O-1119-24

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK3705373

IN THE NAME OF SOHO FLORDIS UK LIMITED IN RESPECT OF THE TRADE MARK

POTTER'S

IN CLASSES 3, 5, 30 & 32

AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER NO. 506220

BY ERNEST JACKSON & CO LTD

BACKGROUND AND PLEADINGS

1. UK Registration No. 3705373 stands in the name of Soho Flordis UK Limited ("the Registered Proprietor"). The trade mark, as shown on the cover page of this decision, was filed by the Registered Proprietor on 30 September 2021. It became registered on 21 January 2022. The goods as registered are as follows:

> Class 3: Soaps; Perfumery; Essential oils; Cosmetics; Non-medicated skin care preparations; Cosmetic preparations for body care; Fragrances for personal use; Essential oils for personal use; Beauty care cosmetics; Non-medicated toilet preparations; Hair lotions; Shampoos; Cleaning and fragrancing preparations; Aromatherapy preparations; Cleansing lotions; Cleansing creams [cosmetic].
>
> Class 5: Biological preparations for medical purposes; Dermatological preparations; Dietary supplements; Dietary fibre; Dietetic substances adapted for medical use; Nutritional supplements; Herbal supplements; Vitamin preparations; Fish oil for medical purposes; Food for babies; Mineral food supplements; Pharmaceutical preparations; Protein dietary supplements; Vitamin supplements; Beverages adapted for medicinal purposes; Herbal beverages for medicinal use; Vitamin and mineral preparations; Mineral supplements; Malt extracts for pharmaceutical use; Nutritional supplement meal replacement bars for boosting energy; Nutritional drink mix for use as a meal replacement; Meal replacement powders; Meal for pharmaceutical purposes; Extracts of medicinal herbs; Dietetic foods adapted for medical use; Tonics for medical use; Plant extracts for pharmaceutical use; Plant and herb extracts for medicinal use; Extracts of medicinal plants; Mineral waters for medical purposes; Preparations for making medicated beverages; Vitamin drinks; Vitamin and mineral food supplements; Liquid herbal supplements; Herbal medicine; Herbal creams for medical use; Herbal preparations for medical use; Cleansing solutions for medical use.
>
> Class 30: Aromatic preparations for making non-medicated tisanes; Cereal bars and energy bars; Coffee, teas and cocoa and substitutes therefor;

Infusions, not medicinal; Herb teas, other than for medicinal use; Snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Cereal-based snack food; Processed herbs; Preserved herbs; Dried herbs; Herbal infusions; Garden herbs, preserved [seasonings]; Herbal preparations for making beverages; Edible essences for foodstuffs [other than etheric substances and essential oils]; Salts, seasonings, flavourings and condiments; Mineral salts for preserving foodstuffs; Syrup for food; herbal beverages.

Class 32: Energy drinks; Sports drinks; Fruit drinks; Fruit juices; Isotonic beverages; Vegetable drinks; Aerated waters; Vegetable juices [beverages]; Mineral waters; Non-alcoholic beverages; Non-alcoholic preparations for making beverages; Extracts for making beverages; Preparations for making beverages; Powders for the preparation of beverages; Syrups for making beverages; Beverages containing vitamins; Non-alcoholic drinks enriched with vitamins and mineral salts; Protein drinks; Whey beverages; Soya-based beverages, other than milk substitutes.

2. On 27 June 2023, Ernest Jackson & Co. Limited (“the Cancellation Applicant”) filed an application for invalidation under section 47(2) of the Trade Marks Act 1994 (“the Act”). The invalidation is against the Registered Proprietor’s class 5 goods only and is based on sections 5(1), 5(2)(a) & 5(2)(b) of the Act.

3. Sections 5(1), 5(2)(a) & 5(2)(b) are relevant in invalidation proceedings under section 47(2) of the Act. The application for invalidation is on the basis of the following mark and goods:

UK00000645168

POTTER’S.

Filing date: 22/02/1946
Registration date: 22/02/1946

Relying upon all goods for which it is protected as follows:

Class 5: Medicated confectionery for human use for the treatment of catarrh, coughs and colds.

4. The Cancellation Applicant claims that the marks are identical (or similar to the extent they are “virtually identical”) and both marks cover identical and similar goods. Due to this, they claim that “a likelihood of confusion is inevitable”.

5. The Registered Proprietor filed a counterstatement denying all of the claims and put the Cancellation Applicant to proof of use of its mark.

6. Both parties filed evidence. A hearing was held before me on 6 June 2024. The Cancellation Applicant was represented by Mr Sam Carter of counsel, instructed by Wilson Gunn. The Registered Proprietor, represented in these proceedings by Joshi-IP.Law, did not attend and did not provide any submissions in lieu.

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Evidence

8. The Cancellation Applicant filed evidence in chief in the form of a witness statement from David Mark Walter dated 6 October 2023. Mr Walter is the Managing Director of the Cancellation Applicant. The witness statement of 6 October was accompanied by an earlier witness statement from Mr Walter dated 25 June 2019 and three further exhibits. The main purpose of this evidence is to prove use of the Cancellation Applicant’s mark.

9. The Registered Proprietor filed evidence in the form of a witness statement dated 5 December 2023 from Sara Delpopolo who is the Global Trademarks Manager for the

SFI Health Group of companies which includes the Registered Proprietor. This statement was accompanied by 20 exhibits.

10.The Cancellation Applicant filed evidence in reply in the form of a further witness statement from David Mark Walter dated 29 January 2024 together with two exhibits.

DECISION

Section 47

11. Section 47 states as follows:

"47. (1) […]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) […]
(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

12. The trade mark upon which the Cancellation Applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act because it was applied for at an earlier date than the contested mark. The earlier mark is subject to the proof of use requirements as it has been registered for five years or more before the filing date of the Registered Proprietor's mark, as per section 6A of the Act.

Sections 5(1), 5(2)(a) & (b)

13. Section 5(1) of the Act is as follows:

"5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

14. Section 5(2)(a) and (b) of the Act are also being relied upon and are as follows:

> "5(2) A trade mark shall not be registered if because-
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services 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".Section 5(2)(b) is being relied upon and is as follows:
> >
> > (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".

15. 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."

Proof of use

16. I will begin by assessing whether there has been genuine use of the earlier registration.

17. Section 6A:

> "(1) This section applies where
>
> > (a) an application for registration of a trade mark has been published,

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

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

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

18. 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."

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the contested mark i.e 1 October 2016 to 30 September 2021.

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze*

Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

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

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

create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

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

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

Evidence

21. Mr Walter’s witness statement dated 6 October 2023 introduces into evidence his earlier witness statement of 25 June 2019 together with the three exhibits attached

thereto as they are relying upon the same evidence previously used before the Registry.

22. Mr Walter states that POTTER'S has been used as a trade mark for *inter alia* catarrh pastilles since the early 19th century. He goes on to state that his company produces and sells a range of pastilles for the treatment of catarrh, coughs and colds. Exhibit DMW-01 has examples of the packaging of the products as follows:

23. I note that the poster the image of two boxes is extracted from is dated in 2013 and the prototype box extract is from April 2016. Both are prior to the relevant period.

24. The evidence provided by Mr Walter is mostly for the period 2013 to 2018 and he states that within that period, more than 6.5 million packs of pastilles were sold. He sets this out in a table for a year on year breakdown as follows (as the retail sales value data has been redacted I have not replicated that column here):

Year	**Units**
2013	1,109,796
2014	875,118
2015	904,464
2016	1,288,422
2017	1,124,244
2018	1,243,902

25. Further, Mr Walter provided the figures for annual expenditure, marketing and promoting the pastilles as follows:

Year	**Advertising expenditure (£)**
2013	11,303
2014	14,333
2015	48,809
2016	13,228
2017	14,895

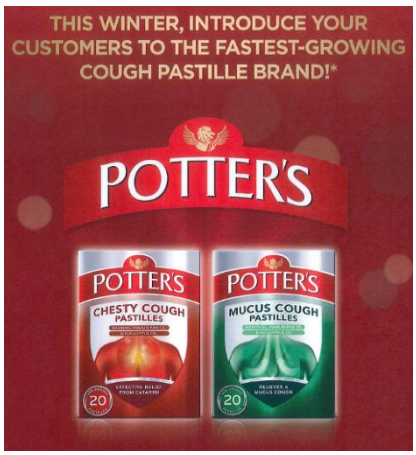
26. Exhibit DMW-02 contains sample invoices showing sales of pastilles. I have extracted the following information from the invoices (I will only refer to the invoices that fall within the relevant period):

Date	**Purchaser**	**Goods**	**Quantity**
16/11/2016	Poundland Ltd	Potters Chesty Cough Pastilles	1056
24/11/2016	Tesco Stores Ltd	Potters Chesty Cough Pastilles Potters Mucus Cough Pastilles	352 352
4/08/2017	DDD LTD	Potters Lem Glyc Honey Pastilles Potters Mucus Cough Pastilles Potters Chesty Cough Pastilles Potters B/C Crystallised	17 90 43 20
15/12/2017	Poundland	Potters Chesty Cough Pastilles	648 1056

		Potters Mucus Cough Pastilles	
13/07/2017	Tesco Stores Ltd	Potters Chesty Cough Pastilles Potters Mucus Cough Pastilles	176 176
15/02/2018	Poundstretcher Ltd	Potters Mucus Cough Pastilles Potters Chesty Cough Pastilles	(data unclear)
15/02/2018	Tesco Stores Ltd	Potters Chesty Cough Pastilles Potters Mucus Cough Pastilles	176 352
21/03/2018	T J Morris Ltd	Potters Mucus Cough Pastilles	1056

27. The invoices seem to show regular sales to UK based companies of various types of cough/catarrh pastilles.

28. Exhibit DMW-03 comprises copies of flyers, advertisement and an advertorial. The only item that can be said to fall within the relevant period is the 2016 advertorial, and extract of which can be found below:



Analysis

Form of the mark/how the mark is used

29. 'POTTER'S' has been used throughout the evidence. For the most part, it has been used in a composite form (such as at paragraph 28 above). However, the word 'POTTER'S.' retains an independent distinctive role in the evidenced mark and therefore, this is acceptable variant use.[1]

Conclusions from the evidence on genuine use

30. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. This will be the UK as the mark is a UK registration. In making this assessment, I am required to consider all relevant factors, including:

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

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[2]

32. The Cancellation Applicant has provided continuous substantial UK sales figures together with notable advertising expenditure. Even though there are only figures for 3 years out of the 5 that make up the relevant period, this is still enough for a finding

[1] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, paras 31-35
[2] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

of use. There were regular purchases by UK retail companies and the mark is shown on the packaging and on the invoices as the name of the product.

33. The evidence refers throughout to various types of pastilles for coughs, colds and catarrh and I consider that they have shown use of the specification, as relied upon being*: Medicated confectionery for human use for the treatment of catarrh, coughs and colds.*

Sections 5(1), 5(2)(a) & 5(2)(b)

34. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Identity of the marks

35. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00, the Court of Justice of the European Union held that:

> "54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

36. The marks are 'POTTER'S' and 'POTTER'S.' respectively. The only point of difference between the marks is a full stop at the end of the earlier mark. I consider that this difference may go unnoticed by the average consumer and therefore, find the marks to be identical.

Comparison of goods

37. At the hearing, Mr Carter confirmed that the Cancellation Applicant was no longer contesting the term 'food for babies' from the Registered Proprietor's specification and therefore, I will consider this no further.

38. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

39. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

40. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) ('Meric')*, Case T-133/05, the General Court ("the GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM - Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

41. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that 'complementary' means:

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

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

43. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

44. The Parties' respective specifications are:

Contested goods	Earlier goods
Class 5: Biological preparations for medical purposes; Dermatological preparations; Dietary supplements; Dietary fibre; Dietetic substances adapted for medical use; Nutritional supplements; Herbal supplements; Vitamin preparations; Fish oil for medical purposes; Mineral food supplements; Pharmaceutical preparations; Protein dietary supplements; Vitamin supplements; Beverages adapted for medicinal purposes; Herbal beverages for medicinal use; Vitamin and mineral preparations; Mineral supplements; Malt extracts for pharmaceutical use; Nutritional supplement meal replacement bars for boosting energy; Nutritional drink mix for use as a meal replacement; Meal replacement powders; Meal for pharmaceutical purposes; Extracts of medicinal herbs; Dietetic foods adapted for medical use; Tonics for medical use; Plant extracts for pharmaceutical use; Plant and herb extracts for medicinal use; Extracts of medicinal plants; Mineral waters for medical purposes; Preparations for making medicated beverages; Vitamin drinks; Vitamin and mineral food supplements; Liquid herbal supplements; Herbal medicine; Herbal creams for medical use; Herbal	Class 5: Medicated confectionery for human use for the treatment of catarrh, coughs and colds.

preparations for medical use; Cleansing solutions for medical use.	

Biological preparations for medical purposes

45. I do not agree with the Cancellation Applicant's submissions at the hearing that these goods are identical under the *Meric* principle. However, as stated, the above goods from the Registered Proprietor's specification are for medical purposes which overlaps with the Cancellation Applicant's goods. I also consider that the users and trade channels would overlap. I believe that the nature and method of use is likely to be different – confectionary versus biological preparations (which I consider to be a type of medical preparation derived from a living organism such as yeast or plant cells). They are not complementary nor are they in competition. I therefore consider them to be similar to a medium degree.

Dermatological preparations;

46. It is possible that the above goods could have a medicinal purpose for treating skin issues and therefore, I consider there to be an overlap in general purpose with the Cancellation Applicant's goods. Further, there could be an overlap in user. They could both be sold in pharmacies or similar outlets however, they might be found in different sections. However, they are not complementary, nor are they in competition. As the Cancellation Applicant agreed at the hearing, they differ in nature and method of use. I therefore find them to be similar to a low degree.

Dietary supplements; Dietary fibre; Dietetic substances adapted for medical use; Nutritional supplements; Herbal supplements; Vitamin preparations; Mineral food supplements; Protein dietary supplements; Vitamin supplements; Vitamin and mineral preparations; Mineral supplements; Nutritional supplement meal replacement bars for boosting energy; Nutritional drink mix for use as a meal replacement; Meal replacement powders; Meal for pharmaceutical purposes; Extracts of medicinal herbs; Dietetic foods adapted for medical use; Vitamin drinks; Vitamin and mineral food supplements; Fish oil for medical purposes; Beverages adapted for medicinal purposes; Herbal beverages for medicinal use; Tonics for medical use; Mineral waters

for medical purposes; Herbal medicine; Herbal preparations for medical use; Liquid herbal supplements;

47. The above goods are all ingested for their perceived health related benefits and therefore, there is an overlap in user, purpose and a general overlap in nature (i.e. they come in edible forms). There could also be an overlap in trade channels. They are not complementary nor are they in competition. I therefore find them similar to between a medium and a high degree.

Pharmaceutical preparations; Malt extracts for pharmaceutical use; Plant extracts for pharmaceutical use; Plant and herb extracts for medicinal use; Extracts of medicinal plants; Preparations for making medicated beverages.

48. These goods overlap in general user and purpose with the Cancellation Applicant's as they are for people with illnesses. There is some overlap in nature and trade channels although I note the more specific nature of their shape and consumption will be different. They could be in competition as the average consumer chooses alternative methods of taking medication. They are not complementary. I therefore find them to be similar to a medium degree.

Herbal creams for medical use; Cleansing solutions for medical use

49. These goods overlap in general user and purpose with the Cancellation Applicant's as they are for people with illnesses. They might be found in the same stores (albeit different sections). They differ in nature and use. They are not complementary nor are they in competition. I therefore find them similar to a low degree.

50. It is a requirement of section 5(1) that the goods and marks are identical. As I have not found any of the goods to be identical, the claim under section 5(1) fails. However, the claims under sections 5(2)(a) and 5(2)(b) may proceed.

Average consumer and the purchasing act

51. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

52. 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. (as he then was) described the average consumer in these terms:

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

53. I agree with the Cancellation Applicant's submissions that the relevant goods are directed at the public at large. I do not discount that there might be business or professional buyers of the goods also. Generally, as per *Olimp Laboratories sp. z o.o. v EUIPO,* Case T-817/19, the level of attention is likely to be higher where pharmaceuticals are concerned. Due to the range of goods at issue, I consider that the level of attention will range from medium (for less considered items such as cough pastilles or paracetamol) to high (for more considered medicines).

54. I believe it to be a largely visual purchasing process, the consumer will handle the goods to check that it is suitable for their symptoms/illness. If the consumer is buying online then I also note they will see the marks on websites. I do not, however, ignore the potential for the marks to be spoken, for example, by pharmacists, doctors or sales assistants as the Cancellation Applicant rightly pointed out, they could be requested over a counter.

Distinctive Character of the Earlier Mark

55. 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 WindsurfingChiemsee 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)."

56. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The Cancellation Applicant claims to have a medium degree of inherent distinctiveness in the earlier mark. The distinctiveness of a mark can be enhanced by virtue of the use made of it. As the Cancellation Applicant has have provided evidence regarding the use of the marks, I can consider this further.

57. The turnover figures provided in the witness statement of Mr Walter are redacted but do show the number of units sold as follows:

Year	Units	Retail Sales Value (£ Sterling)
2013	1,109,796	[redacted]
2014	875,118	[redacted]
2015	904,464	[redacted]
2016	1,288,422	[redacted]
2017	1,124,244	[redacted]
2018	1,243,902	[redacted]

58. I have found the Cancellation Applicant has shown use for their goods being medicated confectionary. I believe this to be a fairly large market and assuming the units shown are the number of packets sold then I consider that this is not a large amount of sales for that market. The annual expenditure for advertising was usually between £11,000 and £15,000 (although I note that 2015 was somewhat of an anomaly where by £48,809 was spent) which I do not consider to be large amounts when considered in the context of the market in which the Cancellation Applicant operates. I therefore do not believe that the Cancellation Applicant has shown that their mark has been enhanced through use. I therefore have only the inherent position to consider.

59. The mark 'POTTER'S.' is likely to be understood by consumers to the possessive form of a surname. It bears no relation to the goods in question nor is it allusive of them. Surnames are a fairly common way to indicate the economic origin of goods and consumers are accustomed to their use as such. I also consider Potter to be a fairly common surname. I therefore find the mark to be inherently distinctive to a medium degree at best.

Likelihood of confusion

60. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being

the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

61. In the present case, as is necessary for all section 5(2)(a) claims, the marks are identical. I have found the remaining goods and services to range in similarity from a low to a high degree. Even where the similarity of the goods is low, the identity of the marks and the medium distinctiveness of the earlier mark will mean the average consumer is likely to mistake one for the other. Therefore, I consider there to be a likelihood of direct confusion under section 5(2)(a).

62. Even if the marks are not considered to be identical, the only difference would be the full stop in the earlier mark which would mean that the competing marks are very highly similar visually and aurally and conceptually identical and therefore, there would still be a likelihood of confusion under section 5(2)(b) of the Act.

63. At the hearing, Mr Carter raised the issue that the witness statement of Ms Delpopolo appears to be attempting to raise the defence of honest concurrent use. I note that the evidence provided by the Registered Proprietor could be used to support such a defence. However, the Registered Proprietor did not actively plead honest concurrent use in their Form TM8 and counterstatement. All that was stated within box 8 ‘Counterstatement by the Defendant’ was as follows:

> “The Applicant [sic] denies and does not admit and disputes the invalidity filed under the three grounds namely Sections 5(1), 5(2)(a) and 5(2)(b) and puts the Applicant to strict proof of all statements made in its Form TM26(I) including its reference to the use of its mark.

The Registrant requests an award of costs is made in its favour."

64. I therefore agree with Mr Carter's submission at the hearing that the defence cannot be relied upon. In any event, in order for honest concurrent use to be successful, the two marks co-existing on the same market must be peaceful (as per *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 paras 82 and 83) however, I note that these are not the first proceedings between the parties regarding marks relating to the term 'Potter's' (and those cases were referred to by the Cancellation Applicant in their skeleton argument). I note the joint advertising campaign that the parties had in 2009 but this was for a short period of time (6 months) and issues have arisen between the parties since then.

65. Further, there must be substantial parallel trade for a long period.[3] Although the evidence shows the parties share origin (Exhibits SLD 1-6) however, no sales or turnover figures were provided so I cannot say that any parallel trade was substantial. Therefore, any claim of honest concurrent use by the Registered Proprietor could not have succeeded.

Conclusion

66. The opposition under section 5(2)(a) (and section 5(2)(b) if necessary) is successful, subject to any appeal, in relation to all goods in class 5 save for 'food for babies' which the Cancellation Applicant did not pursue at the hearing.

Costs

67. The Cancellation Applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 (as the proceedings commenced after 1 February 2023). I award the Cancellation Applicant the sum of **£1900**, calculated as follows:

[3] *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, EU:C:2011:605 para 82

Official fees	£100
Preparing the Notice of opposition and considering the counterstatements	£250
Preparing evidence and considering the other side's evidence	£750
Preparing for and attending a hearing	£800
Total	**£1900**

68. I therefore order Soho Flordis UK Limited to pay Ernest Jackson & Co. Limited the sum of £1900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 25th day of November 2024

L Nicholas
For the Registrar