

O/1190/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003703827

IN THE NAME OF ICCT PHARMA LTD

FOR THE FOLLOWING TRADE MARK:

The logo for 'MOTHER SAGE' features the word 'MOTHER' in a large, gold, serif font. Above the letter 'H' in 'MOTHER' is a stylized gold leaf icon. Below 'MOTHER' is the word 'SAGE' in a smaller, gold, serif font.

MOTHER  
SAGE

IN CLASSES 3 AND 5

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431999

BY SAGE THERAPEUTICS, INC.

## BACKGROUND AND PLEADINGS

1. On 29 September 2021, ICCT Pharma Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was made pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union (“EU”), meaning the applicant can rely upon its earlier EU filing date i.e. 27 November 2019. The trade mark was published for opposition purposes on 21 January 2022 and registration is sought for the goods shown in paragraph 15 below.

2. On 18 March 2022, the application was opposed by Sage Therapeutics, Inc. (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies upon UKTM no. 916810079 for the mark SAGE, which was filed on 6 June 2017 and registered on 19 September 2017. The opponent relies upon all goods for which the mark is registered, namely:

Class 5      Pharmaceutical preparations.

3. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made.

5. Only the opponent filed evidence. A hearing took place before me on 26 September 2023, by video conference. The applicant was represented by Maxwell Keay of Counsel, instructed by Lawrence Stephens Limited and the opponent was represented by Jonathan Moss of Counsel instructed by Haseltine Lake Kempner LLP. Both filed skeleton arguments in advance of the hearing.

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<sup>1</sup> The opponent also originally relied upon sections 5(3) and 5(4)(a) of the Act, but these grounds were subsequently withdrawn.

## **EVIDENCE AND SUBMISSIONS**

6. The opponent filed evidence in the form of the witness statement of Rachel Hearson dated 28 December 2022, which is accompanied by 4 exhibits. Ms Hearson is the opponent's representative in these proceedings.

7. The opponent's evidence was accompanied by written submissions dated 28 December 2022.

8. The applicant filed undated submissions during the evidence rounds on 28 February 2023.

9. I have taken the parties evidence and submissions into account in reaching this decision and will refer to them below where necessary.

## **RELEVANCE OF EU LAW**

10. 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 upon 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.

## **PRELIMINARY ISSUE**

11. In its written submissions, the applicant has identified three other trade marks which are registered in class 5 and which include the word SAGE (UKTM nos. 908506305, 3358468 and 915035819). For the avoidance of doubt, I do not consider that this assists the applicant. Plainly, there may be any number of reasons why the opponent is not in dispute with the owners of these marks; it may be that they are not actually being used in the marketplace or perhaps they have entered into co-existence agreements. I do not consider that this line of argument assists the applicant.

## DECISION

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

“5(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 of association with the earlier trade mark.”

13. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods for which its mark is registered.

14. 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.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

### Comparison of goods

15. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 5</u> Pharmaceutical preparations.	<u>Class 3</u> Cosmetics; toiletries; skin care preparations (non-medicated); facial makeup; concealers; blushers; facial powders; foundation makeup; eye makeup; eye pencils; eyebrow pencils; mascara; false eyelashes; face and body glitter; cosmetic compacts; cosmetic pencils; lipstick; lipstick cases; lipstick holders; lip gloss; lip pomades; lip pencils; makeup removers; makeup applicators in the nature of cotton swabs for cosmetic purposes; eye creams; facial cleansers; toners; facial exfoliants and scrubs; facial creams; facial moisturizers; facial lotions and non-medicated facial treatments; wrinkle removing skin care preparations; nail polishes; nail polish base coat; nail polish top coat; nail strengtheners; nail hardeners; nail polish removers; nail

	creams; cuticle removing preparations; nail tips and nail buffing preparations; beauty milks; skin moisturizers and skin moisturizer masks; skin conditioners; hand creams; massage oils; essential oils for personal use; talcum powder; perfumed powders; bath beads; bath crystals; bath foam; bath gels; bath oils; bath powders; bath salts; face wash; skin cleansers; skin highlighter; body scrubs; body fragrances; fragrances for personal use; body and hand lotions; body gels; shower gels; body oils; body powders; body exfoliants; body masks; body mask creams and lotions; shaving preparations; after shave lotions; shaving balm; shaving cream; shaving gel; skin abrasive preparations; non-medicated skin creams and skin lotions for relieving razor burns; non-medicated lip care preparations; lip cream; sunscreen preparations; suntanning preparations and after-sun lotions; cosmetic sun-protecting preparations; sun tan oils; self-tanning preparations, namely, self tanning milk and cream, accelerated tanning cream, self-tanning lotions, gels and sprays; perfume; perfume oils; cologne; eau de toilette; eau de perfume; eau de cologne and toilette water; toothpaste; deodorant and antiperspirant; cosmetic pads; pre-moistened cosmetic wipes; pre-
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	<p>moistened cosmetic tissues and towelettes; cotton sticks for cosmetic purposes; all purpose cotton swabs for personal use and cosmetic purposes; non-medicated topical skin creams; ointments; gels; toners; lotions; aromatherapy creams; lotions and oils; hair care products; shampoos; conditioners; mousse, namely, styling mousse, shaving mousse, hair mousse, cleansing mousse and skin care mousse; gels; hair frosts; creams; hair rinses; hair color; hair waving lotion; permanent wave preparations; hair lighteners; hair dyes; hair emollients; hair mascara; hair pomades; hair color removers; hair relaxing preparations; hair styling preparations; hair removing cream and hair care preparations; astringents for cosmetic purposes; baby wipes; disposable wipes impregnated with chemicals or compounds for personal hygiene and household use; incense; room fragrances; fragrance emitting wicks for room fragrances; scented ceramic stones; scented linen sprays and scented room sprays; scented oils used to produce aromas when heated; scented pine cones; potpourri.</p> <p><u>Class 5</u></p>
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	Food supplements; dietary food supplements; mineral food supplements; nutritional supplements; vitamins and vitamin preparations; dietetic foods adapted for medical purposes; dietetic substances adapted for medical use; medicinal oils; pharmaceuticals, medical and veterinary preparations; medicinal ointments; medicated creams.
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16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

17. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

20. In its written submissions, the applicant focuses upon the differing markets and activities of the respective parties. This line of argument was not expanded upon at the hearing by Mr Keay. For the avoidance of doubt, it is the parties’ respective

specifications that I must consider for the purposes of my assessment, on a notional basis, and not the actual activities of the parties.

### Class 3

*Facial makeup; concealers; blushers; facial powders; foundation makeup; eye makeup; eye pencils; eyebrow pencils; mascara; false eyelashes; face and body glitter; cosmetic compacts; cosmetic pencils; lipstick; lipstick cases; lipstick holders; lip gloss; lip pomades; lip pencils; makeup removers; makeup applicators in the nature of cotton swabs for cosmetic purposes; facial cleansers; toners; facial exfoliants and scrubs; nail polishes; nail polish base coat; nail polish top coat; nail strengtheners; nail hardeners; nail polish removers; cuticle removing preparations; nail tips and nail buffing preparations; beauty milks; massage oils; essential oils for personal use; talcum powder; perfumed powders; bath beads; bath crystals; bath foam; bath gels; bath oils; bath powders; bath salts; face wash; skin cleansers; skin highlighter; body scrubs; body fragrances; fragrances for personal use; body gels; shower gels; body oils; body powders; body exfoliants; shaving preparations; after shave lotions; shaving balm; shaving gel; skin abrasive preparations; perfume; perfume oils; cologne; eau de toilette; eau de perfume; eau de cologne and toilette water; toothpaste; deodorant and antiperspirant; cosmetic pads; pre-moistened cosmetic wipes; pre-moistened cosmetic tissues and towelettes; cotton sticks for cosmetic purposes; all purpose cotton swabs for personal use and cosmetic purposes; gels; toners; hair care products; shampoos; conditioners; mousse, namely, styling mousse, shaving mousse, hair mousse, cleansing mousse and skin care mousse; gels; hair frosts; hair rinses; hair color; hair waving lotion; permanent wave preparations; hair lighteners; hair dyes; hair emollients; hair mascara; hair pomades; hair color removers; hair relaxing preparations; hair styling preparations; astringents for cosmetic purposes; baby wipes; disposable wipes impregnated with chemicals or compounds for personal hygiene and household use.*

21. The opponent has filed evidence regarding the rise of ‘cosmeceuticals’, being cosmetic products with pharmaceutical properties.<sup>2</sup> Some of this evidence appears to

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<sup>2</sup> Exhibit RH1

be aimed at the US market and is not, therefore, relevant. However, I do note that it includes reference to, for example, an article in *The Independent* which would have been visible to UK consumers. This article explains that cosmeceuticals are goods that contain non-prescription formulas which have an increased ability to, for example, increase collagen metabolism or reduce wrinkles. However, they still differ in nature and purpose from the opponent's goods, with one being to treat an illness/medical condition and the other to improve the appearance of the user. In terms of trade channels, the opponent has filed evidence to demonstrate that retailers such as Boots and Superdrug sell cosmetics, pharmaceuticals and offer botox and other cosmetic procedures.<sup>3</sup> I accept that there will be an overlap in that the goods can be sold through the same retailers, such as large pharmacies. However, in my view, they would not be sold in the same section of the shop. In my view, that is where the overlap in trade channels ends; I do not have any convincing evidence before me to suggest a meaningful overlap in producers of cosmetics and pharmaceuticals. The fact that a business might sell a cosmetic product with enhanced abilities (such as those goods termed 'cosmeceuticals') does not of itself demonstrate to me that it is typical in the market for cosmetics and pharmaceuticals to be produced by the same businesses. There may be some overlap in method of use at a very general level for some of these goods to the extent that they could be applied to the body. There is no competition given the differing purposes. I do not consider the goods to be complementary because one is not important or indispensable for the other. The goods are similar to a low degree.

*Cosmetics; toiletries; skin care preparations (non-medicated); eye creams; facial creams; facial moisturizers; facial lotions and non-medicated facial treatments; wrinkle removing skin care preparations; nail creams; skin moisturizers and skin moisturizer masks; skin conditioners; hand creams; body and hand lotions; body masks; body mask creams and lotions; shaving cream; non-medicated skin creams and skin lotions for relieving razor burns; non-medicated lip care preparations; lip cream; sunscreen preparations; suntanning preparations and after-sun lotions; cosmetic sun-protecting preparations; sun tan oils; self-tanning preparations, namely, self tanning milk and cream, accelerated tanning cream, self-tanning lotions, gels and sprays; non-*

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<sup>3</sup> Exhibit RH1

*medicated topical skin creams; ointments; lotions; aromatherapy creams; lotions and oils; creams; hair removing cream and hair care preparations.*

22. The same factors apply to these goods, with the additional point of similarity arising from the fact that the nature of the goods could overlap in that they could all take the form of creams. However, the specific nature (being medicated vs non-medicated would differ). I consider it unlikely that the goods would be in competition, and I have no evidence before me to suggest that they would. There is no complementarity. The goods are similar to between a low and medium degree.

*Incense; room fragrances; fragrance emitting wicks for room fragrances; scented ceramic stones; scented linen sprays and scented room sprays; scented oils used to produce aromas when heated; scented pine cones; potpourri.*

23. Mr Moss (rightly) accepted that these goods are dissimilar to those in the opponent's specification.

#### Class 5

*Food supplements; dietary food supplements; mineral food supplements; nutritional supplements; vitamins and vitamin preparations;*

24. In my view, these goods are all identical to the opponent's goods on the principle outlined in *Meric*. If I am wrong in this finding, then they will overlap in purpose, nature, method of use, trade channels and user. There may also be some competition (where a user chooses a dietary supplement to treat a medical issue rather than an alternative type of pharmaceutical, for example). They are highly similar.

*Dietetic foods adapted for medical purposes; dietetic substances adapted for medical use; medicinal oils; pharmaceuticals, medical and veterinary preparations; medicinal ointments; medicated creams.*

25. The applicant accepts that these goods are identical or similar to a high degree to the goods of the opponent. Plainly, that is correct.

26. As some degree of similarity between the goods is essential for a likelihood of confusion, the opposition must fail in respect of those goods that are dissimilar.<sup>4</sup>

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

27. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

28. The average consumer for the goods will be members of the general public and medical professionals (for the pharmaceutical and medical goods). For the non-medicated goods, the goods are likely to be relatively low cost and frequent purchases, but factors such as scent, aesthetics and ingredients are likely to be taken into account. I consider a medium degree of attention will be paid during the purchasing process. For the medicated goods, the average consumer will be considering the suitability for the particular health condition in question. For members of the general public, they are likely to be concerned with their own personal wellbeing and medical professionals will be concerned with the wellbeing of the patient. Consequently, I consider that both will be paying a high degree of attention.

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<sup>4</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

29. The goods are likely to be selected following the perusal of packaging and websites. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants/medical professionals and orders may be placed by telephone (in the case of medical professionals).


### **Comparison of trade marks**

30. It is clear from *Sabel* 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. 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.”

31. 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.

32. The respective trade marks are set out below:

Opponent's trade mark	Applicant's trade mark
SAGE	

33. The opponent's mark consists of the word SAGE, in which the overall impression resides. The applicant's mark consists of the words MOTHER SAGE, presented one on top of the other, in a gold capitalised font. Above the letters E and R in MOTHER is a leaf device. As the eye is naturally drawn to the element of the mark that can be read, the text element plays the greater role in the overall impression, with the device playing a lesser role. I accept that at least some of the goods in the applicant's specification could be targeted at mothers specifically. For those goods, I consider the word MOTHER to be non-distinctive.

34. Visually, the opponent's mark is replicated in its entirety in the applicant's mark. However, the word MOTHER and the leaf device act as points of visual difference. The opponent's mark is a word only mark, so could be presented in any colour/font. Mr Key noted that, as a general rule, consumers tend to pay more attention to the beginning of marks than the ends.<sup>5</sup> I accept that general rule of thumb, although I do not think that rule applies where the first word is of no (or low) distinctiveness for the goods in issue. In my view, the marks are visually similar to a medium degree.

35. Aurally, the word SAGE will be pronounced identically in both marks. The word MOTHER in the applicant's mark will act as a point of aural difference. The marks are aurally similar to a slightly higher than medium degree.

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<sup>5</sup> See, for example, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

36. Conceptually, the parties are in agreement that the opponent's mark will be understood as referring to a type of herb or a wise person. In the applicant's mark, for those goods that are not aimed at the antenatal/postnatal markets, the word MOTHER may be perceived as a title i.e. referring to someone called Mother Sage, with Sage being a name. In those circumstances, the marks are conceptually dissimilar. However, for those goods that are aimed at the antenatal/postnatal markets, the word MOTHER will be non-distinctive and will be seen as referring to the target market. Consequently, the word SAGE will be attributed its own independent meaning which will be identical to the opponent's mark. Whilst the word MOTHER will still act as a point of conceptual difference, it will be a non-distinctive one. I do not consider that the leaf device will convey any particular message to the average consumer.

### **Distinctive character of the earlier mark**

37. 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-2779, 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).”

38. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are descriptive or highly allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

39. Whilst the opponent filed evidence, it did not file evidence of use. Consequently, I have only the inherent position to consider. The opponent’s mark consists of the word SAGE, which is a type of herb or a wise person. I have been provided with no evidence to suggest that the herb sage might be used as an ingredient in any of the goods in issue. Consequently, I can see no reason for it to have any connection with the relevant goods. In my view, the opponent’s mark is inherently distinctive to a medium (or average) degree.

### **Likelihood of confusion**

40. 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 undertaking 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 goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has an 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.

41. I have found as follows:

- a) The goods vary from identical to similar to a low degree.
- b) The average consumer for the goods is a member of the general public or a medical professional who will pay a medium or high degree of attention during the purchasing process, depending on the goods.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.
- d) The marks are visually similar to a medium degree and aurally similar to a slightly higher than medium degree. For those goods that cannot be aimed at the antenatal/postnatal market, the marks will be conceptually dissimilar. For those goods that are aimed at the antenatal/postnatal market, the word SAGE will be attributed identical meanings, and the word MOTHER will act as a point of conceptual difference (but not a distinctive one).
- e) The opponent's mark is inherently distinctive to a medium (or average) degree.

42. Given that the purchasing process is predominantly visual and the marks are only visually similar to a medium degree, I consider it unlikely that they will be mistakenly recalled or misremembered as each other. In my view, there is no likelihood of direct confusion, even when used on identical goods.

43. In relation to indirect confusion, 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)".

44. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. 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.

45. For those goods that are often aimed at the antenatal/postnatal market, where the word MOTHER is non-distinctive, the addition of this word is entirely consistent with a sub-brand i.e. being a range of goods directed at mothers, where the goods are similar to a high degree or identical. For those goods, there will be a likelihood of indirect confusion. Where the goods are similar to only a low or between low and medium degree, the distance between the goods is sufficient to offset the similarity of the marks, even where the word MOTHER is non-distinctive for the goods, taking into account the interdependency principle. For those goods, there will be no likelihood of indirect confusion.

## **CONCLUSION**

46. The opposition is successful in relation to the following goods, for which the application is refused:

Class 5      Food supplements; dietary food supplements; mineral food supplements; nutritional supplements; vitamins and vitamin preparations; dietetic foods adapted for medical purposes; dietetic substances adapted for medical use; medicinal oils; pharmaceuticals, medical and veterinary preparations; medicinal ointments; medicated creams.

47. The opposition is unsuccessful in relation to the following goods, for which the application may proceed to registration:

Class 3      Cosmetics; toiletries; skin care preparations (non-medicated); facial makeup; concealers; blushers; facial powders; foundation makeup; eye makeup; eye pencils; eyebrow pencils; mascara; false eyelashes; face and body glitter; cosmetic compacts; cosmetic pencils; lipstick; lipstick cases; lipstick holders; lip gloss; lip pomades; lip pencils; makeup removers; makeup applicators in the nature of cotton swabs for cosmetic purposes; eye creams; facial cleansers; toners; facial exfoliants and scrubs; facial creams; facial moisturizers; facial lotions and non-

medicated facial treatments; wrinkle removing skin care preparations; nail polishes; nail polish base coat; nail polish top coat; nail strengtheners; nail hardeners; nail polish removers; nail creams; cuticle removing preparations; nail tips and nail buffing preparations; beauty milks; skin moisturizers and skin moisturizer masks; skin conditioners; hand creams; massage oils; essential oils for personal use; talcum powder; perfumed powders; bath beads; bath crystals; bath foam; bath gels; bath oils; bath powders; bath salts; face wash; skin cleansers; skin highlighter; body scrubs; body fragrances; fragrances for personal use; body and hand lotions; body gels; shower gels; body oils; body powders; body exfoliants; body masks; body mask creams and lotions; shaving preparations; after shave lotions; shaving balm; shaving cream; shaving gel; skin abrasive preparations; non-medicated skin creams and skin lotions for relieving razor burns; non-medicated lip care preparations; lip cream; sunscreen preparations; suntanning preparations and after-sun lotions; cosmetic sun-protecting preparations; sun tan oils; self-tanning preparations, namely, self tanning milk and cream, accelerated tanning cream, self-tanning lotions, gels and sprays; perfume; perfume oils; cologne; eau de toilette; eau de perfume; eau de cologne and toilette water; toothpaste; deodorant and antiperspirant; cosmetic pads; pre-moistened cosmetic wipes; pre-moistened cosmetic tissues and towelettes; cotton sticks for cosmetic purposes; all purpose cotton swabs for personal use and cosmetic purposes; non-medicated topical skin creams; ointments; gels; toners; lotions; aromatherapy creams; lotions and oils; hair care products; shampoos; conditioners; mousse, namely, styling mousse, shaving mousse, hair mousse, cleansing mousse and skin care mousse; gels; hair frosts; creams; hair rinses; hair color; hair waving lotion; permanent wave preparations; hair lighteners; hair dyes; hair emollients; hair mascara; hair pomades; hair color removers; hair relaxing preparations; hair styling preparations; hair removing cream and hair care preparations; astringents for cosmetic purposes; baby wipes; disposable wipes impregnated with chemicals or compounds for personal hygiene and household use; incense; room fragrances; fragrance emitting wicks for room fragrances; scented ceramic stones;

scented linen sprays and scented room sprays; scented oils used to produce aromas when heated; scented pine cones; potpourri.

## **COSTS**

48. The applicant has enjoyed the greater degree of success and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I have applied an appropriate reduction for the only partial success. In the circumstances, I award the applicant the sum of **£1,300**, calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£350
Written submissions	£250
Preparing for and attending the hearing	£700
<b>Total</b>	<b>£1,300</b>

49. I therefore order Sage Therapeutics, Inc. to pay ICCT Pharma Ltd the sum of **£1,300**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 18<sup>th</sup> day of December 2023**

**S WILSON**

**For the Registrar**