



World Intellectual Property  
Organisation (WIPO)  
International Bureau  
34, Chemin des Colombettes  
1211 Geneva 20  
Switzerland

**Your Reference:**  
**International Registration No:**  
WO0000001285806  
**Examiner:** Lara Hayes  
**Direct Telephone:** +44(0)1633811033  
**Date:** 10 August 2016

**Intl Reg No:** WO0000001285806  
**Mark:** OIL-IN  
**Holder:** Henkel AG & Co. KGaA  
**Class(es):** 3

**Notification Of A Provisional Total Refusal Of Protection Based On An  
Opposition By The United Kingdom Intellectual Property Office In  
Accordance With Article 5 Of The Madrid Protocol**

I am writing to inform you that following receipt of an opposition to the above trade mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at [ipo.gov.uk/tmforms](http://ipo.gov.uk/tmforms) and **return it to this office** on or before **10 October 2016**. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 will result in the provisional refusal being upheld.

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the TM8 can be extended for a further seven months by the filing the form TM9c 'Request for a cooling off period, which is available at [ipo.gov.uk/tmforms](http://ipo.gov.uk/tmforms)

The TM8 should be received on or before the date requested above unless a cooling off period is entered into by the parties.

If one is not provided within this time the refusal will be made final.

Yours faithfully,

*Lara Hayes*  
**Trade Marks Registry**



Intellectual  
Property  
Office

M5-IP0-FAX  
04/AUG/2016

J773457/ 0001 B78821 TM07.....  
05AUG16 100-00 ECARD-0P000407107

## Form TM7

### Notice of opposition and statement of grounds

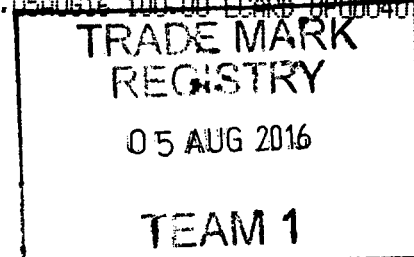
Fee ☒ £100

Opposition based on Section 5(1) and/or 5(2) ONLY

☐ £200

Opposition based on, or including, any other grounds

*Note: If you wish to oppose under Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200*



Use this form to notify of an opposition to a trade mark application or international registration and to set out the grounds on which you are basing this opposition.

Do not use this form if you wish to file a Fast Track opposition under Section 5(1) and/or 5(2): use Form TM7F.

1. Trade mark number Number of the trade mark you are opposing. If the opposition concerns an international registration, help us identify the correct trade mark by adding "IR"	IR1285806
2. Full name of applicant/holder Whose trade mark you are opposing	Henkel AG & Co. KGaA
3. Full name of opponent Person opposing the trade mark	The Sunrider Corporation
Address If the address is not within the United Kingdom, European Economic Area (EEA - which includes the European Union) or the Channel Islands you must have a representative in one of these regions and complete section 4 below	1625 Abalone Avenue Torrance United States of America Postcode 90501
Email address Complete if you have no representative and would like us to correspond with you by email	
4. Representative name If you have no representative, go to section 5.	James Love Legal
Address The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.	One Sceptre House Hornbeam Square North Harrogate Postcode HG2 8PB
NOTE: We will communicate with the representative if this section has been completed.	
Email address Complete if you would like us to correspond with you by email	lw@jllip.com

**5. Related proceedings**

If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.

IPO Registry

UK Courts

EUIPO

Number

**6. Opposition notification date**

If you have informed the applicant/holder of an intention to oppose the trade mark application, designation – enter the date you notified them.  
[\*\*See Note]

6 July 2016

**\*\*Note:** An opposition launched without giving the applicant or holder a reasonable opportunity to withdraw the application, international designation or amendment may result in the opponent being ineligible for an award of costs.

**7. Declaration**

I believe that the facts stated in this form and the attached statement of grounds are true.

**Signature**

James Love Legal

**Name**

(BLOCK CAPITALS)

JAMES LOVE LEGAL

**Date**

4 AUGUST 2016

**8. Your reference**

Complete if you would like us to quote this in communications with you, otherwise leave blank.

LJW/JLLIP/DONT-001-GB

**Contact details**

Name, daytime telephone number of the person to contact in case of query.

Ms Lindsey Wrenn  
0845 621 8000

Number of sheets attached to this form

18

**Checklist**

Please make sure you have remembered to:

- ☐ Sign and date the form
- ☐ Complete fee sheet (Form FS2)
- ☐ Enclose the fee and fee sheet. Make cheques payable to Intellectual Property Office

**Where to send**

Intellectual Property Office  
Trade Marks Registry  
Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

TM7

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)



Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark.

> **COMPLETE SECTION A**

Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark. Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION B**

Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier right. Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION C**

Opposition is based on Section 3: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

Note: Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION D**

Opposition is based on other grounds.

Note: Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION E**

TM7

**SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.**

**Please tick the relevant section(s) that apply.**

<input checked="" type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input checked="" type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

*You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.*

**ABOUT THE EARLIER TRADE MARK**

Trade mark number  
Your trade mark

156554

Type of mark  
Please tick

UK



EUTM

International

**Representation of your trade mark**

Enter your trade mark in the space provided - use a continuation sheet if necessary.

ON-LIN

TM7

**Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?**

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

**Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the application you wish to oppose?**

☒ Yes

☐ No > GO TO Q4

**Q3. Has the trade mark been used?**

☒ Yes

☐ No > GO TO Q3b

**Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?**

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

> GO TO Q4.

TM7

Q3b. Please state any proper reasons for non-use.

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?

<input checked="checked" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.

See attached Statement of Grounds.

TM7



**SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.**

**Please tick the relevant section(s) that apply.**

<input checked="" type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input checked="" type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

*You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.*

**ABOUT THE EARLIER TRADE MARK**

**Trade mark number**

2018449

Your trade mark

**Type of mark**  
Please tick

<input checked="" type="checkbox"/>	UK	<input type="checkbox"/>	EUTM	<input type="checkbox"/>	International
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**Representation of your trade mark**

Enter your trade mark in the space provided - use a continuation sheet if necessary.

OL-LIN

TM7

**Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?**

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

**Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the application you wish to oppose?**

☒ Yes

☐ No > GO TO Q4

**Q3. Has the trade mark been used?**

☒ Yes

☐ No > GO TO Q3b

**Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?**

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

> GO TO Q4.

TM7

Q3b. Please state any proper reasons for non-use.

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?

<input checked="checked" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.

See attached Statement of Grounds.

**SECTION A:** Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

<input checked="" type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input checked="" type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

#### ABOUT THE EARLIER TRADE MARK

Trade mark number

Your trade mark

2018450


Type of mark

Please tick

<input checked="" type="checkbox"/>	UK	<input type="checkbox"/>	EUTM	<input type="checkbox"/>	International
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#### Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.



TMT

**Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?**

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

**Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the application you wish to oppose?**

☒ Yes

☐ No > GO TO Q4

**Q3. Has the trade mark been used?**

☒ Yes

☐ No > GO TO Q3b

**Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?**

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

> GO TO Q4.

TM7

**Q3b. Please state any proper reasons for non-use.**

**DETAILS OF THE TRADE MARK YOU ARE OPPOSING**

**Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?**

<input checked="checked" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

**Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.**

See attached Statement of Grounds:

TM7

**TRADE MARKS ACT 1994****STATEMENT OF GROUNDS OF OPPOSITION**

**IN THE MATTER OF UK TRADE MARK APPLICATION NO. WO0000001285806  
OIL-IN IN CLASS 3 IN THE NAME OF HENKEL AG & Co. KGaA**

**AND OPPOSITION BY THE SUNRIDER CORPORATION**

1. The Opponent is The Sunrider Corporation having as its address 1625 Abalone Avenue, Torrance, United States of America, 90501. The Opponent manufactures a wide range of goods including herbal foods and beverages, nutritional supplements, fitness and weight loss products, cosmetics, skin care, body and hair care products, oral care products and household products.
2. The Opposition is directed at International Registration number 1285806, designating the UK, for OIL-IN in Class 3 ("the Application") by Henkel AG & Co. KGaA ("the Applicant").
3. The Application was published in the UK Trade Marks Journal on 6 May 2016 and a Form TM7A was filed in respect of the Application on 4 July 2016.
4. The Opponent is the owner of UK Trade Mark Registration Number UK00002018449 OI-LIN and UK00002018450 Oi-Lin (stylised) and EU Registration Number EU000156554 OI-LIN, all in Class 3. Full details of these registrations are appended to this Statement of Grounds.
5. Under the provisions of Section 6 (1) (a) of the Trade Marks Act 1994, the Opponent's UK Trade Mark Registrations and EU Trade Mark Registration (referred to in paragraph 4 above) are deemed to be "earlier trade marks" to the Application referred to in paragraph 2 above.
6. The Opponent contends that the Application should be refused under the provisions of Section 5 (1) of the Trade Marks Act 1994 on the grounds that the mark which is the subject of the Application is identical to the Opponent's earlier trade marks and is to be registered for goods identical to those covered by the Opponent's earlier trade marks. For example, the Application is for the identical five letter sequence 'O I L I N' as the Opponent's earlier trade marks and includes the identical goods 'soaps; perfumery; essential oils; cosmetics; hair lotions.'

7. In the alternative, the Opponent contends that the Application should be refused under the provisions of Section 5 (2) (a) of the Trade Marks Act 1994 on the grounds that the mark which is the subject of the Application is identical to the Opponent's earlier trade marks and is to be registered for similar goods to those covered by the Opponent's earlier trade marks and that there also exists a likelihood of confusion on the part of the public which includes a likelihood of association with the Opponent's earlier trade marks. For example, the Application is for the identical five letter sequence 'O I L I N' as the Opponent's earlier trade marks and includes 'preparations for caring, cleaning, tinting, colouring, bleaching, fixing, styling and waving of hair' which are similar to 'preparations for hair wash, hair care and hair lotions' and 'shampoos; conditioners; hair tonics; crème rinses; styling glaze, spray, mousse and gel' as included in the Opponent's earlier trade marks.
8. In the further alternative, the Opponent contends that the Application should be refused under the provisions of Section 5 (2) (b) of the Trade Marks Act 1994 on the grounds that it is similar to the Opponent's earlier trade marks; that the goods included in the Application are either identical or similar to those included in the Opponent's earlier trade marks and that there also exists a likelihood of confusion on the part of the public which includes a likelihood of association with the Opponent's earlier trade marks.
9. With regard to Section 5 (2) (b), the Application consists of the word OIL-IN which is visually highly similar as well as phonetically almost identical to the Opponent's mark OI-LIN. The only difference between the two marks is the separation of the same five letter sequence by a hyphen, being after 'OIL' in the Application and after 'OI' in the Opponent's earlier marks. However, this positioning of the hyphen has negligible impact in the overall comparison of the marks. Therefore, as the dominant element of the Application is a reproduction of the entirety and/or overall impression of the Opponent's marks, it is clear that there is a strong risk of the two being confused. Furthermore, the Application covers goods that are identical or similar to those goods covered by the Opponent's earlier marks as set out in paragraphs 6 and 7 above.
10. The Opponent asks that the Application be refused in its entirety and that an award of costs be made in its favour.

*James Love Legal*

**JAMES LOVE LEGAL**

4 August 2016.





Intellectual Property Office

**Case details for trade mark EU000156554****Trade mark****Trade mark:** OI-LIN**Status:** Registered**Relevant dates****Filing date:** 01 April 1996**Date of entry in register:** 26 January 1999**Renewal date:** 01 April 2026**Seniority details****Seniority date:** 16 February 1996**Seniority country:** United Kingdom**Seniority No:** 2018449**List of goods**

**Class 3:** Soaps; perfumery, eau de cologne, essential oils, cosmetics; preparations for hair wash, hair care and hair lotions, deodorants for personal use (perfumery), cosmetic suntan preparations; dentrifices and non-medicated preparations for dental and mouth care; all the above-mentioned goods being herbal products.

**Name and Address details****Holder's name:** The Sunrider Corporation1625 Abalone Avenue, Torrance,  
United States Of America, 90501

**Representative:**

MEISSNER BOLTE  
PATENTANWÄLTE  
RECHTSANWÄLTE  
PARTNERSCHAFT MBB

Widenmayerstraße 47, München, Germany, 80538

**Publication details**

**First advert:**

Journal : 1998/007    Date of  
publication : 02 February 1998

The information displayed is our version of the details supplied by EUIPO. For the official register of the case please refer to the EUIPO website ([Click here](#)).

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## Intellectual Property Office

## Case details for trade mark UK00002018449

## Trade mark

Trade mark: OI-LIN  
Status: Registered

## Relevant dates

Filing date: 21 April 1995  
Date of entry in register: 16 February 1996  
Renewal date: 21 April 2025

## Priority details

Priority date: 28 October 1994  
Priority country: United States Of America  
Claim: Whole

## List of goods

Class 3: Perfumes; soaps; cosmetics; non-medicated toilet preparations; bubble baths; bath and shower gels; preparations for personal and beauty care; body, face, eye, hand, moisturizing and cleansing creams, lotions, gels, scrubs, oils, powders, splashes and balms; body and face powder; rouge; eyebrow pencils, eyeliners; eyeshadow; mascara; lash enhancers; lipstick; lip liners; facial and body cleansing and moisturizing masks; preparations for hair care; shampoos; conditioners; hair tonics; creme rinses; styling glaze, spray, mousse and gel; shaving cream, foam and gel; aftershave lotion; skin

cleansing cream and foam; nail enamel and varnish; nail lacquer; sunscreens; suntanning preparations; topical skin balms, creams, lotions and moisturisers; body shampoo; dentifrices and toothpastes; mouth washes and sprays; skin-whitening gels and creams; lip balms; cellulite creams, gels and lotions; contour creams, gels and lotions; deodorants and antiperspirants; skin care creams and gels; firming and toning agents.

**Name and Address details**

**Owner(s) name:** The Sunrider Corporation d.b.a.  
Sunrider International

1625 Abalone Avenue, Torrance, California 90501, United States of America,  
United States Of America

**Country of Incorporation:** United States Of America

**Incorporation state:** Utah

**View owner's other trade marks**

**IPO representative name:** J A Kemp  
14 South Square, Gray's Inn, London,  
United Kingdom, WC1R 5JJ

**Publication details**

**First advert:** Journal : 6099 Date of publication :  
01 November 1995

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## Intellectual Property Office

## Case details for trade mark UK00002018450

## Trade mark

Status:

Registered

## Relevant dates

Filing date:

21 April 1995

Date of entry in register:

12 January 1996

Renewal date:

21 April 2025

## List of goods

Class 3:

Perfumes; soaps; cosmetics; non-medicated toilet preparations; bubble baths; bath and shower gels; preparations for personal and beauty care; body, face, eye, hand, moisturizing and cleansing creams, lotions, gels, scrubs, oils, powders, splashes and balms; body and face powder; rouge; eyebrow pencils, eyeliners; eyeshadow; mascara; lash enhancers; lipstick; lip liners; facial and body cleansing and moisturizing masks; preparations for hair care; shampoos; conditioners; hair tonics;

creme rinses; styling glaze, spray, mousse and gel; shaving cream, foam and gel; aftershave lotion; skin cleansing cream and foam; nail enamel and varnish; nail lacquer; sunscreens; suntanning preparations; topical skin balms, creams, lotions and moisturisers; body shampoo; dentifrices and toothpastes; mouth washes and sprays; skin-whitening gels and creams; lip balms; cellulite creams, gels and lotions; contour creams, gels and lotions; deodorants and antiperspirants; skin care creams and gels; firming and toning agents.

**Name and Address details**

**Owner(s) name:** The Sunrider Corporation d.b.a.  
Sunrider International

1625 Abalone Avenue, Torrance, California 90501, United States of America,  
United States Of America

**Country of Incorporation:** United States Of America

**Incorporation state:** Utah

**View owner's other trade marks**

**IPO representative name:** J A Kemp  
14 South Square, Gray's Inn, London,  
United Kingdom, WC1R 5JJ

**Publication details**

**First advert:** Journal : 6094 Date of publication :  
27 September 1995

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