

O/0881/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION
NUMBERS 4203030 AND 4220442
BY ZOHRA GACEM
TO REGISTER THE TRADE MARK:

The Scientists

IN CLASSES 3, 10 AND 44

AND

THE SCIENTISTS HAIR LAB

IN CLASSES 3, 25, 35 AND 44

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NUMBERS 600003808 AND 600003809
BY BIENCES SWISS COSMETICS SA

BACKGROUND & PLEADINGS

1. These consolidated proceedings concern two applications by Ms Zohra Gacem (“the applicant”) to register the trade marks shown on the cover page of this decision, the details of which are as follows:
 - i. The application no. 4203030 for “The Scientists” was filed on 13 May 2025 and was published on 27 June 2025. Registration is sought for various goods and services in Classes 3, 10 and 44 shown in Annex 1 at the end of this decision.¹ However, the partial opposition (no. 600003808) is directed only against the goods in Class 3, reproduced later in this decision.
 - ii. The application no. 4220442 for “THE SCIENTISTS HAIR LAB” was filed on 17 June 2025 and was published on 4 July 2025. Registration is sought for various goods and services in Classes 3, 25, 35 and 44 shown in Annex 1 at the end of this decision. However, the partial opposition (no. 600003809) is directed only against the goods in Class 3, reproduced later in this decision.
2. On 23 September 2025, Biences Swiss Cosmetics SA (“the opponent”) filed two partial oppositions (using the Fast Track provisions) against the applications on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)². For the purposes of these partial opposition proceedings, the opponent relies upon the following mark:

¹ On 16 February 2026, the applicant filed Form TM21B to amend the terms in Classes 3, 10 and 44. The Registry’s letter dated 16 March 2026 invited the opponent to confirm whether the amendment to the specification of goods would allow the opposition to be withdrawn. No response was received, and the Registry with its letter dated 16 April 2026 confirmed that the opposition would continue against the applicant’s mark in relation to the amended specification.

² The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and

Trade Mark no.	WO0000001689518
Trade Mark	
Goods for which the mark is registered	Class 3: Skin care and hygiene products for cosmetic use, such as lotions, creams, gels, oils or emulsions, except for products that directly target skin pigmentation problems such as freckles, age spots, skin lightening and topical products containing cysteamine.
Designation date	18 May 2022
Date of protection of the international registration in UK	14 April 2023
Priority details	Priority date: 02 February 2022 Priority country: Switzerland TM from which priority claimed: 781023

3. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as the protection date of the opponent's earlier mark took effect in the UK less than five years before the filing dates of the contested marks, proof of use is not relevant in these proceedings as per Section 6A of the Act.
4. In its statement of grounds, in respect of both oppositions, the opponent claims that the competing marks are visually, phonetically, and conceptually highly similar and the respective goods are identical or highly similar. On this basis, the opponent claims that there is a likelihood of confusion.
5. The applicant filed notices of defence on the same terms in each case, denying the opponent's claims in full.

Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

6. On 16 April 2026, the parties were notified that the oppositions would be consolidated in accordance with Rule 62(1) of the Trade Mark Rules 2008.
7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013/2235, disapplies paragraphs (1) to (3) of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
8. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. No leave was sought to file any evidence in respect of these proceedings.
9. Rule 62(5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
10. Neither party requested a hearing, nor was it considered necessary. Only the applicant filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. This decision has been taken following a careful consideration of the papers.
11. In these proceedings, the opponent is represented by Franks & Co Limited, and the applicant is a litigant in person.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act states:

“A trade mark shall not be registered if because-

[...]

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

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

13. Section 5A states:

“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.”

14. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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

15. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the CJEU stated that:

“23. In assessing the similarity of the goods or services concerned, [...], all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

19. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002]

ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

20. The competing goods to be compared are shown in the following table:

Earlier Goods	Contested Goods
Class 3: Skin care and hygiene products for cosmetic use, such as lotions, creams, gels, oils or emulsions, except for products that directly target skin pigmentation problems such as freckles, age spots, skin lightening and topical products containing cysteamine.	<u>Re. Opposition no. 600003808</u> Class 3: Non-medicated hair care preparations; Shampoos; Hair conditioners; Hair serums; Hair oils; Hair masks; Hair styling products; Scalp treatments and tonics; Non-medicated scalp exfoliants; Scalp scrubs; Cosmetic preparations for use on the hair and scalp; Hair treatment formulations; Aromatherapy oils for hair and scalp use; Sensory-enhancing cosmetic compositions for hair and scalp; Hair thickening preparations; Hair volumising preparations; Anti-frizz hair preparations; Leave-in hair treatments; Hair heat protection sprays; Hair gloss treatments; Hair lamination preparations; Hair smoothing preparations; Pre-wash hair treatments; Post-treatment hair care preparations; Hair strengthening preparations; Hair repair preparations; Hair detox preparations; Cosmetic preparations for improving hair texture; Scalp balancing preparations. <u>Re. Opposition no. 600003809</u> Class 3: Non-medicated hair care preparations; Shampoos; Hair conditioners; Hair care lotions; Hair masks; Hair styling preparations; Non-medicated scalp treatment preparations; Essential oils for hair and scalp use; Hair oils; Hair serums; Hair perfumes; Hair cleaning preparations; Scalp exfoliating preparations; Scalp scrubs; Cosmetic preparations for use on the hair and scalp; Hair strengthening preparations; Hair repair preparations; Hair thickening

	preparations; Hair volumising preparations; Anti-frizz hair preparations; Leave-in hair treatments; Hair heat protection sprays; Hair gloss treatments; Pre-wash hair treatments; Post-treatment hair care preparations; Cosmetic preparations for improving hair texture; Scalp balancing preparations.
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21. Ms Gacem states in both counterstatements that:

“The earlier mark is relied upon for certain Class 3 skincare and hygiene products.

The contested application, as limited, relates to goods and services primarily connected with hair and scalp care, together with associated professional services.

The Applicant denies that the respective goods and services are identical.

[...]

Skincare products directed at the skin generally are not automatically identical or highly similar to goods and services specifically directed at hair and scalp care.

The mere fact that goods fall within the broader personal care sector does not establish identity or sufficient similarity.”

22. Further, Ms Gacem submits that:

“The respective goods and services therefore differ materially in anatomical focus, intended cosmetic outcome, commercial context, mode of provision and consumer perception.

Professional hair and scalp services are encountered within a materially different commercial environment from skincare products sold as general cosmetic goods.

Consumers are accustomed to selecting professional hair and scalp-related services with reference to specialised treatment focus, technical expertise and intended cosmetic outcome.

The degree of similarity, if any, remains limited and insufficient to give rise to a likelihood of confusion.”

23. Some of the applicant’s submissions refer to professional hair and scalp services. However, the oppositions are directed only against the goods in Class 3. I note that the comparisons must be based on the ordinary and fair use of the goods covered by the respective specifications,³ and the nature and commercial environment of the unopposed services do not form part of these comparisons.
24. Further, I note that the opponent’s specification contains the limitation *“except for products that directly target skin pigmentation problems such as freckles, age spots, skin lightening and topical products containing cysteamine”*. However, the limitation itself does not preclude similarity between the competing specifications. I also note that the reference to *“lotions, creams, gels, oils or emulsions”* is illustrative rather than exhaustive.
25. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.⁴

Opposition no. 600003808

Scalp treatments and tonics; Non-medicated scalp exfoliants; Scalp scrubs; Cosmetic preparations for use on the [...] scalp; Aromatherapy oils

³ See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraph 22 and *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84.

⁴ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

for [...] scalp use; Scalp balancing preparations; Sensory-enhancing cosmetic compositions for [...] scalp

26. The contested goods are cosmetic and personal care products specifically intended for use on the scalp, including scalp treatment products and preparations. I note that the earlier term is not expressly limited to facial or body skin and is therefore capable, in its ordinary meaning, of covering products intended for the scalp (subject to its limitation). In this regard, I consider that the earlier goods could readily cover the contested goods. Therefore, I find that they will be identical as per the principle set out in *Meric*.
27. If I am wrong, I consider that the competing goods will still be highly similar. There is an overlap in nature, as the competing goods could be offered in the same physical form, such as lotions, creams, gels, oils or other topical preparations. Their intended purposes also overlap at a general level, as the competing goods will be used to improve personal appearance and maintain parts of the body. The competing goods will share the same users, namely members of the general public. The goods may be produced by the same undertakings and may reach the consumer through the same trade channels, as they are all sold through the same retail outlets, including pharmacies, supermarkets and beauty or cosmetics retailers. Although there is no degree of complementarity between the goods, I consider that there may be a degree of competition as a consumer may select one or another when, for example, seeking a cosmetic moisturising or conditioning product for the scalp. Consequently, I find that the competing goods are similar to a high degree.

Hair oils; Hair serums; Cosmetic preparations for use on the hair [...]; Aromatherapy oils for hair [...] use

28. The contested goods concern the treatment and improvement of hair. I note that such goods may be applied not only to the hair itself but also directly to the scalp. In addition, the earlier specification expressly includes

cosmetic oils, and hair serums and cosmetic preparations for use on the hair may likewise take the form of oils, creams, gels or other topical cosmetic formulations. Such formulations correspond in physical form to the lotions, creams, gels and oils expressly mentioned in the earlier specification. Consequently, there is an overlap at a general level in nature, method of use, and purpose (that of cosmetic care and improving appearance). However, I note that the specific purpose of the contested goods remains the care, treatment and appearance of hair rather than skin care and hygiene. Although the respective goods may share trade channels, they are likely to be found in distinct areas of the relevant retail outlets. That said, they may be offered by the same undertakings under a broader range of cosmetic or personal care products. The goods are neither in competition nor complementary. Taking all the relevant factors into account, I find these goods similar to a medium degree.

Non-medicated hair care preparations; Shampoos; Hair conditioners; Hair masks; Hair treatment formulations; Sensory-enhancing cosmetic compositions for hair [...]; Leave-in hair treatments; Pre-wash hair treatments; Post-treatment hair care preparations; Hair strengthening preparations; Hair repair preparations; Hair detox preparations; Cosmetic preparations for improving hair texture

29. The contested goods primarily concern cleansing, conditioning, treating or repairing hair. The competing goods may overlap in their nature, as they are all cosmetic or personal care preparations and may be of a similar consistency. They are also likely to share the same users and trade channels for the same reasons set out above. Although the competing goods overlap in the broad purpose of cosmetic care and personal grooming, their specific purposes differ materially. The contested goods are directed towards, for example, washing, conditioning, treating, maintaining or repairing the hair, whereas the earlier goods are directed to skin care and hygiene. Again, in this case, there is no degree of competition or complementarity. Consequently, I find that the competing goods are similar to between a low and medium degree.

Hair styling products; Hair thickening preparations; Hair volumising preparations; Anti-frizz hair preparations; Hair heat protection sprays; Hair gloss treatments; Hair lamination preparations; Hair smoothing preparations

30. These goods are largely concerned with improving, altering, protecting or controlling the appearance of hair. The competing goods may share the same nature to the extent that they may take the same form, such as creams, lotions, oils or sprays. There is also some overlap in broad purpose, since the goods are intended to improve or maintain personal appearance and are used topically as part of personal grooming routines. However, I note that the specific purpose of the contested goods is directed towards specific effects on the hair, such as styling, controlling frizz, increasing volume or thickness of the hair. In contrast, the earlier goods are directed to the cosmetic care and hygiene of the skin, which I do not consider should be interpreted so broadly as to encompass hair-styling products. Giving the respective specifications their ordinary and natural meanings, the competing goods are, in that respect, directed at different parts of the body and perform different functions. Nevertheless, there is an overlap in users and trade channels for the reasons set out above, and the goods may be offered by the same undertakings within a broader range of cosmetic or personal care products. They are neither in competition nor complementary. Taking all the relevant factors into account, I find these goods similar to between a low and medium degree.

Opposition no. 600003809

31. Although the contested specification at hand is slightly different from the first contested mark, I note that the comparison of goods is not materially different from the assessment I conducted previously. Therefore, I adopt the same findings in paragraphs 26-30 above for the overlapping terms and the same reasoning and findings will apply for the non-overlapping terms as set out below.

Non-medicated scalp treatment preparations; Scalp exfoliating preparations; Essential oils for [...] scalp use

32. The same reasoning applies as set out in paragraphs 26-27 above. Thus, the competing goods are *Meric* identical, or if I am wrong, similar to a high degree.

Essential oils for hair [...] use

33. The same reasoning applies as set out in paragraph 28 above. Thus, the competing goods are similar to a medium degree.

Hair perfumes; Hair care lotions; Hair cleaning preparations

34. The same reasoning applies as set out in paragraph 29 above. Thus, the competing goods are similar to between a low and medium degree.

Hair styling preparations

35. The same reasoning applies as set out in paragraph 30 above. Thus, the competing goods are similar to between a low and medium degree.

Average Consumer and the Purchasing Act

36. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.
37. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind."

38. The average consumer of the goods will be a member of the general public, although professional users, such as beauticians and hair-care professionals, may also purchase the goods. The goods can be selected from retail outlets, including pharmacies, brochures, catalogues, and their online equivalents. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers.

Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure that they select the correct type and quality, their scent and other aesthetic characteristics, and their suitability for the consumer's particular needs. In this regard, the average consumer is likely to pay a medium degree of attention when selecting the goods at issue. However, professional users are likely to pay a higher degree of attention than a member of the general public, who consequently is more likely to be confused. I shall therefore consider the position based on the average consumer who is a member of the general public.

Comparison of Trade Marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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 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.”

40. 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.

41. The marks to be compared are:

Earlier Mark	Contested Marks
	<u>Trade Mark no. 4203030</u> The Scientists <u>Trade Mark no. 4220442</u> THE SCIENTISTS HAIR LAB

Overall Impression

42. The earlier mark is a composite mark, consisting of a device and the verbal elements “THE” and “SCIENTIST” in black, arranged in a stacked format. The word “THE”, placed above the letter ‘E’, appears at the top of the mark in a thin uppercase font. Positioned at the centre of the mark, the word element “SCIENTIST” is the largest element of the mark, also in uppercase and bold font, with a slightly stylised ‘C’ letter. At the bottom, the device will be perceived as a signature, though it is not legible as a name or word. In this respect, I find, in accordance with settled case law, that the word elements will be more distinctive than the figurative elements of a mark, as the relevant public is more likely to keep verbal elements in mind to identify and refer to the mark instead of describing its figurative elements.⁵ Thus, due to its central position and prominent size, the word “SCIENTIST” will be the dominant element of the mark, having the greatest weight in the overall impression. The definite article “THE”, which is the smallest element in the mark, the stylised ‘C’ letter, and the signature device, which is smaller in size by comparison, make a lesser contribution to the overall impression.

⁵ See for instance: *Migros-Genossenschafts-Bund v EUIPO*, T-68/17; and *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

43. The contested marks are word marks. Registration of a word mark protects the words themselves.⁶ Regarding the contested mark no. 4203030, the overall impression of the mark lies solely in the words of which it consists. In terms of the contested mark no. 4220442, the applicant submits that no single element independently dominates the overall impression of the mark. However, as I will come to discuss in more detail in the conceptual comparison below, the words “HAIR LAB” in the contested mark strongly allude to the goods in the specification. In that context, the word “SCIENTISTS”, appearing near the start of the mark,⁷ will have the greatest weight in the overall impression, whilst the word “THE” and the words “HAIR LAB”, albeit non-negligible, will play a lesser role.

Opposition no. 600003808

Visual Comparison

44. The contested mark consists of 13 letters, while the verbal elements of the earlier mark consist of 12. The contested mark incorporates the entirety of the verbal elements of the earlier mark with the addition of a final ‘S’ letter. However, the presence/absence of the additional letter ‘S’, the stylised ‘C’ letter, the signature device, and the stacked format in the competing marks will be all points of visual difference. I do not consider the difference in capitalisation/title case is relevant to the visual impact, as the registration of a word mark gives protection irrespective of capitalisation.⁸ Taking into account the overall impression of the marks and their similarities and differences, I consider the marks to be visually similar to between a medium and high degree.

⁶ See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

⁷ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

⁸ See *Bentley Motors above*.

Aural Comparison

45. The verbal elements of the marks will be pronounced in the ordinary way. The competing marks share the syllables “THE-SCI-EN-TIST”, save for articulating the plural ending of “SCI-EN-TISTS”. I do not consider that the average consumer will attempt to articulate the device of the earlier mark. Therefore, I find that there is a very high degree of aural similarity.

Conceptual Comparison

46. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.
47. The contested mark consists of the definite article “THE” and the dictionary word “SCIENTISTS”, a well-known word to the UK average consumer that will be immediately understood as referring to persons engaged in science. The applicant submitted that the difference between the singular and plural form of the competing marks will be immediately perceptible. However, I note that, despite its singular form, the verbal element “SCIENTIST” in the earlier mark will convey the same concept as in the contested mark. Further, I consider that the signature device will be seen as such without evoking any further concept. Therefore, taking into account the overall impression of the competing marks, I find that they are conceptually similar to a high degree.

Opposition no. 600003809

Visual Comparison

48. The contested mark consists of 20 letters, whilst the earlier mark has 12. Again, in this case, the contested mark incorporates the entirety of the verbal elements of the earlier mark. However, the presence/absence of the additional letter ‘S’, the stylised ‘C’ letter, the words “HAIR LAB”, the

signature device, and the stacked format in the competing marks will all be points of visual difference. Similarly in this case, the difference in capitalisation/title case is irrelevant to the visual impact. Taking into account the overall impression of the marks and the similarities and differences, I consider that the marks are visually similar to a medium degree.

Aural Comparison

49. Again, in this instance, the competing marks share the verbal elements “THE-SCI-EN-TIST”, except for the plural ending. However, there is no phonetic counterpart to the additional word elements “HAIR LAB” in the earlier mark. Also, in this case, the device element in the earlier mark will not be articulated. Therefore, I find that there is between a medium and high degree of aural similarity.

Conceptual Comparison

50. The applicant submits that:

“The inclusion of the wording HAIR LAB contributes materially to the perception of a specialised professional environment focused on hair and scalp-related activities and reinforces the conceptual distance between the respective signs.”

51. Similarly, to my assessment at paragraph 47, the marks share the definite article and convey the same concept of a scientist or scientists (irrespective of whether they are in singular or plural form). The contested mark also introduces additional concepts absent from the earlier mark. Based on the words “HAIR LAB”, the “LAB” element will be seen as an abbreviation for laboratory and the “HAIR” element as a reference to the contested goods. Considering the Class 3 goods in the contested specification and the contested mark as a whole, the words “THE SCIENTISTS HAIR LAB” in combination will be perceived by the average consumer as strongly alluding to a place where hair products are

tested/developed by scientists. That said, I consider that the additional words “HAIR LAB” will reinforce the shared concept of “SCIENTISTS” by identifying the field in which those scientists are said to operate. Taking into account the marks as a whole and their respective overall impressions, I consider that they share a medium degree of conceptual similarity, based on the shared elements.

Distinctive Character of the Earlier Trade Mark

52. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraphs 22 and 23, the CJEU stated that:

“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).

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).”

53. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
54. The applicant submits that “[i]n the absence of [...] evidence, the earlier mark is entitled only to a normal degree of inherent distinctiveness.”
55. The opponent has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. As described above in this decision, the earlier mark consists of the verbal elements “THE SCIENTIST” with a stylised letter ‘C’ and a signature device. I consider that the term “SCIENTIST” may be seen as vaguely suggestive of scientific formulation or expertise in relation to the registered goods. Thus, I consider that it is inherently distinctive to a slightly less than a medium degree. However, the stylisation and signature device contribute some additional distinctive character to the mark. The applicant submitted that the earlier mark has a ‘normal’ degree of inherent distinctive character. I agree that the mark as a whole has a normal (or medium) degree of inherent distinctiveness. However, I will bear in mind that it is the distinctiveness of the common element which is key for the purposes of my assessment of likelihood of confusion.

Likelihood of Confusion

56. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree

of similarity between the marks, and vice versa.⁹ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹⁰

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
58. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), sitting 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.

⁹ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁰ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹¹

59. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*¹² with regard to composite trade marks. He stated:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the

¹¹ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

¹² Case C-120/04.

situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

The judge found that there was no likelihood of confusion because the word ‘ORIGIN’, as part of the composite ‘JURA ORIGIN’ mark, would not play an independent distinctive role in the eyes of the relevant consumers.

The expression would instead be understood as a unit, essentially because when used after the name of the Scottish island Jura, the word 'ORIGIN' would simply be taken as indicating that the product in question came from the island of Jura, rather than having any independent trade mark significance within the context of the 'JURA' mark.

60. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

61. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [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.

62. Earlier in this decision I have concluded that:

- the competing goods range from identical to similar to between a low and medium degree;
- the average consumer of the goods will be a member of the general public, without excluding professionals. The selection process is predominantly visual without discounting aural considerations. The level of attention paid for the goods during the purchasing process will be medium for the general public;
- the earlier mark and the contested mark 4203030 are visually similar to between a medium and high degree, aurally similar to a very high degree, and conceptually similar to a high degree;
- the earlier mark and the contested mark 4220442 are visually and conceptually similar to a medium degree, and aurally similar to between a medium and high degree;
- the earlier mark as a whole has a medium degree of inherent distinctive character, while the SCIENTIST element has a slightly less than a medium degree of inherent distinctive character.

63. At this point, I note that the question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public.¹³ In spite of the higher degree of attention paid by the professional users than the members of the general public during the selection process of the goods, I bear in mind that in relation to the assessment of the likelihood of confusion, it is the section of the public with the lowest level of attention which must be taken into consideration.¹⁴

Opposition no. 600003808

64. Considering all of the factors above, there is a likelihood of direct confusion for identical goods. While I appreciate that the earlier mark presents the verbal elements “THE” and “SCIENTIST” arranged in a stacked format and not side-by-side, as in the contested mark, I find that the average

¹³ See Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at paragraph 34.

¹⁴ Case T-247/12, *Argo Group International Holdings Ltd. v OHIM*.

consumer is likely to retain the nearly identical verbal elements in their imperfect recollection of the marks.¹⁵ Further, the stylisation of the earlier mark and the plural/singular form of the verbal elements in the competing marks may well be overlooked. In addition, it is my view that the average consumer will not place sufficient weight to the signature device to recall the earlier mark due to its illegibility, size and position in the mark, and, as a result, the device may well be forgotten. Therefore, taking all of the above into account and bearing in mind the principles of imperfect recollection and interdependency, I find that there exists a likelihood of direct confusion between the competing marks, where the marks will mistakenly be recalled or misremembered as each other.

65. If I am wrong about the likelihood of direct confusion, I consider the competing marks would be indirectly confused. Having identified that the marks are different, a significant proportion of consumers in the UK will assume that the respective marks originate from the same or economically linked undertakings. Despite the differences in the competing marks, including the non-coinciding signature device and the presentation of the earlier mark, the average consumer will rely on the dominant and shared SCIENTIST/SCIENTISTS element, which creates a conceptual ‘hook’ between the marks, leading a significant proportion of consumers to erroneously conclude that the goods are offered by the same or an economically linked undertaking to the earlier mark. I also consider that the plural/singular form of the shared element in the marks will be imperfectly recalled. Thus, given the visual, aural, and conceptual similarity of the competing marks, the contested mark could be perceived as a brand variation or sub-brand of the earlier mark. For example, the contested mark could be perceived as an alternative or more simplified verbal presentation of the opponent’s mark. Thus, I find a likelihood of indirect confusion.

¹⁵ See *Kurt Geiger* above.

66. The above findings extend to the remaining contested goods that I found to be similar to any degree under the interdependency principle and the factors identified above.

Opposition no. 600003809

67. Taking into account all of the above factors, I find that there is no likelihood of direct confusion for identical goods. Notwithstanding the principle of imperfect recollection and the shared word SCIENTIST/SCIENTISTS element, which has the greatest weight in the competing marks, the average consumer would not overlook the presence/absence of the divergent elements. Although I have found that the words “HAIR LAB” will be perceived as strongly allusive in relation to the contested goods, I am of the view that they would not simply be overlooked. They still contribute to the overall impression of the contested mark, albeit to a lesser extent than the word “SCIENTISTS”. Therefore, the average consumer will not mistakenly recall or misremember the competing marks as each other.
68. I turn now to consider indirect confusion. In this respect, I note the applicant’s submissions where it is stated that: “the contested mark forms a composite and unitary expression. [...] The average consumer is unlikely to assume a common commercial origin. [...] The structural and conceptual differences likewise exclude any realistic likelihood of indirect confusion or assumption of economic linkage.”
69. At this point, I remind myself of the comments of Arnold J (as he then was) at paragraph 20 in *Whyte and Mackay*, quoted above, where he set out that the *Medion* principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. Further, he set out that the principle does not apply where the composite mark is perceived as a unit. In the present case, I have found that the words “THE SCIENTISTS HAIR LAB”, despite “SCIENTISTS” being the stronger element, have a composite meaning and will be perceived as a unit. As

such, the *Medion* principle cannot apply to this mark. However, that does not preclude a finding of indirect confusion. It remains necessary to consider whether, taking account of the contested mark as a whole, the average consumer would believe that there is an economic connection between the marks, or that they are variant marks from the same undertaking, as a result of the shared SCIENTIST/SCIENTISTS element.

70. It is my view that while the differences between the marks will be noticed, the consumer would believe the marks to originate from either the same or economically linked undertakings. This is because the non-coinciding word elements “HAIR LAB” strongly allude to the contested goods, communicating a specific field of commercial specialisation, namely a laboratory-based range of hair products. Whether consciously or subconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. As a result, a significant proportion of consumers will conclude that the contested mark denotes a logical brand extension of the earlier mark or a product variation, being indicative, for example, of a specialist range of hair products offered under the earlier mark. Put simply, the inclusion of the “HAIR LAB” words would be seen as an addition of the kind that the average consumer would expect to find in a brand extension or a sub-brand, rather than as indicating that the goods come from different traders. I also consider that the singular or plural form of SCIENTIST/SCIENTISTS may be imperfectly recalled. Thus, bearing in mind that the average consumer does not conduct a side-by-side comparison of the trade marks, the shared concept, regardless of pluralisation, created by both marks will be retained. Taking all the above factors into account, and allowing for imperfect recollection, whilst keeping in mind the principle of interdependency, and the distinctiveness of the common element, I find that a significant proportion of the relevant public would be indirectly confused as to the origin of the goods, believing that the respective goods come from the same or economically linked undertakings.

71. The above finding extends to the rest of the contested goods that I have found to be similar to any degree on the basis of the interdependency principle and the factors identified above.

Outcome

72. The oppositions under section 5(2)(b) succeed in respect of all the opposed goods in Class 3. Subject to any successful appeal, both applications will be refused in respect of those goods.
73. The unopposed goods and services in Classes 10 and 44 of application no. 4203030, and Classes 25, 35 and 44 of application no. 4220442, may proceed to registration.

COSTS

74. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Official fee x2	£200
Preparing a statement and considering the counterstatement x2	£500
Total	£700

75. I, therefore, order Ms Zohra Gacem to pay to Biences Swiss Cosmetics SA the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 28th day of September 2026

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General

ANNEX 1

Specification re. application no. 4203030

Class 3: Non-medicated hair care preparations; Shampoos; Hair conditioners; Hair serums; Hair oils; Hair masks; Hair styling products; Scalp treatments and tonics; Non-medicated scalp exfoliants; Scalp scrubs; Cosmetic preparations for use on the hair and scalp; Hair treatment formulations; Aromatherapy oils for hair and scalp use; Sensory-enhancing cosmetic compositions for hair and scalp; Hair thickening preparations; Hair volumising preparations; Anti-frizz hair preparations; Leave-in hair treatments; Hair heat protection sprays; Hair gloss treatments; Hair lamination preparations; Hair smoothing preparations; Pre-wash hair treatments; Post-treatment hair care preparations; Hair strengthening preparations; Hair repair preparations; Hair detox preparations; Cosmetic preparations for improving hair texture; Scalp balancing preparations.

Class 10: Light-based devices for cosmetic hair and scalp treatment; LED devices for cosmetic hair care; Phototherapy apparatus for non-medical hair and scalp use; Infrared light therapy devices for cosmetic hair and scalp use; Cosmetic hair treatment devices for non-medical use; Scalp therapy devices; Non-medicated massage apparatus using vibration, light or heat for cosmetic hair and scalp purposes; Apparatus for aesthetic stimulation of the scalp; Devices for sensory stimulation for cosmetic hair use; Devices for stimulating hair follicles using non- medical technology; LED helmets for cosmetic hair care; Integrated cosmetic hair treatment devices combining product application with light or heat therapy; Aesthetic apparatus for cosmetic hair and scalp enhancement; Non-medical devices for enhancing cosmetic hair procedures; Personal beauty enhancement apparatus for hair and scalp use; Cosmetic hair analysis devices; Digital scalp diagnostic devices for cosmetic purposes; Non-medical laser devices for cosmetic hair stimulation; Cosmetic microcurrent devices for hair and scalp.

Class 44: Hairdressing and hair salon services; Hair cutting, colouring and styling; Scalp analysis and scalp care treatments; Head spa services; Non-medical hair rejuvenation procedures; Sensory and olfactory wellness experiences relating to hair care; Application of cosmetic products to the hair and scalp; Personalised hair and scalp consultation services; Hair wellness consultancy; Cosmetic scalp therapy services; Hair care advisory services; Personalised hair ritual services; Hair regeneration cosmetic services.

Specification re. application no. 4220442

Class 3: Non-medicated hair care preparations; Shampoos; Hair conditioners; Hair care lotions; Hair masks; Hair styling preparations; Non-medicated scalp treatment preparations; Essential oils for hair and scalp use; Hair oils; Hair serums; Hair perfumes; Hair cleaning preparations; Scalp exfoliating preparations; Scalp scrubs; Cosmetic preparations for use on the hair and scalp; Hair strengthening preparations; Hair repair preparations; Hair thickening preparations; Hair volumising preparations; Anti-frizz hair preparations; Leave-in hair treatments; Hair heat protection sprays; Hair gloss treatments; Pre-wash hair treatments; Post-treatment hair care preparations; Cosmetic preparations for improving hair texture; Scalp balancing preparations.

Class 25: Clothing; T-shirts; Sweatshirts; Hoodies; Aprons; Robes; Uniforms; Headwear; Hats; Beanies; Caps; Scarves; Jackets; Vests; Footwear; Socks.

Class 35: Retail services in relation to hair care products; Online retail services relating to hair care products; Retail services connected with the sale of hair preparations and scalp care products; Business management of hair salons.

Class 44: Hairdressing services; Hair care services; Hair styling services; Hair colouring services; Scalp treatment services; Scalp massage services; Head massage services; Hair salon services;

Personalised hair and scalp consultation services; Provision of information relating to hair styling; Hair wellness consultancy services.