27 9NR, United Kingdom, the Opponent, do hereby declare as follows:

2. I am the founder and creator of Milton-Lloyd Limited. Milton-Lloyd Limited is the manufacturing licensee of United Toiletries and Cosmetics Limited and has been since 1978. In this role, Milton-Lloyd Limited manages the Opponent's intellectual property.

3. I have been involved with the Opponent's brand protection since 1978. I am familiar with current United Kingdom and global marketing and brand extension trends in my field. I am duly authorised by the Opponent to make this Statement on its behalf.”

12. Mr Hannay, for the applicant, filed evidence questioning Mr Jackson’s capacity for making a witness statement on behalf of the opponent and provided Companies House records showing that Mr Jackson appears to have no connection with the opponent which is a dormant company with no recorded accounts, assets, or employees. Mr Hannay made further submissions on this matter at the hearing.

13. In response in evidence, Mr Weston, for the opponent, exhibited two letters, both dated 29 August 2023. The first exhibit was letter signed by Alison Jackson, a director of Milton-Lloyd, on that company’s letterhead² and the second exhibit was a letter signed by Alan Hasso, a director of the opponent, set out on that company’s

² Exhibit JW1

letterhead.³ The text of both letters is identical as shown below, however Mr Hasso's letter contains a typographical error regarding the correct name of the opponent,

"We, the Director of United Toiletries and Company Limited write this letter to confirm that all matters referred to in the Witness Statement of the 8" August 2023 are fully authorised by us, and we further confirm the personal relationship that Peter Jackson has enjoyed with United Toiletries and Company Limited and with Milton-Lloyd Limited, and with Union Trading Company from the start of this unique cooperation in 1978 -- which continues until today."

14. I note that both Milton-Lloyd and United Toiletries and Cosmetics Limited share the same business address and that Alison Jackson is also recorded as the company secretary for the opponent. ⁴ Taking all this information into account, I regard the above as being sufficient to prove that Peter Jackson is authorised to file a witness statement and associated evidence as a licensee of the opponent.

15. Turning now to Mr Jackson's evidence, he states that the earlier mark is used on perfumes and was first used in the Middle East in 1978. He does not state when it was first used in the UK.

16. Mr Jackson provides an undated outline image of the packaging for the Kashmir perfume box⁵, viz:



³ Exhibit JW2

⁴ Exhibit B -PH1-01, page 5

⁵ Exhibit PJ1

17. The following undated images illustrate what can be seen of the earlier mark when the box is assembled. Also featured in the illustration is the perfume bottle itself:⁶



18. Mr Jackson also includes an undated merchandising booklet⁷ containing the full range of Milton-Lloyd products which include images of the box and bottle of Kashmir branded perfume as set out in the illustration below. Mr Jackson stated the booklet is distributed in the UK.



19. Mr Jackson provided the following table for UK turnover between 2000-2022

Year	Turnover
2000	£6120
2001	£9518
2002	£4725

⁶ Exhibit PJ1

⁷ Exhibit PJ1

2003	£1164
2004	£65875
2005	£3804
2006	£6646
2007	£8696
2008	£13398
2009	£19645
2010	£8733
2011	£15354
2012	£4682
2013	£3556
2014	£300
2015	£1555
2016	£2533
2017	£7427
2018	£13239
2019	£22905
2020	£10744
2021	£7595
2022	£19572

20. Mr Jackson states that global sales of Kashmir products have amounted to 1 million bottles but does not give a time period for this figure. The Kashmir products are available in the UK to purchase from Amazon and several screenshots dated 8 August 2023 are provided from that website showing a Kashmir branded perfume extract product for sale in pounds sterling.

21. Mr Jackson exhibits ten invoices dated between 2018 and 2023 containing orders for Kashmir products.⁸ Six invoices were sent to a London address with an SE19 postcode, three were sent to Birmingham address with a B19 postcode and there was a single invoice for an address in Tipton in the West Midlands. The goods are

⁸ Exhibit PJ3

described in the invoices as Kashmir PDT, which was confirmed at the hearing as an abbreviation for perfume de toilette.

22. Mr Jackson states that the opponent's Kashmir branded goods have been promoted amongst the opponent's other brands at trade shows such as Cosmoprof Bologna, Cosmoprof Las Vegas, Cosmoprof Hong Kong, International Duty-Free Symposium Cannes and BeautyWorld Dubai. Mr Jackson further states that each trade show cost £60k to attend, therefore representing an annual expenditure of £300k. In addition, he exhibits two undated images of Milton-Lloyd's attendance at a trade show.⁹

23. That concludes my summary of the evidence.

Proof of use

24. The relevant statutory provision is Section 6A, which reads as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

⁹ Exhibit PJ4

(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.”

25. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also 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”.

26. Section 100 of the Act states that:

“100. 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.”

27. 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13

P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with

the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

28. I also find the following case law to be of use where in *Awareness Limited v Plymouth City Council*¹⁰, Mr Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, 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.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

¹⁰ Case BL O/236/13

29. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*¹¹, Mr Geoffrey Hobbs Q.C. (as he was then) also sitting as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed

¹¹ Case BL O/404/13

for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Variant use of the earlier mark

30. Under sections 5(2)(b) and 5(3) of the Act, the opponent relies on a single earlier registered mark, which is a composite arrangement consisting of three letters K (“triple K”) and word Kashmir positioned largely below the second letter K, namely



. Given their size and scale (in relation to the word element) and their positioning at the top of the mark, I find that the triple K element makes a visual, aural and conceptual impact of its own. In my view, the triple K constitutes a distinctive element of the mark making an equal contribution, along with the word element, to the overall distinctiveness of the earlier registration.

31. The evidence provided in exhibit PJ1 demonstrated how the mark is used in the course of trade, i.e. when applied to the perfume box and the perfume bottle. In relation to the perfume box, once assembled, the first and third letters K are folded on



to the left and right side panels as per this illustration . When applied to the perfume bottle itself the mark used is a single K and the word Kashmir, as per this



illustration . The question I must consider is whether use in these two forms constitutes acceptable variant use of the earlier registered mark.

32. In *Lactalis McLelland Limited v Arla Foods AMBA*¹², Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

¹² BL O/265/22

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

33. In my view, the mark applied to the perfume bottle does not constitute acceptable variant use of the mark as registered. The mark, as registered, has the triple K element which I’ve already found has an independent distinctive character. The mark on the bottle is a single letter K. However, I find use of a single letter K has a different visual, aural and conceptual impact and as such is a significant alteration to the distinctive character of the triple K element.

34. When the earlier mark is applied to the perfume box, the triple K element is present on the image of the flattened box but is then distorted by the structure of the assembled box which is when consumers will interact with the product. When a consumer looks at the box front on, if it were displayed on a shelf for example as per the illustration in the opponent’s merchandising booklet given in exhibit PJ1, they would only see a single letter K and the word Kashmir which I have previously found above is a significant alteration to the distinctive character of the triple K element. Even if the box were picked up and examined or as presented in the images for the Amazon retail site, it is not clear to me that a consumer would see the letters K on each of the left and right panels as being part of a singular trade mark. They may not give the letters K on the side panels of the box any trade mark significance at all, particularly as when unpacking and viewing the product, the consumer will be presented with a bottle featuring a single letter K above the word KASHMIR. Taking all this into account, I find the use of the mark as applied to the perfume box to be unacceptable variant use.

35. Therefore I do not find the opponent has cleared the first hurdle for their claim under sections 5(2)(b) and 5(3).

Section 5(4)(a)

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

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

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

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

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

39. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,¹³ Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

¹³ [1990] RPC 341, HL, page 406.

“First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

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

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

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

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

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

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

Relevant date

41. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,¹⁴ Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:¹⁵

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess

¹⁴ BL O-410-11

¹⁵ BL O-212-06

whether the position would have been any different at the later date when the application was made.”

42. The filing date for both contested applications is 15 January 2023. Therefore, all factors will be assessed as at this date.

Goodwill

43. The first hurdle for the opponent is to show that it had the required goodwill for the sign Kashmir at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*¹⁶ viz,

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

44. In *Smart Planet Technologies, Inc. v Rajinda Sharm*¹⁷ Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

¹⁶ [1901] AC 217 (HOL)

¹⁷ BL O/304/20

45. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the

UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

46. The relevant market for assessing goodwill is the UK. In its notice of opposition, the opponent claims to have used the sign Kashmir in the UK since 1978 in relation to *perfumes; scents; eau de toilette; aftershave; Cologne*.

47. Peter Jackson's witness statement states that the Kashmir mark was first used in 1978 but does not state where it was first used. Mr Jackson further submits that global annual sales of Kashmir branded goods amount to 1 million bottles but does not specify a time period for that assertion. Neither has this been narrowed down to a UK specific figure. Moreover, none of the trade shows mentioned by Mr Jackson as being attended by the opponent's licensee, Milton-Lloyd, took place in the UK. I find it difficult to see how attending a trade show in Las Vegas or Dubai can be said to equate to promotion of the products to UK consumers. UK consumers may attend those trade shows but there is no evidence before me to show that the opponent attempted to attract UK customers at those events or that it was seeking to create or maintain a share of the UK market. Whilst Mr Jackson specifies how much each trade show cost to attend, there are no other advertising expenditure figures given nor is there any evidence given of any other advertising in the UK, such as in a relevant trade publication or in other mainstream or online media for example.

48. In Mr Jackson's exhibit PJ1 there is a copy of what is described in the witness statement as a merchandising booklet, which he states is distributed in the UK but gives no detail as to who the booklet is distributed to, where the recipients are located, how often the booklets are distributed or how many such booklets are distributed.

49. The evidence provided by Mr Jackson shows that the mark used in the course of trade, which is where a consumer would encounter it, is the word Kashmir combined with a figurative element being a stylised letter K. The only dated use of the word only sign Kashmir, by which I mean dated prior to the relevant date, is given on ten invoices where it is referenced in the following way, namely **Kashmir 55ml pdt**. It was confirmed at the hearing that 'pdt' is an abbreviation for perfume de toilette and 55ml is the liquid volume of that particular product. There was no evidence presented within the invoices to show the word Kashmir being used to denote anything other than this single type of perfume.

50. Other uses of the sign Kashmir solus are given on the Amazon screenshots in the product descriptions but these are dated after the relevant date. The undated images taken at the trade shows, as evidenced in exhibit PJ4, do not assist either as it was not confirmed by Mr Jackson in his witness statement when they were taken or even whether they were taken in the UK. Moreover, the only visible reference I can make out in the images, helpfully being pointed at by a person standing next to a display in the second image, is not the word Kashmir but the stylised letter K presented either singly or in batches of four.

51. The opponent has provided a table showing UK derived turnover between 2000 and 2022. However, in its skeleton argument at paragraph 17.3, the opponent says it is a "breakdown of turnover under the KASHMIR brand". In my view this is not the same as turnover generated under the sign Kashmir solus, which is the sign claimed by the opponent under section 5(4)(a). The dated evidence provided does not support that the word Kashmir solus was used in the course of trade on anything other than invoices. What the remaining evidence shows is either undated or in the case of the Amazon website listings is dated after the relevant date, but even that is use of the word Kashmir combined with the stylised letter K. Taking guidance from the RECUP

decision, and taking in account the UK specific and dated evidence, I do not find that this is sufficient to generate a protectable goodwill.

52. Therefore I find that the opponent has failed to demonstrate goodwill in the sign Kashmir solus and as such has failed to clear the first hurdle required for its claim under section 5(4)(a).

Conclusion

53. The oppositions fail in their entirety.

Costs

54. As the successful party in these proceedings, the applicant is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the TPN, I award costs as follows:

£600	Considering Notices of Opposition and preparing counterstatements.
£900	Preparing evidence and considering the other side's evidence.
£1000	Preparing for and attending the hearing.
£2500	Total

55. I order United Toiletries & Cosmetics Ltd to pay J. & J.G. Dickson & Son Ltd the sum of £2500. 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 22nd day of November 2024

June Ralph

For the Registrar

The Comptroller-General

Annex 1

Opposed Goods for UK TM No. 3867945

Class 3: Creamy rouge; Anti-aging cream; Anti-wrinkle cream; Mattifying gel cream; Shaving mousse; Lip cream; Cuticle cream; Creamy rouges; Hair cream; Cream foundation; Aftershave moisturising cream; Nail cream; Shaving cream; Skin cream; Cleansing mousse; Facial cream; Cleansing cream; Cream soaps; Styling mousse; Anti-wrinkle cream [for cosmetic use]; Camouflage cream; After-sun creams; Hair mousse; Cream for whitening the skin; Whitening the skin (Cream for -); Sunscreen cream; Blemish balm creams; Wrinkle resistant cream; Anti-ageing creams; Moisturizing creams; Base cream; Moisturising creams; Anti-aging creams; Hair protection mousse; Eau de parfum; Eau de toilette; Eye cream; Suntan creams [self-tanning creams]; Anti-wrinkle creams; Skin cleansing cream; Skin cream [for cosmetic use]; Depilatory creams; Bath cream; Beauty balm creams; Creams for leather; Leather (Creams for -); Facial cream [for cosmetic use]; Eaux de toilette; Cosmetic nourishing creams; Perfumed creams; Skin care mousse.

Annex 2

Opposed goods and services for UK TM No.3867948

Class 3: Cosmetics; Skincare cosmetics; Moisturisers [cosmetics]; Cosmetics and cosmetic preparations; Hair cosmetics; Skin fresheners [cosmetics]; Cosmetics for eye-lashes; Cosmetics for suntanning; Organic cosmetics; Anti-aging moisturizers used as cosmetics; Lip cosmetics; Nail cosmetics; Non-medicated cosmetics; Natural cosmetics; Skin moisturizers used as cosmetics; Cosmetics preparations; Mousses [cosmetics]; Make-up palettes containing cosmetics; Tanning oils [cosmetics]; Tanning gels [cosmetics]; Cosmetics in the form of lotions; Facial creams [cosmetics]; Beauty care cosmetics; Colour cosmetics; Self-tanning preparations [cosmetics]; Cosmetics for animals; Eyebrow cosmetics; Tanning preparations [cosmetics]; Suncare lotions [for cosmetic use]; Decorative cosmetics; Multifunctional cosmetics; Eye cosmetics; Milks [cosmetics]; Body creams [cosmetics]; After-sun oils [cosmetics]; Skin masks [cosmetics]; Cosmetics for eye-brows; Tanning milks [cosmetics]; Functional cosmetics; Suntan oils [cosmetics]; Facial gels [cosmetics]; Skin care cosmetics; Fluid creams [cosmetics]; Cosmetics for children; Suntan lotion [cosmetics]; Non-medicated cosmetics and toiletry preparations; Humectant preparations [cosmetics]; Emollient preparations [cosmetics]; Cosmetics in the form of creams; Powder compacts [cosmetics]; Sun-tanning preparations [cosmetics]; Cosmetic hair lotions; Suntanning oil [cosmetics]; Colour cosmetics for the skin; After-sun milk [cosmetics]; After-sun milks [cosmetics]; Cosmetic moisturisers; Sunscreens [for cosmetic use]; Cosmetic creams and lotions; Bath powder [cosmetics]; Skin recovery creams [cosmetics]; Night creams [cosmetics]; Body gels [cosmetics]; Body and facial creams [cosmetics]; Cosmetic products in the form of aerosols for skincare; Sun blocking lipsticks [cosmetics]; Cosmetics for use on the skin; Lip stains [cosmetics]; Sunscreen [for cosmetic use]; Cosmetic soaps; Sunscreen creams [for cosmetic use]; Cosmetic creams; Creams (Cosmetic -); Body care cosmetics; Cosmetics in the form of powders; Cosmetics for the use on the hair; Cosmetics containing keratin; Hair care lotions [for cosmetic use]; Cosmetic skin fresheners; Dyes (Cosmetic -); Cosmetic dyes; Cosmetics in the form of oils; Beauty lotions; Facial lotions [cosmetic]; Cosmetic facial lotions; Cosmetics containing panthenol; Nail paint [cosmetics]; Cosmetic suntan lotions; After-sun lotions [for cosmetic use]; Perfume oils for the manufacture of cosmetic preparations; Skin care lotions [cosmetic]; Nail

hardeners [cosmetics]; Anti-aging creams [for cosmetic use]; Tissues impregnated with cosmetics; Nail tips [cosmetics]; Colour cosmetics for children; Nail primer [cosmetics]; Sun protecting creams [cosmetics]; Cosmetic products for the shower; Anti-ageing creams [for cosmetic use]; Smoothing emulsions [cosmetics]; Skin cleansers [cosmetic]; Perfumed powders [for cosmetic use]; Liners [cosmetics] for the eyes; Cosmetic creams for the skin; Skin creams [cosmetic]; Skin creams [for cosmetic use]; Body and facial gels [cosmetics]; Cosmetic oils; Moisturising skin lotions [cosmetic].

Class 35: Retail services, mail order retail services, online retail services, wholesale services connected with the sale of makeup, paint, cream, lotion gloss, colouring, the bringing together, for the benefit of others, of a variety of promotional services and marketing services, enabling customers to conveniently view and purchase those services; information, advisory and consultancy services relating to all the aforesaid services; all of the foregoing in relation to cosmetics; marketing research in the fields of cosmetics, perfumery and beauty products; Online retail services relating to cosmetics.