

**O-572-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3020261  
BY CARE IN BATHING LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 10, 11, 37 & 42:**

**Aquanova**

**AND**

**OPPOSITION THERETO (NO. 401462) BY  
AQUANOVA B.V.**

## **Background and pleadings**

1. This dispute concerns whether the trade mark **Aquanova** should be registered for the following goods and services:

**Class 10:** Bathing systems in the form of hoists and lifting aids for those with special needs, such as patients and invalids; medical apparatus and equipment for use in assisted bathing; medical apparatus and equipment for manoeuvring those with special needs, such as patients and invalids into and out of baths, spas and showers; seats, grab rails and head rests for baths, spas and showers; splash back panels; parts of all the aforesaid goods.

**Class 11:** Bathing systems, supplied or installed, in the form of baths and showers for those with special needs, such as patients and invalids together with any sanitary or hydrotherapy accessories as an integral part of the bath.

**Class 37:** Installation, maintenance, repair and servicing of bathing systems for those with special needs.

**Class 42:** Assisted bathroom design services, design services relating to baths, design services relating to the installation of baths, showers, planning (design) of bathrooms.

2. The mark was filed by Care in Bathing Limited (the applicant) on 30 August 2013 and was published for opposition purposes on 4 October 2013.

3. Registration is opposed by Aquanova B.V. (the opponent) under sections 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). The opponent relies on its earlier community trade mark (CTM) registration (no. 1741727) for the word **AQUANOVA**, which is registered for the following goods:

**Class 3:** Bath salts, not for medical purposes, bath and shower gel, bath and shower cream; bath oils; soap; cosmetics.

**Class 21:** Household of kitchen utensils and containers (not of precious metal or coated therewith); bathroom accessories not included in other classes, plane tables, cup holders, soap holders, towel racks, toilet brush garnishing, tooth brush holders, combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semiworked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

**Class 24:** Textile and vinyl shower curtains; bath linen (except clothing).

**Class 25:** Bath robes; bath slippers.

**Class 27:** Tuffed bath mats and floor coverings.

4. The mark was filed on 6 July 2000 and it completed its registration procedure on 25 September 2003. Under section 5(2)(a) the claim is that the marks are identical

and the goods/services are similar, the combination of which would lead to a likelihood of confusion. In relation to the goods/services, the opponent states:

“The goods and services of the application in suit are similar to the goods of the opponent’s earlier registration in that they have the same nature, bathroom products and associated services, same purpose, being for use in bathrooms and associated services, and they have same sales outlets, being, for example, bathroom shops and home improvement shops.”

5. Under section 5(3), the opponent claims a reputation for all of the registered goods. In this regard it makes four separate points:

- i) That there is an unfair advantage because consumers may be confused into believing that the applicant’s goods are those of the opponent.
- ii) That the use of the applied for mark would take unfair advantage of the time and effort the opponent has put into achieving its reputation.
- iii) That if there is a difference in the quality of the respective parties goods this could impair the opponent’s reputation.
- iv) That the distinctiveness of the opponent’s mark may be diminished or impaired by the use of the applied for mark which would result in consumers not be able to distinguish the goods of the opponent from the applicant, potentially leading to consumers mistakenly purchasing the wrong product.

6. The opponent also relies on the use, since 2009, of the sign **AQUANOVA** on a range of goods which correspond to those of its CTM. The claim is that through the use of that sign, the opponent has acquired goodwill and the use of the applied for mark would be preventable under the law of passing-off.

7. The final point to note about the opponent’s case is that the earlier mark relied upon completed its registration process more than five years before the date on which the applicant’s mark was published. The significance of this is that the proof of use provisions contained in section 6A apply and, therefore, the earlier mark may only be relied upon to the extent that it has been genuinely used. In that regard, the opponent made a statement of use claiming that it has genuinely used its mark [in the five years preceding publication] in relation to all of the goods for which the earlier mark is registered.

8. The applicant filed a counterstatement denying the claims. It puts the opponent to proof of use in relation to all of the goods for which the earlier mark is registered. The main points highlighted in its defence are that:

- i) The applied for mark was adopted in 1989 for specialist baths sold in the medical devices market.
- ii) There is no “casual link” between the two product ranges”.

- iii) The applicant's goods are not sold through general channels such as bath and home improvement shops.
- iv) Its products are highly regarded, being seen as the "Rolls Royce" of the sector.
- v) Given its long use, the applicant is not attempting to pass-off.
- vi) The applied for goods are of a "capital nature" with a single order normally being in the region of £7000.

9. The opponent is represented by Novagraaf. The applicant is represented by Swindell & Pearson; I note, though, that the applicant initially represented itself, only appointing Swindell & Pearson mid-way through the proceedings. Both sides filed evidence, the applicant also filed some written submissions. A hearing took place before me on 25 September 2015 at which Ms Moggridge, of counsel, instructed by Novagraaf, represented the opponent and at which Mr Wood, of the firm Swindell & Pearson, represented the applicant.

### **The evidence**

10. There is an issue to do with late evidence that I will come on to shortly. For the time being, I will summarise the evidence filed during the normal evidence rounds.

#### *The opponent's evidence*

11. The evidence comes from Mr Jean Piereu, the opponent's chief executive officer. He states that the opponent's mark was first used in the UK in 1982 during an exhibition at the Olympia Exhibition Centre in London and that it has been in continuous use since then. He states that the mark is "used mainly" for the following goods:

"Bath mats, shower curtains, bathroom accessories, laundry bins, pedal bins, solid soaps, liquid soaps, bath robes and home wear".

12. He states that since 1982 the mark has also been used for the goods (a reference to the above goods) elsewhere in the EU (numerous Member States are listed).

13. It appears that the opponent's name was initially Matram B.V. but this was changed in 1992 "to make clear to the public the relation to the Goods sold under the trade mark".

14. Mr Piereu then details the form in which the mark is used. Since 2002 he says that it has been used in the same form (as below), with or without the shell device:



15. Prior to 2002 it was used as follows:



16. Turnover and unit sales figures are provided, which Mr Piereu describes as substantial. Provided later in the evidence are EU promotional expenditure figures which I have added to the table below:

Year	UK: Approx. Turnover	UK: Volume (units sold)	EU: Approx. turnover	EU: Volume (units sold)	Approx. promotional spend - EU
2006	82.9k	No records available	4.8million	No records available	162k
2007	64.8k	“”””	3.8million	“”””	124k
2008	23.6k	“””	3.8million	“”””	248k
2009	3.4k	8.1k	3.4million	395k	220k
2010	37.2k	13k	3.2million	398k	68k
2011	9.8k	2.7k	3.2million	470k	166k
2012	59.4	23.2k	3.8million	514k	143k
2013	107.3k	26k	3.6million	472k	196k

17. Mr Piereu states that since launch the mark has been advertised and promoted in various ways including by way of point of sale materials, pamphlets and catalogues, promotional displays, national press, magazines, exhibitions and trade fairs. His commentary includes no specific details about any of this. He then refers to a number of exhibits containing various brochures and promotional materials. Rather than summarise this now, I will return to it later when I assess whether the opponent has met the proof of use provisions as the content of such material is particularly pertinent to that question.

#### *The applicant's evidence*

18. This comes from Mr Gordon Farmiloe, the applicant's managing director. He explains that the applicant has been active in the bath and bath-ware area since at least 1986. The applicant has a particular focus on mobility baths and showers and baths and showers for those with accessibility issues. Exhibit GF1 are prints from the applicant's website showing these types of products. They show the applicant's name not the word AQUANOVA. In relation to AQUANOVA the following emerges:

- The mark was used by a competitor of the applicant (Abacus) in relation to a bath for people with mobility issues.
- Abacus ran into financial difficulties so the applicant purchased its IP assets.
- Exhibit GF2 is a letter from mgrappraisals dated 3 January 2012 which is said to support the acquisition, but there is no mention of IP.
- Abacus entered the market in 1989 and its flagship product is said to have been the AQUANOVA bath.

- Exhibit GF3 contains the annual reports and accounts (2003-2008) of Abacus which, it is said, prove that it was active during these times.
- Exhibit GF4 contains an extract from an NHS procurement document from November 2004. It includes information showing that Abacus supplied a number (12) of Aquanova hi-lo baths. They cost between £4-5k each.
- Exhibit GF5 contains extracts from third party websites about AQUANOVA. At least two refer to the AQUANOVA bath.
- Most sales of the bath were to the public sector.
- Exhibit GF6 contains an entry from the European Assistive Technology Information Network (from which public authorities can view products) showing Aquanova being listed since 2000.
- A member of Abacus' staff (who now works for the applicant) believes that around 80% of Abacus' business was in respect of the Aquanova bath.
- Since acquiring the IP of Abacus, turnover under the mark has been £0.3 million (3 months to March 2013), £0.9 million (year to 31 March 2014) and £0.7 million (11 months to 28 February 2015).
- Exhibit GF7 is a current brochure containing Aquanova baths (of the mobility type described) which is said to be the same bath as was previously sold.

### **The late evidence**

19. The late evidence is from the opponent. It consists of an email which it claims is an instance of confusion. Mr Piereu exhibits the email to a short witness statement. The email is from Ms Sheree Murray of J&P Healthcare. The email is sent to the email address: info@aquanova.com. It reads:

“Hello,

A customer of ours has a Scorpio bath S/N: 3125

The bath goes up and down as well as the seat.

It needs a new side panel, 4 button handset and pop up waste. Could I have codes and prices for these parts please?”

20. A reply was sent to Ms Murray explaining that “[we] are Aquanova NV from Belgium..... We’re not the producers of the Scorpio bath. Sorry we can’t be of any help to you.” Both emails are dated 18 August 2015.

21. The applicant responded to the above by providing its own further evidence to be considered in the event that the applicant's late evidence was accepted. That evidence consists of a witness statement of Ms Natasha Hybner, a trade mark advisor at Swindell & Pearson. She explains that she was asked by Mr Wood to visit the website of Aquanova BV and he showed her a copy of the clamshell device to assist this. She was then left to find the website herself. She did so by using the Google search engine using the term AQUANOVA. She then visited the landing page of aquanova.com. Exhibit NLH1 consist of the Google results page showing aquanova.com (the opponent's website) as the first hit and abacushealthcare.co.uk (the applicant's website) third – there is a mention in the description of the applicant's hit that it produces the Aquanova assisted bath. Exhibit NLH2 is the landing page for the opponent's website. AQUANOVA is featured in the top left along with the words HOME & BATH.

22. I discussed the late evidence with the parties at the hearing. Whilst I had some reservations as to how significant the evidence was likely to be, the representatives took a sensible view on matters in that neither would object to the inclusion of the other's evidence, so long as their evidence could come in. I accepted the evidence in so that all the material the parties wished to adduce could be considered by the tribunal.

### **The proof of use provision**

#### **Legislation and leading-case-law**

23. The earlier CTM must meet the use conditions in respect of the goods it relies on. The use conditions are set out in section 6A of the Act as follows:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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 [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

24. Section 100 is also relevant, it reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

25. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

"In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in 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 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use



may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

26. The earlier mark is a CTM, therefore, in accordance with section 6A(5) of the Act, the earlier mark must have been put to genuine use in the EU. In its judgment in *Leno Merken BV v Hagelkruis Beheer BV* C-49/11 (ONEL) the CJEU stated:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.”

27. Regarding the territorial scope of the use, the CJEU went on to state:

“52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño*

[2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

28. At the hearing Mr Wood referred to the recent decision in the case of *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC) where Judge Hacon suggested that in relation to a CTM, genuine use must extend beyond one Member State. However, there are conflicting judgments in relation to such a principle. For example, in *Now Wireless Ltd v OHIM*, Case T-278/13, the General Court accepted that use of a CTM for internet and computing services provided in London and the Thames Valley constituted genuine use of the CTM in the Community. However, the issue does not arise here because although Mr Piereu has attested to the CTM being used in the UK, it is clear that it has also been used in other areas of the EU. Indeed, the UK represents, according to the sales figures detailed earlier, only a small proportion of its use.

### **The relevant period**

29. As per section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five period ending on the date of publication of the applied for mark, so, in these proceedings, the relevant period is 5 October 2008 to 4 October 2013.

## The evidence and exhibits

30. I have already touched on some of the evidence. Figures for sales of goods sold under the mark have been provided, but they are not, as Mr Wood highlighted, been broken down by product type. Mr Piereu made a statement in his evidence identifying the goods for which the mark is “used mainly”. Given the absence of a breakdown in the sales figures, and given that the evidence provided in the exhibits is from before the relevant date as well as during it, it is necessary to go through the exhibits in some detail to ascertain what goods the mark has been used in relation to (during the relevant period) and to then decide if such use constitutes genuine use.

31. Although all of the exhibits have been borne in mind, I will detail only the material from within the relevant period as whilst I accept that pre-relevant period evidence may assist, to some extent, in guiding as to the genuineness of the use, the use must still be present in the relevant period if it is to count. Exhibits J11 – JP16 are the pertinent exhibits.

- Exhibit JP11 contains a number of documents with Mr Piereu explaining that they are from 2009:
  - i) There is a brochure from SPRING 2008 but, as the relevant period commenced in October of 2008, this does not assist.
  - ii) There is a brochure from AUTUMN 2008. Only the cover page is exhibited. It depicts the AQUANOVA mark with the clamshell device above it. There are six photographs on the front. Two photographs are of ladies wearing bathrobes. One is of what appears to be a bin of some sort, possibly a laundry bin. One is a photograph of what appears to be a rug depicting Mickey Mouse. There is also a stand-alone soap dispenser, the type of one where one pushes down on the spout to release liquid soap.
  - iii) There is also what Mr Piereu describes as pages from a Christmas Gift Catalogue produced by Galeria Inno, a department store. The exhibited page contains a number of products. One is a towel with the accompanying description “8. Handdoek: “Empire” (12.95) AQUANOVA”.
- Exhibit JP12 contains a number of documents with Mr Piereu explaining that they are from 2009.
  - i) There is another AQUANOVA brochure (undated) sub-titled INSPIRING MOMENTS. Again, only the front cover is provided. The photographs show some tableware and a photograph of what appears to be a soap dispenser, a toilet brush and holder and, possibly, a toilet roll holder. There is also a photograph of a bathroom scene featuring a bath, a towel, a rug and items such as a soap dispenser, toilet brush

and holder, a bathroom utensil holder; all these items are stand-alone items.

- ii) An AQUANOVA brochure headed SPRING 2009. It shows the same bathroom scene. There is also a close up of some bathroom accessories (the type depicted in the scene above), a man doing the washing up, and a silver bowl containing some form of cosmetic or cleaning product in a small bottle along with what appear to be a number of flannels.
  - iii) An AQUANOVA brochure headed AUTUMN 2009. It shows another bathroom scene this time featuring a rug and what appears to be a laundry bin; a lady wearing a bathrobe; some bathroom accessories such as a soap dispenser, a bowl and a cup (possibly of the type for holding toothbrushes).
  - iv) There is an extract from a magazine entitled *de Bijenkorf* from April 2009. It shows some bathroom accessories (soap dispenser, bowl, cups, toilet brush and holder) along with the description "Aquanova diverse badaccessoires".
  - v) There is an extract from a publication called SENSEA which contains what appears to be an advertisement for AQUANOVA, the picture depicts a lady wearing a Mickey Mouse bathrobe.
  - vi) An (undated) brochure for AQUANOVA. The front cover features bathroom accessories (of the type already mentioned), tableware, a bathroom scene (featuring a bath, a laundry bin and a rug) and a lady wearing a Mickey Mouse bathrobe. Pages from inside the brochure are provided. The goods include: towels (described as "handoken "Dolce" DE WITTE LIETAER"), bathroom accessories such as a soap dispenser and a cup (described as roomkleunge handdoek; en bipassend washhandje; AQUANOVA"). There are many other household goods depicted for other areas of the home.
  - vii) Another extract from SENSEA from September 2009. It features a number of bathroom products, but the one relevant to AQUANOVA is a photograph of some towels in a cupboard and, also, what appears to be a laundry bin. The description reads: "verschillende handdoken AQUANOVA/ Hoge washmand AQUANOVA".
- Exhibit JP13 contains a number of documents with Mr Piereu explaining that they are from 2010.
    - i) The front cover of an AQUANOVA brochure from Spring 2010. It depicts a lady wearing a bath robe, a bathroom scene showing a rug, and some bathroom accessories of the type mentioned earlier and a bin, possibly a laundry bin.

- ii) The front cover of an AQUANOVA brochure from Autumn 2010. It shows a lady wearing a bath robe, table wear and a scene showing bathroom accessories (of the type mentioned earlier).
  - iii) An extract from *Bijenkorf* magazine showing some slippers, a bath robe and some bathroom accessories of the type described earlier. The descriptive text on this article cannot be read.
  - iv) An extract from a publication called ColliShop. In a section headed AQUANOVA, there are various bedding products and, also, a lady wearing a bath robe, all of which feature Mickey Mouse.
  - v) An extract from *Sensa*. One of the items depicted inside the magazine is a rug/mat described as “Rode badmat “Nevada” AQUANOVA”.
  - vi) Further extracts from *Sensa*, one features an advertisement for AQUANOVA featuring a lady wearing a bathrobe. Another contains a similar advertisement, but additionally featuring table wear and bathroom accessories (of the type already identified).
- Exhibit JP14 contains a number of documents with Mr Piereu explaining they are from 2011.
    - i) The front cover of an AQUANOVA spring 2011 brochure featuring a man with a towel around his neck.
    - ii) The front cover of an AQUANOVA brochure featuring a man in a bath robe, a lady in bed, and a bathroom scene showing a bath, a soap, a toilet brush and holder, and what seems to be a waste bin.
    - iii) The front cover of an AQUANOVA Autumn 2011 brochure featuring a scene with a lady in a bath robe, a mirror and a rug and a further photograph of a bath with a rug in front of it.
    - iv) An extract from a publication issued by Telegraaf, entitled DISNEY SPECIAL. The exhibited page shows various Disney themed products including someone in Mickey Mouse pyjamas. There is a mention of Aquanova in the un-translated accompanying text.
    - v) An extract from *Bijenkorf Living*. The exhibited page shows a pair of weighing scales, the accompanying text reading “AQUANOVA weegschaal Retro”.
    - vi) An extract from another *Bijenkorf* publication showing a bath mat described as “AQUANOVA badmat shaggy en Xaria”.
    - vii) A Christmas gifts catalogue from Galeria Inno, the exhibited page depicts a pedal bin with the description “Poubelle a pedale “Taco” – AQUANOVA.” And, also, what appears to be weighing scales described as “Pese-personne “Escala” metal chrome – AQUANOVA”.

- viii) An extract from SENSEA featuring an advertisement for AQUANOVA with a person sleeping in bed.
- Exhibit JP15 contains a number of documents with Mr Piereu explaining that they are from 2012
  - i) The front cover of an AQUANOVA Christmas 2012 brochure featuring a picture of a living room with burning fire.
  - ii) The front cover of an AQUANOVA Spring 2012 brochure featuring bed linen, a person wearing a bath robe, kitchen linen and a soap dispenser.
  - iii) An extract from a publication called ZELFBOUWMARKT, the exhibited page featuring an advertisement for AQUANOVA depicting a lady wearing a bathroom, some candles, bed linen, tableware and soap dispensers.
  - iv) An extract from Bijenkorf Women, the exhibited page featuring two bathrobes and a bundle of towels both in relation to AQUANOVA (the accompanying description is difficult to read) and, also, a further extract showing a bathrobe underneath which the AQUANOVA name appears (again the rest of the text is unclear).
  - v) An extract from SENSEA containing an AQUANOVA advertisement featuring a lady wearing a bathrobe.
  - vi) A Christmas gifts catalogue from Galeria Inno featuring what appears to be some form of storage box and, also, an AQUANOVA advertisement featuring a lady wearing a bath robe, candles, table wear, bed linen and soap dispensers.
  - vii) An extract from a publication called Gaafgoed showing a bath with a towel draped across it, a laundry bin and a rug. The text is difficult to read, but the website of [aquanova.com](http://aquanova.com) is given.
- Exhibit JP16 contains a number of documents with Mr Piereu explaining that they are from 2013
  - i) The front cover of an AQUANOVA 2013 brochure featuring a lady wearing a bathrobe, possibly set in a bedroom.
  - ii) The front cover of an AQUANOVA Spring 2013 brochure showing a storage shelf with some towels placed upon it.
  - iii) There are further documents in this exhibit, but it is not possible to ascertain whether they were published before the end of the relevant period (which ended in October 2013).

## Discussion

32. There are a number of factors to consider in the assessment of genuine use. One of the factors is whether the mark has been used in the form as registered or in a form differing in elements which do not alter the distinctive character of the mark (as per section 6A(3)(a)). Mr Wood raised this point at the hearing, although, it is fair to say, he did not press the matter vigorously. Having gone through the exhibits in detail, I am satisfied that the test has been met. The mark as registered consists of the plain word mark Aquanova. There is ample use of the word alone. Further, there is use of the word in conjunction with the clamshell figurative device but in way in which the word mark would be perceived simply as being jointly affixed or, alternatively, as a separate element of a composite mark. Therefore, it counts as use of the mark *per se* (as per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 and *Castellblanch SA v OHIM*). The form of use is acceptable even without having to rely on the variant mark provisions of section 6A(3)(a).

33. Mr Wood was critical of the evidence generally and he highlighted that such criticisms had already been raised in written submissions, yet the opponent had not sought to improve its position. He highlighted the lack of a breakdown of sales figures, the CTM dimension, the lack of translations of the documents relied upon, the lack of information about the publication, the lack of clarity in what was being sold. I agree that the evidence is not well-marshalled. However, what I think is quite clear from the evidence is that the opponent has operated a business under the AQUANOVA mark as the supplier of a range of home ware products for many years. Further, such use has included use on bathroom products as part of that range and given the brochures and advertisements that have been provided, it cannot be said that use in the bathroom field has been sporadic or insignificant. It is clearly an important part of the business.

34. Notwithstanding the above, it is not possible to say what proportion of those sales related to bathroom products and what proportion related to other home ware products. However, one must not lose sight of the fact that the question is not about commercial success, but simply about use that is warranted in the economic sector concerned. No information has been provided about the size of the EU market for the relevant goods. One would assume it is huge. Nevertheless, the nature of the use put forward persuades me that, on face value, the mark has been put to genuine use in the field of supplying bathroom (and other home ware) products during the relevant period. There are, though, two main points that have given me greater cause for concern. The first is specifically what goods the mark has been used in relation to, and the second is whether the mark is the mark of a supplier such as a retailer or whether it is being used to identify the trade origin of the goods themselves.

35. In terms of what has been supplied, Mr Piereu states that the following are the main items:

“Bath mats, shower curtains, bathroom accessories, laundry bins, pedal bins, solid soaps, liquid soaps, bath robes and home wear”.

36. I agree with Mr Wood’s submission that the opponent can go no further than this. At the hearing Ms Moggridge identified the following as the “core” goods on which the mark has been used and which are relevant for the purposes of this opposition, namely:

Bath and shower gel (class 3); bathroom accessories (class 21); bath linen (class 24); bath robes (class 25); tufted bath mats and floor coverings (to the extent that use has been made on rugs) (class 27).

37. I intend to make my assessment on the basis of such core goods because even if there has been use on anything further, such use will not improve the position under the grounds of opposition relied upon.

38. One of the difficulties in examining the exhibits is that they contain various promotional photographs. Such photographs contain products which are not even claimed to have been used. The most obvious example of this is that many of the products feature a bath. There is no claim that the opponent has supplied baths. One can see why pictures of baths are included in the promotional material. It is useful from a promotional sense to see the products in the context in which they will be used. But the question that arises from this is how one is to differentiate between the goods actually being supplied and goods that are simply there for context. If all that had been provided in evidence were the front covers of the AQUANOVA brochures then this task may have been impossible. However, the additional materials show that some goods are highlighted as being supplied by AQUANOVA. Having gone through the various materials, I am satisfied that there is evidence of the supply of rugs; bathroom accessories such as soap dispensers, toilet brush/holders, cups (as a bathroom accessory), bath robes and towels. I am not satisfied that the use covers, as Ms Moggridge submitted, (liquid) soap. Whilst many soap dispensers are depicted, it is not clear if they contain soap or if it is just the dispenser itself.

39. My second concern is whether the opponent is simply the supplier/retailer of the goods (supplying the products of other undertakings) or whether they are AQUANOVA products. In relation to such concerns, I note the following guidance. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11), Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“17. .... unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:



“...even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in Article 43 of the Community Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said:

“23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ (*Céline*, paragraph 21).

24. Conversely, there is use ‘in relation to goods’ where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.

In *Euromarket Designs Inc. v Peters* [2001] F.S.R. Jacob J. (as he then was) stated that:

“56. That is not all on the question of non-use. If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader would regard the use of the shop name as really being “in relation” to the goods. I think this is an issue worthy of trial in itself. The argument is that there is an insufficient nexus between “Crate & Barrel” and the goods; that only a trade mark obsessed lawyer would contend that the use of “Crate & Barrel” was in relation to the goods shown in the advertisement.

57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods”. There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled “Boots”, only a trade mark lawyer might say that that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign “in relation to” the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel United States shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.”

and in *Cactus SA v OHIM*, Case T-24/13, the General Court held that the owner of a CTM who used the mark only as the name of a shop had used the mark “in relation to” the natural plants, flowers and grains sold in the shop (as well as in relation to retail services for those goods). This is because it had demonstrated that the public would link the (otherwise unbranded) goods to the mark used for the shop and regard the user of that mark as being responsible for the quality of the goods. The court stated that:

“69 Accordingly, in view of the context of the present case, as described in paragraphs 66 to 68 above, and, in particular, the applicant’s specific expertise in the plants and flowers sector, which it publicises, it must be considered that the documents submitted by the applicant which show the earlier marks establish to the requisite standard that there is a link between those marks and plants, flowers and seeds which bear no mark. Those documents show that the applicant offers for sale or sells those goods with the earlier marks as the only indication of a trade mark, with the result that those marks are the only signs that provide an indication of the commercial origin of the goods in question.

70 That conclusion is not affected by the consideration referred to by the Board of Appeal and OHIM that, in the light of the registration of the earlier marks in relation to retail services in Class 35, the earlier marks must be regarded as designating the applicant’s stores which retail plants, flowers and seeds, not those goods themselves. Although the earlier marks are also registered to designate retail services in respect of the sale of plants, flowers and seeds, as is apparent from paragraphs 31 to 39 above, that does not mean, given the context of the present case described in paragraphs 66 to 68 above, that those same marks may not also designate plants, flowers and seeds which bear no mark and which are offered for sale in shops operated by the applicant.

71 In those circumstances, it must be concluded that the Board of Appeal erred in deciding that the applicant had not proved genuine use of the earlier marks in relation to 'natural flowers and plants, grains' in Class 31."

40. The text in the various advertisements has not been translated. However, it is clear from the nature of the use that many are just foreign descriptive words. Certainly, in many cases there is nothing which is obviously standing as a third party brand. There are some uses of phrases such as Nevada and Taco following what appears to be a foreign description. However, the whole nature of use suggests to me that this is likely to be seen as a sub-range of AQUANOVA rather than as a third party brand sold by AQUANOVA.

41. I accept that the evidence as a whole could fall foul of the warnings set out by Mr Daniel Alexander QC (sitting as the Appointed Person) in *PLYMOUTH LIFE CENTRE* (BL O-236-13), when in paragraph 22 he stated:

".....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."

42. However, for the reasons I have given above, I am satisfied that genuine use has been made of the mark, at least in relation to: rugs; bathroom accessories such as soap dispensers, toilet brush/holders and cups; bath robes; towels.

### **Fair specification**

43. In relation to coming up with a fair specification to reflect the use made, I note that Mr Geoffrey Hobbs Q.C. (sitting as the Appointed Person), when deciding case *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* (BL O/345/10), stated:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

44. More recently, in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for

devising a fair specification where the mark has not been used for all the goods/services for which it is registered; he said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

45. My findings of fact, bearing in mind the goods for which the mark is registered, together with what I consider a fair specification to be, means that I will consider the opposition on the basis of the following goods:

**Class 21:** Bathroom accessories not included in other classes

**Class 24:** Bathroom towels.

**Class 25:** Bath robes

**Class 27:** Tuffed bath mats; floor coverings in the nature of rugs and mats.

46. To explain my findings in terms of a fair specification, in class 21, the various items on which use have been shown in that class combine to result in the average consumer describing such goods as bathroom accessories and this represents a recognisable category of goods. In class 27, bath linen is somewhat wider than just towels and as this is the only product, a product which itself is a category of goods, means that towels is the term that must remain. Whilst it could be said that the addition of the word “bath” is pernickety, this is required because the original term was bath linen. In class 25, “bath robes” is the only relevant term and must remain as is. In class 27, I have restricted floor coverings to rugs and mats as the former is much wider than the latter. The latter also represents a recognisable category of floor covering. In relation to tuffed bath mats, these are a subset of the term I have allowed so they may remain in the specification.

### **Section 5(2)(a)**

47. Section 5(2)(a) of the Act states that:

“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.”

48. The following principles are gleaned from the judgments 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Identity of marks**

49. It is a prerequisite of section 5(2)(a) that the respective marks are identical. There is, sensibly, no dispute about this. The marks are **AQUANOVA** and **Aquanova**. The only difference between the marks resides in their casing. However, as these are just plain words marks both can be used in all upper case or, alternatively, upper and lower case. The marks are identical.

### **Average consumer and the purchasing act**

50. 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*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

51. In terms of the items covered by the earlier mark, these do not strike me as being particularly expensive and whilst they may not be purchased with as much frequency as say, groceries in a weekly shop, neither are they very infrequent purchases. I consider these factors to combine to mean that the average consumer, who will be a member of the general public, will pay an average level of care and attention in their selection, neither materially higher nor lower than the norm.

52. The applicant's goods, on the other hand, strike me as more infrequent purchases and, also, fairly expensive. The fact that the specification limits the goods to types of product for those with mobility issues (and that the products are specifically designed for such people) adds to this and, also, the likely cost. The average consumer will be a person with mobility issues or certain recognised disabilities and/or their carers. People in the healthcare profession will also be a category of average consumer. I consider that a high degree of care and attention will be deployed.

53. I will come on to trade channels later, but it is fair to say that both sets of goods will be selected after perusing websites, brochures, catalogues or even visiting stores to inspect them. This suggests a process that is more of a visual one as opposed to aural one. There is, of course, room for aural use of the marks (particularly in relation to the applicant's goods) through discussion with sales advisors.

### **Comparison of goods/services**

54. When making a comparison, all relevant factors relating to the goods/service in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

"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."

55. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- "(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."

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

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use



of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

57. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 LOVE were he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

58. The applied for goods are:

**Class 10:** Bathing systems in the form of hoists and lifting aids for those with special needs, such as patients and invalids; medical apparatus and equipment for use in assisted bathing; medical apparatus and equipment for manoeuvring those with special needs, such as patients and invalids into and out of baths, spas and showers; seats, grab rails and head rests for baths, spas and showers; splash back panels; parts of all the aforesaid goods.

**Class 11:** Bathing systems, supplied or installed, in the form of baths and showers for those with special needs, such as patients and invalids together with any sanitary or hydrotherapy accessories as an integral part of the bath.

**Class 37:** Installation, maintenance, repair and servicing of bathing systems for those with special needs.

**Class 42:** Assisted bathroom design services, design services relating to baths, design services relating to the installation of baths, showers, planning (design) of bathrooms.

59. I will begin by comparing the class 11 goods with those of the earlier mark. There can be no doubt that the competing goods are all to be used in the bathroom. However, the nature of the goods of the earlier mark will be vastly different from the applied for goods as will the method of use. The goods do not compete. You would not buy one as an alternative to the other. Ms Moggridge relied on complementarity. She felt that there would be some aesthetic complementarity and, further, that the competing goods were important or indispensable for the use of the other. In terms of

the latter, she gave an example that even a person using a special needs bath would need a towel to dry oneself or to use liquid soap (or given my findings as to genuine use, a soap dispenser). Whilst I note the submissions, it appears to overlook the second aspect of the complementarity test, namely that the complementarity must be in a way that customers may think that the responsibility for those goods lies with the same undertaking. There is nothing to suggest that this would be the case with the type of goods at issue. In terms of the aesthetic argument, whilst a person may wish to buy a rug that matches the colour of their bath, there is nothing to suggest that it would ordinarily be the case that consumers would think that such goods have shared responsibility with the applied for goods. The same applies in relation to liquid soap dispensers. Further, the likelihood of the consumer making such an assumption would be further lessened by the fact that the goods applied for are specific for the needs of disabled people or with mobility issues.

60. There is also the trade channels to consider. There is no evidence directed at this point. The opponent's use does not show that there would be similar trade channels, nor does the applicant's use. Of course, there is potential in a large DIY store for a bath to be sold in the same establishment as bathroom accessories, however, there is nothing to show that they will be in close proximity. The position though is even starker when one considers the specialist nature of the applied for goods as there is no evidence to show that the more specialist products covered by the earlier mark would even be sold in such establishments. The logical assumption is that such products are more likely to be sold by suppliers of various products aimed at people with mobility issues.

61. Based on all the factors assessed so far, the outcome is pointing more to their being no similarity between the goods than there being similarity. The position is not much better when one starts to consider the purpose of the goods. The purpose of a bath or shower is to enable the person to bathe or shower. The purpose of a towel is to dry oneself, the purpose of a rug is to decorate and or to prevent slippages and the purpose of a soap dispenser is to squirt soap into ones hands. Whilst one could say that the purpose is related, this is very superficial and is measured at a very high level of generality. I come to the view that if there is any similarity between the class 11 goods and the goods of the earlier mark then it is of an extremely low level.

62. In relation to the class 10 goods the position is exactly the same for the same reasons.

63. Class 37 covers the installation etc of bathing systems for people with special needs. This is a step further away from the goods with the earlier mark. I think it reasonable to find that the goods and the services are dissimilar.

64. In relation to class 42, the design services are not specific to disabled or mobility bathrooms and products. Such services may, therefore, be more general in nature and the design service may cover the full ambit of such design including the incorporation of bathroom accessories. I consider there to be a low degree of similarity with the goods of the earlier mark, although this can be reduced/removed with a revision to the specification which I will outline later.

## **Distinctiveness character of the earlier marks**

65. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

66. For the use of the earlier mark to have been relevant, it must have had an impact on the average consumer for it is the average consumer that must be confused. For reasons that will be explained in more detail later, I am far from satisfied that the use of the earlier mark in the UK will have had any material impact on the average consumer in the UK. I acknowledge that the courts have recognised that a likelihood of confusion may be found in circumstances where there is likely to be confusion at a level that is “sufficiently significant”<sup>1</sup>, however, I am not satisfied that the use has the potential to assist even on this basis.

67. However, from an inherent perspective, I consider that the earlier mark is to be regarded as having a normal level of distinctive character. Whilst AQUA is likely to be seen as a reference to water, and whilst NOVA will be known as a reference to NEW, as a whole it makes no great allusion to the goods.

## **Likelihood of confusion**

68. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of

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<sup>1</sup> See *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290 (particularly paragraph 37), where Floyd J. summed up the Court of Appeal's earlier judgment in *Interflora Inc. and another v Marks and Spencer plc* [2014] EWCA Civ 1403

confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. I should add that the evidence relating to the instance of confusion is not telling. This is because the circumstances in which the alleged confused person encountered the various names is not explained. The person may not have been exposed to the goods being considered in the notional exercise before the tribunal.

69. In terms of the class 10 and 11 goods, I have assessed that if there is any similarity between the goods then it must be of an extremely low level. The marks are, though, identical, and I must bear in mind the interdependency principle whereby a lower degree of similarity between the goods may be offset by the identical nature of the marks. The earlier mark also has a normal level of inherent distinctive character. This is a typical multi-factorial assessment. Bearing in mind all of the factors I have assessed, my conclusion is that there is no likelihood of confusion. I come to the view that any similarity between the goods is not enough for the average consumer to assume that the goods come from the same or a related undertaking. Whilst the use in the same general field may make the average consumer pause to wonder, I do not think that they will assume that they are from the same stable. This is due largely to the specialised nature of the applied for goods and that the average consumer would not consider it likely that such a specialist producer will have branched into the field of general bathroom accessories or vice versa. Even bearing in mind, again, the point about sufficiently significant confusion, this, in my view, will not arise. **There is no likelihood of confusion in relation to the class 10 or 11 goods.**

70. In relation to the services in classes 37, I found these not to be similar to the goods of the earlier mark, so, there can be no likelihood of confusion as some similarity between the goods and services is a prerequisite<sup>2</sup>.

71. I finally turn to the services in class 42. Here, given the non-specialized nature of the services, and that the services relate more generally to bathrooms, the factors combine for me to conclude that there will be confusion at least amongst a sufficiently significant proportion of people. **The opposition succeeds to this extent.** However, the likelihood of confusion may be avoided if the specification were limited to something along the lines of:

**Class 42:** Assisted bathroom design services, design services relating to baths, design services relating to the installation of baths, showers, planning (design) of bathrooms; all relating to the design of bathrooms which incorporate bathing systems for people with special needs, such as patients and invalids.

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<sup>2</sup> See, for example, *Waterford Wedgwood plc OHIM* - Case C-398/07.

### **Section 5(4)(a)**

72. Ms Moggridge did not press this ground above and beyond section 5(2)(a). Even if the opponent had goodwill, there is no better claim under this ground than there is under section 5(2)(a). **The ground is dismissed.**

### **Section 5(3)**

73. Section 5(3)<sup>3</sup> of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

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

### **Reputation**

74. The earlier mark must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

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

75. The earlier mark is a CTM so the relevant test is to establish a reputation in a substantial part of the EU<sup>4</sup>. Some use has been made in the UK (but nowhere near the level that would meet the test for establishing a reputation), but most of the use has been made elsewhere in the EU. The figures for the EU as a whole, whilst not insignificant, do not strike me as establishing a particularly strong reputation. However, the problem faced by the opponent is that even if I were to hold that the earlier mark had a reputation on account of its EU use, the necessary link<sup>5</sup> must be made by the relevant public in the UK. I take account of the judgment of the CJEU in *Iron & Smith Kft v Unilever NV C-125/14*, where it stated:

“However, even if the earlier Community trade mark is not known to a significant part of the relevant public in the Member State in which registration of the later national mark has been applied for, it is conceivable that a

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<sup>3</sup> Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01).

<sup>4</sup> See, for example, *Pago International* (case C-301/07)

<sup>5</sup> As per *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07)

commercially significant part of the latter may be familiar with it and make a connection between that mark and the later national mark.”

76. However, having regard to (i) the level of use in the UK, (ii) that any reputation in the EU is not strong and (iii) there is no evidence to show why any of the reputation in the EU would spill over to the UK, my view is that there would never be a commercially significant part of the relevant public that would have the capacity to make the required link. **The claim under section 5(3) of the Act is dismissed.**

### **Conclusion**

77. The opposition succeeds in relation to:

**Class 42:** Assisted bathroom design services, planning (design) of bathrooms; design services relating to baths, design services relating to the installation of baths, shower.

78. But the opposition fails, and the application may proceed, for:

**Class 10:** Bathing systems in the form of hoists and lifting aids for those with special needs, such as patients and invalids; medical apparatus and equipment for use in assisted bathing; medical apparatus and equipment for manoeuvring those with special needs, such as patients and invalids into and out of baths, spas and showers; seats, grab rails and head rests for baths, spas and showers; splash back panels; parts of all the aforesaid goods.

**Class 11:** Bathing systems, supplied or installed, in the form of baths and showers for those with special needs, such as patients and invalids together with any sanitary or hydrotherapy accessories as an integral part of the bath.

**Class 37:** Installation, maintenance, repair and servicing of bathing systems for those with special needs.

### **Revision of specification in Class 42**

79. Given my comments in paragraph 71, the applicant is permitted 14 days to propose an amended specification along the lines of what I have set out. The opponent will then have 14 days to comment on it, following which I will issue a brief supplementary decision, which will also trigger the appeal period.

### **Costs**

80. The applicant has succeeded to a reasonably large extent and I consider it to be entitled to a contribution towards its costs. My assessment is set out below:

*Preparing statements and considering the other side's statements - £400*

*Filing and considering evidence - £800*

*Attending the hearing - £500*

*Total - £1700*

81. I therefore order Aquanova BV to pay Care in Bathing Limited the sum of £1700. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 3rd day of December 2015**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**