

O/0320/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003633240  
BY WISSOTZKY TEA (ISRAEL) LTD. TO REGISTER:



AS A TRADE MARK IN CLASS 30

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 427768 BY TEA LAB COMPANY LIMITED

AND

IN THE MATTER OF APPLICATION NO. 504531 TO  
REVOKE ON THE GROUNDS OF NON-USE REGISTRATION NO.  
UK00002625062 FOR THE MARK

**the tea lab**

**THE TEA LAB**

(SERIES OF TWO)

IN CLASS 30

OWNED BY TEA LAB COMPANY LIMITED

## BACKGROUND AND PLEADINGS

1. These are consolidated proceedings between Wissotzky Tea (Israel) Ltd. (“Wissotzky”) and Tea Lab Company Limited (“Tea Lab”). I will first set out the background regarding the parties’ marks before setting out the basis of each parties’ respective proceedings.

### Wissotzky’s mark

2. On 27 April 2021, Wissotzky applied to register the following trade mark in the UK:



(“Wissotzky’s mark”)

3. By virtue of being a trade mark applied for in accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union,<sup>1</sup> Wissotzky’s mark is deemed to have the same filing date and date of priority as the corresponding EUTM. In the present case, I note that the corresponding EUTM enjoys a filing date of 19 November 2020 and a priority date of 19 May 2020.
4. Wissotzky’s mark was published for opposition purposes on 23 July 2021. Wissotzky seeks to register its mark for the following goods:

Class 30: Tea Products; all included in class 30.

### Tea Lab’s registrations

5. Tea Lab is the registered proprietor of the following UK trade mark registrations:

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<sup>1</sup> Article 59 of the Withdrawal Agreement between the UK and the European Union allowed for owners of pending EUTMs as at 31 December 2020 (“IP Completion Day”) to file a corresponding mark in the EU within nine months of IP Completion Day and, in doing so, they retain the priority date of the earlier EUTM.

the tea lab

THE TEA LAB

(Series of two)

UK registration no. 2625062

Filing date 15 June 2012; registration date 21 September 2012

Registered for the following goods:

Class 30: Tea; aromatic, artificial, herbal and fruit flavoured teas; beverages made with tea; tea bags.

(“Tea Lab’s first registration”); and



UK registration no. 3126096

Filing date 8 September 2015; registration dated 5 February 2016

Registered for the following goods:

Class 30: Teas.

(“Tea Lab’s second registration”).

### Tea Lab’s opposition

6. On 26 October 2021, Wissotzky’s mark was opposed by Tea Lab. The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is aimed at all of Wissotzky’s goods. In respect of its 5(2)(b) and 5(3) grounds, Tea Lab relies on both of its registrations in full.
7. Under its 5(2)(b) ground, Tea Lab claims that Wissotzky’s mark is confusingly similar to its own registrations and is to be registered for identical goods and, as a

result, there is a likelihood of confusion on the part of the public which includes a likelihood of association.

8. Under its 5(3) ground, Tea Lab claims that it enjoys a reputation in both of its registrations in the UK and as a result, use of Wissotzky's mark will result in the UK public making an association between the parties' marks. This association, Tea Lab claims, means that any use of Wissotzky's mark, without due case, would take unfair advantage of, or be detrimental to the distinctive character or the repute of the Tea Lab's registrations.
9. Lastly, the 5(4)(a) ground relied upon by Tea Lab relies on two earlier signs. The first of which is the sign "TEA LAB" ("Tea Lab's first sign") that Tea Lab claims to have used throughout the UK since June 2015 in respect of "tea", "aromatic, artificial, herbal and fruit flavoured teas", "beverages made with tea" and "tea bags". The second sign is as follows:



("Tea Lab's second sign")

10. Tea Lab claims to have been using the above sign throughout the UK since September 2015 for the same set of goods outlined at paragraph 9 above.
11. In support of its 5(4)(a) ground, Tea Lab claims that it has extensive and well established goodwill in its signs and that use of Wissotzky's mark is likely to confuse the average consumer into believing that there is an economic connection between the parties. Such confusion, it claims, equates to misrepresentation by Wissotzky and, as such, damage through diversion of sales is likely.
12. Wissotzky filed a counterstatement denying the claims made and put Tea Lab to proof of use in respect of its first registration only.

### Wissotzky's application for revocation

13. On 26 January 2022, Wissotzky applied to revoke Tea Lab's first registration in full in accordance with sections 46(1)(a) and 46(1)(b) of the Act. Wissotzky alleges that Tea Lab has not used its first registration in the United Kingdom during various relevant periods and should, therefore, be revoked.
14. The first period during which Wissotzky alleges non-use of the trade mark under section 46(1)(a) is the five years after registration of Tea Lab's first registration, being 22 September 2012 to 21 September 2017 ("the first relevant period"), with revocation sought from 22 September 2017. Further, or in the alternative, Wissotzky claims that, under section 46(1)(b), Tea Lab has failed to use its first registration for the periods of 19 May 2015 to 18 May 2020 ("the second relevant period") with revocation sought from 19 May 2020 (being the priority date of Wissotzky's mark) and 26 January 2017 to 25 January 2022 ("the third relevant period"), with revocation sought from 26 January 2022 (being the date of the application for revocation).
15. Tea Lab filed a counterstatement defending its first registration for all goods for which it is registered and confirming that evidence supporting its use shall be adduced in due course.
16. Upon the filing of Tea Lab's counterstatement to the revocation application, the Tribunal wrote to the parties on 24 April 2022 and confirmed that under Rule 62 of the Trade Marks Rules 2008 ("the Rules"), the proceedings would be consolidated.
17. Both parties filed evidence in chief with Tea Lab electing to also file evidence in reply. A hearing took place before me on 17 January 2023, by video conference. Wissotzky was represented by Ms Stephanie Wickenden of Serle Court. Ms Wickenden was instructed by J A Kemp LLP, who have represented Wissotzky throughout these proceedings. Tea Lab was represented by Mr Matthew Harris of Pinsent Masons LLP, who have represented Tea Lab throughout these proceedings.

18. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE**

19. Tea Lab's evidence in chief came in the form of the witness statement of Julie Crofts-Mitchell dated 21 June 2022. Ms Crofts-Mitchell is the Director of Tea Lab, a position she has held since June 2015, and her statement is accompanied by 42 exhibits, being those labelled Exhibits JCM1 to JCM42.

20. Wissotzky's evidence in chief came in the form of the witness statement of James Andrew Fish dated 22 August 2022. Mr Fish is a Chartered Trade Mark Attorney and Solicitor at Wissotzky's representative and his statement is accompanied by one exhibit, being that labelled Exhibit JAF1.

21. As for evidence in reply, Tea Lab filed this by way of the second witness statement of Julie Crofts-Mitchell dated 21 October 2022 which is accompanied by a further three exhibits, being those labelled Exhibits JCM43 to JCM45.

22. I will refer to points from the evidence where necessary.

## **PRELIMINARY ISSUE**

23. On the morning of the hearing, Wissotzky's representative confirmed via email to the Tribunal that it wished to amend its case by admitting that the evidence submitted by Tea Lab was sufficient to prove that there was genuine use of Tea Lab's registrations (albeit the second registration was not put to proof of use). However, Wissotzky maintained that Tea Lab's claim to a reputation and goodwill

was denied and remained in issue. As a result of this admission, the issue of proof of use under the 5(2)(b) ground falls away.

24. While the above is noted, the correspondence from Wissotzky's representative made no mention of the revocation based on sections 46(1)(a) and 46(1)(b) of the Act, being the grounds based on non-use of Tea Lab's first registration. It is not simply the case that if genuine use is accepted then there must also be use under the grounds of the revocation. This is on the basis that the relevant period for genuine use under 5(2)(b) may differ from the period(s) for which use is required to be proved under the 46(1)(a) and 46(1)(b) grounds. In the present case, use is required under 5(2)(b) for 20 May 2015 to 19 May 2020. This is different from the second relevant period in the revocation action by just one day. It, therefore, follows that if use is accepted for 20 May 2015 to 19 May 2020 then it is also accepted for the second relevant period. However, the period within which use is accepted differs rather significantly from the remaining two relevant periods. On this point, I do not necessarily consider that just because use is accepted for one period, it is accepted for all.

25. In order to clarify the issue, I sought confirmation from Wissotzky as to its position regarding the revocation at the hearing. Ms Wickenden confirmed that Wissotzky accepts that the evidence of use is sufficient for general use purposes under the revocation application and that, as far as Wissotzky was concerned, the revocation application was no longer live. As a result, I accept that genuine use of Tea Lab's first registration under the 5(2)(b) ground is no longer at issue. Further, I accept that Wissotzky has hereby withdrawn its revocation application against Wissotzky's first registration. The revocation action is, therefore, no longer at issue.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

26. Section 5(2) of the Act reads as follows:

“(2) A trade mark shall not be registered if because –

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark.”

27. Section 5A of the Act states as follows:

“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.”

28. The registrations relied on by Tea Lab qualify as “earlier trade marks” for the purposes of the claimed grounds since they were applied for at an earlier date than Wissotzky’s mark’s priority date.<sup>2</sup> Tea Lab’s first registration has a registration date more than five years before the priority date of Wissotzky’s mark. As above, Tea Lab was put to proof of use for this registration but, prior to the hearing, Wissotzky accepted that genuine use had been proven meaning that Tea Lab’s first registration is not subject to proof of use pursuant to section 6A of the Act. As for Tea Lab’s second registration, this did not complete registration five years prior to priority date of Wissotzky’s mark and is, therefore, not subject to proof of use. This means that Tea Lab can rely upon all of the goods for which its registrations are registered.

29. The following principles are 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.*

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<sup>2</sup> See Section 6(1)(a) of the Act



Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (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.

**Comparison of goods**

30. The competing goods are as follows:

Tea Lab's goods	Wissotzky's goods
<p><i>Tea Lab's first registration</i></p> <p><u>Class 30</u> Tea; aromatic, artificial, herbal and fruit flavoured teas; beverages made with tea; tea bags.</p>	<p><u>Class 30</u> Tea Products; all included in class 30.</p>
<p><i>Tea Lab's second registration</i></p> <p><u>Class 30</u> Teas.</p>	

31. The General Court confirmed in *Gérard Meric v OHIM*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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 fur 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”.

32. It is Tea Lab's position that the goods are identical. At the hearing, Ms Wickenden accepted that the goods at issue are either identical or highly similar. This concession leaves me with having to decide whether the goods are similar to a high degree or identical. Wissotzky's only goods are “tea products” which, upon the plain reading of the term, can be said to cover any and all products relating to tea such as tea pots and tea cups. However, by virtue of being listed in class 30 (and specifically limited as such), Wissotzky's goods cannot be said to cover anything beyond the actual tea goods themselves, being tea leaves or tea bags, for example. Tea Lab's first and second registrations include the class 30 goods “tea” and “teas”, respectively. These goods are, in my view, either self-evidently identical or identical under the principle of *Meric*. I say this because the distinction between the parties' terms, namely the inclusion of ‘products’ in Wissotzky's specification, is not necessarily clear as to whether one party's term is broader than the other or whether, simply, “tea products” and “tea”/“teas” cover exactly the same range of goods, thereby being self-evidently identical. Either way, the goods are identical.

### **The average consumer and the nature of the purchasing act**

33. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in

the course of trade. In *Hearst Holdings Inc, Fleischer Studios Insc 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.”

34. The average consumer for the goods at issue will be members of the general public at large. The goods will, for the most part, be available via retailers, being both general and specialist retailers, and their online equivalents. At the retailers’ physical premises, the goods will be displayed on shelves and self-selected by the consumer. A similar process will apply when the goods are selected online, in that a consumer will select them after seeing an image on a webpage. In these scenarios, I am of the view that the selection of the goods at issue will be primarily visual although I do not discount an aural component also playing a part in the form of word of mouth recommendations and advice from sales assistants. In addition to these selection methods, I am of the view that the goods will also be selected in hospitality environments such as restaurants or cafes, for example. I do not discount there may be an aural component in the selection and ordering of the goods in these establishments, however, this is likely to take place after a visual inspection of a menu meaning that the visual component will remain the most important.

35. I turn now to the level of attention paid by the average consumer. Tea Lab submits that the level of attention paid in respect of the goods at issue is average. Wissotzky’s position is that as tea products overall or tea bags are low-value items commonly found in supermarket shops, the level of attention paid would be low. Alternatively, Wissotzky argues that even if specialist outlets of tea are involved

which could give rise to an average degree of attention, this does not necessarily affect the assessment of confusion. On this point, Wissotzky argues that there is no limitation on the specification to a particularly high-end specialist range of tea meaning that all purchase scenarios must be taken into account and if that affects the level of attention, it is the lowest level of attention that needs to be taken into account as it gives rise to the greatest risk of a likelihood of confusion. In giving submissions in reply on this point at the hearing, I note that Mr Harris argued that the product ranges sold by Tea Lab are loose leaf tea and that the attention for such goods is likely to be higher than that submitted by Wissotzky. Mr Harris took me to evidence of Tea Lab's product ranges.<sup>3</sup> While Mr Harris's points are noted, the goods at issue are not limited to the product range of loose leaf teas and may, instead, cover the type of goods that Wissotzky argues would attract a low degree of attention (being tea bags in a supermarket). I, therefore, conclude that the average consumer will, for the most part, pay a lower than medium degree of attention but appreciate that for those consumers who buy their goods at specialist retailers, this will extend to medium.

### **Comparison of the marks**

36. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

37. The Court of Justice for the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

"... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and



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<sup>3</sup> Exhibit JCM5

of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

39. The respective trade marks are shown below:

Tea Lab’s registrations	Wissotzky’s mark
<p style="text-align: center;">the tea lab THE TEA LAB (Series of two)  (“Tea Lab’s first registration”)</p> <div style="text-align: center;">  </div> <p style="text-align: center;"> (“Tea Lab’s second registration”)</p>	<div style="text-align: center;">  </div>

40. At the hearing, both parties made detailed submissions as to the comparison of the marks. I do not intend to reproduce them here but will, where necessary, address them below.

## Overall Impression

41. At the hearing, Mr Harris argued that, when considering the overall impression of the marks at issue, the dominant and distinctive components were the words 'TEA LAB' in Tea Lab's registrations and the component 'T LAB' in Wissotzky's mark. On the contrary, Ms Wickendon's submissions argued that, in respect of Tea Lab's first registration, the word 'THE' cannot be disregarded on the basis that it does add some conceptual meaning to the registration in that it refers to a specific lab, i.e. *the* lab. Further, Ms Wickendon argued that the word 'COMPANY' in Tea Lab's second registration cannot simply be ignored because it is presented smaller. In respect of Wissotzky's mark, Ms Wickendon's position at the hearing was that its most striking and distinctive element was the word 'WISSOTZKY'. While she appreciates that it is presented in smaller lettering, it is the most striking and unusual word which has the most novelty to it and, therefore, is the element likely to grab the attention of the consumer. Having taken the parties' arguments into account, I make the following findings in respect of the overall impression of the marks at issue.

### *Wissotzky's mark*

42. Wissotzky's mark is made up of several components that sit on top of each other. The element at the top of the mark is the letter 'T'. This is presented in a bold, black standard typeface. Under this is a short horizontal black line. Below the line is the word 'LAB' displayed in the same size and styled typeface as the letter 'T'. While the letter 'T' and the word 'LAB' are separated by a horizontal line, I find that they will be viewed together as 'T LAB' given their shared use of size and typeface. At the bottom of the mark is the word 'WISSOTZKY'. This is presented in the same typeface as the other word elements but is displayed smaller and not in bold. All of these elements sit inside a square, black border. Despite Tea Lab's submissions regarding the dominance of 'T LAB', I find that it is the word 'WISSOTZKY', regardless of its size, that will play the strongest role in the overall impression of the mark with 'T LAB' playing a lesser role. I make this finding for reasons that I will come to discuss when considering the conceptual comparison of the marks. As for the remaining elements, being the horizontal line and the border together with the

way in which the words are presented (being stacked vertically), I find that as they are purely decorative, they will have a negligible impact on the mark as a whole.

### *Tea Lab's registrations*

43. Tea Lab's first registration is a series of two marks consisting of identical words, being 'THE TEA LAB'. The only difference between the marks is the use of lower case in the first mark and upper in the second. As word only marks, both are capable of being used in either upper case, lower case or any customary combination of the two. As a result, the marks can be displayed in identical ways and I will, therefore, will consider them together. I note the comments from the parties regarding the role that the word 'THE' plays. While it may sometimes be the case that the word 'THE' is overlooked from a trade mark perspective, I agree with Wissotzky's position that the inclusion of the word 'THE' means that it will be considered as a reference to a specific tea lab i.e. *the* tea lab. As a result, I consider that 'the tea lab' forms a unit and, therefore, the overall impression lies in the entirety of the mark.

44. Turning to Tea Lab's second registration, this is a figurative mark that consists of a number of elements. The first is the word 'TEA' that sits above the word 'LAB' which, in turn, sits above the word 'COMPANY'. All of these words are displayed in standard black typefaces; however, 'TEA' and 'LAB' are displayed a lot larger than 'COMPANY'. Enveloping all of these elements are two gold square brackets. Given the size of 'TEA' and 'LAB' I find that these will play the greater role in the overall impression of the registration. Further, they will be read as a unit, being 'TEA LAB'. As for 'COMPANY', I find that due to the fact that it is presented in such a smaller typeface and on the basis that it is a simple reference to the nature of the undertaking responsible (in that it is a company), it plays a lesser role. As for the gold square brackets and the way in which the words are presented (in that they are stacked vertically), I am of the view that they are purely decorative elements that will only play negligible roles.



## Visual Comparison

### *Wissotzky's mark and Tea Lab's first registration*

45. Visually, these marks share the word 'LAB'. They are also similar in that their perceived first letter is 'T' (on the basis that it sits at the top of Wissotzky's mark), however, I do not place much weight on this as a significant point of visual similarity as it is presented in solus in Wissotzky's mark but forms part of a word in Tea Lab's first registration. The marks differ in the presence of the words 'THE' and 'TEA' in Tea Lab's first registration (albeit acknowledging Wissotzky's use of the same first letter) and the word 'WISSOTZKY' in Wissotzky's mark. None of these elements have a counterpart in the competing mark. I appreciate that, as a series of word only marks, Tea Lab's registration is capable of being presented in an identical typeface to that of Wissotzky's mark. However, I do not consider that this extends to the use of the horizontal line and border elements. While I consider that the way in which Wissotzky's mark is displayed has a negligible impact, it is still a point of visual difference. Taking all of this into account and bearing in mind the overall impression of the marks, I find that the marks are visually similar to between a low and medium degree.

### *Wissotzky's mark and Tea Lab's second registration*

46. These marks share the same points of similarity as those discussed above. As for their differences, these are the use of the words 'TEA' and 'COMPANY' in Tea Lab's second registration and the word 'WISSOTZKY' in Wissotzky's mark. None of these elements have a counterpart in the competing mark. Further, when it comes to the presentation of these marks, I consider that they are a step closer than those that I have assessed in the preceding paragraph. This is on the basis that Tea Lab's second registration consists of words that are stacked vertically meaning that, visually, there is a degree of similarity in the way in which the marks are presented. This presentational similarity applies to the stacked vertical words only and not the borders used, which are clearly different. While the presentational elements all play negligible roles in their respective marks, they still have an impact on the marks visually. Taking all of this into account and bearing in mind my

conclusions on the overall impression of these marks, I find that these marks are similar to a medium degree.

### Aural Comparison

47. Regardless of the roles that different words have within their respective marks, I find that all of the words in the registrations at issue will be pronounced. I make this finding whilst bearing in mind the case of *Purity Hemp Company Improving Life as Nature Intended*<sup>4</sup> wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness does not of itself render an element negligible or aurally invisible.

### *Wissotzky's mark and Tea Lab's first registration*

48. Wissotzky's mark consists of five syllables that will be pronounced 'TEE-LAB-WIZ-OTT-SKEE'. As for Tea Lab's first registration, this consists of three syllables that will be pronounced in the ordinary way. The first two syllables of Wissotzky's mark are identical to the second and third syllables of Tea Lab's first registration. However, the first syllable of Tea Lab's registration and the last three in Wissotzky's mark differ entirely. I remind myself that while there is no special test which applies to the comparison of 'short' marks,<sup>5</sup> I am of the view that in the present case the shortness of 'THE TEA LAB' means that the average consumer is more likely to notice the differences, particularly given that the element 'WISSOTZKY' is longer than the shared syllables. Overall, I find that the marks are similar to between a low and medium degree.

### *Wissotzky's mark and Tea Lab's second registration*

49. Wissotzky's mark will be pronounced as set out above. As for Tea Lab's second registration, this consists of five syllables that will be pronounced in the ordinary way. These marks share the same length and are identical in their first two

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<sup>4</sup> Case BL O/115/22

<sup>5</sup> See paragraph 44 of *BOSCO*, BL O/301/20

syllables, being where the average consumer tends to focus.<sup>6</sup> It could be argued that this results in a higher degree of similarity than that discussed in the preceding paragraph. However, this is not necessarily the case. Firstly, it is not always the case that similar beginnings are necessarily important or decisive.<sup>7</sup> Secondly, Tea Lab's second registration consists of a further point of aural difference, being the presence of the word 'COMPANY' at the end of the mark. Taking all of this into account and applying the same logic used at paragraph 48 above, namely that the points of difference are longer than the points of identity, I find that these marks are also similar to between a low and medium degree.

### Conceptual Comparison

50. Mr Harris's submissions at the hearing were that the marks at issue are conceptually identical in the sense that they convey a fanciful message of being a developer of tea. In response to this submission, Ms Wickenden comments that the comparison provided by Tea Lab ignores the word 'WISSOTZKY' and that this is an error in approach. Further, Ms Wickenden argues that Tea Lab's submissions equate to an admission that its registrations are descriptive, being a point I will address when considering the distinctive character of Tea Lab's registrations.

51. Having considered the parties' positions, I agree with Ms Wickenden in that the dissection by Tea Lab in relation to Wissotzky's mark, namely ignoring the 'WISSTOZKY' element, is an incorrect approach. Therefore, the conceptual comparison is not, as Tea Lab suggests, simply 'TEA LAB' against 'T LAB'. I will now proceed to consider the conceptual comparison of the marks at issue in full.

### *Wissotzky's mark and Tea Lab's first registration*

52. Tea Lab's first registration is simply the words 'THE TEA LAB'. I consider that the reference to a 'LAB', which will immediately be understood as short for 'laboratory', is somewhat unusual in the context of tea itself on the basis that, as far as I understand it, tea is not commonly produced in a laboratory. Having said that, I still

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<sup>6</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>7</sup> *CureVac GmbH v OHIM*, T-80/08

consider that the registration as a whole will be understood as being descriptive of the fact that the goods at issue are tea, albeit goods that originate from a lab. I have found that the inclusion of 'THE' creates the impression that it refers to a specific tea lab, being *the* tea lab. However, I do not consider that this impacts on the overall concept to any significant degree as (1) it does not describe precisely which tea lab is referred to and (2) the overall concept still describes a tea lab.

53. As for Wissotzky's mark, I find that despite the use of the single letter 'T', it will still allude to tea, being the goods at issue. As for the addition of 'LAB', I consider that it creates an identical concept to that of Tea Lab's first registration, being a tea laboratory. Again, this is descriptive in the context of the goods at issue. That being said, the addition of the word 'WISSOTZKY' creates a point of conceptual difference between the marks. This is because 'WISSOTZKY' is, in my view, likely to be understood as a surname of foreign origin by at least a significant proportion of average consumers. Alternatively, I accept that it may also be understood as a made-up or foreign language word with no obvious meaning by a lesser, but still significant, proportion of average consumers. Either way, 'WISSOTZKY' will be understood as the indicator of origin that is ultimately responsible for the 'tea lab', thereby pointing to Wissotzky's tea lab.

54. While the shared reference to a tea lab is noted, the use of the words 'THE' and 'WISSOTZKY' (regardless of how it is understood) in the marks will create an understanding in the mind of the average consumer that the marks refer to different tea labs. Therefore, they act as points of conceptual difference. Overall, I find that these marks are conceptually similar to between a medium and high degree.

#### *Wissotzky's mark and Tea Lab's second registration*

55. I am of the view that the differences between Tea Lab's registrations, being the use of 'COMPANY' instead of 'THE' and the way in which the second registration is presented will result in a very similar concept being understood by the average consumers. For example, the reference to a tea lab will remain but, for this registration, the average consumer will understand that the mark refers to a company that operates a tea lab that produces tea and not *the* tea lab itself,

whatever that may be. As a result, I find that the same issues discussed in the conceptual comparison of Tea Lab's first registration will apply here, namely that the tea lab concept will run through them both with the reference to a 'COMPANY' and 'WISSOTZKY' being points of conceptual difference. Overall, I find that these marks are conceptually similar to between a medium and high degree.

### **Distinctive character of Tea Lab's registrations**

56. 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).”

57. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive

character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In the present case, Tea Lab argues that its registrations enjoy an enhanced distinctive character and filed evidence in support of the same. Before considering the position in respect of the claim to enhanced distinctiveness, I will first consider the inherent position.

58. At the hearing, Mr Harris claimed that Tea Lab's registrations enjoy a high degree of inherent distinctiveness. On this point, I remind myself of the submissions of Ms Wickenden (being those referred to at paragraph 50 above) wherein she argued that Tea Lab's submissions (that both parties' marks convey a meaning that they both are developers of tea) equate to an admission that its registrations are descriptive. To me, Wissotzky's argument on this point is that Tea Lab accepts that its registrations are of low distinctive character. While I agree that Tea Lab accepts that this is the meaning of its registrations, I do not consider such an acceptance equates to an admission by Tea Lab that its registrations are of low inherent distinctive character. As such, it is necessary for me to make my own assessment of the registrations.

59. I appreciate that the words 'TEA LAB' will be seen as somewhat unusual on the basis that it is not, as far as I understand it, common for tea to be created in a laboratory. However, I consider that average consumers will still understand that the registrations describe the goods at issue, namely that they describe tea that is created or developed in a laboratory. As such, I find that 'TEA LAB' in the registrations is of low inherent distinctiveness. In respect of the registrations as wholes, I do not consider that the addition of 'THE' or 'COMPANY' in the registration and the presentational arrangement of the second registration will contribute to the distinctive character of the registrations to any significant degree beyond the distinctiveness created by 'TEA LAB'. To confirm, I find that Tea Lab's registrations as wholes only enjoy a low degree of distinctive character. I will now consider the position regarding the enhanced distinctiveness claim.

60. At the hearing, both parties gave detailed submissions in respect of the position regarding enhanced distinctiveness. I do not intend to reproduce those here but confirm that I have taken them into account in making my assessment.

61. Tea Lab's evidence sets out that it has been continuously and consistently promoting goods under its registrations since the brand was created in June 2015. The evidence goes on to state that the goods it produces, promotes and sells are synonymous with the sign 'TEA LAB' which is the dominant component of the brand and often its most visible element. The evidence claims that use of the word 'TEA LAB' can also be used to show that both of Tea Lab's registrations have an enhanced degree of distinctive character.

62. The evidence goes into the history of Tea Lab and confirms that it largely advertises and sells its full product range on the website tealab.co.uk. It also claims to have an extensive and wide social media presence. Print-outs of the main pages of the website are provided in evidence.<sup>8</sup> While noted, they are all undated and the only reference to dates comes in the copyright of each page, being 2022. The relevant date for this assessment is 19 May 2020. The print-outs are, therefore, after the relevant date and I will not consider them during the course of this assessment. Having said that, I note that the narrative evidence confirms that Tea Lab's website has only ever been tealab.co.uk. Additionally, I note the presence of additional print-outs from the website taken from the internet archive facility, The Wayback Machine.<sup>9</sup> These print-outs are not accurately dated as the date appears to be included in the URL of the webpage and is presented with a range of numbers that do not, as far as I can see, correlate with any date. That being said, I am able to decipher from the URL that there are print-outs taken from each year between 2016 and 2019. These print-outs show a range of loose leaf tea.

63. While discussing the website evidence, Tea Lab goes on to discuss its online presence in the UK by way of visitor figures to the above website in the UK between 2015 and 2021. Despite what the narrative evidence states, there are no figures for 2015 and as far as the 2021 figures are concerned, these fall after the relevant

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<sup>8</sup> Exhibit JCM3

<sup>9</sup> Exhibit JCM10

date and are of no relevance to this assessment. The relevant figures provided show that for “2016 (Aug)”<sup>10</sup> there were 4,932 visitors, for 2017 there were 6,157 visitors, for 2018 there were 6,484 visitors, for 2019 there were 7,292 visitors and for 2020 there were 18,926 visitors. This results in a total of 43,791 visitors; however, I bear in mind that the relevant date falls in May 2020 meaning that a significant amount of the 2020 figures will inevitably be from visits after the relevant date. Further, I note that there is nothing confirming whether these figures are unique visitors or simply the total number of views that the website has attracted.

64. Tea Lab has also provided 12 examples of what it refers to as wholesale enquiries between 18 December 2016 and 30 March 2020.<sup>11</sup> Some of the enquiries are generated by ‘Shopify’ and some are direct emails to Tea Lab. I note that the details of the enquirers and their business names have been redacted. Further, some of the enquiries show no message whatsoever<sup>12</sup> and some are not entirely clear as they appear to have been cut off. For example, I note that one message dated 12 January 2020 states “Hi guys we are looking for a tea supplier to serve and sell in a new lifestyle”.<sup>13</sup> While this evidence is noted, I am of the view that it is of limited assistance on the basis that, in total, I can see complete messages from just five enquiries and while four of them appear to be genuine wholesale enquiries (the remaining is a message that says “We Love Your Products!”),<sup>14</sup> there is nothing to suggest that these enquiries led to any sales.

65. Tea Lab’s social media presence is then discussed in further detail. A table is reproduced in the evidence that shows the follower figures for Tea Lab’s Facebook, Instagram, Twitter and Pinterest accounts. I note that the figures provided are all up to 21 June 2022 with all accounts being created in May 2015. Of these, I note that its Facebook account has 485 followers, its Instagram account has 4,244 followers, its Twitter account has 398 followers and its Pinterest account has 181 followers (with 16,000 views per month). Print-outs from the Facebook, Instagram

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<sup>10</sup> The figures labelled “2016 (Aug)” are presumably either the figures from August 2016 to the end of that year or from January to August 2016. Either way, I am satisfied that they are attributable to 2016.

<sup>11</sup> Exhibit JCM10

<sup>12</sup> See Exhibit JCM10 at pages 74 and 78 to 82

<sup>13</sup> See Exhibit JCM10 at page 76

<sup>14</sup> See Exhibit JCM10 at page 77



and Twitter accounts are provided that show posts from various dates.<sup>15</sup> While all of this evidence is noted, the figures cover up to 21 June 2022, being over one year after the relevant date. Further, the nature of social media means that some of these followers could be international followers and I have nothing before me to confirm the amount of followers these accounts had as at the relevant date and how many of those followers were from the UK. As a result, I am only able to place very little weight on this evidence.

66. Reviews taken from what Tea Lab claims to be a popular ecommerce platform, Yotpo, have been provided.<sup>16</sup> These reviews are confirmed as being examples and I note that 14 of them are from prior to the relevant date. The narrative evidence confirms that Tea Lab's products have 246 five-star reviews. There is no indication as to whether or not these reviews were posted prior to the relevant date or not and given that a number of the reviews provided as examples were from after the relevant date, it is reasonable to infer that this figure includes reviews posted after the relevant date.

67. Turnover figures are then discussed and Tea Lab confirms its approximate annual turnover in respect of UK sales for August 2016 to the end of 2021. Again, the 2021 figures fall after the relevant date and are, therefore, disregarded. I note that the evidence confirms that these turnover figures cover a combination of Tea Lab's three key product areas, being loose leaf teas, tea gifting and tea tools. Earlier in the narrative evidence, there is information regarding tea gifting and tea tools. Tea gifting is a range of "unique gifting options that offer a range of TEA LAB drinking experiences, from starter kits to ceremonial matcha rituals" being something that it offered "to complement the tea drinking experience."<sup>17</sup> As for tea tools, the evidence sets out that these includes bags, mugs, jars, glasses and teapots, amongst others, none of which being actual tea.<sup>18</sup> It is my view that tea gifting and tea tools are not goods within the specification upon which Tea Lab relies, being class 30 tea goods.

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<sup>15</sup> Exhibits JCM12, JCM13 and JCM14

<sup>16</sup> Exhibit JCM15

<sup>17</sup> Paragraph 19.1.2 of the witness statement of Julie Crofts-Mitchell

<sup>18</sup> See paragraph 19.1.3 of the witness statement of Julie Crofts-Mitchell

68. The turnover figures are broken down as being £1,423 for 17 August 2016 to 31 October 2016, £5,830 for 1 November 2016 to 31 October 2017, £16,817 for 1 November 2017 to 31 October 2018, £27,449 for 1 November 2018 to 31 October 2019 and £46,057 for 1 November 2019 to 31 October 2020. This equates to a total turnover of £97,576 but, again, I note that the 2020 figure inevitably includes turnover from five months after the relevant date. The evidence includes examples of invoices between 25 November 2016 and 28 April 2020 (there are additional invoices, however, these fall after the relevant date).<sup>19</sup> While I note that the invoices show sales of teas, they also include other goods that are not class 30 tea goods and these include goods such as glass jars, tea cages, tea pots and gift bags. This is consistent with what the narrative evidence confirms, being that discussed at paragraph 67 above.

69. The evidence goes on to discuss promotion and advertisement in the UK and, in support of such, encloses a range of print-outs that cover various areas such as features/advertisements in magazines, attendance at trade shows and events and bespoke collaborations.<sup>20</sup> The majority of the evidence is dated prior to the relevant date. While I do not intend to go over every piece of evidence, I will briefly summarise the areas covered. In respect of the advertisements in magazines (both printed and online), I note that this includes features in Elle magazine and BBC Good Food magazine.<sup>21</sup> It is my understanding that these are UK-wide publications that attract a significant readership from across the UK. However, the remaining evidence on this point comes from more localised or, as far as I understand it, lesser-known magazines such as Bath Life, Virgin Tribe, Crumbs and Magazine Heaven.<sup>22</sup> I have nothing to ascertain the readership for such publications or their spread across the UK.

70. In respect of the trade shows and events evidence, there are only two events that suggest attendee figures, being 50 attendees to the 'High Sheriffs Dinner' hosted by William Sitwell and the House of Commons tasting events which served

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<sup>19</sup> Exhibit JCM16

<sup>20</sup> Exhibits JCM17 to JCM38

<sup>21</sup> Exhibits JCM25 and JCM27

<sup>22</sup> Exhibits JCM22 to JCM24, JCM26 and JCM28 to JCM29

between 400 and 500 people.<sup>23</sup> As for the remaining events and/or trade shows, there is nothing to suggest the level of attendees or the awareness of the same. Lastly, I note the latest event, being the 'Planted, Zero' event, took place over April and May 2022, being after the relevant date.<sup>24</sup>

71. As I have set out above there is a reference to a bespoke collaboration. The evidence indicates that this was with Penguin Books, however, I note that the book referred to is one that was released in April 2022 and while I note there are photos on social media posts showing Tea Lab's second mark on a test tube,<sup>25</sup> it is not clear when this product was released. Given the release date of the book, it is reasonable to infer that the product was released on or around April 2022 to coincide with the launch, being after the relevant date.

72. Lastly in respect of the promotion and advertisement evidence, there are print-outs that relate to retail shops, a hotel shop, catering for private aviation, high end lifestyle stores and award-winning cafes.<sup>26</sup> While noted, the print-outs are all undated and, therefore of no assistance.

73. The evidence then goes on to discuss two awards that Tea Lab has achieved. One is after the relevant date so will not be considered. The award from prior to the relevant date is a 2017/2018 'Carlsberg Northamptonshire Food & Drink Award' for 'New Local Drink of the Year' for Tea Lab's 'Dreamcatcher tea' and 'cinnamon and vanilla rooibos tea'.<sup>27</sup> The evidence also mentions Tea Lab being a runner up for the 'One to Watch' award at the 2018/2019 'Carlsberg Northamptonshire Food & Drinks Awards'.<sup>28</sup> While this evidence is noted, I have nothing to confirm how these awards are voted for, be that by a judging panel or from votes from members of the public. Further, I note that they are local awards so any reach is likely to be limited and I have nothing before me to suggest otherwise.

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<sup>23</sup> Exhibits JCM35 and JCM37

<sup>24</sup> Exhibit JCM30

<sup>25</sup> Exhibit JCM38

<sup>26</sup> See Exhibit JCM17 to JCM21

<sup>27</sup> Exhibit JCM39

<sup>28</sup> Exhibit JCM41

74. In regard to Tea Lab's evidence in reply, I am of the view that save for some comments relating to Wissotzky's evidence, it is not strictly in reply and, instead, simply serves to introduce supplementary evidence regarding press coverage. For the sake of completeness, it includes an article from thegentlemanselect.com dated 5 December 2016,<sup>29</sup> an article from sophieetc.com dated 31 May 2017<sup>30</sup> and an article from vitastudent.com from March 2019.<sup>31</sup> Notwithstanding the issues regarding the fact that such evidence was not strictly in reply to Wissotzky's evidence, it is of no assistance to Tea Lab. This is on the basis that there is no evidence confirming the readership of these websites and without such, there is nothing to inform me as to the reach of such articles across the relevant section of the public.

75. Taking the evidence as a whole, I do not consider that it is sufficient to warrant a finding that the distinctiveness of Tea Lab's registrations has been enhanced as a result of the use made of them. I make this finding whilst also bearing in mind that, as set out in Wissotzky's evidence, the market in the UK for tea products is staggering with the annual turnover of the market being £1.64 billion in 2012 before slowly increasing on a year by year basis to a figure of £1.76 billion in 2019, albeit falling to £1.51 billion in 2020 (presumably due to the effects of the COVID-19 pandemic).<sup>32</sup> In comparison to such a market, the turnover of £97,576 over a period of 5 years is miniscule. On the point of the turnover, I refer to my comments of the evidence at paragraphs 67 and 68 above that the turnover covers three product ranges, being loose leaf teas, tea gifting and tea tools and that the invoices provided also cover goods that can be said to fall outside of Tea Lab's specifications. It is, therefore, reasonable to suggest that of the total turnover provided, not all of it relates to the goods at issue. This is, in my view, a considerable issue for Tea Lab as, despite the provision of a total turnover figure, it is not possible for me to determine an accurate level of turnover achieved insofar as it relates to the goods at issue. In addition, the remaining evidence (being the 43,791 visitors to Tea Lab's website, Tea Lab's social media following and the press coverage/awards) is not particularly compelling either, especially given the

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<sup>29</sup> Exhibit JCM43

<sup>30</sup> Exhibit JCM44

<sup>31</sup> Exhibit JCM45

<sup>32</sup> See Exhibit JAF1

issues I have identified throughout the above assessment. As a result, the claim that the distinctiveness of Tea Lab's registrations has been enhanced through use is dismissed and the inherent position stands, namely that they are distinctive to only a low degree.

### **Evidence of actual confusion**

76. Before proceeding to consider the likelihood of confusion, I consider it necessary to first address the evidence of alleged actual confusion filed by Tea Lab. On the point of actual confusion, I note the comments of Kitchin LJ (as he then was) in the case of *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220. While the relevant discussion in that case surrounded the lack of confusion in the marketplace, he did state that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion.”

77. If I am satisfied that Tea Lab has filed evidence of actual confusion, it is not the end of the matter but, as above, it is to be considered powerful evidence in favour of Tea Lab's opposition.

78. The evidence of actual confusion came in the form of a screenshot from Tea Lab's Instagram account.<sup>33</sup> The screenshot consists of four posts uploaded by four different accounts. I note that the posts show Wissotzky's mark and the users have tagged the account '@tealabcompany' which is Tea Lab's Instagram handle. At the hearing, Mr Harris argued that this supports, without question, that a likelihood of confusion exists. In response, Ms Wickenden pointed out that it was not at all clear what the evidence actually shows and requested that it be dismissed. Ms

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<sup>33</sup> Exhibit JCM42

Wickenden went into some detail in discussing her points in respect of actual confusion and while I do not intend to reproduce those arguments in full here, I do wish to summarise them briefly. The first issue raised is that there are no details of who exactly posted these photos. The second issue is that there is nothing at all upon which I can be sure that these instances come from the UK. The third issue raised was that there is no information as to whether these users are followers of Tea Lab and if so, whether they simply started typing in "tea" resulting in a prompt from the Instagram app that asks whether the user would like to tag Tea Lab, thereby resulting in the incorrect application of the tag.

79. Having reviewed the evidence myself, I am in agreement with Ms Wickenden. There is no information as to who posted these images and where they were posted from. On the latter point, I note that one of the images posted appears to have text in a foreign language, possibly Hebrew, indicating that it may have been posted outside of the UK. The same issue can be said to apply to the remaining posts in that, despite their use of English, there is nothing to guide me on where the posts came from. As for the comments regarding the prompting of the tag, there is nothing before me to suggest that this is how Instagram posts operated, however, Ms Wickenden is correct in that there is just not enough information from Tea Lab to determine this as evidence of actual confusion. Lastly, I note that there is no information as to when these images were posted. Taking all of this into account, I do not accept that this evidence constitutes evidence of actual confusion. I will now proceed to consider a likelihood of confusion in the ordinary way.

### **Likelihood of confusion**

80. 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier registrations, 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.

81. I have found the parties' goods to be identical. I have found that the average consumer for the goods is made up of members of the general public at large who will select the goods through primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will, for the most part, pay a lower degree of attention when selecting the goods at issue but, in some circumstances, this extends to medium. In regard to the similarity of the marks, I have found Wissotzky's mark to be visually and aurally similar to between a low and medium degree and conceptually similar to between a medium and high degree with Tea Lab's first registration and visually similar to a medium degree, aurally similar to between a low and medium degree and conceptually similar to between a medium and high degree with Tea Lab's second registration. I have found that Tea Lab's registrations are inherently distinctive to a low degree. While that may be the case, I am reminded of the fact that the low distinctive character of an earlier mark does not preclude a likelihood of confusion.<sup>34</sup>

82. At the hearing, there was a significant focus from Mr Harris regarding the interdependency principle in that Tea Lab has established that the goods are identical so it follows that the signs/marks can be less similar for a likelihood of confusion to be found. However, Tea Lab argues that it has demonstrated that the marks at issue are also highly similar and therefore it follows from this that there would be a likelihood of confusion between the respective marks. Even though I acknowledge that the goods are identical, it is not simply the case that confusion must follow for marks that are of a lesser degree of similarity. While the argument regarding the interdependency principle is noted, I am of the view that it disregards

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<sup>34</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

what is an important consideration in the present case, being the presence of the word 'WISSOTZKY'. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that the presence of 'WISSOTZKY' is such that it will assist the average consumer in accurately remembering and recalling the parties' marks for one another. I see no scenario wherein the average consumer will overlook the dominant and distinctive word in Wissotzky's mark, being 'WISSOTZKY'. I appreciate that the marks share the conceptual hook of a 'tea lab', however, this does not in any way mean that 'WISSOTZKY' will be overlooked, particularly given the descriptive nature of said conceptual hook. Consequently, I do not consider that there is a likelihood of direct confusion between the marks, even on goods that are identical or in circumstances where the average consumer pays a lower degree of attention. I will now proceed to consider indirect confusion.

83. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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



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

84. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

85. In the present case, Tea Lab claims that average consumers would, upon viewing Wissotzky's mark on the goods applied for, automatically assume that they were economically linked to Tea Lab. Taking all of the above into account, I do not consider that this will be the case. I appreciate that there exists a shared concept of a 'tea lab' between the parties' marks, however, I have discussed above that the reference to a tea lab is descriptive of the goods at issue meaning that the shared element would not be 'so strikingly distinctive' that the consumer would believe only one undertaking would use it. In the present case, to be satisfied that there exists a likelihood of indirect confusion, I am of the view that the average consumer would

need to believe that the alternate use of 'T' and 'TEA' in the marks is a logical change that an undertaking would make that would be consistent with a brand extension, sub-brand or alternative mark. I would also need to find that the average consumer would consider it logical that an undertaking would remove/add a distinctive element from/to its mark, being 'WISSOTZKY'. I do not consider that either would occur. Firstly, while I accept that 'T' may be understood as alluding to 'TEA' in the context of the goods at issue, I fail to see why the consumer would think it logical for an undertaking to alternate their use of 'T' and 'TEA' across different marks. Such an alternate use would, in my view, not be consistent. Secondly, the word 'WISSOTZKY' will be viewed as the primary indicator of origin in Wissotzky's mark and I see no reason why the average consumer would think it logical that such a distinct element would be removed from a mark so that the mark would be read simply as a descriptive reference to a tea lab. In respect of Tea Lab's submissions, I accept that the categories laid out in *L.A. Sugar* (cited above) are not exhaustive, but I have no argument before me as to whether there are any other circumstances that may give rise to a likelihood of direct confusion. Taking all of this into account and bearing in mind the comments of Arnold LJ in *Liverpool Gin* (being those reproduced above), I find that there is no likelihood of indirect confusion in the present case, even when bearing in mind that the marks will be viewed on identical goods and in circumstances where the average consumer pays a lower degree of attention.

86. On the point of confusion, I have also given consideration to the *Medion* principle<sup>35</sup> and whether the average consumer would perceive Wissotzky's mark to consist of two or more signs with one of which having a distinctive significance which is independent of the whole. For such a principle to apply to the present case, I would need to be satisfied that the consumer would believe that 'T LAB' had a distinctive significance independent of the mark as a whole. Given what I have said about the significance of 'WISSOTZKY' as the primary indicator of origin and the descriptive nature of 'T LAB', I do not consider that the consumer would perceive Wissotzky's mark in such a way.

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<sup>35</sup> See *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04 and the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) wherein the correct approach to the *Medion* principle was set out by Arnold J (as he then was)

87. As a result of the above, Tea Lab's opposition reliant upon the 5(2)(b) ground fails. I will now proceed to consider the 5(3) ground.

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

88. Section 5(3) of the Act states:

“5(3) A trade mark which –

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 a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

89. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

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

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

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

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails

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

90. The conditions of section 5(3) are cumulative. There must be similarity between the marks. Tea Lab must also show that its registration has achieved a level of knowledge, or reputation, amongst a significant part of the public. Tea Lab must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by Tea Lab will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

91. The relevant date for the assessment under section 5(3) is the priority date of Wissotzky's mark, being 19 May 2020.

## **Reputation**

92. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

93. Under its 5(3) ground, Tea Lab relies on the same registrations as it did under its 5(2)(b) ground and claims to have obtained a reputation in the same set of goods that were relied upon under that ground.

94. When assessing whether there was enhanced distinctiveness of Tea Lab's registrations, I undertook a detailed assessment of the evidence filed. This same evidence is relied upon for the basis of Tea Lab's 5(3) claim. A summary of the evidence can be found at paragraphs 62 to 75 above and while I do not intend to reproduce that evidence here, I remind myself that Tea Lab's UK turnover was approximately £97,576 between 2016 and 2020 (although I bear in mind that the 2020 figure includes turnover that inevitably accrued after the relevant date and that the turnover does not relate solely to the goods at issue). I note that Wissotzky has provided evidence of the size of the market at issue which stood at £1.64 billion in 2012, increasing to £1.76 billion in 2019. While the market dropped to £1.51 in 2020, seemingly as a result of the COVID-19 pandemic, this still represents an enormous market. The turnover provided is minute in comparison to the market at issue and I remind myself, again, of the issue with the turnover provided in that it is not specific to the goods at issue.

95. While the issue with the turnover evidence does not mean that Tea Lab cannot enjoy a reputation, I note that the remaining evidence is not particularly compelling. Of this I remind myself that Tea Lab had 43,791 visitors to its website, a limited social media following (insofar as it can be said to cover UK users from before the relevant date), a limited number of enquires obtained from its website, just 14 reviews from an online review forum and a limited level of exposure in press (only two instances where it was featured in UK-wide publications and a limited range of coverage in local press articles, of which there is no evidence to suggest their reach across the relevant public). Taking all of the evidence into account, I am not satisfied that Tea Lab has demonstrated that it enjoys a reputation amongst the relevant public the UK in either of its registrations. Without a reputation under 5(3) grounds, there can be no link and, therefore, no damage. As a result, Tea Lab's reliance upon its 5(3) ground fails in its entirety. I will now proceed to consider the 5(4)(a) ground.

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

96. Section 5(4)(a) of the Act reads as follows:

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

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

(aa) .....

(b) .....

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

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

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

98. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

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

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

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation<sup>1</sup> among a relevant class of persons; and



- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

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

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

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

## Relevant Date

100. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

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

101. As noted above, Wissotzky's mark has a priority date, being 19 May 2020. Further, there is no evidence to suggest any use of Wissotzky's mark prior to this date meaning that the relevant date for the 5(4)(a) assessment falls on this priority date.

## **Goodwill**

102. The first hurdle for Tea Lab under this ground is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the signs relied upon were distinctive and/or associated with that goodwill. I remind myself that the signs relied upon are follows:

TEA LAB  
("Tea Lab's first sign")



("Tea Lab's second sign")

103. I also remind myself that the goods relied upon under both signs are the same, being "tea", "aromatic, artificial, herbal and fruit flavoured teas", "beverages made with tea" and "tea bags".

104. Firstly, I wish to address the fact that Tea Lab's second registration under its 5(2)(b) ground is identical to the second sign relied upon here. I found no likelihood of confusion between Wissotzky's mark and Tea Lab's second registration, even for identical goods. I appreciate that the range of goods relied upon here are different than those relied upon under the 5(2)(b) ground, however, they are still tea products and, in my view, remain identical to Wissotzky's goods. On this point, I refer to the case of *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, wherein Lewison L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same result as the test for a likelihood of confusion. He pointed out that it is sufficient for passing off purposes that "a *substantial number*" of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

105. As a result of the case law cited above, I am of the view that even if it was the case that Tea Lab enjoyed goodwill in this sign, it would not result in any different outcome than that which was reached under the 5(2)(b) ground. Therefore, Tea Lab's reliance upon its second sign must fail. This leaves Tea Lab's first sign, being one that is very similar to the Tea Lab's first registration as relied upon under the

5(2)(b) ground. However, given that it is not identical, I will proceed with the 5(4)(a) assessment.

106. I refer here to the evidence summary provided under the enhanced distinctiveness assessment at paragraphs 62 to 75 of this decision. While my assessment of enhanced distinctiveness and reputation focused on Tea Lab's registrations, which are slightly different to the sign relied upon here, this summary represents the totality of Tea Lab's evidence. In the event that I find that the evidence points to the existence of a protectable level of goodwill in Tea Lab's business, I will assess whether 'TEA LAB' is distinctive of and/or associated with that goodwill at that stage.

107. I remind myself that the evidence was not sufficient to find any level of enhanced distinctive character, and neither was it sufficient to find the existence of any reputation in favour of Tea Lab. While I appreciate that the test for goodwill is less onerous than the ones assessed above, this does not necessarily mean that there exists goodwill in Tea Lab's business. Further, I remind myself of the deficiencies with Tea Lab's evidence, being that the turnover, as provided, is miniscule in relation to the size of the market at issue. On this point, I note that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.<sup>36</sup> While that may be the case, the issue for Tea Lab in this regard is further compounded by the fact that the evidence confirms that the turnover figure provided does not relate solely to the goods relied upon under the present ground. I have discussed this above but, for the sake of the present ground, I remind myself that the turnover relates to three separate categories of goods, being loose-leaf tea, tea gifting and tea tools. The latter two categories include a range of goods that are not relied upon under the present ground.

108. Taking the above into account, I am unable to determine the precise level of turnover that actually relates to the goods at issue. Without such, I cannot accurately attribute the level of turnover that relates to the goods relied upon. As a

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<sup>36</sup> *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

result, I am unable attach any particular weight to the turnover provided. Further, I remind myself of the fact that the supporting evidence (that I have discussed throughout this decision) is not particularly compelling. I do not intend to retread the issues again here save to say that Tea Lab's website visitor figures, its social media following and the press coverage are all very limited and I am not satisfied that they are capable of pointing to the existence of any protectable level of goodwill. Having taken all of the evidence into account, I conclude that Tea Lab has failed to demonstrate that its first sign and without such, Tea Lab's reliance on the 5(4)(a) ground fails.

109. Even if I were to find that Tea Lab enjoyed goodwill and that the sign relied upon was distinctive of and/or associated with that goodwill, this would not further Tea Lab's case. I say this whilst bearing in mind the comments I have made at paragraphs 104 and 105 above. While the sign relied upon, being 'TEA LAB' differs from the registrations relied upon under the 5(2)(b) ground, it remains very similar to Tea Lab's first registration, being 'THE TEA LAB'. I fail to see how the absence of the word 'THE' at the beginning of the sign would result in a different outcome from the one I have found in respect of there being no likelihood of confusion between Wissotzky's mark and Tea Lab's first registration. Consequently, I consider that this means that there would be no misrepresentation under the present ground. To reiterate, Tea Lab's reliance upon the 5(4)(a) ground fails.

## **CONCLUSION**

110. In respect of the revocation application, I note that this has been withdrawn by Wissotzky. As for Tea Lab's opposition, this has failed in its entirety and Wissotzky's mark may proceed to registration.

## **COSTS**

111. At the hearing, both parties gave submissions that costs should be awarded on the scale published in Tribunal Practice Notice 2/2016 ("the TPN"). In respect of the withdrawal of the revocation proceedings, Ms Wickenden submitted that while this was not contested at the hearing, the evidence filed was also relied upon for

the grounds of the opposition. Therefore, Ms Wickenden submitted that the costs associated with the evidence can be considered as the costs of the opposition and that no adverse costs order should be made. In the present circumstances, I agree with Ms Wickenden that the evidence filed in defence of the revocation was also used in support of the grounds of the opposition so I do not consider that the costs associated with this can be considered wasted costs. As a result, I do not intend to make an adverse costs award in respect of the withdrawal of the revocation application.

112. As Wissotzky has been successful, it is entitled to a contribution towards its costs based upon the scale published in the TPN. In the circumstances, I award Wissotzky the sum of **£1,200** as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£200
Considering Tea Lab's evidence and preparing evidence:	£500
Preparation for and attendance at the hearing:	£500
<b>Total:</b>	<b>£1,200</b>

113. I hereby order Tea Lab Company Limited to pay Wissotzky Tea (Israel) Ltd. the sum of £1,200. The above 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 31<sup>st</sup> day of March 2023**

**A COOPER**  
**For the Registrar**