

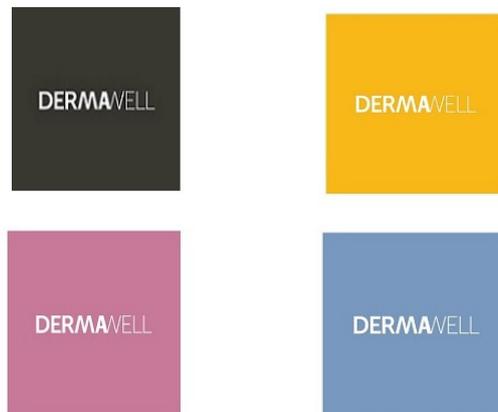
O-753-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATIONS 3229058 AND 3229070
BY BESTWAY PANACEA HOLDINGS LIMITED
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 3 AND 5**

DERMAWELL

DERMAWELL



AND

OPPOSITION THERETO (NO. 410306 and 410307)

BY BIOLOGISCHE HEILMITTEL HEEL GMBH

Background and pleadings

1. Bestway Panacea Holdings Limited (“the applicant”) filed UK trade mark application 3229058 on 5 May 2017 to register the word mark DERMAWELL. On the same day they also filed UK trade mark application 3229070 to register a series of 5 stylised marks set out above. The applications were published in the Trade Marks Journal on 23 June 2017. Registration of the marks is opposed by Biologische Heilmittel Heel GmbH (“the opponent”). The opponent relies on EU trade mark 1104365, a word mark, DERMAVEEL, which was filed on 6 December 2012 and registered on 1 April 2013. The opponent relies on section 5(2)(b) of the Trades Mark Act 1994 (“the Act”) to oppose the application for registration.
2. The opponent’s trade mark is registered for a detailed specification of goods in classes 3, 5 and 16. However, for the purpose of this opposition, they rely only upon their goods in classes 3 and 5. As a result the respective specifications in play are:

Applied for marks	Earlier mark
Class 3: Cleaning preparations; cosmetic preparations; make up preparations; skin care treatments; moisturisers and moisturising creams; anti-ageing products, preparations and treatments; skin cleansers; skin conditioners; skin creams; body and beauty care preparations; dentifrices; hand and foot care preparations; hair, body and skin care preparations; soaps, perfumery; aftershave; essential oils; dental preparations; toiletry preparations; aromatherapy	Class 3: Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.

lotions and creams; aromatherapy preparations; aromatherapy pillows comprising potpourri in fabric containers; aftershave; cosmetics; nail and nail care preparations; hair lotions; non-medicated toilet preparations; non-medicated bath preparations; preparations for the teeth; facial wipes; hand care lotions; cleansing lotions; non-medicated moisturising lotions; skin tonic; hand care preparations; non-medicated lotions for the hands and for the body; night creams; skin care preparations for protection from the effects of the sun; lotions and creams, all for use after exposure to the sun; sun tanning preparations for the skin in the form of creams, lotions and ointments; cotton sticks for cosmetic purposes, cotton wool for cosmetic purposes; non-medicated lotions and creams, all for the care of the skin; non-medicated preparations for toning the skin; shampoos; hair conditioners; shaving preparations; post shave creams and balms; make-up removing preparations; toiletries; cleansing wipes; impregnated wipes; antiperspirants; deodorants; facial cleansing wipes; skin care preparations; cleansing balm; lip balm; balms; bubble bath; hand and body butter; colourants for toilet purposes;

whitening gel; eye gel; Buffing compounds; face mask; hydrating mask; moisturiser; cleansing mousse; hand and body oil; facial oil; cleansing oil; eye make-up remover; microdermabrasion polish; body polish; face scrub; exfoliating body scrub; body scrub; gel scrub; purifying face scrub; hair care serum; anti-ageing serum; face wash; hair and body wash; foam wash; make-up pads of cotton wool; self tanning preparations; self tanning creams, lotions, sprays, mists and wipes; glue for strengthening nails; lotions for strengthening nails; adhesive for fixing false nails; nail enamels, polish, varnish and gel; nail tips; nail strengtheners and hardeners; nail glitter; nail cream, nail decolorants; artificial nails; nail art stickers; nail buffing preparations; nail enamel remover; nail polish remover; nail paint (cosmetics); nail polish top and base coats; room perfumes; scented oils; refresher oils for perfumes and scents; scented sachets; fragrance oils; fragrance oils for scenting candles; cosmetic glitter; perfumed room mist; perfumed room spray; room fragrances and scenters; room scenters in the form of waxed figures; pot pourri; incense; incense cones;

<p>incense sachets; incense spray; incense sticks; essential oils; refresher oils; bath oils; preparations, products and substances emitting a perfume or aroma for masking odours and smells.</p>	
<p>Class 5: Pharmaceutical preparations; pharmacy products; pharmaceutical creams, lotions, preparations, treatments and substances all for use on the skin or scalp; medicinal healthcare products; ophthalmic preparations and substances; impregnated pads and tissues containing medicated preparations; dermatological products, preparations and treatments; hygienic products, preparations and treatments; homeopathic supplements, pharmaceuticals and anti-inflammatory ointments; chemico-pharmaceutical, sanitary and medical preparations, substances and treatments; hyaluronic acid preparations, substances and treatments; medicated skincare preparations, treatments, substances, creams and lotions; chemical preparations for medical, pharmaceutical, skincare and skin treatment purposes; medicines; sanitary preparations for medical purposes; dietetic substances for medical use; dietary food</p>	<p>Class 5: Pharmaceutical and veterinary preparations; Sanitary preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals; Plasters, material for dressings; Material for stopping teeth, dental wax; Disinfectants; Preparations for destroying vermin; Fungicides; Herbicides.</p>

supplements; medicated food supplements; mineral food supplements; food supplements for dietetic use; food supplements for medical purposes; health food supplements made principally of vitamins and/or minerals; vitamin preparations in the nature of food supplements; food for babies, infants and invalids; plasters, materials for dressings; disinfectants; first aid boxes; vitamins; pregnancy testing kits; medicated tissues; medicated preparations for slimming; contraceptives; sanitary towels, sanitary tampons; bunion protection; toe supports; nappies.	
---	--

3. The opponent filed two notices of opposition and statements of grounds on 22 September 2017. The applicant filed two notices of defence and counterstatements on 27 November 2017. On 15 December 2017 the tribunal consolidated the proceedings. Both are therefore dealt with within this one decision.

4. On 15 February 2018 the opponent filed written submissions and a witness statement from Anne Wong with accompanying exhibits. On 16 May 2018 the applicant filed written submissions and a witness statement from Emma Christina Anne Hodson with accompanying exhibits. On 18 July 2018 the opponent filed further written submissions and a further witness statement from Anne Wong with exhibits. The evidential stage then closed. On 20 August 2018 the opponent filed final written submissions. The applicant did not file any further submissions. Neither party requested an oral hearing. This decision is therefore taken following careful consideration of all the papers.

5. The applicant is represented by Murgitroyd & Company. The opponent is represented by MW Trade Marks.

The Evidence

The opponent's initial evidence

6. The opponent's initial evidence is from Anne Wong, a Chartered Trade Mark Attorney with MW Trade Marks. Her first statement dated 15 February 2018 produces two exhibits. Exhibit 1 is a House of Commons Library Briefing Paper dated 11 January 2018 detailing migration statistics. Page 24 of the Briefing Paper shows EU nationals living in the UK by nationality in 2016. Exhibit 2 is a response to a Freedom of Information Act request provided by the Office for National Statistics dated 30 June 2016. This states that in 2014 (the most up to date statistic available at that time) the estimated number of Indian nationals living in the UK was 365,000.

The applicant's evidence

7. The applicant's evidence is from Emma Christina Anne Hodson, a Chartered Trade Mark Attorney with Murgitroyd & Company. The statement is dated 23 April 2018 and produces various exhibits. Exhibit "ECAH 1" contains what I am told is the result of a search of the UK Trade Marks Register, the EU Trade Marks Register and the International Register so far as it covers UK and EU designations. The search result appears to show 309 trade marks beginning with "DERMA" in classes 3 and 5. I am told the second part of Exhibit "ECAH 1" is a schedule setting out those search results. It is a 9 page schedule headed "Selected TM Records". It does not in fact appear to detail 309 trade marks but a selection of approximately 80 trade marks, both registered and unregistered, which contain "DERMA". This schedule includes the applied for marks. I do not know on what basis the results scheduled were chosen.
8. Ms Hodson's statement says that, because of the large number of marks located, a further search was conducted looking solely at the UK National

register for live marks with the prefix “DERMA” in classes 3 and 5. I am told that the most “pertinent” marks containing “DERMA” and another suffix are set out at Exhibit “ECAH 2”. This is a schedule of approximately 23 marks which I am told are registered UK trade marks.

9. Ms Hodson states that internet searches were carried out to locate use on the internet of the marks exhibited at “ECAH 2” and that full details of those registrations found to be in use are exhibited at “ECAH 3” together with examples of the internet usage found.
10. Exhibit “ECAH 3” includes details of the registration of the trade mark “Dermanoir – Ethnic Skin Specialists” which was registered on 29 January 2016. Pages 19 to 23 of the exhibit appear to be printed out from the website of Dermanoir.co.uk on 23 April 2018 and seemingly provide links to skin treatments that can be bought online and a link to an online shop for skincare products. There are no details of any products that can actually be bought and the image of products on page 21 appears to be under a mark of Neostrata with no obvious reference to Dermanoir – Ethnic Skin Specialists.
11. Exhibit “ECAH 3” next includes details of the registration of trade marks “MEDI DERMAPRO” and “MEDI DERMA-PRO”; registered on 29 January 2016. Pages 25 to 34 of the exhibit are apparently printed from the website of medicareplus.co.uk on 23 April 2018. These show some goods, such as skin protection ointment, showing “Medi” in a circle at the top and underneath the words “Derma Pro” which it would appear can be bought online. There are also some pages with products showing a label of “Medi Derma-S” (which is different to the trade mark search relied upon.)
12. The next trade mark put in evidence is “Dermaspray” which was registered on 27 July 2012. I am given a print out from the website of Salcuraskincare.co.uk dated 23 April 2018 which is intended to demonstrate that the product can be bought online. The online product uses both “Bioskin” and “Dermaspray” in its labelling and product referencing.

13. The exhibit then provides details of the trade marks “Dermapaedic” and “Dermapedics”, which were registered on 21 October 2005 and owned by Halo GB Limited. I am then given pages 39-40, printed out from ebay on 23 April 2018, for a product called “Halos n Horns Baby” Moisturising Lotion. The picture of the product for purchase contains on the packaging the word “Dermapaedic.” It is sold by a third party seller, Discounted Products Ltd.
14. Finally, I am given the registration details of the trade marks “Dermacia” and “DERMACIA”, both registered on 19 December 2003. At pages 42 to 45 I am given a printout from the website dermaciapharmacy.co.uk which again lists various products apparently for sale. The quality of the printing is poor, but none of the products shown appear to display either of the marks. “Dermacia” only appears to feature as a weblink to the products on the dermaciapharmacy.co.uk website.

The opponent’s reply evidence

15. The second statement of Anne Wong is dated 18 July 2018. Exhibit “AW1” is a printout from sloanmagazine.com which is undated. It offers the opportunity of winning a hamper from Well Pharmacy containing 8 Dermawell branded products priced from £5.49 to £10.99. Exhibit “AW2” is a printout from beauty-magazine.co.uk dated 3 November 2017 which purports to quote the CEO of Well Pharmacy speaking about the launch of a Dermawell skincare range saying “here was a gap in the market for a luxury skincare brand addressing dermatological needs that is more affordable than its direct competitors.” The evidence is filed in response to the applicant’s statement that their primary goods of interest by reference to the applied for marks are skincare products. It is exhibited to show that the applicant’s goods are everyday low cost items.
16. Exhibit “AW3” is a publication by the Office for National Statistics dated 23 May 2018 giving the population of the UK by country of birth and nationality in 2017. I am told the relevant part is that there are 1 million Polish nationals resident in the UK. Exhibit “AW4” is a print out from Companies House, undated, stating that Dermanoir Ltd was dissolved on 19 December 2017. Exhibit “AW5” is a

printout from Companies House, undated, stating that Halo GB Ltd is a dormant company.

17. This is an opportune moment to summarise the opponent's comments on the use of DERMA in the market place. These, in summary form, are:
 - That the owners of the mark "Dermanoir" are dissolved and there is no evidence of use of the mark on any goods or products for sale on the website printouts provided;
 - The owner of the "Dermapaedic" and "Dermapaedics" marks is a dormant company. The website extract provided is from ebay, a reseller website. There is no confirmation that the product is genuine and in any event the suffix is further away visually, conceptually and aurally from the marks in question here;
 - "MEDI DERMAPRO" and "MEDI DERMA-PRO" do not have DERMA as their prefix as the prefix is "medi";
 - The suffix in "Dermaspray" is much further away visually and aurally from the marks in question and the evidence shows use of a different mark "Bioskin Dermaspray";
 - "Dermacia" is different to the marks in question on an oral, conceptual and visual basis and it is not a mark that breaks down naturally into two parts "Derma" and "cia". It is more likely to be seen as one whole mark. There is no evidence that it is in use on any goods.
18. I will return to the relevant parts of the evidence and the parties wider submissions as to its relevance at the most pertinent places within my decision below.

Section 5(2)(b)

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

“5. - (2) 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.”

20. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the

marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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;
- (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

Comparison of goods – the legal principles

21. 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*, the CJEU stated at paragraph 23 of its judgment:

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

22. Guidance on this issue has also come from Jacob J. (as he then was) in the *British Sugar Plc v James Robertson & Sons Limited* [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.”

23. I also remind myself of the guidance given by the courts on the correct interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

“... 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”.

24. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”...anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

25. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II- 4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 Vedral V OHIM France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

26. 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 General Court 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”.

27. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“...it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

Comparison of goods – the parties' submissions

28. The applicant has not commented on the similarity of the goods other than to say that their primary focus is skincare products. The applied for specification is, however, much wider than skincare products and the applicant has not limited their application. I must therefore compare the notional use of the marks across the full width of the competing specifications¹.
29. The opponent argues the respective goods are identical or similar. They argue that the competing goods serve a similar purpose, have the same users, are sold via the same channels of trade and are likely to be sold in close proximity to each other and are complementary. In their written submissions of 20 August 2018, the opponent sets out a table with their view on the comparison of all the goods. I have taken this into account, albeit I must make my own comparison of the similarity of the goods term by term, grouping them when it is reasonable to do so, and applying the legal principles set out above.

Class 3

30. The following goods in the applied for class 3 specification are clearly identical to the opponent's as the terms are identically worded: **cleaning preparations; dentifrices; soaps; perfumery; essential oils; cosmetics; hair lotions.**
31. The ordinary meaning of a "cosmetic" is a substance applied to the face, body or hair with the intention of improving or enhancing its appearance. In my view the following terms in the applied for specification are cosmetics and therefore identical to the opponent's broad category of "cosmetics" applying the *Meric* principles: **cosmetic preparations; make up preparations; skin care treatments; moisturisers and moisturising creams; anti-ageing products,**

¹ 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].

preparations and treatments; skin conditioners; skin creams; body and beauty care preparations; hand and foot care preparations; hair, body and skin care preparations; hand care lotions; non-medicated moisturising lotions; hand care preparations; non-medicated lotions for the hands and for the body; night creams; cosmetic glitter; self tanning preparations; self tanning creams, lotions, sprays, mists; non-medicated lotions and creams, all for the care of the skin; hair conditioners; eye gel; hydrating mask; moisturiser; skin care preparations; lip balm; hand and body butter; hand and body oil; facial oil; anti-ageing serum; balms; face mask; lotions for strengthening nails; nail enamels, polish, varnish and gel; nail strengtheners and hardeners; nail glitter; nail cream, nail decolorants; nail paint (cosmetics); nail polish top and base coats; nail and nail care preparations; post shave creams and balms; hair care serum; skin tonic; non-medicated preparations for toning the skin. If my analysis as to identity is incorrect for any of these goods, they would in any event be highly similar to cosmetics, as they have the same purpose, end users, and distribution channels.

32. Again applying an ordinary meaning to the terms used, in my view the following goods fall within the opponent's wider category of "cleaning preparations" and are identical under *Meric* principles (some would also fall within, and would be identical to the opponent's "soaps"): **skin cleansers; cleansing lotions; make-up removing preparations; cleansing wipes; facial cleansing wipes; cleansing balm; cleansing mousse; cleansing oil; eye make-up remover; face wash; hair and body wash; foam wash; facial wipes; shampoos; toiletry preparations; non-medicated bath preparations; toiletries; impregnated wipes; bubble bath; nail enamel remover; nail polish remover; and non medicated toilet preparations.** Again, if I am incorrect as to the identity of any of these particular goods they would in any event be highly similar to cleaning preparations as they have the same purpose, end users, and distribution channels.
33. The following goods, in my view, fall within and are therefore identical with the earlier category of "polishing, scouring and abrasive preparations" (some could

also be considered identical with cosmetics and/or cleaning preparations): **microdermabrasion polish; body polish; face scrub; exfoliating body scrub; body scrub; gel scrub; purifying face scrub; buffing compounds; nail buffing preparations.** Again, if I am incorrect as to any of these particular goods they would in any event be highly similar based on purpose, end users, and distribution channels.

34. The ordinary meaning of perfumery would be a scent applied to the body, hair, or to a product or room to emit an aroma. It follows that the following goods fall within the opponent's "perfumery" and are therefore identical: **aftershave; room perfumes; perfumed room mist; perfumed room spray; room fragrances and scenters; and preparations, products and substances emitting a perfume or aroma for masking odours and smells.** Alternatively, they would be highly similar based on their purpose, end users and distribution channels.
35. The applicant's mark covers **aromatherapy pillows comprising potpourri in fabric containers; scented sachets room scenters in the form of waxed figures; pot pourri; incense; incense cones; incense sachets; incense spray; and incense sticks.** These are all products intended to produce a pleasant aroma in a room or an object like a bed or a clothes cupboard. They are not likely to be considered perfumes per se but they have a similar purpose and have the same end users and distribution channels. They would not be found on the same retail shelves and the goods are not generally competitive or complementary. I consider there is a medium degree of similarity.
36. **Antiperspirants and deodorants** are arguably not perfume and they are not competitive with perfume nor normally found on the same retail shelf. However, they serve a very similar purpose to perfume, they have the same end users, and trade channels. They should be regarded as highly similar. They would also be highly similar to cosmetics again based on a similar purpose, end users and distribution channels.

37. The earlier mark covers “essential oils” which are oils extracted from plants. They can be used for perfuming, massaging purposes and aromatherapy. The applied for goods of **fragrance oils; fragrance oils for scenting candles; scented oils; refresher oils for perfumes and scents; refresher oils; bath oils; aromatherapy lotions and cream and aromatherapy preparations** are therefore highly similar to essential oils bearing in mind the similar use, ingredients, method of use, end users, trade channels and some degree of competitiveness. They would also be highly similar with “perfumery” on the same basis.
38. The applied for terms of **skin care preparations for protection from the effects of the sun; lotions and creams, all for use after exposure to the sun; sun tanning preparations for the skin in the form of creams, lotions and ointments** are not, in my view, strictly cosmetics as their primary purpose is to protect or restore the skin from the effects of the sun as opposed to beautifying it. However, the products contain various moisturisers which help the skins appearance, some contain additional elements which enhance the tanning process and which are utilised for cosmetic purposes, and some cosmetics (such as foundation) themselves incorporate sun protecting elements. They have the same end users and distribution channels. The goods would not be found on the same retail shelves and they are not generally competitive or complementary. There is a medium degree of similarity.
39. **Self tanning wipes** may not be considered cosmetics given their nature as a wipe. However, they have the same purpose of enhancing the appearance of the body by applying a tan colour to the skin and they have the same end users and distribution channels. They would be found on the same retail shelves as other tanning products which are cosmetics. They are therefore highly similar.
40. **Glue for strengthening nails; adhesive for fixing false nails; nail tips; artificial nails** and **nail art stickers** likewise may not be considered to be cosmetics. However, they are highly similar bearing in mind they are all goods which are used to improve or embellish the appearance of nails and they have the same end users and distribution channels as cosmetics. They would be

found on (or very near) the same retail shelves, and are complementary with, cosmetic goods such as nail polish. Average consumers would believe them to be offered by the same or economically linked undertakings. There is a high degree of similarity.

41. **Shaving preparations** are also unlikely to be regarded as cosmetics as their purpose is to assist the shaving process rather than a direct purpose of beautification. However, they may contain ingredients that look after the skin when shaving and there is therefore some similarity in nature with cosmetics. They are likely to be sold through similar trade channels and whilst the respective goods may not be competitive, there is a complementary link with, for example, post shave cosmetics designed to sooth the skin. The average consumer is likely to believe that shaving preparations and cosmetics are offered by the same or economically connected undertakings. I find there is a medium degree of similarity.
42. The earlier mark covers “dentifrices.” The applied for goods of **preparations for the teeth; whitening gel; dental preparations** would either fall within dentifrices and would be identical or alternatively are highly similar. They serve a similar purpose of teeth cleaning, breath freshening and the promotion of dental health, and have the same end users and distribution channels. Some of the goods will be competitive with dentifrices and some will serve a complementary role.
43. **Cotton sticks for cosmetic purposes, cotton wool for cosmetic purposes and make-up pads of cotton wool** are utilised in the application or removal of cosmetics. When used for the removal of cosmetics there is similarity with the cleaning preparations within the opponent’s specification, although they are used for wider purposes than cleansing alone. There will be some competition with other cleaning preparations such as face wipes. The goods will be sold in close proximity to each other and through the same trade channels. I therefore find a medium degree of similarity with the opponent’s “cleaning preparations”. I would also find a medium degree of similarity with cosmetics on complementarity principles as the average consumer would consider it natural

to use these products in conjunction with cosmetics and would be likely to believe that the respective goods are offered by the same or economically connected undertakings.

44. **Colourant for toilet purposes** could be understood as a product placed within toilets that colours the water and has other cleaning and bleaching properties. If so, it would be identical with the opponent's wider "cleaning preparations" on *Merici* principles. If I am incorrect as to this, they would in any event be highly similar bearing in mind the similar purpose, and the same end users and distribution channels. Alternatively, it could be understood as a colourant product intended for personal use such as a hair dye. If so, it would be highly similar to the opponent's "cosmetics" bearing in mind they have the same purpose of enhancing physical appearance, and the same end users and distribution channels.

Class 5

45. There is identity of goods for **pharmaceutical preparations; sanitary preparations for medical purposes; plasters; materials for dressings and disinfectants** as the exact same terms appear in both specifications.
46. "Pharmaceutical and veterinary preparations" covers drugs, medicines and products incorporating medicated elements used for human or veterinary healthcare. It would therefore include as identical goods under *Merici* principles: **pharmaceutical creams, lotions, preparations, treatments and substances all for use on the skin or scalp; medicinal healthcare products; ophthalmic preparations and substances; impregnated pads and tissues containing medicated preparations; chemico-pharmaceutical, medical preparations, substances and treatments; medicated skincare preparations, treatments, substances, creams and lotions; medicines; medicated tissues; medicated food supplements; medicated preparations for slimming; dermatological products, preparations and treatments; chemico-pharmaceutical, sanitary and medical preparations, substances and treatments; hyaluronic acid**

preparations, substances and treatments; chemical preparations for medical, pharmaceutical, skincare and skin treatment purposes; contraceptives; pregnancy testing kits; and pharmacy products. If I am incorrect then such goods would in any event be highly similar to pharmaceutical preparations given they all serve the same health care purpose and have the same end users and distribution channels.

47. **Homeopathic supplements, pharmaceuticals and anti-inflammatory ointments** are applied for goods that incorporate a homeopathic element. Homeopathy is an alternative medicine based on the principle of administering small amounts of substances to cure the same symptoms it would cause if administered in large amounts. Given the reference to “pharmaceutical” in the term such goods would be identical with pharmaceutical preparations. If I am incorrect then they would be highly similar given they have the same purpose of improving health, they are similar in nature and have the same end users. They would have similar distribution channels via either practitioners or over the counter purchases.
48. “Dietetic food and substances adapted for medical or veterinary use” are foodstuffs and similar ingested substances devised for special nutritional requirements and that also serve a medical or veterinary purposes. This is identical to the applicant’s **dietetic substances for medical use.**
49. **Food for babies, infants and invalids** would be identical to the opponent’s “Dietetic food and substances adapted for medical or veterinary use, food for babies.” “Food for babies” is an identical term and “food for infants and invalids” would be considered to be dietetic food adapted for medical use and therefore identical on *Meric* grounds. If I am incorrect they would in any event be highly similar bearing in mind they serve the same purpose and have the same end users and distribution channels.
50. The opponent’s “Dietary supplements for humans and animals” are products such as vitamins, minerals, essential acids and fibre that are usually taken in a tablet or liquid form to supplement an individual’s standard diet and as a means

to consume nutrients they may otherwise be missing. The applicant's **dietary food supplements; food supplements for dietetic use; food supplements for medical purposes; mineral food supplements; health food supplements made principally of vitamins and/or minerals; vitamin preparations in the nature of food supplements;** and **vitamins** would fall within the opponent's broader term and are therefore identical on *Meric* principles. If not, they would again be highly similar bearing in mind they serve the same purpose and have the same end users and distribution channels.

51. The opponent's "sanitary preparations for medical purposes" are products which go beyond simple cleaning and have, for example, a sterilising or disinfecting purpose. They are medicinal in the sense that they are designed and used to promote hygiene, improve health and prevent illness or the spread of disease. The applicant's **hygienic products, preparations and treatments** would similarly have the purpose of keeping an individual or their surroundings clean in order to prevent illness or the spread of disease and which would incorporate a sterilising or disinfecting element. The goods would therefore be identical but, if not, there would be a high degree of similarity bearing in mind they serve the same purpose and have the same end users and distribution channels.
52. **Sanitary towels, sanitary tampons and nappies** are highly similar to "sanitary preparations for medical purposes" given they have the same hygiene purpose and promote health and wellbeing. They also have the same end users and distribution channels.
53. The opponent's mark covers "plasters, materials for dressings" which are dressings that cover and protect the body whilst it heals. This would cover the applicant's **bunion protection** and **toe supports** under *Meric* principles. If not, they would be highly similar bearing in mind their similar purposes, and the same end users and trade channels. They are likely to be found on the same shelves in retail shops.

54. **First aid boxes** are likely to contain a range of goods that would be found in class 5 such as, amongst other things, analgesia and antiseptic cream (which would be pharmaceutical preparations) and plasters and materials for dressings. They would have the same end users and the same healthcare purposes. They would not be in competition and may not be found on the same retail shelves. The channels to market would overlap but would not be identical. First aid boxes would also be complementary as there is a close connection between the goods and the average consumer is likely to consider that first aid boxes would be produced by the same or economically linked undertakings to those producing pharmaceutical preparations or plasters and materials to dressings. They are therefore similar to “pharmaceutical preparations” or “plasters and materials for dressings” to a medium degree.

The average consumer and the purchasing act

The average consumer – the legal principles

55. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods in play. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 Schufabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Bliss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that

constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

The average consumer – the parties’ submissions

56. The opponent, in their initial submissions of 15 February 2018, submitted that the average consumer would be a member of the public as well as health professionals. They submitted the goods would be sold in retail outlets, through catalogues, online and additionally pharmaceutical preparations may be sold over the counter, on prescription, or via the internet. They observed the cost can vary but routine items tend to be relatively low cost. In the main they favoured the average consumer paying a low degree of attention. In their second submissions of 18 July 2018 the opponent again argued the average consumer is likely to pay a low or average degree of attention to the goods, based on the applicant’s statement that their primary goods of interest are skincare products. The submission is also based on the perceived pricing of the applicant’s goods apparently publicised by their CEO as an affordable skincare range. They argue that the goods are everyday low cost items, frequently bought.
57. In their final submissions the opponent similarly argues that the majority of the goods are every day, routine purchases typically at a low to modest cost and often bought off the shelf or online. In these submissions they favour an average or normal degree of attention being paid by the average customer.
58. The applicant, in their submissions of 23 April 2018, dispute that the average consumer will pay a low degree of attention, particularly for pharmaceutical, medicinal and medicated products in class 5. They observe that the average consumer will take great care when choosing a skincare product to make sure it is the right product for their skin type or for any allergies they may have. They submit that greater care will also be taken with pharmaceutical products due to the inherent health risks in selecting the wrong product. They therefore submit that overall the average consumer will pay a high degree of attention.

59. The applicant has not limited their specification to skincare goods alone. The application is for a wide specification as set out above. I must therefore address the whole specification applied for.

The average consumer – findings

60. The class 3 goods are in the fields of cosmetics, toiletries, perfumes and cleaning products. The applicant's class 5 specification also includes some common personal care items such as ladies' sanitary products, nappies plasters, sanitary preparations for medical purposes and disinfectants. Although the cost of these goods can vary, these goods are not, generally speaking, highly expensive and they will be purchased fairly frequently. Whilst I note the applicant's submission that for products such as skincare creams a consumer will take care to choose an appropriate product, I do not believe that raises the degree of attention to high for such products. Nor do I agree it will be a low degree of attention as originally, at least, submitted by the opponent. The purchase of those type of goods will be a normal, reasonably considered process with an average degree of attention paid².
61. These types of goods will most often be self-selected from a shelf in a retail shop such as supermarkets and pharmacies (or online equivalents) and the marks may be seen in advertising and websites. The visual impact of the marks for these type of goods will be the most important, although I do not completely rule out aural considerations.
62. Some of the parties' goods are pharmaceutical or medicinal in nature which would include goods prescribed by a medical practitioner and over-the-counter or self-selected goods. The opponent did not address in their submissions the impact this would have on the analysis of the attention paid by the average

² See similar conclusions reached in *Tetra Pharm (1997) v EUIPO [SeboCalm]* [2017] T-441/16 at [34] and [35].

consumer during the purchasing process.³ In *Mundipharma AG v OHIM*, Case T-256/04, the General Court accepted that there were two groups of relevant consumers for pharmaceutical products, namely health care professionals and the general public, bearing in mind some products would be supplied on prescription and some bought over the counter without a prescription.

63. Where goods are supplied on prescription there will be a higher degree of attention paid than the norm when they are prescribed by a medical professional and subsequently checked by a pharmacist⁴ before they are passed to the end consumer. End consumers are also likely to display a higher degree of attention than the norm when the products in question are prescribed, bearing in mind they are pharmaceutical products⁵.
64. Where pharmaceutical goods are sold without prescription and are bought over the counter or self selected from a retail shelf (or online equivalent), the average consumer is still likely to pay a higher than average (but not the highest) degree of attention.⁶ Even where they are low cost, the level of attention paid will take into account ingredients, side effects, dosage, and the appropriateness for the condition in question given these are products that affect their health. The degree of attention paid will generally therefore be higher than that paid for non-medicated cosmetic goods.
65. The same degree of attention (above average but not the highest) is also likely to be paid for the goods in class 5 that may not be pharmaceutical as such but will still be purchased for a health purpose⁷. This would apply to goods such as, inter alia: first aid boxes; materials for dressings (and their equivalents); dietary supplements for humans and animals (and their equivalents); food for

³ The opponent referred to two EUIPO cases B1996175 and B1673634 however, these decisions are not binding upon me and in any event they did not concern pharmaceutical products but were concerned with everyday consumer goods.

⁴ See *Armour Pharmaceutical Co v OHIM*, Case T-483/04 at [79]

⁵ See *Bionecs GmbH v OHIM* [2015] T-262/14 at [17]

⁶ See *Aventis Pharma SA v OHIM* Case T-95/07 at [29] and the case law referred to there.

⁷ See *Bionecs GmbH v OHIM* [2015] T-262/14 at [19]

babies, infants and invalids; and hygienic products, preparations and treatments.

66. Prescribers are likely to encounter the marks in medical journals/catalogues and discussions with pharmaceutical sales representatives. The general public would learn about products through displays on shelves, on the internet, advertisements, word-of-mouth, and consultations with medical professionals and pharmacists. Bearing all of this in mind, I find that both visual and aural considerations are important in relation to both users when purchasing these types of class 5 goods⁸.

Comparison of trade marks

67. 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 them, 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.”

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

⁸ See *Tetra Pharm (1997) v EUIPO [SeboCalm]* [2017] T-441/16 at [59].

69. The trade marks to be compared are:

Earlier Mark:

EU1104365 (a word mark)	DERMAVEEL
----------------------------	------------------

Applied for Mark:

UK3229058 (a word mark)	DERMAWELL				
UK3229070 (a series of 5 stylised marks)	DERMAWELL				
	1	2	3	4	5

Overall Impression

The parties' submissions

70. In terms of overall impression, the opponent argues the competing marks have a high degree of similarity, based on the phonetic, visual and conceptual points of view. In summary, they point out that the word elements of the competing marks contain DERMA as an identical prefix and that this has significance as generally consumers will pay most attention to the start of a mark. They argue the differences in the suffixes are limited and will be masked by the fact they are within long words. They argue that the competing marks both share a connection with matters relating to the skin due to the common element DERMA which is important to the overall impression.

71. The opponent also argues that, due to the presentation of the stylised marks, the W could be mistaken for a V. If so, the average consumer would see the word DERMAVELL, giving an overall impression that is even closer to their earlier mark. They submit that the remaining stylisation of the applied for stylised marks do not detract from the overall impression given by the word element in the marks. They state that the whole word, DERMAWELL, is descriptive whereas their mark, DERMAVEEL, stands out as distinctive due to its made up suffix.
72. The applicant, in summary, denies that the average consumer will pay more attention to the common prefix arguing that consumers are used to seeing DERMA prefixed marks in relation to the subject goods. They argue that consumers will pay attention to the differences in suffixes when forming an overall impression. They argue that this is particularly so as their suffix is the word WELL which will be immediately recognised by the UK consumer. They submit that in the stylised marks the W will clearly be seen as W. They state that the overall impression taken from their applied for marks will be the concept of “healthy skin” whereas the opponent’s mark overall has no meaning. They submit that the stylisation of the stylised marks further distinguishes them in terms of overall impressions.
73. The applicant further argues that DERMA is common as a prefix in UK trade mark registrations and in the UK marketplace in classes 3 and 5, as it refers to the skin. They state there has been a dilution of rights in the prefix DERMA such that it lacks distinctiveness and the opponent therefore cannot successfully claim similarity between the subject marks based on the commonality of the prefix.

Overall impression – The earlier mark

74. The opponent’s trade mark consists of the word DERMAVEEL. VEEL will not suggest any meaning to the average consumer. The average consumer is likely to understand the element DERMA as referring to the skin and, as such,

will recognise that the mark comprises the word/prefix DERMA combined with another word/suffix with no particularly meaning.

75. In my view, notwithstanding the fact that the element DERMA is strongly allusive or descriptive of some of the goods, due to its position at the start of the word mark, its longer syllabic length, and bearing in mind it is the recognisable element of the earlier mark that has some conceptual meaning, it forms part of the overall impression of the mark. VEEL is a shorter element at the end of the mark which also forms part of the overall impression. In my view, neither of the two elements that make up DERMAVEEL are dominant or would not be noticed when the overall impression is formed. Instead, the overall impression conveyed by the earlier mark resides in its totality as a whole.

Overall impression – The applied for word mark

76. The applicant's word mark consists of the word DERMAWELL presented in block capital letters. The element DERMA will similarly be associated with the skin. The element "WELL" will be associated with a meaning of healthy or good health. Given some of the goods are in the healthcare field, the suffix itself therefore has an evocative connotation for some of the goods. Combined, the word elements will evoke a meaning of "healthy skin." Neither of the two word elements independently dominate the mark. The overall impression resides in the totality of the mark.

Overall impression – The stylised marks

77. Mark number 1 is a stylised word. The first 5 letters form the prefix DERMA in black block capital letters. There then follows a suffix presented in a non-bold black standard font in capital letters. Due to the stylisation used the suffix presents itself in a way that could almost trick the eye. It could be viewed by the average consumer in several ways. First, it could be viewed as the letters WELL with the first arm of the letter W conjoining and merging with the last downward diagonal line of the letter A such that they share the same downward diagonal line. Second, it could be seen as a forward slash character followed

by the letters VELL, making up a 5 character suffix (/VELL). Third, particularly for those average consumers who find the presentation more akin to a trick of the eye, it could be seen as the letters VELL.

78. If perceived as the word DERMAWELL, mark 1 will convey the same meanings as the word mark. The stylisation of mark 1 draws attention to the DERMA element due to its bold type face, but not to the extent that the WELL or the overall conceptual meaning are lost. The stylisation does, however, contribute to the overall impression, albeit not as strongly as the word per se.
78. For marks 2 to 5, and again from the perspective of those that see the marks as DERMAWELL, the stylisation is added to by coloured background blocks. These are likely to be seen as a background decorative element and are not a dominant component but do still play a role in the overall impression. Attention is drawn to the DERMA element by way of the bold white type face. Due to the colour blocking the WELL element stands out less than it does for stylised mark 1. However, this is not to the extent that the WELL would be ignored or the overall conceptual meaning lost.
79. For the average consumer who perceives the stylised marks as DERMAVELL or DERMA/VELL, VELL will not suggest any meaning. DERMA will be associated with skin and is a recognisable element of the earlier mark that has some conceptual meaning. Due to its position at the start of the word mark, its two syllabic length, and the fact that the stylisation of the marks does draw attention to the DERMA element, it clearly plays a role in the overall impression. VELL is at the end of the mark and despite it being presented with less significance, it still forms part of the overall impression made on the average consumer. Both word elements play a role in the overall impression (DERMA having slightly more emphasis given that it is emboldened) and the word elements together as a whole play the greater role in the overall impression. The remaining stylisation plays a lesser role.

Visual Comparison

Visual Comparison - The parties' submissions

80. The opponent submits that visually the word marks are highly similar, both containing "DERMA" as an identical prefix and both containing 9 letters with 7 in the same order. Looking at the applied for stylised marks the opponent submits that the word element is stylised with the letters A and W conjoining, such that the W could be perceived as the letter V instead. They submit that DERMAVELL would be the natural reading of the stylised applied for marks, thereby rendering it closer to DERMAVEEL. They submit the remaining stylisation of the marks does not detract from the word element of the mark and that the coloured blocks would be seen as non-distinctive background to the word element.
81. The applicant denies that consumers will pay more attention to the prefix DERMA, arguing that consumers are used to seeing DERMA prefixed marks in relation to the subject goods. They submit that the average consumer will pay attention to differences in the suffixes, particularly so where their suffix is the word WELL which will be immediately recognised by the UK consumer. They submit that the differences between the suffixes will lead to the marks being visually distinguished and that the stylisation of the stylised marks further distinguishes them.

Visual Comparison - The word marks

82. The opponent's trade mark consists of 9 letters "DERMAVEEL" presented in block capital letters. The applicant's word mark application consists of 9 letters "DERMAWELL" presented in block capital letters. Visually, there is an obvious point of similarity due to the presence in both marks of the common element of the 5 letter prefix DERMA.
83. The suffixes are both 4 letters in length with the letters E and L in the same position as the second and fourth letters. The first letter of the suffixes is

different being a V and an W respectively. The third letter is also different (E compared with an L). Of course, I bear in mind that the assessment would not be made by separately comparing the prefixes and suffixes, as it is the whole of the marks that must be considered. In totality, however, the differences between WELL and VEEL are still apparent in the whole mark comparison. Overall, there is a medium degree of visual similarity between the word marks.

Visual Comparison – stylised mark 1

84. Whichever way the suffix is viewed, the prefix DERMA, looking at it solely from a visual perspective, stands out more because of the bold type font used. This prefix is the common element with the earlier mark and therefore produces a degree of visual similarity irrespective of how the suffix is perceived.
85. For the average consumer who sees the suffix as WELL the similarities and differences in the letter patterns are as set out above in the word mark comparison. The applied for mark has the additional element of letter stylisation which does produce a further degree of visual difference. There is therefore a slightly lower (but not the lowest) degree of visual similarity when the applied for stylised mark 1 is viewed as DERMAWELL than the visual similarity found when comparing the word marks with no stylisation.
86. For the average consumer who sees the suffix as VELL, there is a heightened degree of visual similarity as 3 of the 4 letters of the suffix are the same (VE*L). The start of the suffix will be seen to have the same letter “V”. For the average consumer who sees the suffix as /VELL there is also a heightened degree of visual similarity as there are 3 identical letters when comparing the 4 and 5 letter suffixes respectively: (VEEL compared with /VELL). Whilst the additional stylisation adopted produces some visual difference, there is overall a reasonably high degree of visual similarity between the marks as a whole.

Visual Comparison - stylised marks 2 to 5

87. The applied for stylised marks numbered 2 through to 5 have that same stylisation of the letters/characters with the same range of possible perceptions of the suffix as for stylised mark number 1. Here, however, the letters are in a white bold font (for DERMA) or white standard font (for the suffix) set in the centre of different coloured blocks of black, yellow, pink and light blue.
88. The coloured blocks form a background to the lettering, and the stylisation of the lettering together with its white colour are all visual differences compared with the earlier word mark which are more than negligible. However, the word element still plays the greater visual role in those stylised marks. Overall, in my view there is likewise a slightly lower (but not the lowest) degree of visual similarity with the earlier word mark if the suffix is viewed as WELL compared with the word mark comparison. There is also still a reasonably high degree of visual similarity if the suffix is viewed as VELL or /VELL, albeit for both there is slightly less similarity than the assessment made with stylised mark 1.

Aural Comparison

Aural comparison – the parties’ submissions

89. The opponent submits that aurally the signs are highly similar. They argue both are pronounced with the opening prefix DERMA and it is significant there is a shared identical beginning. In their first submissions the opponent submitted that the marks all end with an “ul” sound. In their final submissions they say it is an “el” sound. In any event, they argue both the beginning and end of the marks are aurally identical. They state that any aural differences between the “VEEL” and “WELL” are masked within the long marks as a whole and they are sufficiently close phonetically for one to be imperfectly recalled as the other.
90. The opponent also submits that the applicant’s stylised marks could be pronounced as DERMAVELL and not DERMAWELL due the average

consumer articulating the marks in a way that reflects the different ways in which the mark could be read as a result of the stylisation adopted, as set out above. They argue this would increase the aural similarity.

91. The opponent further argues that German, Indian and Polish residents of the UK would pronounce all of the applied for marks as DERMAVELL as they would pronounce the W in DERMAWELL as a V. They rely on the evidence exhibited by Ms Wong as to the number of German, Indian and Polish residents of the UK which added together they submit amounts to 2.4% of the UK population (equivalent to half the population of Wales).
92. The applicant counters that the number of nationals living in the UK who may pronounce a “W” as a “V” are insignificant compared to the total UK population. They submit that the majority of the UK population would pronounce the suffixes as VEEL and WELL respectively and that the marks are aurally dissimilar. They argue that in the stylised marks that the W can clearly be seen and would be recognised and pronounced as the word WELL, as it would be immediately recognised as an everyday word.

Aural Comparison - The word marks

93. Aurally the average consumer is likely to vocalise the earlier mark as the 3 syllable word DER-MA-VEEL with the last syllable rhyming with the word “eel.” The average consumer is likely to vocalise the applied for word mark as the 3 syllable word DER-MA-WELL. I agree with the applicant that the “WELL” will be pronounced as the standard English word. The first two syllables making up the prefix DER-MA are therefore identical. The endings are aurally different apart from the fact the last syllables finish off with a “l” sound. Those last syllables do, however, overall have a different sound to them. The final syllable of the earlier mark starts with the letter V and has the long double E sound as in “eel”. The applied for word mark starts with a W and a duller overall sound with its “ell” ending. There is a medium degree of aural similarity between the word marks.

94. Whilst the opponent has provided some statistical evidence about the number of Polish, German and Indian nationals living in the UK they have not provided evidence that such nationals would pronounce the “W” as a “V” sound instead. This is not something that I can take judicial notice of. In any event, even if I accept that such individuals make up 2.4% of the UK population I do not agree that is such a significant proportion that it would establish and define a particular category of consumers targeted by the contested trade mark application.⁹

Aural Comparison – The stylised marks

95. The stylisation of the marks or the coloured blocks in marks 2 through to 5 are not likely to be vocalised. For the reasons set out above the stylised marks are likely to be vocalised by the average consumer as either DER-MA-WELL or DER-MA-VELL depending on how they read and then enunciate the stylisation of the A and the W. Above I also identified that some average consumers may perceive the stylised marks as containing a forward slash: DER-MA-/VELL. For those that do so they are unlikely, in my view, to vocalise the “/”. They are likely to vocalise it as DER-MA-VELL.
96. For the average consumers who articulate the stylised marks as DERMAWELL there is a medium degree of similarity with the opponent’s mark.
97. For the average consumers who see a V in the stylised marks, I do not believe that the fact that “WELL” is a recognisable English word and that “VELL” is not would prevent them pronouncing it as VELL. If the average consumer thinks there is a letter V, they will pronounce it as such.

⁹ See, by way of analogy the decision in *Hipp & Co KG v OHIM* [2012] T-41/09 where the individuals who could speak Croatian in the relevant public of Germany, Austria and Italy was not sufficient to establish a particular category of consumers. See also *Case T-286/02 Oriental Kitchen v OHIM - Mou Dybfrost (KIAP MOU)* [2003] ECR II-4953, paragraph [33] to [35] and [41] .

98. For those average consumers pronouncing the applied for stylised marks as DERMAVELL, the first two syllables making up the prefix DER-MA remain identical in the enunciation of the competing marks. There are similarities in the word endings as both start with the phonetic “V” sound and end with the “L”. The aural difference lies in the middle of the third syllable with the earlier mark having the long double E sound whereas “VELL” will be vocalised with the duller “ell” ending. Overall there is a reasonably high degree of aural similarity between the earlier mark and the applied for stylised marks for those average consumers who would vocalise the mark as DERMAVELL.

Conceptual comparison

Conceptual comparison – the parties’ submissions

99. The opponent argues that the respective marks share a connection with matters relating to the skin due to the common prefix which provides conceptual similarity.
100. The applicant submits that DERMA is another term for skin. They state that “WELL” is defined as “in good health.” The applicant therefore argues that the conjoining of the two words will bring to mind the concept of “healthy skin.” They argue that as the prefix DERMA is common for the goods in question, the average consumer’s attention would be drawn to the endings and therefore drawn to the differences between VEEL and WELL. They submit that VEEL is meaningless as compared with the applied for mark where both WELL and the whole “DERMAWELL” will evoke a meaning. They submit that this overarching meaning will be immediately apparent and will distinguish the mark from the meaningless “DERMAVEEL.” They argue the marks are conceptually dissimilar.
101. The applicant also argues that the prefix DERMA is common in UK trade mark registrations and in the UK marketplace in classes 3 and 5 as it refers to the skin. They argue that there has been a dilution of rights in the prefix DERMA

such that it lacks distinctiveness and the opponent therefore cannot claim similarity between the subject marks based on the commonality of the prefix.

Conceptual comparison - The word marks

102. Both marks contain the prefix DERMA. This is likely to be understood by the average consumer as relating to the skin. In the earlier mark, the suffix VEEL will have no meaning for the average consumer. DERMAVEEL as a whole will therefore not have a conceptual meaning for the average consumer. That does not, however, prevent the average consumer taking some conceptual meaning from the prefix. Whilst the average consumer will not analytically unpick a mark to find a meaning in it, they will also notice that part of a mark that easily offers some conceptual meaning. Here the DERMA element will be strongly suggestive/descriptive of some of the goods. Even for those goods where it is not directly descriptive it will still provide an evocative connotation and some meaning.¹⁰
103. For the applied for word mark DERMAWELL, the average consumer will understand the suffix WELL as meaning in good health, or healthy. The suffix therefore has its own evocative connotation for many of the goods in play that relate to healthcare in its own right. It is also an easily recognisable standard English word. The average consumer is likely to pick up on an overall conceptual notion of “healthy skin”, which will be descriptive of some of the goods and have a noticeable overall conceptual evocative connotation in any event.
104. The applied for mark therefore has its own overall conceptual notion of “healthy skin”, which the earlier mark does not have. This does indicate a degree of conceptual divergence. But the marks nonetheless still share the general idea of the link to the skin and the conceptual similarity between the marks must be assessed on the basis of the evocative force that may be recognised in each of

¹⁰ See *Usinor SA v OHIM* T-189/05

them as a whole¹¹. Overall, therefore, there is a low degree of conceptual similarity.

105. With regard to the applicant's argument that the lack of distinctiveness of the DERMA element prevents any conceptual similarity arising, this is something more to be taken into account when assessing likelihood of confusion in due course.

Conceptual comparison - The stylised marks

106. For those average consumers who view the stylised marks as DERMAWELL, there is the additional stylisation of the marks. But, the graphic design of the stylised marks is not particularly striking in the sense that it will have any significant affect upon the conceptual meaning evoked by the marks. There is therefore still a low degree of conceptual similarity.
107. For those average consumers who perceive the stylised marks as DERMAVELL or DERMA/VELL, the applied for marks lose their overarching concept of "healthy skin." The comparison is then between two marks with the common prefix of DERMA (which will invoke the notion of relating to the skin), both combined with meaningless suffixes. The remaining stylisation of the stylised marks again does not significantly alter their conceptual view. DERMA is suggestive/descriptive of some but not all of the goods and, in any event, provides the same, and only, evocative connotation in all the marks. Again, the fact it is descriptive for some of the goods is to be taken into account when assessing likelihood of confusion. Overall there is a medium degree of conceptual similarity.

¹¹ See *Usinor SA v OHIM* T-189/05 and *Zero Industry SiL v OHIM* T-400/06 at [63]

Distinctive character of the earlier trade mark

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

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

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

109. The opponent does not claim enhanced distinctiveness so I need only consider the inherent position. The opponent submits that the earlier mark is not descriptive, laudatory or allusive and therefore it has a normal degree of inherent distinctiveness.

110. The applicant submits that the prefix DERMA lacks distinctiveness, that third parties commonly use the prefix in the UK register and the UK market place such that there has been a dilution of rights in the prefix. The applicant relies on the evidence summarised at paragraphs 7 to 14 above. In response the opponent argues that state of the register evidence is not relevant. In relation to third party use of DERMA in the market place they make the responses to the applicant's evidence set out at paragraphs 15 to 17 above. In summary, they argue that the applicant's evidence includes owners who are no longer in existence, marks which do not actually have DERMA as the prefix, and marks which are further away from the competing marks such that they are of no relevance.
111. It is a rough rule of thumb that invented words usually have the highest level of distinctiveness; words which are allusive of the goods usually have less. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:
- “73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).“
112. It is clear from such case law that the fact that that the element DERMA may be found in a number of trade marks on the UK or EU registers is not enough

by itself to establish that the distinctive character has been weakened because of its frequent use in the classes at play. That is simply state of the register evidence that does not show actual use of the marks in the market place.

113. The additional evidence submitted shows around 6 to 8 other marks in the UK in use that contain the prefix DERMA in the same classes in play here. However, this evidence is not without its flaws given that it cannot be placed before the relevant date and, further, the significance of use and the impact it will have had on the average consumer is difficult to determine. That said, it does reinforce in my own mind the conclusion I have already reached that DERMA is likely to be perceived and understood as relating to the skin. It therefore has a meaning that is descriptive or highly allusive of some, but not all, of the opponent's goods many of which are related to beauty care, personal care and skin care and its use overall produces an evocative connotation.
114. The element VEEL is more distinctive as the average consumer would view it as a made-up word. The term DERMAVEEL as a whole also does not have a meaning. Overall the earlier mark has an average degree of inherent distinctive character.

Likelihood of confusion

The legal principles

115. The factors considered above have a degree of interdependency (*Canon* at [17]), so that a higher degree of similarity between the goods may offset a lower degree of similarity between the marks, and vice versa. I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

116. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*; Case BL O/375/10 Mr. Iain Purvis Q.C., sitting as the Appointed Person, explained these types of confusion as follows:

“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 recognised 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).”

117. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr. James Mellor Q.C., as the Appointed Person emphasised that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules.¹² The categories of case where indirect confusion may be found are not closed. Each case must be assessed on its own facts and the assessment must take account of the overall impression created by the marks. Mr Mellor Q.C. emphasised the importance of envisaging the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier. Ultimately the assessment is whether the average consumer will make a connection between the marks and assume that the goods or services in question are from the same or economically linked undertakings. He stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

Likelihood of confusion – The parties’ submissions

118. The opponent submits there is a high likelihood of confusion in the market place and that use of the mark would be likely to mislead customers that the applicant’s goods are associated with theirs. They argue that there have been identical arguments before EUIPO, citing an example of case B901407 *Dermatex v Dermatess*. They emphasise that the average consumer will not be making a careful and attentive examination, and will not be making a direct comparison and will have an imperfect picture of the marks in mind. They argue that the identical dominant element of DERMA leads to greater similarity. They submit that the average consumer may perceive the applied for marks as a sub

¹² See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

brand or a variation of the earlier mark configured in a different way according to the types of goods it designates. The target public may regard the goods designated by the contested trade mark as belonging to two ranges of goods coming from the same undertaking.

119. The opponent argues there is no evidence to show that the nature, extent or duration of trade under third party marks containing DERMA has been sufficient to test any capacity for confusion which is then found not to exist
120. The applicant argues that consumers will not pay more attention to the prefix, and will pay attention to the suffixes particularly where it is a dictionary defined word (WELL) which is immediately recognisable. They submit that the differences in suffixes lead to the marks being distinguished and the stylisation further distinguishes them. There is a further distinction due to DERMAWELL having an overall apparent meaning of “healthy skin.” They argue that taking account of the high degree of care taken by an average consumer when purchasing the goods, and the overall visual, aural and conceptual differences means there is no likelihood of confusion.

Likelihood of confusion – the stylised marks

121. I will assess firstly the applied for stylised marks for pharmaceutical related goods (and their equivalents). I bear in mind that I have found such goods will be selected, by medical professionals or the general public, with a higher degree of attention than the norm, which could mitigate to some extent, the effect of imperfect recollection.
122. The goods are identical or similar to a high or medium degree. The purchasing process covers both prescription, over the counter and off the self purchases and the process will have both visual and aural considerations.
123. I have found that the word element of the applied for stylised marks may be seen by average consumers as DERMAWELL, DERMAVELL, or DERMA/VELL. I have no evidence before me as to the propensity for the

average consumer to perceive the stylised marks in such a way. I must therefore reach my own assessment.

124. I have considered whether such average consumers are in fact less likely to “misread” the applied for stylised marks as DERMAVELL or DERMAVELL because of the nature of the goods and the higher than the norm degree of attention being paid. The “misreading”, however, is due to a trick of an eye which limits the potential for the degree of attention to act as a counterbalance. However, even if it could be argued that medical professionals, in particular, bearing in mind they are experts with specific medical knowledge, and paying a high level of attention specifically to terminology used when prescribing, may be more likely to see the applied for stylised marks as the applicant intends them to be seen (as DERMAWELL), none of the goods in the application are limited to prescription goods or to goods used by medical practitioners alone. All of the goods in the application may be directed at the general public and include goods available over the counter or on retail shelves (or online equivalents) where the consumer may well self select the goods. The position of the general public, particularly those making self-selected purchases, must therefore be considered.

125. In *Interflora Inc v Marks and Spencer plc* [2014] EWCA Civ 1402 the Court of Appeal stated:

"129. As we have seen, the average consumer does not stand alone for it is from the perspective of this person that the court must consider the particular issue it is called upon to determine. In deciding a question of infringement of a trade mark, and determining whether a sign has affected or is liable to affect one of the functions of the mark in a claim under Article 5(1)(a) of the Directive (or Article 9(1)(a) of the Regulation), whether there is a likelihood of confusion or association under Article 5(1)(b) (or Article 9(1)(b)), or whether there is a link between the mark and the sign under Article 5(2) (or Article 9(1)(c)), the national court is required to make a qualitative assessment. It follows that it must make

that assessment from the perspective of the average consumer and in accordance with the guidance given by the Court of Justice. Of course the court must ultimately give a binary answer to the question before it, that is to say, in the case of Article 5(1)(b) of the Directive, whether or not, as a result of the accused use, there exists a likelihood of confusion on the part of the public. But in light of the foregoing discussion we do not accept that a finding of infringement is precluded by a finding that many consumers, of whom the average consumer is representative, would not be confused. *To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then we believe it may properly find infringement.*

130. In the circumstances of this case we are, of course, concerned with a claim under Article 5(1)(a) (and Article 9(1)(a)) in the context of internet advertising and the question to be answered was whether the advertisements in issue did not enable reasonably well-informed and observant internet users, or enabled them only with difficulty, to ascertain whether the goods and services so advertised originated from Interflora or an undertaking economically linked to Interflora or, on the contrary, originated from M & S, a third party. In answering this question we consider *the judge was entitled to have regard to the effect of the advertisements upon a significant section of the relevant class of consumers, and he was not barred from finding infringement by a determination that the majority of consumers were not confused.*" [my emphasis]

126. In *SoulCycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch) Mr. Justice Mann, applying the above principle, found that it was permissible to consider confusion by considering different classes of average consumer who would have differing perceptions of the mark. He accepted that confusion could be considered in relation to a proportion of the class of average consumer by

reference to their perceptions of the mark, subject to them representing a significant proportion of the relevant public.

127. The stylisation of the mark, with the overlapping of the A with the W is such that in my view, even the reasonably well informed, observant and circumspect general public, when purchasing the kind of pharmaceutical goods in question and even when paying a higher than normal degree of attention may well still “misread” the stylised marks as DERMAVELL or DERMA/VELL. Here, in my assessment, the part of the general public who would view the stylised marks as DERMAVELL or DERMA/VELL is sufficiently significant that the likelihood of confusion on their part as a grouping of average consumers does need to be assessed.
128. In my view, for such a grouping of the general public that perceives the marks as DERMAVELL or DERMA/VELL, there does exist a likelihood of confusion. Here I have found there is a reasonably high degree of visual and aural similarity between the marks. 7 out of 8 letters are the same when comparing DERMAVEEL on the one hand and DERMAVELL or DERMA/VELL on the other. Both have the same two syllable prefix, DERMA. Bearing in mind the average consumer is unlikely to be making a direct comparison between the marks, and will be making a purchasing process that is subject to imperfect recall, in my view the visual and aural similarities are so high there exists a likelihood of confusion even when a higher than normal degree of attention is being paid.
129. In reaching this decision I have taken account of the fact that the conceptual similarity, whilst medium, rests only in the word DERMA which is descriptive/allusive for many of the goods at play. I have also taken account of the fact that whilst DERMAVEEL has a medium degree of inherent distinctiveness, the common element DERMA has weak distinctiveness for skincare related products and has wider evocative connotations for the goods in general. It does not, however, prevent there being a likelihood of confusion in the circumstances in question. As was said in *Hipp & Co KG v OHIM* [2012] T-41/09:

“56 In any event, it should be noted that the finding of a weak distinctive character for the earlier trade mark does not preclude a finding of a likelihood of confusion in the present case. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among many involved in such assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see Case T-134/06 *Xentral v OHIM - Pages jaunes (PAGESJAUNES.COM)* [2007] ECR II-5213, paragraph 70 and the case-law cited). Even if the component 'beb' can be considered to be descriptive of the goods in question and, therefore, the earlier mark is itself considered to be weakly distinctive, the degree of similarity between the goods covered by the marks at issue and the degree of similarity between the marks themselves, considered cumulatively, are sufficiently high to justify the conclusion that there is a likelihood of confusion (see, to this effect, judgment of 28 June 2011 in Case T-475/09 *ATB Norte v OHIM - Bricocenter Italia (Affiliato BRICO CENTER)*, not published in the ECR, paragraph 64).”¹³

130. In my view, even if I accepted that the earlier mark has a weak distinctive character by reason of the common element DERMA, the similarity between the goods in play and the visual and aural similarities are so high, including for the suffixes in question, that a likelihood of confusion must be found to exist even where a higher than the norm degree of attention is being paid
131. In making this assessment I have taken account of the additional stylised and decorative elements of the applied for marks in the stylisation of the word element and the coloured blocks in the stylised marks 2 through to 5. Whilst accepting that stylisation does play a role in the overall impression of the applied for stylised marks, it is not, in my view, again sufficient to counter the

¹³ See also similar comments in *Usinor* at [70] and [71]

visual and aural similarity between the word elements of the mark which I have found is of importance in terms of the overall impression of the marks. Even if the stylisation was noticed and recalled, this would not prevent the average consumer from assuming that the goods came from the same or economically linked undertaking.

132. Therefore there is a likelihood of confusion for the group of average consumers who perceive the applied for stylised marks as DERMAVELL or DERMA/VELL when purchasing pharmaceutical and equivalent goods. If such consumers have a likelihood of confusion when paying a higher than normal level of attention for pharmaceutical goods, it is inevitable they would also have a likelihood of confusion when paying a lower degree of attention for the other non-pharmaceutical and non health care or routine low level health care related goods identified within class 5 and the more everyday cosmetic, and cleaning type products identified within class 3.
133. As such, it must follow, in my view, that the group of average consumers who perceive the applied for stylised marks as DERMAVELL or DERMA/VELL is a sufficiently significantly sized proportion of the average consumer base in total that there exists a likelihood of confusion for the applied for stylised marks under application number 3229070.
134. The likelihood of confusion, or indeed an absence of likelihood of confusion, for the group of average consumers who would perceive the applied for stylised marks as DERMAWELL cannot change that outcome. In the words of the Court of Appeal in *Interflora Inc v Marks and Spencer Plc*, there is a significant proportion of the relevant public that is likely to be confused such as to warrant the intervention of this tribunal.
135. **The opposition to trade mark application number 3229070 therefore succeeds and its registration is refused.**

Likelihood of confusion – the word marks

136. I turn now to the competing word marks and again will first assess the purchase of the pharmaceutical goods and their equivalents within class 5. Again, the average consumer is both medical professionals and the general public, paying a higher than the norm degree of attention. Both visual and aural considerations are relevant to the selection process. The goods are identical, highly similar or similar to a medium degree.
137. I have found there is a medium degree of visual and aural similarity between DERMAVEEL and DERMAWELL and low conceptual similarity.
138. In my view, the differences here are such that there is no likelihood of direct confusion for the average consumer. Even taking account of the fact that the average consumer is not likely to be comparing the competing marks side by side and is subject to imperfect recall, in my view the different conceptual meaning that is associated with DERMAWELL is sufficient that the average consumer will notice and appreciate the difference between that applied for mark and DERMAVEEL which itself has no overall conceptual meaning. There is also less visual and aural similarity (compared to the assessment made above where the mark is perceived as DERMAVELL or DERMAVELL) which further assists the distinguishing process.
139. The average consumer, both medical professionals and members of the public, when making a purchase would notice the differences between the word marks and would not mistake or misremember the applicant's word mark for the opponent's earlier mark, or vice versa. That prohibits a likelihood of direct confusion.
140. I must also consider indirect confusion. I have found that the average consumer will recognise that the applied for mark DERMAWELL is different from the earlier mark of DERMAVEEL. The common element here is DERMA which is descriptive/allusive for some goods and produces a wider evocative meaning even for goods in the classes where it is not directly descriptive.

It is not so unusual that the average consumer would assume no other trader would use this element as part of their trade mark so that the parties must be economically linked. In my view, the distinctiveness point, coupled with the competing constructions of the respective marks, would not suggest to the average consumer that it was a sub-brand or extension of the earlier brand of DERMAVEEL, or vice versa. I have found that DERMAWELL is a word with its own conceptual meaning of “healthy skin” and that is an important element of the overall impression held by the average consumer. That difference in overall impression held by the average consumer, in my view, further avoids an instinctive reaction that the respective marks are variants or sub-brands or that overall the goods in question are from the same or economically linked undertakings. I therefore find there is no likelihood of indirect confusion.

141. The above analysis is based on pharmaceutical products with the average consumer playing a higher than average level of attention. Above I identified that the average consumer for the cosmetic and cleaning related products, and for non-pharmaceutical and non health care or routine, low level health care products would pay a normal, average degree of attention. It follows that such consumers may be more prone to confusion and I must consider their position.
142. In my view there still remains no likelihood of confusion between the competing word marks. Even taking into account the lower level of attention paid, in my view the visual differences, combined with the conceptual differences remain sufficient that the average consumer is likely to notice the differences between the marks and not mistake or misremember them, even taking account of imperfect recall. For the same reasons set out above I also do not find a likelihood of indirect confusion for these types of goods.
143. The opponent in their submissions address the question of concurrent use and argue that the principle cannot apply as there is no evidence that the parties have traded in circumstances that suggest consumers have been exposed to both marks and have been able to differentiate between them without confusion as to trade origin. I do not in fact understand the applicant to have

been arguing concurrent trading between the parties. My understanding is their arguments related to the ability of DERMA to act as an indicator of commercial origin given it is descriptive or allusive nature for many goods in play and is (on their argument) a term that is in wider use for goods in the classes in general by third parties. I have addressed that argument at appropriate places above. However, for completeness I confirm that I have not been presented with any evidence of concurrent trade without confusion between the specific parties here and my decision is not based upon such arguments.

Conclusion

144. For trade mark application number 3229070 the opposition has been successful and the application will be refused.
145. For trade mark application number 3229058 the opposition has been unsuccessful and the application can proceed to registration.

Costs

146. The proceedings were joined early on and both parties have achieved a measure of success in their arguments. I therefore decline to make a costs award in favour of either party and direct that each party bears their own costs.

Dated this 26th day of November 2018

**Rachel Harfield
For the Registrar
The Comptroller-General**